UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79239023

MARK: THE HEAT COMPANY

79239023

CORRESPONDENT ADDRESS:

The Heat Company Aktivwärme- und Aktivkühlprodukte GmbH Enns park 20 A-5541 Altenmarkt im Pongau AUSTRIA

APPLICANT: The Heat Company Aktivwärme- und; Aktivk

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A
CORRESPONDENT E-MAIL ADDRESS:

CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspko.gov/trademarks/teas/response_forms.jsp

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1418619

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. *See* 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Section 2(e)(1) Refusal Merely Descriptive
- Identification of Goods

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE

Registration is refused because the applied-for mark merely describes a feature, function or purpose of applicant's goods. Trademark Act Section 2(e) (1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 et seq.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); see, e.g., In re TriVita, Inc., 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); In re Steelbuilding.com, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 543 (1920)).

Determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. See In re The Chamber of Commerce of the U.S., 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing In re Bayer Aktiengesellschaft, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. In re Bayer Aktiengesellschaft, 488 F.3d at 963-64, 82 USPQ2d at 1831.

Applicant has applied to register the mark THE HEAT COMPANY (in standard characters) for "Heating pads for therapeutic purposes" in

International Class 10, "Heating pads for warming other than for medical purposes" in International Class 11 and "Clothing; gloves [clothing]" in International Class 25.

The attached Internet dictionary evidence from httpl://www.ahdictionary.com/word/search.html?g=beat shows that the term "HEAT" refers to "the sensation or perception of ... warmth or hotness" and means, in verb form, "to make warm or hot."

Applicant's goods are identified as heating pads for both therapeutic and non-medical purposes as well as clothing and gloves. As demonstrated by the attached Internet dictionary evidence from https://www.dictionary.com/browse/beating-pad?r=66, a heating pad is a flexible fabric-covered pad containing heating elements for applying heat to the body. Thus, when considered in connection with applicant's heating pads in International Classes 10 and 11, the term "HEAT" in the mark immediately describes the function or purpose of these goods, namely, to transfer warmth or heat to one's body.

With regard to applicant's gloves and other clothing items, the attached Internet evidence shows that these items are commonly sold with heating elements or other technologies to help provide heat to wearers. Applicant's clothing items are identified broadly such that it is presumed that they contain technologies or elements used to provide heat to those wearing them. Thus, the term "HEAT" in the mark immediately describes a feature of applicant's clothing items, namely, that they feature elements to provide heat to wearers.

The addition of the entity designator "COMPANY" in the mark does not detract from the overall descriptiveness of the mark. Business type designations and abbreviations such as "Corporation," "Inc.," "Company," "LLC," and "Ltd." or family business designations such as "& Son's" or "Bros." merely indicate applicant's business type or structure and generally have no source-indicating capacity. TMEP §1213.03(d); see, e.g., Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U.S. 598, 602-03 (1888); In re Piano Factory Grp., Inc., 85 USPQ2d 1522, 1526 (TTAB 2006); In re Patent & Trademark Servs., Inc., 49 USPQ2d 1537, 1539-40 (TTAB 1998).

Similarly, the addition of the leading term "THE" to the mark fails to obviate the descriptiveness of the mark as a whole. Adding the term "the" to a descriptive or generic term generally does not add any source-indicating significance or otherwise affect the term's descriptiveness or genericness. See In re The Place Inc., 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive of restaurant and bar services; "the definite article THE... add[s] no source-indicating significance to the mark as a whole"); Conde Nast Publ'ns Inc. v. Redbook Publ'g Co., 217 USPQ 356, 357, 360 (TTAB 1983) (holding THE MAGAZINE FOR YOUNG WOMEN a "common descriptive or 'generic' name of a class or type of magazine" and incapable of indicating source; "[t]he fact that the slogan also includes the article 'The' is insignificant. This word cannot serve as an indication of origin, even if applicant's magazine were the only magazine for young women."); In re The Computer Store, Inc., 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive of, and the common descriptive name for, computer-related services); see also In re G. D. Searle & Co., 143 USPQ 220 (TTAB 1964), aff'd, 360 F.2d 1966, 149 USPQ 619 (C.C.P.A. 1966) (holding "THE PILL" a common descriptive name for pharmaceutical preparations in tablet form, and thus does not serve as an indicator of source or origin in applicant).

In sum, applicant's mark is merely descriptive because consumers are likely to perceive the proposed mark as describing feature, function or purpose of applicant's goods rather than the source of the goods. Accordingly, registration is refused pursuant to Section 2(e)(1) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

IDENTIFICATION OF GOODS

The word "clothing" in the identification of goods in International Class 25 is indefinite and too broad and must be clarified because the word does not make clear the nature of the goods and could identify goods in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although clothing can be classified in international classes other than International Class 25 (e.g., International Classes 9, 10, and 18), any modification to the identification must identify goods in International Class 25 only, the class specified in the application for such goods. See TMEP §1904.02(c)(ii).

Examples of acceptable identifications for clothing in International Class 25 include the following: "shirts," "shorts," "pants," "coats," "dresses," "skirts," and "socks." Applicant may also amend the identification by inserting the word "namely," after "clothing" and then listing the specific types of clothing items.

In addition, the wording "heating pads for warming other than for medical purposes" is indefinite because it fails to specify the particular type or method of activation of the heating pads. Applicant should specify whether the heating pads are electric, chemically activated, and/or microwaveable, or otherwise describe the method of activation of the goods.

Please see the suggested amendments below. Applicant should note that any wording in **bold**, in *italics*, and/or in ALL CAPS below offers guidance or shows the changes being proposed for the identification of goods. If there is wording in the applicant's identification of goods which should be removed, it will be shown with a line through it such as this: strikethrough. When making amendments, applicant should enter them in standard font, not in **bold**, in *italics*, and/or in ALL CAPS.

Applicant may adopt the following identification of goods, if accurate:

International Class 10: Heating pads for therapeutic purposes

International Class 11: ELECTRIC heating pads for warming other than for medical purposes

International Class 25: Clothing, NAMELY,	{specify types of clothing items in International Class 25 only, e.g., shirts,
pants, jackets}; gloves BEING {clothing}	

See TMEP §1402.01.

Applicant may amend the identification to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and/or services may not later be reinserted. *See* TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable <u>U.S. Acceptable</u> <u>Identification of Goods and Services Manual</u>. See TMEP §1402.04.

RESPONSE GUIDELINES

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see "Responding to Office Actions" on the USPTO's website.

If applicant does not respond to this Office action within six months of the issue/mailing date, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. See 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. See 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. See 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Tradenark Electronic Application System (TEAS) with a \$100 fee. See 37 C.F.R. §§2.6(a)(15)(ii), 2.66(a)(1), (b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. See 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. See 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; *see* 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a) (1)-(2). Such designations may be filed online at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

/J. Evan Mucha
J. Evan Mucha
Examining Attorney
Law Office 106
(571) 270-1989
evan.mucha@uspto.gov

date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail <u>TEAS@uspto.gov</u>. For questions about the Office action itself, please contact the assigned trademark examining attorney. E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.



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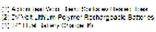
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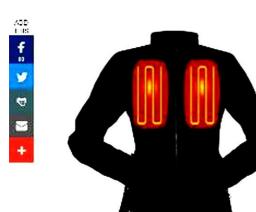
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We only offer the best heated apparel that hold up to our standards, so if you don't see it listed here, it didn't pass the test!

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Battery Heated All Purpose Gloves

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SALE SILE \$159."

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Wyvern Wemens 3 Zone Heated lacket, Endoavor

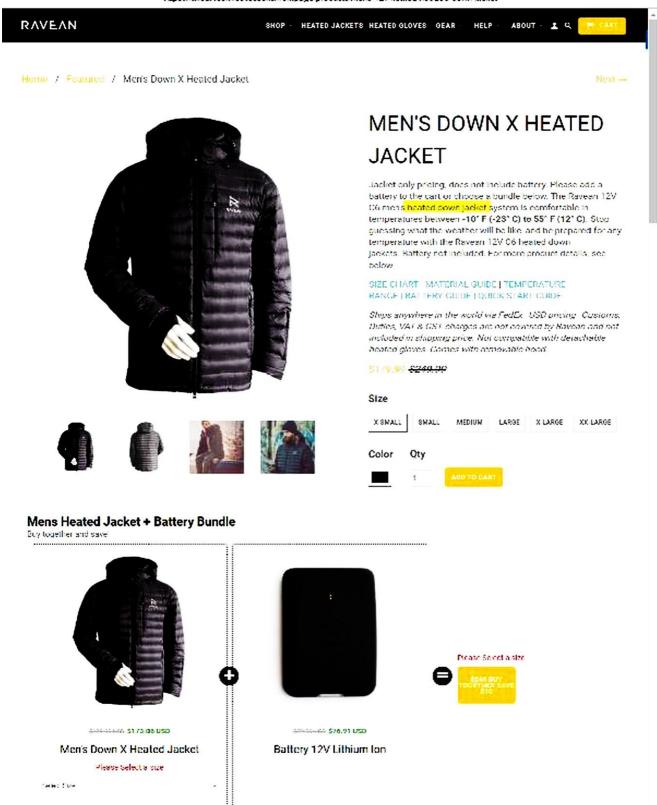
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