

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

U.S. APPLICATION SERIAL NO. 79250577

MARK:

79250577

CORRESPONDENT ADDRESS:

Bayerische Motoren Werke
Aktiengesellschaft
AJ-55
80788 München
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CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_form.jsp

APPLICANT: Bayerische Motoren Werke Aktiengesellschaft ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO.:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1446562

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.

Search for Conflicting 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).

Summary of Issues

SUMMARY OF ISSUES:

- Requirement -- Identification of Goods
- Requirement -- Inquiry -- Unclear if Mark is Two- or Three-Dimensional and Description of the Mark
- Requirement -- Inquiry -- Request for Product Information and Manner of Use and/or Intended Use of the Mark

Requirement -- Identification of Goods

The identification of goods is indefinite because it uses broad categories of goods that must be further clarified by providing the common commercial name of the goods. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may adopt the following identification, if accurate:

"motor vehicles, namely, <specify type, e.g., automobiles, vans, sport utility vehicles, trucks>," in International Class 12;

"toys, games, playthings, namely, <specify items by common commercial name, e.g., toy vehicles and accessories therefor, board games, action skill toys>," in International Class 28.

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.S. Acceptable Identification of Goods and Services Manual*. See TMEP §1402.04.

Requirement – Inquiry – Unclear if Mark is Two- or Three-Dimensional and Description of the Mark

The drawing shows a two-dimensional image; however it is not clear from the record whether applicant is applying for (1) a two-dimensional design mark that is not trade dress; or (2) a three-dimensional mark that is trade dress for product design (i.e., the configuration or shape of the goods themselves), product packaging (i.e., the container in which the goods are sold), or a specific design feature of the product design or packaging. Thus, applicant must clarify whether the applied-for mark is intended to be a two-dimensional design or a three-dimensional configuration mark. See 37 C.F.R. §2.61(b); TMEP §1202.02(c)(i)-(c)(ii).

If applicant is applying for a two-dimensional design mark, applicant must clarify so for the record, and may amend the description accordingly. See 37 C.F.R. §2.61(b); TMEP §1202.02(c)(i)-(c)(ii).

If applicant is applying for a three-dimensional configuration mark that is trade dress, applicant must amend the description to provide a clear and concise description of the mark that does the following:

- (1) Indicates the mark is a three-dimensional configuration of the product design or packaging, or of a specific design feature of the product design or packaging.
- (2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark.
- (3) Specifies any elements that are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii).

In addition, although applicant submitted a drawing showing the mark in color with a color claim, applicant did not provide the required description that specifies where each color appears in the literal and design elements in the mark. See 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Therefore, applicant must provide this description. See TMEP §807.07(a)(ii). Generic color names must be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark, applicant must so specify in the description. See TMEP §807.07(d).

If the mark is a three-dimensional configuration, the following is suggested, if accurate:

The mark consists of a three-dimensional configuration comprising <specify, e.g., two stylized partial ovals representing the grill of a motor vehicle> with the outer portion in silver and white and the inner portion bordered in black.

If the mark is a two-dimensional design mark that is not trade dress, the following is suggested, if accurate:

The mark consists of two partial stylized incomplete oblong shapes representing <specify, e.g., the shape of a grill of a motor vehicle with the outer portion in silver and white and the inner portion bordered in black.

Requirement – Inquiry – Request for Product Information and Manner of Use and/or Intended Use of the Mark

To permit proper examination of the application, applicant must submit additional product information about applicant's goods because the nature of such goods is not clear from the present record. See 37 C.F.R. §2.61(b); TMEP §§814, 1904.02(a). The requested product information should include fact sheets, instruction manuals, advertisements and promotional materials, and/or a photograph of the identified goods. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ. Applicant must also describe in detail the nature, purpose, and channels of trade of the goods, and provide examples of the use of the mark in connection with the identified goods.

Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814. Merely stating that information about the goods and services is available on applicant's website is an insufficient response and will not make the relevant information of record. See *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

General Information for Applicant

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>.

/Michael P. Keating/
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Law Office 101
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing 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 TEAS@uspto.gov. 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 by e-mail at TrademarkAssistanceCenter@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>.