

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

U.S. APPLICATION SERIAL NO. 79249942

MARK: · SOCIAL FRIDAY ·

79249942

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APPLICANT: Zendeli Filkret

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1445165

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 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-1st 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 Results

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).

Significance of Wording

To permit proper examination of the application, applicant must provide all the following information:

Explain whether the wording in the mark "SOCIAL FRIDAY" has any meaning or significance in the trade or industry in which applicant's goods and/or services are manufactured or provided, any meaning or significance as applied to applicant's goods and/or services, or if such wording is a term of art within applicant's industry.

See 37 C.F.R. §2.61(b); TMEP §814.

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.

Mark Description Required

Applicant must submit a description of the mark, because one was not included in the application. 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies all the literal and design elements. See 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b). In this case, the drawing of the mark is not in standard characters.

The following description is suggested, if accurate: **The mark consists of 2 concentric circles within which is the wording SOCIAL forming an upper arc and the wording FRIDAY forming a lower arc and a dot at the midpoint of each side arc.**

Identification of Goods and Services

The identification of goods and/or services in the application includes unacceptably broad wording from the class heading of one or more international classes that must be clarified. See 37 C.F.R. §2.32(a)(6); TMEP §§1401.02(a), 1401.08. The USPTO considers class headings, whose sole purpose is to indicate the subject matter and general scope of each international class of goods and/or services, to be too broadly worded to identify goods and/or services in a U.S. application. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298-99 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); TMEP §§1401.08, 1402.01(c), 1402.07(a).

For amendments to identifications consisting of class headings, the scope of the identification is limited by both the ordinary meaning of the words and the international class assigned by the International Bureau of the World Intellectual Property Organization. See 37 C.F.R. §2.85(d), (f); TMEP §§1402.06(a), (b), 1402.07(a), 1904.02(c).

Accordingly, applicant must amend the class heading(s) to identify specific goods and/or services that fall within (1) the ordinary meaning of the words specified in the class heading(s), and (2) the international classification of the heading(s). See 37 C.F.R. §2.32(a)(6); TMEP §§1402.06(a), (b), 1402.07(a), 1904.02(c).

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 of the World Intellectual Property Organization 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 and/or apparel 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.

The word “headgear” in the identification of goods must be clarified because it is indefinite and too broad. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii). This word is indefinite because it does not make clear what the goods are. Further, this wording could identify goods in more than one international class.

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although headgear may be classified in international classes other than International Class 25 (e.g., International Classes 9, 10, 26, and 28), 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).

Applicant may (1) amend “headgear” to “headwear,” and/or (2) retain “headgear,” add “namely,” and then list the specific types of headgear items in that class (e.g., headgear, namely, sports caps and hats, for International Class 25). Given the overbroad nature of “headgear,” the wording after “namely” must identify the goods with sufficient specificity that it would be considered definite and properly classified absent the term “headgear.”

The identification for “game” or “games” in International Class 28 must be clarified because it is too broad and could identify goods and/or services in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. For example, “game software” is classified in International Class 9; “board games, card games, and arcade games” are classified in International Class 28; and “entertainment services, namely, providing an on-line board game” and “providing online non-downloadable game software” are services classified in International Class 41.

Therefore, applicant must specify the type of Class 28 game and, if electronic, the medium in which it is provided (e.g., electronic interactive board games for use with an external monitor in International Class 28). See TMEP §§1402.01, 1402.03.

The identification for educational services is indefinite because it does not indicate the type of educational service provided. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. For example, applicant could be providing seminars on a particular topic, analyzing educational test scores and data for others, or providing educational testing.

Applicant must specify the nature of the educational service being provided. If applicant is providing classes or similar group learning activities, the identification must specify (1) the form of the activity (e.g., classes, seminars, workshops) and (2) the subject matter or field (e.g., retirement benefits, nutrition, business management).

The identification of services is indefinite and too broad and must be clarified because it suggests both the services of providing Internet access and providing Internet content and could identify services in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.03, 1402.11(a)(ii)-(iii).

Providing multiple-user access to the Internet is a service provided by Internet Service Providers (“ISPs”) who supply the computer connection that enables computer users to access the Internet and all its data and content. See TMEP §1402.11(a)(iii). If applicant is an ISP, applicant must amend the identification to specify these services and to classify them in International Class 38. See *id.* The following format is suggested, if appropriate: “Internet service provider (ISP),” in International Class 38.

The USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A* 109 USPQ2d 1593, 1597 (TTAB2014) (citing *In re Omega S.A*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and/or services in a U.S. application to be specific, definite, clear, accurate, and concise. TMEP §1402.01; see *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d at 1597-98; *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954).

Applicant may amend the class heading(s) in the identification to the following, if accurate:

Class 25: Clothing, namely _____ [specify type of Class 25 clothing, e.g. pants, skirts, sweaters, coats]; footwear; headgear, namely _____ [specify type of Class 25 headgear, e.g. hats, caps]

Class 28: Games, namely _____ [specify type of Class 28 games, e.g. board games, dice games, role play games]; toys; namely _____ [specify type of Class 28 toys, e.g. crib toys, model cars, jigsaw puzzles, plus toys]; video game apparatus, namely _____ [specify type of Class 28 apparatus, e.g. video game consoles, video game machines]; gymnastic and sporting articles, namely _____ [specify type of Class 28 goods, e.g. gymnastic apparatus, gymnastic benches, spring boards, sleds, golf ball dispensers]; decorations for Christmas trees except confectionery and electric Christmas lights]

Class 35: Advertising services; commercial business management; commercial administration of _____ [specify type of Class 35 services, e.g. the licensing of the goods and services of others]; providing office functions

Class 38: Telecommunications services, namely _____ [specify type of Class 38 services, e.g. telecommunications gateway services]; provision of access to platforms on the Internet as well as on the mobile Internet; provision of access to portals on the Internet.

Class 41: Education services, namely _____ [specify type of Class 41 services, e.g. providing classes and seminars in the field of sports training, video production]; training in the field of _____ [specify field, e.g. soccer, basketball, singing]; entertainment services, namely _____ [specify type of Class 41 services, e.g. wine tastings, live dance performances, production of television programs]; sporting and cultural activities, namely _____ [specify type of Class 41 services, e.g. organizing community sporting and cultural events]

Class 42: Non-downloadable software for the provision of Internet platform services, namely _____ [specify function of Class 42 software, e.g. software for use in VoIP platform telephony]; scientific and technological services as well as research and design services relating thereto, namely _____ [specify type of Class 42 services, e.g. testing and analysis in the field of polymeric materials and computer networking hardware]; industrial analysis and research services, namely _____ [specify type of Class 42 services, e.g. analysis of the goods of others to assure compliance with computer industry standards]; design and development of computers and software.

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.

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp and e-mail technical questions to TEAS@uspto.gov.

WHOIS 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>.

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_form.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/>.

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