

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

U.S. APPLICATION SERIAL NO. 79251789

MARK: COMFORTMAX

79251789

CORRESPONDENT ADDRESS:

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APPLICANT: SHANDONG HONGSHENG RUBBER
TECHNOLOGY CO. ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1449562

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID PARTIAL ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL PARTIAL 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 partial refusal is the "Create/Mail Date" of the "1B-1st Refusal Note."

This is a **PROVISIONAL PARTIAL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application that **applies to only the following goods in the application:**

- non-skid devices for vehicle tires

See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional partial 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:

- Definite Identification of Goods Required – Partial Requirement
- Standard Character Claim - Advisory
- Partial Abandonment - Advisory

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).

DEFINITE IDENTIFICATION OF GOODS REQUIRED – PARTIAL REQUIREMENT

The wording "non-skid devices for vehicle tires" in the identification of goods is indefinite. This wording must be clarified because it is not clear what the devices are. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1904.02(c), (c)(ii). Accordingly, applicant must indicate the common commercial name of the devices in Class 012.

In addition, applicant is advised that while the wording "[tyres]" in "casings for pneumatic tires [tyres]" is acceptably definite, the alternate spelling for tires as "tyres" in brackets is unnecessary and duplicative. Therefore applicant is advised to delete or incorporate the bracketed spelling, or the USPTO will remove duplicative alternative spelling shown in brackets from the identification prior to registration. See generally TMEP §§1402.01, 1402.01(a).

Applicant may adopt the following wording, if accurate:

International Class 012: Tires for vehicle wheels; aircraft tires; solid tires for vehicle wheels; safety seats for children, for vehicles; non-skid devices for vehicle tires, **namely, non-skid chains and studs**; casings for pneumatic tires; pneumatic tires; automobile tires; treads for retreading tires; tubeless tires for bicycles.

Applicant should note that the bolded language above is to indicate the examining attorney's suggestions. Applicant need not amend its identification other than where specified.

In a Trademark Act Section 66(a) application, classification of goods may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §1401.03(d), 1904.02(b). Additionally, classes may not be added or goods transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Applicant may amend the identification to clarify or limit the goods, but not to broaden or expand the goods 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 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. 37 C.F.R. §2.85(f); TMEP §1402.07(a), 1904.02(c).

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.

STANDARD CHARACTER CLAIM - ADVISORY

The drawing of the mark in the Section 66(a) application appears to be in standard characters (i.e., text only with no particular font style, size, or color). However, the application does not appear to include the required claim of standard characters and will be treated as a special form drawing only. See TMEP §807.03(h). Any registration issuing from this application will thus be limited to the particular appearance and text style shown in the drawing. See TMEP §§807.04 *et seq.*

A mark registered in standard characters, however, would provide protection of a text mark in any lettering style, size, and color. See 37 C.F.R. §2.52(a); TMEP §807.03(a). A mark in the international registration and corresponding U.S. application may meet the USPTO's requirements for a standard character drawing even though no claim to standard characters was included in the application. TMEP §807.03(h). The absence of a standard character claim could be due to the differences in requirements for such claims in different countries. *Id.*

If applicant seeks to register the mark in standard characters in the United States, applicant must submit the following **two statements**:

- (1) **Under the laws of the country of the basic application and/or registration, the basic application and/or registration includes, and thus the international registration includes, the legal equivalent of a standard character claim.**
- (2) **The mark consists of standard characters without claim to any particular font style, size, or color.**

See 37 C.F.R. §2.52(a); TMEP §807.03(a), (h).

If applicant does not provide these two statements, the USPTO will consider the mark drawing to be in special form. See TMEP §807.03(h).

PARTIAL ABANDONMENT - ADVISORY

FAILING TO RESPOND WILL RESULT IN PARTIAL ABANDONMENT OF APPLICATION: If applicant does not respond to this Office action within the six-month period for response, the goods identified above, in the beginning of this Office action, will be **deleted from the application**.

In such case, the application will then proceed only with the following goods:

International Class 012: Tires for vehicle wheels; aircraft tires; solid tires for vehicle wheels; safety seats for children, for vehicles; casings for pneumatic tires; pneumatic tires; automobile tires; treads for retreading tires; tubeless tires for bicycles.

See 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

RESPONSE GUIDELINES

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL PARTIAL 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_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>.