

To: HML Finans ApS (info@bridgeip.net)
Subject: U.S. Trademark Application Serial No. 79246711 - NASH - 300.024092
Sent: August 20, 2019 02:15:55 PM
Sent As: ecom100@uspto.gov
Attachments:

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application
Serial No.
79246711

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Applicant:
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Reference/Docket
No. 300.024092

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NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 20, 2019
International Registration No. 0810285

Notice of Provisional Full Refusal

Deadline for responding. The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned. To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "IB-1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response

form appears at the end of this Office action.

Discussion of provisional full refusal. This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). *See* 15 U.S.C. §§1141f(a), 1141h(c).

This Office action is in response to applicant's communication filed on June 26, 2019.

Trademark Act Section 2(d) Refusals - MAINTAINED

The Trademark Act Section 2(d) refusals based on U.S. Registration Nos. 9843936 (as to the applicant's Class 9 goods) and 0530815 (as to the applicant's Class 11 goods) are maintained.

The applicant and registrant's marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods and/or services. *Id.* Therefore, the marks are confusingly similar.

Generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the goods and/or services of the parties is required to support a finding of likelihood of confusion. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

International Class 11 Identification of Goods - MAINTAINED

The requirement to amend the International Class 11 identification of goods is maintained.

The wording "heating apparatus, namely, electric heaters for household purposes" and "drying apparatus, namely, dehumidifiers for household" in the amended Class 11 identification of goods is indefinite and must be clarified to specify the type of electric heater and correct a grammatical omission. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may substitute the following wording, if accurate: "Lighting apparatus, namely, lighting installations; heating apparatus, namely, electric **radiant** heaters for household purposes; steam generating installations; apparatus for cooking, namely, cooktops and microwave ovens; refrigerators; drying apparatus, namely, dehumidifiers for household **purposes**; ventilating apparatus, namely, fans for household, commercial and industrial use; water purification and filtration apparatus" in Class 11.

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).

NEW ISSUE – International Class 9 Identification of Goods

Based on the applicant's response, the following new issue must be responded to: International Class 9 identification of goods.

The original Class 9 identification of goods was acceptable as written in the original application. The applicant in their response amended the Class 9 identification of goods to "apparatus for recording, transmission and reproduction of sound and/or images, loudspeakers, amplifiers and CD players excluding recorded audio disc, compact discs, DVD audio disc, DVD video discs and tapes all featuring music and sound effects".

The identification must be clarified because the added exclusionary wording makes the wording unclear and indefinite. *See* 37 C.F.R.

§2.32(a)(6); TMEP §1402.01. For example, as worded, the applicant's CD players exclude compact discs. A CD player that does not allow for inserting compact discs does not exist. In addition, as worded, the applicant's loudspeakers and amplifiers also exclude recorded audio disc, compact discs, DVD audio disc, DVD video discs and tapes all featuring music and sound effects. As loudspeakers and amplifiers do not generally include these items, the wording is unclear, indefinite and unacceptable. Finally, "apparatus for recording, transmission and reproduction of sound and/or images" may include blank discs and tapes, but they do not generally include prerecorded discs and tapes such as the excluded items.

The applicant may amend their Class 9 identification of goods to clarify the goods or may amend the identification to the wording stated in the original application: "Apparatus for recording, transmission and reproduction of sound and/or images; loudspeakers, amplifiers and CD players".

The proposed amendment to the identification of goods and/or services is not acceptable for the reasons stated in this Office action. Thus, the previous wording in the existing identification remains operative for purposes of future amendments and for determining the scope of future amendments. *See* TMEP §1402.07(d).

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).

How to respond. Click to file a response to this nonfinal Office action

Applicant must be represented by a U.S.-licensed attorney at the USPTO to respond to or appeal the provisional refusal. The application record indicates that applicant's domicile is outside of the United States in Denmark, but no attorney who is an active member in good standing of the bar of the highest court of a U.S. State or territory has been appointed to represent the applicant in this matter. All applicants whose permanent legal residence or principal place of business is not within the United States or its territories must be represented by a U.S.-licensed attorney at the USPTO. 37 C.F.R. §§2.2(o), 2.11(a). Thus, applicant is required to be represented by a U.S.-licensed attorney and must appoint one. 37 C.F.R. §2.11(a). This application will not proceed to registration without such representation. *See id.* *See* Hiring a U.S.-licensed trademark attorney for more information.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should (1) submit a completed Trademark Electronic Application System (TEAS) Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form and (2) promptly notify the trademark examining attorney that this TEAS form was submitted. Alternatively, if applicant has already retained an attorney, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. *See* 37 C.F.R. §2.17(b)(1)(ii).

Applicant must be represented by a U.S.-licensed attorney at the USPTO to respond to or appeal the provisional refusal. The application record indicates that applicant's domicile is outside of the United States in Denmark, but no attorney who is an active member in good standing of the bar of the highest court of a U.S. State or territory has been appointed to represent the applicant in this matter. All applicants whose permanent legal residence or principal place of business is not within the United States or its territories must be represented by a U.S.-licensed attorney at the USPTO. 37 C.F.R. §§2.2(o), 2.11(a). Thus, applicant is required to be represented by a U.S.-licensed attorney and must appoint one. 37 C.F.R. §2.11(a). This application will not proceed to registration without such representation. *See id.* *See* Hiring a U.S.-licensed trademark attorney for more information.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should (1) submit a completed Trademark Electronic Application System (TEAS) Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form and (2) promptly notify the trademark examining attorney that this TEAS form was submitted. Alternatively, if applicant has already retained an attorney, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. *See* 37 C.F.R. §2.17(b)(1)(ii).

/Patricia A. Horrall/
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Law Office 100
571-272-9651
Informal inquiries: patricia.horrall@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.
- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, find **contact information for the supervisor** of the office or unit listed in the signature block.

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United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **August 20, 2019** for
U.S. Trademark Application Serial No. 79246711

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be abandoned. Please follow the steps below.

(1) **Read the official letter.**

(2) **Direct questions** about the contents of the Office action to the assigned attorney below.

/Patricia A. Horrall/
Staff Attorney
Law Office 100
571-272-9651
Informal inquiries: patricia.horrall@uspto.gov

Direct questions about navigating USPTO electronic forms, the USPTO website, the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the Trademark Assistance Center (TAC).

(3) **Respond within 6 months** (or earlier, if required in the Office action) from **August 20, 2019**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond.

GENERAL GUIDANCE

- **Check the status of your application periodically** in the Trademark Status & Document Retrieval (TSDR) database to avoid missing critical deadlines.
- **Update your correspondence email address**, if needed, to ensure you receive important USPTO notices about your application.
- **Beware of misleading notices sent by private companies about your application.** Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All official USPTO correspondence will only be emailed from the domain “@uspto.gov.”