

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

U.S. Application Serial No. 79265105

Mark:

Correspondence Address:

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Applicant: SDCIC CONSTRUCTION GROUP SHARES CO., LTD

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION

International Registration No. 1482290

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 coverletter, 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 "TB-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. §§1141(f)(a), 1141h(c).

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).

Summary of Issues

- Identification of Services
- Translation Requirement in Proper Format

Identification of Services

The identification of services in Class 42 is accepted.

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and/or services from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing international class to another. 37 C.F.R. §2.85(d); see TMEP §§1402.07(a), 1904.02(c).

The wording "repair information" "construction" and "decorative painting services" in the identification of services is indefinite and must be clarified because the wording does not make clear the nature of the services, e.g., "providing home repair information" "construction planning" and "decorative interior house painting services." See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

The following substitute wording is suggested, if accurate:

Class 37: Building construction supervision; **providing home repair information; construction [specify, e.g., planning]; decorative interior house painting services**; upholstering repair; office machines and equipment installation, maintenance and repair; electric appliance installation and repair;

installation and repair of air-conditioning apparatus; furniture maintenance; burglar alarm installation and repair; construction consultancy

Additions to Identification Not Permitted

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. See 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably narrowed. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. 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* at <http://tess2.uspto.gov/netahhtml/tidm.html>. See TMEP §1402.04.

Translation Requirement in Proper Format

To permit proper examination of the application, applicant must submit an English translation of the foreign wording in the proper format. Moreover, the additional second sentence is not required. 37 C.F.R. §§2.32(a)(9), 2.61(b); see TMEP §809. The following English translation is suggested:

The English translation of "SHEN" means "deep", "ZHUANG" means "clothing", and "ZONG" means "sum up".

TMEP §809.03.

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 China, 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).

How to respond. [Click to file a response to this nonfinal Office action](#)

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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 ESTIA 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.