

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

U.S. Application Serial No. 79266319

Mark: MEDBUY.ONLINE

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Applicant: MEDINDUSTRY (CYPRUS) LIMITED

Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

International Registration No. 1485041

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 "1B-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).

INTRODUCTION

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 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).

SUMMARY OF ISSUES

- Amended identification of services required
- Entity clarification required
- U.S. counsel required

Amended identification of services required

Portions of the wording in the identification of goods must be clarified because they contain indefinite language. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. As indicated below, applicant must further clarify the nature of some of the services.

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 (TTAB 2014) (citing *In re Omega SA*, 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).

In addition, the following guidelines are provided for amending the identification:

- Use "namely" after broad terms (e.g., "accessories," "apparatus," "components," "devices," "equipment," "materials," "parts," "systems" or "products") followed by a list of the specific goods, e.g., "accessories, namely, [list specific goods]" (TMEP §§ 1402.01, 1402.03(a))
- Remove parentheses and incorporate the parenthetical information into the description, if necessary. Parenthetical information is permitted only if it serves to explain or translate the matter immediately preceding the parenthetical phrase, e.g., "obi (Japanese sash)," (TMEP § 1402.12)

Applicant may substitute the following wording, if accurate (additions in bold, deletions crossed-out, explanations in italics):

035: **business** administrative assistance in responding to requests for proposals [RFPs]; **business** administrative assistance in responding to calls for tenders; administrative processing of purchase orders; **business** administration of consumer loyalty programs; cost price analysis; auctioneering; **Outsource service provider in the field of business management** ~~outsourced administrative management for companies~~; book-keeping; **records management services, namely**, web indexing for commercial or advertising purposes **for others**; accounting **services**; negotiation of business contracts for others; market **research** studies; **public** opinion polling; invoicing; arranging newspaper subscriptions for others; payroll preparation; tax preparation; demonstration of goods; business **information and inquiries**; business management assistance; **commercial and/or industrial management assistance**; ~~advisory services for business management~~ **advisory**; business research; economic forecasting **services**; providing business information via a web site; compilation of information into computer databases; compilation of statistics; **providing** business information; business management for freelance service providers; business management of reimbursement programmes for others; interim business management; commercial information and advice for consumers in the choice of products and services; commercial administration of the licensing of the goods and services of others; computerized file management; marketing **services**; marketing in the framework of software publishing; targeted marketing **services**; marketing research; provision of commercial and business contact information; provision of an on-line marketplace for buyers and sellers of goods and services; writing of publicity texts; scriptwriting for advertising purposes; word processing; updating of advertising material; updating and maintenance of data in computer databases; updating and maintenance of information in registries; web site traffic optimization; organization of exhibitions for commercial or advertising purposes; organization of trade fairs for commercial or advertising purposes; rental of advertising space; personnel recruitment; business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; outsourcing services **being** ~~business assistance~~; ~~commercial intermediation services relating to the matching of potential private investors with entrepreneurs needing funding~~; competitive intelligence services; layout services for advertising purposes; price comparison services; market intelligence services; procurement services for others **being the** ~~the purchasing of goods and services in the field of~~ *{indicate goods, e.g., computer hardware and software, office equipment and furniture, etc.}* for other businesses; gift registry services; wholesale **store** services for pharmaceutical, veterinary and sanitary preparations and medical supplies; retail **store** services for pharmaceutical, veterinary and sanitary preparations and medical supplies; **computer file management in the nature of** data search in computer files for others; sponsorship search; search engine optimization for sales promotion; presentation of goods on communication media, for retail purposes **being television home shopping services**; publicity material rental; rental of advertising time on communication media; rental of vending machines; rental of sales stands; direct mail advertising **services**; psychological testing for the selection of personnel; publication of publicity texts; radio advertising; registration of written communications and data **in the field of** *{indicate specific field, e.g., state vehicular registrations, ownership of stocks and bonds}* **not being domain names**; advertising **services**; pay per click advertising; outdoor advertising; advertising by mail order; on-line advertising on a computer network; document reproduction; bill-posting; distribution of samples; dissemination of advertising matter; design of advertising materials; systemization of information into computer databases; drawing up of statements of accounts, **namely, preparation of financial statements**; compiling indexes of information for commercial or advertising purposes; sales promotion for others; promotion of goods and services through sponsorship of sports events; production of teleshopping programmes; production of advertising films; **providing office functions in the nature of** transcription of communications ~~office functions~~; television advertising; telemarketing services; negotiation and conclusion of commercial transactions for third parties

Scope Advisory—limited ability to amend identifications

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).

Assistance with amending identifications

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.

Entity clarification required

The application identifies applicant as a "LIMITED," which is not acceptable as an entity designation in the United States because there is no clear U.S. equivalent legal entity and the entity designation does not appear in Appendix D of the *Trademark Manual of Examining Procedure*. See TMEP §803.03(i). Applicant must indicate the U.S. equivalent of its legal entity or provide a description of the nature of the foreign entity. See 37 C.F.R. §§2.32(a)(3), 2.61(b); TMEP §803.03(i).

U.S. counsel required

On August 3, 2019, changes to the federal trademark regulations went into effect. These changes impose a requirement on this application as discussed below.

Applicant must be represented by a U.S.-licensed attorney at the USPTO to respond to or appeal the provisional refusal. An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented at the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §§2.11(a), 11.14; *Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants*, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individual applicant's domicile is the place a person resides and intends to be the person's principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity's domicile is the principal place of business; i.e., headquarters, where a juristic entity applicant's senior executives or officers ordinarily direct and control the entity's activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. Because applicant is foreign-domiciled, applicant must appoint such a U.S.-licensed attorney qualified to practice under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. 37 C.F.R. §2.11(a). 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 submit a completed Trademark Electronic Application System (TEAS) [Revocation, Appointment, and/or Change of Attorney/Domestic Representative](#) form. The newly-appointed attorney must submit a TEAS [Response to Examining Attorney Office Action](#) form indicating that an appointment of attorney has been made and address all other refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, 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 ESTTAmaintenance 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.