

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

U.S. Application Serial No. 79267604

Mark:

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Applicant: JT International SA

Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

International Registration No. 1487726

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).

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).

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:

- Identification of Goods
- Description of the Mark
- U.S. Attorney Required

IDENTIFICATION OF GOODS

Some of the wording in the identification of goods and/or services in International Class(es) 34 is indefinite and/or too broad. *See* 37 C.F.R. §2.32(a)

(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

In particular, the wording “smokers’ articles included in this class” in the identification of goods is indefinite and must be clarified by (1) specifying the common commercial or generic name for these goods, or (2) deleting this wording. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03(a). This wording is an open-ended “catch-all” word or phrase that is not acceptable because it fails to identify specific goods. See TMEP §1402.03(a).

In an identification, an applicant must use the common commercial or generic name for the goods, be specific and all-inclusive, and avoid using indefinite words or phrases. TMEP §§1402.01, 1402.03(a). Further, applicant may amend the identification to list only those items that are within the scope of the goods set forth in the initial application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.*, 1402.07. Scope is generally determined by the ordinary meaning of the wording in the identification. TMEP §1402.07(a).

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 of the World Intellectual Property Organization in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, although the goods and/or services may be classified in several international classes, any modification to this wording must identify goods and/or services in International Class(es) 34 only, the class(es) specified in the application for these goods and/or services. See TMEP §1904.02(c), (c)(ii).

Applicant may adopt the following wording in International Class(es) 34, if accurate:

Class 34 Tobacco, raw or manufactured; smoking tobacco, pipe tobacco, rolling tobacco, chewing tobacco, snus; cigarettes, electronic cigarettes, cigars, cigarillos; snuff; smokers’ articles included in this class, **namely, ash trays**; cigarette paper, cigarette tubes and matches

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.

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).

DESCRIPTION OF MARK REQUIRED

Applicant must submit a description of the mark. 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 *et seq.* In this case, the drawing of the mark is not in standard characters.

The following description is suggested, if accurate: **The mark consists of a wide vertical quadrilateral bar to the left of a slender diagonal wedge.**

U.S. ATTORNEY REQUIRED

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 Address 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

/Q Queen/
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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.
- If needed, **find** contact information for the supervisor of the office or unit listed in the signature block.