

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

U.S. Application Serial No. 79265137

Mark: ONLYOU

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Applicant: CHEN HAIHUI

Reference/Docket No. N/A

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## NONFINAL OFFICE ACTION

International Registration No. 1482377

### 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 "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).

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:

- DESCRIPTION OF THE MARK
- IDENTIFICATION OF GOODS
- U.S. COUNSEL REQUIREMENT

#### 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).

#### DESCRIPTION OF THE MARK

Applicant must submit an amended description of the mark because the current one uses broad, vague language that does not accurately describe the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Descriptions must be accurate and identify all the literal and design elements in the mark. *See* 37 C.F.R. §2.37; TMEP§808.02. In this case, the description is vague because the wording "device" does not describe the nature of the design element.

The following description is suggested, if accurate: **The mark consists of the wording "ONLYOU" appearing underneath a stylized design of a heart formed by curved bands resembling tail flukes.**

#### IDENTIFICATION OF GOODS

The identification of goods contains parenthesis and brackets. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. *See* TMEP§1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately

preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., “fried tofu pieces (abura-age).” *Id.*

Therefore, applicant must remove the brackets from the identification and incorporate any bracketed information into the description of the goods.

The wording “watch pocket (cover)” in the identification of goods is indefinite and must be clarified because the nature of the goods is unclear. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may substitute the following wording, if accurate:

International Class 014: Jewelry charms; necklaces; jewelry; clocks; wristwatches; straps for wristwatches; watch chains; watch cases **being parts of watches**; presentation boxes for watches; \_\_\_\_\_ {clarify “watch pocket (cover),” e.g. watch pocket being watch pouches}

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*. *See* TMEP §1402.04.

## **U.S. COUNSEL REQUIREMENT**

**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](#)

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant’s rights, the trademark examining attorney can provide applicant with additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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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 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.