

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

**U.S. Application Serial No.** 79270070

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**Applicant:** SENSONEO j. s. a.

**Reference/Docket No.** N/A

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## NONFINAL OFFICE ACTION

**International Registration No.** 1493686

### 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 "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 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

- IDENTIFICATION OF GOODS AND SERVICES – AMENDMENT REQUIRED
- RETENTION OF UNITED STATES TRADEMARK ATTORNEY REQUIRED

### IDENTIFICATION OF GOODS AND SERVICES – AMENDMENT REQUIRED

The wording "quantity indicators" in the identification of goods is indefinite and must be clarified because this wording is overly vague and the nature of these goods has not been adequately defined. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The identifications for "computer software being recorded computer programs," "downloadable computer software," "downloadable computer software applications," and "recorded or downloadable computer software platforms" in International Class 9 are indefinite and must be clarified to specify the purpose or function of the software. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). In these listings, "for waste management" appears to describe the particular field of use for these goods, but does not describe the function of the goods.

Likewise, the identifications for "cloud computing featuring software," "software as a service (SAAS) services featuring software," and "platform as a service (PAAS) featuring software platforms" in International Class 42 are indefinite and must be clarified to specify the purpose or function of the software. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). In these listings, "for waste management" appears to describe the particular field of use for these goods, but does not describe the function of the goods.

The USPTO requires such specificity in order for a trademark examining attorney to examine the application properly and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. See *In re N.A.D. Inc.*, 57 USPQ2d 1872,1874 (TTAB 2000); TMEP §1402.03(d).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although software may be classified in international classes other than International Class 9, any modification to the identification must identify goods in International Class 9 only, the class specified in the application for such goods. See TMEP §1904.02(c)(ii).

Finally, applicant has included the term "or" in the identification of goods in International Class 9. Specifically, applicant has included this wording in the listing "recorded or downloadable computer software platforms for waste management." However, this term is generally not accepted in identifications when (1) it is unclear whether applicant is using the mark, or intends to use the mark, on all the identified goods; (2) the nature of the goods and services is unclear; or (3) classification cannot be determined from such wording. See TMEP §1402.03(a). In this case, it is unclear whether applicant is using the mark or intends to use the mark on both "recorded . . . computer software platforms" and "downloadable computer software platforms" or only one of those two.

An application must specify, in an explicit manner, the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. See 15 U.S.C. §1051(a)(2), (b)(2); 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Therefore, applicant should replace "or" with "and" in the identification of goods, if appropriate, or rewrite the identification with the "or" deleted and the goods specified using definite and unambiguous language.

Applicant may adopt the following identification of goods and services, with acceptable amendments in bold and information required from applicant in italics, if accurate:

- Class 9: Ultrasonic sensors; ultrasonic sensors for monitoring fill-levels in garbage cans; sensors for determining position; filling level detectors; level indicators; quantity indicators, **namely {applicant must indicate the specific nature of these goods properly classified in International Class 9, e.g., speed indicators, water level indicators, gas pressure indicators, etc.}**; data processing apparatus; computer software being recorded computer programs for **{applicant must indicate the function or purpose of this software, e.g., database management, word processing, project management}** for waste management; downloadable computer software for **{applicant must indicate the function or purpose of this software, e.g., database management, word processing, project management}** for waste management; downloadable computer software applications for **{applicant must indicate the function or purpose of this software, e.g., database management, word processing, project management}** for waste management; recorded or downloadable computer software platforms for **{applicant must indicate the function or purpose of this software, e.g., database management, word processing, project management}** for waste management; computer hardware
- Class 35: Business information and inquiries; business data analysis; cost price analysis; compilation of statistics for business or commercial purposes; compiling indexes of information for commercial or advertising purposes; compilation of information into computer databases; systemization of information into computer databases; updating and maintenance of data in computer databases; advertising services; retail and wholesale store services featuring ultrasonic sensors; on-line retail and wholesale store services featuring ultrasonic sensors
- Class 39: Transport and storage of waste; provision of information, advisory and consultancy services relating to transport and storage of waste
- Class 40: Destruction of waste and trash; waste treatment services; recycling of waste and trash; upcycling in the nature of waste recycling; sorting of waste and recyclable material; advisory and consultancy services relating to destruction, treatment, recycling, upcycling, sorting of waste
- Class 42: Design and development of computer software; maintenance of computer software; updating of computer software; design and development of computer hardware; consultancy in the design and development of computer software and hardware; development of computer platforms; computer system design; cloud computing featuring software for **{applicant must indicate the function or purpose of this software, e.g., database management, word processing, project management}** for waste management; software as a service (SaaS) services featuring software for **{applicant must indicate the function or purpose of this software, e.g., database management, word processing, project management}** for waste management; platform as a service (PaaS) featuring software platforms for **{applicant must indicate the function or purpose of these software platforms, e.g., database management, word processing, project management}** for waste management; information technology (IT) consultancy; technological consultancy in the field of waste management; calibration services

Applicant's goods and 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 or services or add goods 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 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 or services will further limit scope, and once goods 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 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 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.

## RETENTION OF UNITED STATES TRADEMARK ATTORNEY REQUIRED

**Applicant must be represented by a U.S.-licensed attorney.** 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 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).

## RESPONSE GUIDELINES

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see "[Responding to Office Actions](#)" on the USPTO's website.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. See 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. See 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04.

Where the application has been abandoned for failure to respond to an Office action, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to active status. See 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. See 37 C.F.R. §§2.6, 2.66(b)(1).

**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](#)

/Timothy J. Callery/  
Timothy J. Callery  
Examining Attorney  
Law Office 121

## 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.