

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

U.S. Application Serial No. 79274522

Mark:

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CHINA

Applicant: Asian Electric Appliances & Cables Techn ETC.

Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

International Registration No. 1504605

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.

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:

- I. Refusal—Section 2(e)(2), Primarily Geographically Descriptive
- II. Requirement to Amend the Mark Description
- III. Requirement to Amend the Identification of Goods
- IV. U.S. Licensed Attorney Required

I. SECTION 2(e)(2) REFUSAL – PRIMARILY GEOGRAPHICALLY DESCRIPTIVE

Registration is refused because the applied-for mark is primarily geographically descriptive of the origin of applicant's goods and/or services. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); *see* TMEP §§1210, 1210.01(a).

A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place association; that is, purchasers would be likely to believe that the goods originate in the geographic place identified in the mark.

TMEP §1210.01(a); *see In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014).

The applicant has applied to register “[Chinese characters that transliterate to “ASIAN CABLE”]” (special form) used in connection with:

Class 9: *Copper wire, insulated; materials for electricity mains [wires, cables]; coaxial cables; fibre optic cables; switches, electric; magnetic wires; identification threads for electric wires; junction sleeves for electric cables; sheaths for electric cables; transformers*

The primary significance of “Asia” is a generally known geographic location, namely, a continent. See attached evidence from Columbia Gazetteer, Google Maps, and Wikipedia.

Goods are considered to originate from a geographic location when the record shows that the goods are sold there, manufactured or produced there, packaged and shipped from there, and/or contain a main ingredient or component derived from there. See *In re Jacques Bernier Inc.*, 894 F.2d 389, 391-92, 13 USPQ2d 1725, 1727 (Fed. Cir. 1990), *opposition sustained sub nom. Fred Hayman Beverly Hills, Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996) (holding applicant’s perfume did not originate from RODEO DRIVE because, although goods did not have to be manufactured or produced at the geographic site and could “be sold there” to originate from the geographic location, there was insufficient evidence to show that perfume was sold on RODEO DRIVE); *In re Joint-Stock Co. “Baik,”* 80 USPQ2d 1305, 1310 (TTAB 2006) (holding applicant’s vodka originated from BAIKALSKAYA, a Russian word meaning “from Baikal,” because it was made from the water of Lake Baikal and applicant produced various vodkas from a location near Lake Baikal); *In re JT Tobacconists*, 59 USPQ2d 1080, 1083 (TTAB 2001) (holding applicant’s cigars, cigar cases, and humidors originated from MINNESOTA because they were packaged and shipped from MINNESOTA, and applicant’s business was located in MINNESOTA); *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144, 1145-46 (TTAB 1993) (holding applicant’s beverages originated from NANTUCKET because labels for applicant’s goods suggested a connection with NANTUCKET, additional evidence suggested that some ingredients came from NANTUCKET and that applicant’s goods were sold at applicant’s store located in NANTUCKET, and applicant’s corporate headquarters and research and development center were located in NANTUCKET); TMEP §1210.03. As indicated by the applicant’s address, the applicant is located in China, which is in Asia. Because the applicant is located in Asia, the applicant’s goods will originate from the geographic location named in the mark.

When there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, a public association of the goods with the place is presumed if an applicant’s goods originate in the place named in the mark. TMEP §1210.04; see, e.g., *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (holding DENVER WESTERNS primarily geographically descriptive of western-style shirts originating in Denver). Because Asia is a well-known location and the applicant’s goods originate from Asia, it is presumed consumers will make a goods-place association.

Adding matter to a geographic term does not necessarily diminish its primary geographic significance. See *In re Wada*, 194 F.3d 1297, 1300, 52 USPQ2d 1539, 1541 (Fed. Cir. 1999); *In re S. Park Cigar, Inc.*, 82 USPQ2d 1507, 1513 (TTAB 2007). In some cases, additional matter may even serve to enhance the geographic significance. See *In re Premiere Distillery, LLC*, 103 USPQ2d 1483, 1485 (TTAB 2012) (holding REAL RUSSIAN primarily geographically deceptively misdescriptive of vodka); *In re Bacardi & Co.*, 48 USPQ2d 1031, 1034 (TTAB 1997) (holding HAVANA SELECT, HABANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER primarily geographically deceptively misdescriptive of rum and other alcoholic products). In the applicant’s case the additional transliterated term “cable” does not overcome this refusal because “cable” is a generic term when used in connection with the applicant’s goods.

Similarly, the fact that proposed mark appears in Chinese characters does not overcome this refusal because the foreign equivalent of a merely descriptive English term is also merely descriptive. *In re N. Paper Mills*, 64 F.2d 998, 998, 17 USPQ 492, 493 (C.C.P.A. 1933); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1270 (TTAB 2016) (quoting *In re Optica Int’l*, 196 USPQ 775, 777 (TTAB 1977)). Under the doctrine of foreign equivalents, marks with foreign terms from common, modern languages are translated into English to determine descriptiveness. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (citing *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 220 USPQ 111, 113 (Fed. Cir. 1983); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987)); see TMEP §1209.03(g).

Applicant’s mark is in Chinese characters, which is a common, modern language in the United States. *In re Oriental Daily News, Ltd.*, 230 USPQ 637 (TTAB 1986).

The doctrine is applied when “the ordinary American purchaser” would “stop and translate” the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); TMEP §1209.03(g). The ordinary American purchaser includes those proficient in the foreign language. *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); see *In re Highlights for Children, Inc.*, 118 USPQ2d at 1271.

In this case, the ordinary American purchaser would likely stop and translate the mark because the Chinese language is a common, modern language spoken by an appreciable number of consumers in the United States.

Because Asia is a well-known location, the applicant’s goods originate from the geographic location named in the mark, consumers will make a goods-place association, the additional term in the mark is nondistinctive, and Chinese is common modern language in the US, the applicant’s proposed mark is refused under Section 2(e)(2) of the Trademark Act.

Supplemental Register Unavailable—Advisory

Applicant cannot overcome the refusal by amending the application to the Supplemental Register, because a mark in an application under §66(a) of the Trademark Act is not eligible for registration on the Supplemental Register. Trademark Act Section 68(a)(4), 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c); TMEP §§801.02(b), 815, 816.01 and 1904.02(c).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

II. REQUIREMENT TO AMEND THE MARK DESCRIPTION

Applicant must submit an amended description of the mark because the current one is incomplete and does not describe all the significant aspects of 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 *et seq.*

The following description is suggested, if accurate:

The mark consists of four Chinese characters.

III. REQUIREMENT TO AMEND THE IDENTIFICATION OF GOODS

The identification of goods contains 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 that have been deleted from registrations or in an affidavit of incontestability to indicate goods 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 parenthetical or bracketed information into the description of the goods.

Applicant may substitute the following wording, if accurate (suggestion are **bold**):

Class 9: Copper wire, insulated; materials for electricity mains, **namely, wires and cables** ~~wires, cables~~; coaxial cables; fibre optic cables; switches, electric; magnetic wires; identification threads for electric wires; junction sleeves for electric cables; sheaths for electric cables; transformers

In a Trademark Act Section 66(a) application, classification of goods may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Applicant's goods 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 add goods 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 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 will further limit scope, and once goods 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). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c).

For assistance with identifying and classifying goods in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). *See* TMEP §1402.04.

IV. U.S. LICENSED ATTORNEY REQUIRED

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

Attorney email address required. Applicant's attorney must provide his or her email address for the record. 37 C.F.R. §2.32(a)(4).

RESPONSE GUIDELINES

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may

provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see “[Responding to Office Actions](#)” and the informational video “[Response to Office Action](#)” for more information and tips on responding.

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 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 needed, **find** ~~contact information for the supervisor~~ of the office or unit listed in the signature block.



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Asia

Asia

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TYPE OF PLACE continent

LOCATION Other

POPULATION 3,300,000,000

Asia, the world's largest continent (17,199,000 sq mi; 44,390,000 sq km), with about 3.3 billion people, nearly three-fifths of the world's total population.

Boundaries

Asia's border with [Europe](#)—which, geographically, may be regarded as a peninsula of the Eurasian landmass—lies approximately along the [Ural](#)s, the [Ural](#) River, the [Caspian](#) Sea, the [Caucasus](#), the [Black](#) Sea, the [Bosphorus](#) and [Dardanelles](#) straits, and the [Aegean](#) Sea. The connection of Asia with [Africa](#) is broken only by the [Suez](#) Canal between the [Mediterranean](#) Sea and the [Red](#) Sea. In the far-NE of Asia, [Siberia](#) is separated from [North America](#) by the [Bering](#) Strait. The continent of Asia is washed on the S by the Gulf of [Aden](#), the [Arabian](#) Sea, and the Bay of [Bengal](#); on the E by the [South](#) China Sea, [East](#) China Sea, [Yellow](#) Sea, Sea of [Japan](#), Sea of [Ochotsk](#), and [Bering](#) Sea; and on the N by the [Arctic](#) Ocean.

Geology

Geologically, Asia consists of ancient Precambrian landmasses—the Arabian and Indian peninsulas in the S and the central Siberian plateau in the N—enclosing a central zone of folded ridges. In accordance with this underlying structure, Asia falls into the following major physiographic structures: the N lowlands covering W central Asia and most of Siberia; the vast central highland zone of high plateaus (ca.15,000 ft; 4,570 m) in Tibet, and enclosed by some of the world's greatest mountain ranges ([Himalaya](#), [Karakorum](#), [Kunlun](#), [Tien Shan](#), and the [Hindu Kush](#)); the S peninsular plateaus of India and Arabia, merging, respectively, into the [Ganga](#) and [Irrawaddy](#) basins; and the lowlands of E Asia, especially in [China](#), which are separated by mountain spurs of the central highland zone. Mount [Everest](#) (29,028 ft/8,848 m), in [Nepal](#), is the world's highest peak; the [Dead Sea](#) (1,312 ft; 400 m below sea level) is the world's lowest point. Great peninsulas extend out from the mainland, dividing the oceans into seas and bays; many of them protected by Asia's numerous offshore islands. Asia's rivers, among the longest in the world, generally rise in the high plateaus and break through the great chains toward the peripheral lowlands. They include the [Ob](#) River, [Irtysh](#), [Yenisei](#), [Angara](#), and [Lena](#) of Siberia; the [Amur](#), [Arghun](#), [Huang He](#), [Yangtze](#) ([Yangtze](#)), [Xi](#), [Mekong](#), [Salween](#), and [Irrawadi](#) of E and SE Asia; and the [Ganga](#), [Brahmaputra](#), [Indus](#), and [Tigris](#)—[Euphrates](#) of S and SW Asia. Central Asia has vast areas of interior drainage, including the [Amu Darya](#), [Syr Darya](#), [Jirgatal](#), and [Tartar](#) rivers, which empty into inland lakes or disappear into desert sands. The [Aral](#) Sea, Lake [Baysal](#), and Lake [Balkhash](#) are among the world's largest lakes. Climatically, the continent ranges through all extremes, from torrid heat to arctic cold and from torrential rains (the product of monsoons) to extreme aridity (as in the [Tartar](#) Basin).

Regions

Asia can be divided into five regions, each possessing distinctive physical, cultural, economic, and political characteristics.

SW Asia ([Iran](#), [Turkey](#), in [Asia Minor](#), and the nations of the [Fertile Crescent](#)), and the Arabian Peninsula), long a strategic crossroad, is characterized by an arid climate and irrigated agriculture, reserves, and the predominance of Islam.



Asia

Continent

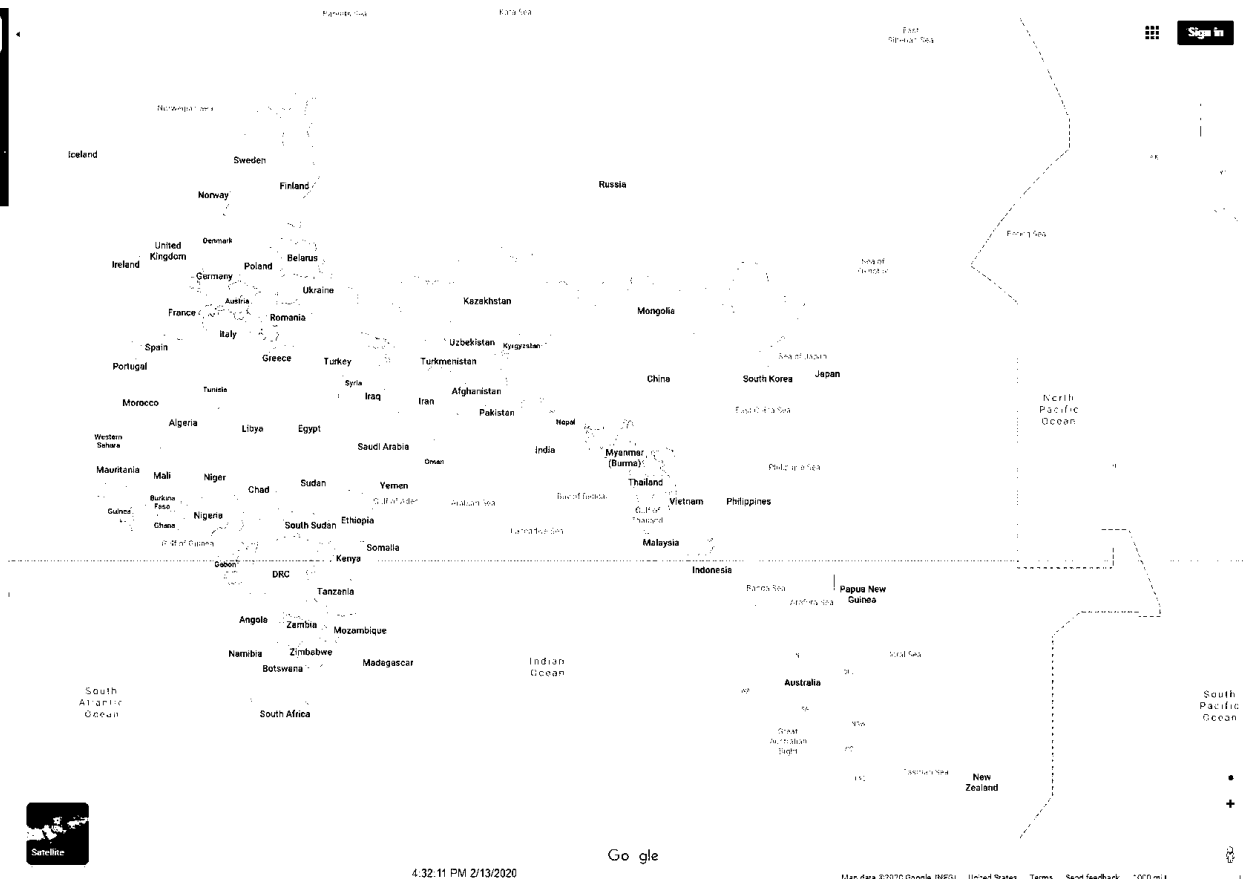


Photos



Quick facts

Asia is Earth's largest and most populous continent, located primarily in the Eastern and Northern Hemispheres. It shares the continental landmass of Eurasia with the continent of Europe and the continental landmass of Afro-Eurasia with both Europe and Africa. [Wikipedia](#)



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