

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

U.S. Application Serial No. 79276848

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Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

International Registration No. 1510070

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), 1141(h)(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.

The trademark examining attorney searched the USPTO database of registered and pending marks and found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

SUMMARY OF ISSUES

- Amendment to the Identification Required
- U.S. Counsel Required

AMENDMENT TO THE IDENTIFICATION REQUIRED

Numerous entries in the identification of goods and/or services are indefinite and must be clarified to specify the nature of the goods and/or services. In particular, the nature of the goods and/or services are not clear, could have multiple interpretations, or can span multiple classes. Suggested changes are set out below. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

As an initial matter, the identification of goods and/or services contains parenthetical language inserted by the International Bureau because the IB was not able to determine if the classification assigned to particular goods and/or services by an applicant's Office of origin was correct. See TMEP §1904.02(c).

This language is not part of the identification and will be removed. *Id.* It will not appear on any U.S. registration certificate that may issue. See *id.*

The identification of goods and/or services 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 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 parenthetical or bracketed information into the description of the goods and/or services.

In addition, particular wording in the identification in the application is indefinite and must be clarified because it does not appear to describe any goods

and/or services in the identified international class(es). See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1904.02(c)(iii). Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of goods and/or services. See TMEP §1402.01(e). However, in this case, the trademark examining attorney is unable to suggest alternative wording because the text that follows is indefinite and does not appear to describe any goods and/or services in that class(es):

Text deleted from class 35: data search in computer files for others

Text deleted from class 39: carting

See TMEP §1904.02(c)(iii).

Applicant may respond by amending this wording to clarify the nature of the goods and/or services; however, any amendment to the identification must identify goods and/or services within the scope of the wording and classification in the initial application. See TMEP §§1402.01(c), 1402.07(a), 1904.02(c)(iii). The scope of the identification for purposes of permissible amendments is limited by the international class(es) 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). If an applicant amends to goods and/or services that are in a class other than that assigned by the International Bureau, the amendment will not be accepted because it would exceed the scope and those goods and/or services would no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

Alternatively, applicant may delete this unacceptable wording from the identification. See TMEP §1904.02(c)(iii)-(iv). However, once an application has been expressly amended to delete goods and/or services, those items generally may not later be re-inserted. See TMEP §1402.07(e).

If applicant believes the classification assigned by the International Bureau was in error, applicant may contact the International Bureau and request correction of, or recordation of a limitation to, the international registration. TMEP §1904.02(c)(iii)-(iv), (e)(i)-(e)(ii). However, filing such a request with the International Bureau is not considered a formal response to this Office action. See TMEP §1904.02(c)(iv), (e)(iii). Applicant must also file a timely and complete response to this Office action, stating that applicant has filed a request for a correction or to record a limitation with the International Bureau that will resolve the outstanding issue. See 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03, 1904.02(c)(iii)-(iv), (e)(iii). The response should include (1) a copy of the request for correction or limitation filed with the International Bureau and (2) a request to suspend action on the application, which will normally be granted under such circumstances. See TMEP §§716.02(g), 1904.02(c)(iii)-(iv).

Applicant should note that in a Trademark Act Section 66(a) application, classification of goods and/or services 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 and/or services 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 may adopt the following wording with suggestions and additions in **bold**, if accurate:

Class 9:

Electronic parking ticket dispensers; coin-operated juke boxes; monitoring apparatus, other than for medical purposes, namely, alarm monitoring systems; sound recording apparatus; global positioning system (GPS) apparatus; telephone apparatus; electronic tags for goods; mechanical signs; signs, luminous; loudspeakers; dictating machines; electronic numeric displays; electronic interactive whiteboards; electronic notice boards; electronic book readers; audio interfaces; simulators for the steering and control of vehicles; measuring instruments, namely, {specify, e.g., height, gravity, resistance measuring instruments}; interfaces for computers; identity cards, magnetic; encoded magnetic {specify, e.g., gift, charge, key, identity} cards; protective helmets; encoded key cards; electronic agendas; computers; laptop computers; tablet computers; notebook computers; wearable computers in the nature of smartwatches; microtomes; modems; computer monitors; downloadable computer software for {specify, e.g., monitoring and controlling factory manufacturing processes, monitoring and controlling communication between computers and automated machine systems}; headphones; cases for sound recording apparatus; blank magnetic data media being disks; blank optical data media being disks; electronic sheet music, downloadable; recorded computer software for {indicate the function, e.g., playing computer games, audio editing, operating system}; computer hardware; smartphone camera selfie lenses; electric luminous and mechanical signaling control panels; electronic pocket translators; telecommunications transmitters; telephone transmitters; transmitters of electronic signals; downloadable and recorded computer software platforms for {specify, e.g., application development, web hosting, database management, ect.}; wafers for integrated circuits; digital signs; personal digital assistants; distance measuring apparatus; laser speed detectors for vehicles; teaching apparatus in the nature of artificial limbs for medical instruction purposes; time recording apparatus; weighing apparatus and instruments; electric navigational instruments; {specify, e.g., distance, pressure, antenna parameter} measuring apparatus; electronic measuring devices for measuring electric current; observation instruments being rockets; navigation apparatus for vehicles in the nature of on-board computers; satellite-aided navigation systems; voltage regulators for electric power; telecommunication apparatus in the nature of wireless receivers in the form of jewelry; audio- and video-receivers; downloadable computer software applications for {indicate the function, e.g., playing computer games, audio editing, operating system}; recorded computer programs for {indicate the function, e.g., playing computer games, audio editing, operating system}; computer game software; downloadable computer program software for {indicate the function, e.g., playing computer games, audio editing, operating system}; computer operating programs, recorded; downloadable computer screen saver software and computer screen saver software, recorded on computer media; computer central processing unit; downloadable electronic publications in the nature of {specify, e.g., journals, magazines, blog articles} in the field of {specify, e.g., medicine, computer games}; electric control panels; radar apparatus; vehicle radios; walkie-talkies; voltage regulators for vehicles; security surveillance robots; laboratory robots; teaching robots; humanoid robots with artificial intelligence; optical fibers; traffic-light apparatus; signals, being road signs and traffic lights, luminous or mechanical; electronic access control systems for interlocking doors; blank integrated circuit cards; smartglasses; smartphones; smartwatches; speed indicators; audiovisual teaching apparatus, namely, electronic sports training simulators; charging stations for electric vehicles; integrated circuits; parking meters; kilometer recorders for vehicles; taximeters; cellular phones; mobile telephones; interactive touch screen terminals; thermostats for vehicles; vehicle breakdown warning triangles; {specify, e.g., depth, petrol, fuel} gauges; automatic steering wheels for vehicles; video recorders; sound reproduction apparatus; computer

hardware and recorded software sold as a unit for generating invoices; data processing apparatus; optical character readers; sound alarms; anti-theft warning apparatus **in the nature of burglar alarms not for motor vehicles**; computer peripheral devices; acoustic couplers; whistle alarms; downloadable ring tones for mobile phones; downloadable image files **containing {indicate content or subject matter}**; downloadable music files; **video disks and video tapes with recorded** animated cartoons; **blank USB flash drives**; cases for smartphones; covers for personal digital assistants; covers for tablet computers; covers for smartphones; fire blankets; **electronic chips for the manufacture of integrated circuits**; virtual reality headsets; downloadable graphics for mobile phones; eyeglasses; sunglasses; security token **hardware**; **cameras for measuring vehicle speed**; wearable activity trackers; bar code readers

Class 35:

Commercial information agency **services**; advertising agency **services**; rental of advertising space; employment agencies; computerized file management; accounting **services**; invoicing; demonstration of goods; **public** opinion polling; market **research** studies; **providing** business information; commercial information and advice for consumers in the choice of products and services; business research; marketing research; personnel recruitment; business management and organization consultancy; business organization consultancy; business management consultancy; personnel management consultancy; professional business consultancy; consultancy regarding public relations communication strategies; consultancy regarding advertising communication strategies; layout services for advertising purposes; marketing **services**; marketing in the framework of software publishing; targeted marketing **services**; updating and maintenance of data in computer databases; online retail **store** services for downloadable and pre-recorded music and movies; online retail **store** services for downloadable ring tones; online retail **store** services for downloadable digital music; organization of exhibitions for commercial or advertising purposes; payroll preparation; sponsorship search; commercial **business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding**; providing business information via a web site; providing commercial and business contact information; provision of an on-line marketplace for buyers and sellers of goods and services; **compiling indexes from websites** for commercial and advertising purposes; **providing television home shopping services in the field of general consumer merchandise**; economic forecasting **services**; auctioneering; sales promotion for others; promotion of goods and services through sponsorship of sports events; production of advertising films; rental of advertising time on communication media; publicity material rental; rental of billboards; rental of vending machines; rental of sales stands; publication of publicity texts; radio advertising; dissemination of advertising matter; direct mail advertising **services**; registration of written communications and data **in the field of {specify, e.g., state vehicular registrations}**; advertising **services**; on-line advertising on a computer network; outdoor advertising; advertising by mail order; television advertising; compilation of statistics; compilation of information into computer databases; business **information and inquiries**; systemization of information into computer databases; **business management** advisory services; compiling indexes of information for commercial or advertising purposes; tax preparation; **preparation of financial account statements**; telemarketing services; **business** administration of consumer loyalty programs; **business** administration of frequent flyer programs; administrative processing of purchase orders; public relations; market intelligence services; web site traffic optimisation; tax filing services; search engine optimisation for sales promotion; price comparison services; pay per click advertising; procurement, **namely, purchasing {specify, e.g., food, alcoholic beverages, office furniture} for others**; word processing; outsourcing services

Class 38:

Electronic bulletin board services; information about telecommunication; providing access to databases; providing internet chatrooms; video-on-demand transmission; transmission of greeting cards online; **electronic** message sending; computer aided transmission of messages and images; transmission of telegrams; transmission of digital files; providing **a n** online forum for **{indicate subject matter of forum, e.g., motorcycle racing, skydiving, vaccines}**; videoconferencing services; rental of message sending apparatus, **namely facsimile apparatus and smartphones**; rental of modems; rental of telecommunication equipment; rental of telephones; transmission of electronic mail; paging services; voice mail services; telecommunications routing and junction services; streaming of data

Class 39:

Motor coach rental; boat rental; garage rental; rental of vehicle roof racks; aircraft rental; parking place rental; rental of warehouses; booking of seats for travel; travel **ticket reservation service**; transport reservation; **emergency truck** towing; vehicle breakdown towing services; delivery of newspapers; message delivery; parcel delivery; delivery of goods; delivery of goods by mail order; flower delivery; traffic information; transportation information; **providing information relating to physical storage devices**; **supply chain** transportation logistics, **namely, storage, transporation, and delivery of goods for others by air, rail, ship, or truck**; arranging of cruises; arranging of transportation for travel tours; armored-car transport; **truck** hauling; transporting furniture; **animal** removal services; transport of travellers; guarded transport of valuables; bus transport; car transport; boat transport; passenger transport; portorage; transport brokerage; freight brokerage; providing driving directions for travel purposes; car rental; rental of motor racing cars; vehicle rental; stevedoring; unloading cargo; packaging of goods **for transport purposes, namely, the packing of goods using {specify, e.g., sustainable or biodegradable} packaging and shipping materials**; escorting of travellers; wrapping of goods **and packaging of goods for transport purposes, namely, the packing of goods using {specify, e.g., sustainable or biodegradable} packaging and shipping materials**; car parking; chauffeur services; pleasure boat transport; car sharing services; courier services; taxi transport; **{specify, e.g., boat, marine}** transport; transport services for sightseeing tours; physical storage of electronically-stored data or documents; storage of goods; warehousing; freight forwarding

Class 41:

Educating at schools being academies; publication of books; **information on** education; recreation information; entertainment information; layout services, other than for advertising purposes; microfilming; videotape editing; production of radio and television programmes; providing online **non-downloadable** electronic publications **in the nature of {specify, e.g., books magazines} in the field of {specify, e.g., wakeboarding competitions}**; **electronic** game services provided online **via a computer network**; **education in the fields of {specify, e.g., computers, science, math} rendered through** correspondence courses; practical training **in the field of welding**; rental of **{specify, e.g., flight, sports} training** simulators; providing recreation facilities; arranging and conducting **educational conferences being colloquiums**; arranging and conducting educational congresses; arranging and conducting **educational** conferences; arranging and conducting workshops **in the field of {specify, e.g., skydiving safety, art appreciation}**; **providing an** in-person educational forum **in the field of {specify, e.g., math and science}**; arranging and conducting seminars; **arranging and conducting educational** competitions **in the field of {specify, e.g., business}**; vocational guidance; **entertainment, namely, television news shows**; mobile library services; vocational retraining **in the fields of {specify, e.g., welding}**; providing online videos **featuring {specify, e.g., music and mathematics instruction}**, not downloadable; providing online music, not downloadable; providing television programs, not downloadable, **via video-on-demand transmission** services; providing films, not downloadable, **via video-on-demand transmission** services;

educational examination services; educational examination services in the field of drone piloting qualifications; electronic desktop publishing; online publication of electronic books and journals; publication of texts, other than publicity texts; entertainment services in the nature of organizing social entertainment events; news reporters services; tutoring at cram schools; teaching at elementary schools; educational services namely, providing pre-kindergarten through 12th grade classroom instruction at international schools; coaching in the field of sports; nursery schools

Class 42:

Computer systems analysis; recovery of computer data; computer virus protection services; installation of computer software; mechanical research; scientific research; technological research in the field of {indicate field or subject matter, e.g., computer hardware systems, renewable energy resources, etc.}; web site design consultancy; computer security consultancy; information technology consulting services; consultancy in the design and development of computer hardware; internet security consultancy; computer software consultancy; data security consultancy; computer technology consultancy in the field of {indicate specific field, e.g., aerospace engineering, geology, etc.}; quality control for others; vehicle roadworthiness testing; updating of computer software; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems by remote access to ensure proper functioning; consulting services in the field of software as a service (SaaS); maintenance of computer software; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; providing search engines for the internet; conversion of computer programs and data, other than physical conversion; conducting technical project studies in the form of scientific feasibility studies; computer system design; rental of web servers; computer rental; rental of computer software; hosting the websites of others on a computer server for a global computer network; server hosting; computer software design; creating and designing website-based indexes of information for others using information technology; creating and maintaining web sites for others; computer programming; technical writing; duplication of computer programs; consulting services in the field of cloud computing; outsource service providers in the field of information technology; off-site data backup; computer technology consultancy; telecommunications technology consultancy; cartography services; data encryption services; electronic data storage; surveying; electronic monitoring of credit card activity to detect fraud via the internet; electronic monitoring of personally identifying information to detect identity theft via the internet

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).

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 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.

Only a U.S.-licensed attorney can take action on an application on behalf of a foreign-domiciled applicant. 37 C.F.R. §2.11(a). Accordingly, the USPTO will not communicate further with applicant about the application beyond this Office action or permit applicant to make future submissions in this application. And applicant is not authorized to make amendments to the application.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) [*Change Address or Representation*](#) 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

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.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the

application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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.