

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

U.S. Application Serial No. 79278193

Mark: HANYUANHUAJIAO

**Correspondence Address:**  
SICHUAN CHENGDU TIA; TRADEMARK & PATENT  
11F, Tower 3, Zheng; No.19 Beida Street,  
610017 Sichuan  
CHINA, , , ,

**Applicant:** Hanyuan County Sichuan Pepper Associatio ETC.

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

**Correspondence Email Address:**

## NONFINAL OFFICE ACTION

**International Registration No.** 1513287

**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 "1B-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).

### Introduction

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### Search Results

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

- Type of Mark Unclear – Collective, Certificate, or Guarantee Mark
- Disclaimer Required
- Amended Identification of Goods Required
- US Counsel Required

### Type of Mark Unclear – Collective, Certificate, or Guarantee Mark

**Clarify type of mark being applied for – collective mark or certification mark.** The international registration indicates the type of mark as a "collective, certificate, or guarantee mark." The USPTO does not register guarantee marks. Collective trademarks and collective service marks (collective marks) and certification marks are registrable; however, they are different types of marks with different application requirements. *See generally* 15 U.S.C. §1054; 37 C.F.R. §§2.44-2.45; TMEP §§1302-1303, 1306. Thus, to enable the application to be properly examined, applicant must clarify the type of mark it seeks to register. *See* 37 C.F.R. §2.61(b); TMEP §814. The application requirements for each type of mark are specified further below.

**Difference between a collective mark and certification mark.** A collective mark is used by the collective organization's members with their goods and/or services to identify and distinguish their goods and/or services from those of non-members. *See* TMEP §1303. A certification mark is used by authorized users with goods or services that possess certain characteristics or meet certain qualifications/standards established by a certifying organization. *See* TMEP §1306.06(a)-(b). Although both collective marks and certification marks are used by more than one party, only the users of collective marks are related to each other through membership in a collective group. TMEP §1306.06(a).

#### A. Application requirement for collective marks

**Verified statements.** Applicant must submit certain statements (shown below) properly verified by affidavit or declaration under 37 C.F.R. §2.20. See 37 C.F.R. §§2.44(a)(4)(v), (b)(2), 2.193(e)(1); TMEP §§804.01(b), 1303.01(a)(v), (b)(ii).

Applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

**How to provide these verified statements.** After opening the correct TEAS form, answer "yes" to wizard question #10, and follow the instructions within the form for signing. In this case, the form will require two signatures: one in the "Declaration Signature" section and one in the "Response Signature" section.

## **B. Application requirements for certification marks**

### **i. Certification statement**

Applicant must submit a certification statement specifying what the applicant will be certifying about the goods or services in the application. See 37 C.F.R. §2.45(a)(4)(v)(A); TMEP §1306.03(a). The certification statement should specify all the characteristics, standards, or other features of the goods and/or services that the mark is intended to certify. TMEP §1306.03(a). The characteristics or features that the mark is intended to certify should be explained in reasonable detail. Terms such as "quality," "mode of manufacture," or "excellence" should not be used without further explanation because they are too broad to accurately identify the characteristics or features intended to be certified. *Id.*

### **ii. Statement that applicant will not engage in production/marketing of the identified goods/services**

Applicant must submit the following statement: "Applicant will not engage in the production or marketing of the goods and/or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods and/or services that meet the certification standards of the applicant." 37 C.F.R. §2.45(a)(4)(v)(A); TMEP §1306.03(c).

### **iii. Authority to Control**

Applicant should explain how it has the authority to control the geographic term "Hanyuan" in the mark. Applicant is an Association with no apparent ties to the Chinese government, and therefore, it is unclear if it has the authority to control the term in the mark. When a certification mark of a geographical term, the examining attorney should inquire as to the authority of the applicant to control the use of the term, if the authority is not obvious. Normally, the entity that has authority to exercise control over the use of a geographical term as a certification mark is a governmental body or a body operating with governmental authorization. The right that a private person can acquire in a geographical term is usually a trademark right, on the basis of exclusive use resulting in the term becoming distinctive of that person's goods. When, however, circumstances make it desirable or necessary for many or all persons in a region to use the name of the region to indicate the origin of their goods, there would be no opportunity for the name to become distinctive for only one person. The term would be used by all persons in the region, not as a trademark indicating commercial origin, but as a certification mark indicating regional origin. See TMEP 1306.05(b)(ii).

When a geographical term is used as a certification mark, two elements are of basic concern: first, preserving the freedom of all persons in the region to use the term and; second, preventing abuses or illegal uses of the mark that would be detrimental to all those entitled to use the mark. Normally, a private individual is not in the best position to fulfill these objectives. The government of a region would be the logical authority to control the use of the name of the region. The government, either directly or through a body to which it has given authority, would have power to preserve the right of all persons entitled to use the mark and to prevent abuse or illegal use of the mark. *Id.*

### **iv. Verified statements**

Applicant must submit certain statements (shown below) properly verified by affidavit or declaration under 37 C.F.R. §2.20. See 37 C.F.R. §§2.45(a)(4)(v)(B), (b)(2), 2.193(e)(1); TMEP §§804.01(b), 1306.02(a)(v), (b)(ii).

Applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, and that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

**How to provide the certification statement:** After opening the correct TEAS form, answer "yes" to TEAS wizard question #3; under the "Additional Statement(s)" section, check the box next to "Miscellaneous Statement;" and enter the certification statement in the text box below.

**How to provide the verified statement and the statement about not engaging in production/marketing of the goods/services.** After opening the correct TEAS form, answer "yes" to wizard question #10, and follow the instructions within the form for signing. In this case, the form will require two signatures: one in the "Declaration Signature" section and one in the "Response Signature" section.

- Applicant must also address the following requirement.

## **- Disclaimer Required**

Applicant must disclaim the Non-English wording that transliterates to “HUA JIAO” because this means “SICHUAN PEPPER” in English. Non-English wording that is merely descriptive, in connection with the identified goods, is an unregistrable component of a mark that is subject to disclaimer. TMEP §§1213.03(a), 1213.08(d); *see Bausch & Lomb Optical Co. v. Overseas Fin. & Trading Co.*, 112 USPQ 6, 8 (Comm’r Pats. 1956). The disclaimer must refer to the non-Latin characters and the transliteration (a phonetic spelling of the pronunciation, in Latin characters); e.g., “the non-Latin characters that transliterate to “HUA JIAO””. TMEP §1213.08(d).

Here, applicant’s identified goods are “Sichuan pepper.” Therefore, “HUA JIAO” which translates to “SICHUAN PEPPER” is at least merely descriptive of applicant’s goods that are Sichuan pepper. An applicant may not claim exclusive rights to terms that others need to use to describe their goods in the marketplace.

Applicant may respond to this issue by submitting a disclaimer in the following format:

**No claim is made to the exclusive right to use “the non-Latin characters that transliterate to HUA JIAO” apart from the mark as shown.**

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

- Applicant must also address the following requirement.

#### **Amended Identification of Goods Required**

The identification of goods is indefinite and must be clarified because applicant must further indicate the nature of the goods. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may adopt the following identification of goods, if accurate:

International Class 030: Sichuan pepper **powder**

- 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.

- Applicant must also address the following requirement.

#### **US 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 to Office Action**

- 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.

**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.

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**How to respond.** [Click to file a response to this nonfinal Office action.](#)

/Jessie A. Maihos/  
Trademark Examining Attorney  
Law Office 121  
571-270-3545  
[jessie.maihos@uspto.gov](mailto:jessie.maihos@uspto.gov)

## 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.