

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

U.S. Application Serial No. 79306005

Mark:

Correspondence Address:
Advokatfirman Vinge KB
Box 1703
SE-111 87 Stockholm
SWEDEN

Applicant: Hästens Sängar AB

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION

International Registration No. 1579478

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 (see <https://www.uspto.gov/trademarks-application-process/abandoned-applications> for information on abandonment). To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database at <https://tsdr.uspto.gov/>, 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 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:

- **Identification of Goods**
- **Mark Description**
- **Applicant's Domicile Address**

Identification of Goods

The wording shown in bold italics below is indefinite and too broad. This wording must be clarified because it is not clear what the goods are. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and services from that assigned by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Therefore, although the goods may be classified in several international classes, any modification to this wording must identify goods in the classes specified in the application for these goods. See TMEP §1904.02(c), (c)(ii).

Applicant may adopt the following wording, *if accurate*:

Class 20: Furniture; furniture fittings, not of metal; beds, mattresses, pillows and cushions; mattress toppers; bedroom furniture; bed frames; bed bases; ***bed headboards***.

Class 24: ***Textiles and substitutes for textiles, namely, [specify goods, e.g., towels]; unfitted fabric*** coverings for furniture; blankets; bed linen; bed sheets; sleeping bag liners; pillowcases; bed throws; bed skirts; bed canopies; quilts; bed covers; lap rugs; felt ***cloth***; bed blankets; throws; duvets; towels of textile; curtains; mattress covers

Class 25: [no changes]

The following goods were deleted for being indefinite and misclassified: “bedding” in Class 20, “bed clothes” in Class 24.

For further 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’s goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. 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 amended. 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).

Mark Description

Although applicant submitted a drawing showing the mark in color with a color claim, applicant did not provide the required description that specifies where each color appears in the literal and design elements in the mark. See 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Therefore, applicant must provide this description. See TMEP §807.07(a)(ii).

Generic color names must be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark, applicant must so specify in the description. See TMEP §807.07(d).

The following description is suggested, if accurate: **“The mark consists of four squares forming a larger square in the colors blue and white, one solid blue, one solid white, and two mixtures of alternating blue and white with stylized horses within them.”**

Applicant’s Domicile Address

Applicant must provide applicant’s domicile address. All applications must include the applicant’s domicile address, and domicile dictates whether an applicant is required to have an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory represent the applicant at the USPTO. See 37 C.F.R. §§2.2(o)-(p), 2.11(a), 2.189; *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. 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 a U.S.-licensed attorney qualified to practice before the USPTO under 37 C.F.R. §11.14. 37 C.F.R. §2.11(a).

The application record lists applicant as a juristic entity of Sweden and specifies applicant’s domicile as a post office box or mail forwarding service instead of a street address. In most cases, a post office box or mail forwarding service is not acceptable as a domicile address because it does not identify the location of applicant’s headquarters where the entity’s senior executives or officers ordinarily direct and control the entity’s activities. See 37 C.F.R. §§2.2(o)-(p), 2.189; Examination Guide 4-19, at I.A.3. Thus, applicant must provide its domicile street address. See 37 C.F.R. §2.189. Alternatively, an applicant may demonstrate that the listed U.S. address is, in fact, the applicant’s domicile. Examination Guide 4-19, at I.A.3.

Applicant must either provide documentation to support a U.S. street address or appoint a U.S. licensed attorney. If applicant amends the application to list a domicile street address outside of the United States or its territories, or if applicant lists a U.S. street address as its domicile and elects not to provide documentation to support its U.S. street address as explained below, applicant must appoint a U.S.-licensed attorney qualified to practice before the USPTO under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. See [*Hiring a U.S.-licensed trademark attorney*](#) for more information. If applicant can establish domicile in the United States, the requirement to appoint a U.S.-licensed attorney will be withdrawn. If applicant appoints a U.S.-licensed attorney, the requirement for documentation will be withdrawn.

If applicant provides a U.S. street address as the applicant’s domicile address and elects not to appoint a U.S.-licensed attorney as its representative, then applicant must provide the following documentation to support its U.S. street address. See 37 C.F.R. §§2.11(b), 2.61(b), 2.189; Examination Guide 4-19, at I.A.1-3. Specifically, applicant must provide the most recent documentation showing that the address is the applicant’s or registrant’s business headquarters, for example one of the following:

(1) a current, valid signed rental, lease, or mortgage agreement; or (2) a current valid homeowner’s, renter’s, or motor vehicle insurance policy; or (3) a computer-generated bill issued by a utility company dated within 60 days of the application filing date./ (1) the most recent final annual or quarterly report or other similar report; or (2) a current certificate of good standing for the corporation or other business entity issued by a federal or state government agency.

Examination Guide 4-19, at I.A.2; see 37 C.F.R. §§2.11(b), 2.61(b), 2.189.

Submitted documentation must show the name, listed address, and the date of the document but should redact other personal and financial information.

To provide documentation supporting a U.S. domicile address. Open the correct TEAS response form and enter the serial number, answer “yes” to wizard question #3, and on the “Additional Statement(s)” page, below the “Miscellaneous Statement” field, click the button below the text box to attach documentation to support the U.S. address.

To appoint 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 then 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).

To provide applicant's domicile street address. Open the correct TEAS response form and enter the serial number, answer "yes" to wizard question #3, and on the "Additional Statement(s)" page in the "Miscellaneous Statement" field enter in the text box applicant's domicile street address. If a U.S. street address is provided as applicant's domicile address, applicant must provide the same information and documentation requested above.

If applicant wants to hide its domicile address from public view because of privacy or other concerns, applicant must have a mailing address that can be made public and differs from its domicile address. In this case, applicant must follow the steps below in the correct order to ensure the domicile address will be hidden:

- (1) First submit a TEAS Change Address or Representation (CAR) form. Open the form, enter the serial number, click "Continue," and
 - (a) Use the radio buttons to select "Owner" for the role of the person submitting the form;
 - (b) Answer "Yes" to the wizard question asking, "Do you want to UPDATE the mailing address, email address, phone or fax number(s) for the trademark owner/holder?" and click "Continue;"
 - (c) On the "Owner Information" page, uncheck the box next to "Domicile Address," and enter the new domicile address in the text box immediately below the checkbox. If applicant also needs to change its mailing address, applicant must do so through the International Bureau.
- (2) Then submit a TEAS response form to indicate the domicile address has been changed. Open the form and
 - (a) Answer "yes" to wizard question #3 and click "Continue;"
 - (b) Click on the "Miscellaneous Statement" box on the "Additional Statement(s)" page, and enter a statement in the text box immediately below the checkbox that the domicile address was previously changed in the CAR form.

Email address required. Applicant must provide applicant's email address, which is a requirement for a complete application. See 37 C.F.R. §2.32(a)(2); *Mandatory Electronic Filing & Specimen Requirements*, Examination Guide 1-20, at III.A. (Rev. Feb. 2020). Applicant's email address cannot be identical to the listed primary correspondence email address of any attorney retained to represent applicant in this application. See Examination Guide 1-20, at III.A.

Applicant must be represented by a U.S.-licensed attorney 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 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 at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-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.

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 at <https://teas.uspto.gov/wra/ccr/car>. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form at <https://teas.uspto.gov/office/roa/> 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.](#)

/Linda King/
Examining Attorney
Law Office 116
571-272-9180
Linda.King@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 ESTIA 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.