

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

U.S. Application Serial No. 79319884

Mark:

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FED REP GERMANY

Applicant: Comité International Olympique

Reference/Docket No. N/A

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## NONFINAL OFFICE ACTION

International Registration No. 1612192

### 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. The 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.

### **No Conflicting Marks Noted**

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. However, the applicant must respond to the following issues within the prescribed six-month response period in order to avoid abandonment.

### **SUMMARY OF ISSUES:**

- **Identification/Recitation of Goods/Services Requirements**
- **Description of the Mark Requirements**
- **Applicant's Email Address Required**
- **Applicant Must be Represented by a U.S.-Licensed Attorney**

### **Identification/Recitation of Goods/Services Requirements**

The identification/recitation of goods/services is indefinite and must be clarified because the true nature of large portions of the goods and services is unclear. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Further, the identification of goods and/or services contains parentheses and brackets. Generally, an applicant should *not* use parentheses and brackets, including curly brackets, in identifications in order to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate (1) goods and/or services that have been deleted from registrations, (2) goods and/or services not claimed in an affidavit of incontestability, or (3) guidance to users of the USPTO's U.S. Acceptable Identification of Goods and Services Manual to draft an acceptable identification. See TMEP §§1402.04, 1402.12. The only exception for including parenthetical information in identifications is 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)." See TMEP §1402.12. Therefore, the applicant must remove the parentheses and brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

Importantly, the 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).

With these requirements in mind, the applicant should amend the identification with the following suggested changes, if accurate:

*“Paper and cardboard; printed products in the nature of printed matter, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., posters, paper signs, printed forms, etc. NOTE: If the printed matter includes publications, the applicant must specify the form and subject matter of the publications, e.g., printed magazines in the field of sports, etc.}; bookbinding material, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., tape, wire, cloth, cords, etc.}; printed photographs; stationery and office requisites excluding furniture, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., staplers, paper cutters, rubber bands, etc.}; adhesives for stationery or household purposes; drawing materials and materials for artists, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., drawing brushes, drawing instruments, artists’ pens, artists’ sketch books, etc.}; paintbrushes; instructional material except apparatus, namely, printed instructional and teaching materials in the field of \_\_\_\_\_ {The applicant must specify the subject matters, e.g., sports, etc.}; plastic sheets, films and bags for packaging and wrapping; printing type, printing blocks; works of art and figurines of paper and cardboard, architects’ models; decoration and art materials and media, including artistic, craft and model-making equipment, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., canvas panels for artists, craft paper, modelling compounds, etc.}; filtering materials of paper, namely, filter paper, bags and articles, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., boxes, envelopes, etc.} for packaging, wrapping and storage of paper, cardboard or plastic; stationery and educational supplies, namely, writing implements and postage meter stamp canceling machines for office use, erasers and erasing pens; label printing machines and bookbinding apparatus and machines for office use; printed educational materials and printed educational media, namely, \_\_\_\_\_ {The applicant must list each item that applies individually by using its common commercial name, e.g., printed educational material and printed educational media, namely, teaching tiles, etc.}; photo albums and collectors’ albums, namely, albums for coins, stamps and stickers; printed matter, namely, books on the subject of \_\_\_\_\_ {The applicant must specify the subject matter of the books, e.g., sports, etc.}; paper and cardboard, namely, paper and cardboard for industrial use; disposable pads of paper or cellulose for house training pets; paper bags for disposable diapers; disposable napkins of paper, party ornaments of paper,” in International Class 16.*

*“Clothing, namely, \_\_\_\_\_ {NOTE: The word “clothing” in the identification of goods in International Class 25 is indefinite and too broad and must be clarified because the word does not make clear the nature of the goods and could identify goods in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii). The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although clothing can be classified in international classes other than International Class 25 (e.g., International Classes 9, 10, and 18), any modification to the identification must identify goods in International Class 25 only, the class specified in the application for such goods. See TMEP §1904.02(c)(ii). Accordingly, the applicant must list each clothing item that applies individually by using its common commercial name, e.g., shirts, shirts, sweatshirts, athletic uniforms, etc.}; footwear, headwear (NOTE: The second listing of “footwear and headwear” is redundant and should either be deleted or clarified),” in International Class 25.*

*“Teaching in the fields of {The applicant must indicate the specific fields, e.g., sports, music, etc.}; Training services in the fields of {The applicant must indicate the specific fields, e.g., sports, music, etc.}; entertainment services, namely, \_\_\_\_\_ {The applicant must list each “entertainment service” individually by using its common commercial name, e.g., entertainment services provided at or relating to sports events, namely, presentation of live show performances in the nature of opening and closing ceremonies of international sports events, etc.}; sporting and cultural activities, namely, \_\_\_\_\_ {The applicant must list each service that applies individually by using its common commercial name, e.g., organizing international community sporting and cultural events, television show production in the field of sporting and cultural entertainment, etc.}; editing printed matter and writing texts, namely, \_\_\_\_\_ {The applicant must list each service that applies individually by using its common commercial name, e.g., written text editing, writing of articles for journals and periodicals other than for advertising or publicity, etc.}; education, entertainment and sports services, namely, \_\_\_\_\_ {The applicant must list each service that applies individually by using its common commercial name, e.g., arranging and conducting education courses in the field of sports, entertainment in the nature of ongoing television programs in the field of sports, etc.}; organization of educational conferences, entertainment exhibitions and competitions, in the field of sports, etc.}; gambling services; audio, video and multimedia production, namely, \_\_\_\_\_ {The applicant must list each service that applies individually by using its common commercial name, e.g., production of video and sound recordings, Entertainment services, namely, multimedia production services, production of television and radio programs, etc.}; photography services; education and instruction services, namely, conducting \_\_\_\_\_ {The applicant must provide the specific forms of instructions, e.g., conferences, programs, classes, seminars, workshops, etc.} in the field of \_\_\_\_\_ {The applicant must provide the specific fields, e.g., sports,*

etc.}; rental services relating to equipment and facilities for education, entertainment, sports and culture, **namely,** \_\_\_\_\_ {The applicant must list each service individually by using its common commercial name, e.g., rental of game equipment, rental of films, rental of indoor recreational facilities for playing sports, sports training, and group recreation events, etc.}; lending library services and rental of media, **namely,** \_\_\_\_\_ {The applicant must list each item individually by using its common commercial name, e.g., rental of video recording in the field of sports, rental of films, video tapes and sound recordings, etc.}; rental of sports equipment, except vehicles, and rental of sports facilities; rental of audiovisual and photographic equipment and rental of photography and recording studios; language translation and interpretation services; ticket booking and pre-booking services for educational, entertainment and sporting events,” in International Class 41.

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.

### **Description of the Mark Requirements**

Although the 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 the design of a stylized dog with a blue tail, blue hind quarters, green fore quarters and a midsection colored by five stripes, from left to right, in the colors, green, yellow, blue, blue and orange. The head, ear and eye of the dog appear in blue.**

### **Applicant’s Email Address Required**

The applicant must provide applicant’s email address, which is a requirement for a complete application. See 37 C.F.R. §2.32(a)(2); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. See TMEP §803.05(b).

### **Applicant Must be Represented by a U.S.-Licensed Attorney**

**Applicant is required to be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal** because applicant’s domicile is located outside of the United States and applicant does not appear to be represented by a qualified U.S. attorney. 37 C.F.R. §2.11(a); TMEP §601.01(a). An applicant whose domicile is located outside of the United States or its territories 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); TMEP §§601, 601.01(a). In this case, applicant’s domicile is identified in the application as Switzerland. For more information, see the U.S. Counsel webpage at <https://www.uspto.gov/trademark/laws-regulations/trademark-rule-requires-foreign-applicants-and-registrants-have-us> and Hiring a U.S.-licensed trademark attorney webpage at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney>.

**To appoint a U.S.-licensed attorney** in this application, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at <https://teas.uspto.gov/wa/cor/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. 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); TMEP §604.01.

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

If the applicant has any questions or needs assistance with the present application, please telephone the assigned examining attorney.

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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.