

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

U.S. Application Serial No. 79323950

Mark: UNI QLO

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**Applicant:** FAST RETAILING CO., LTD.

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

**Correspondence Email Address:**

**NONFINAL OFFICE ACTION**

**International Registration No.** 1156890

**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. §§1141(a), 1141h(c).

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 OF USPTO DATABASE OF MARKS**

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 and Color Claim Required
- Owner Information Required
- Email Address Required
- U.S. Licensed Attorney Required

**IDENTIFICATION OF GOODS**

Wording in the identification of goods is indefinite and must be clarified. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Specifically, applicant must address issues with the following wording:

- The wording "printed matter" is vague. Applicant must identify the nature of the printed materials and the specific subject matter if applicable.
- The wording "photographs" is overbroad. 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). Only printed photographs fall into Class 16.
- The wording "cosmetic and toilet utensils" in Class 21 is vague. Applicant must identify the types of utensils by their common commercial name, e.g., make-up brushes.
- Similarly, the wording "kitchen equipment (not including "gas water heaters (for household purposes), non-electric cooking heaters (for household purposes), kitchen worktops and kitchen sinks")" and "cleaning tools and washing utensils" in Class 21 is vague. Applicant must identify the specific types of kitchen equipment and cleaning products by their common commercial name.
- The wording "handy shoe shiners" is overbroad and may identify goods which fall into multiple International Classes. Shoe shine cloths and

brushes fall into Class 21, electric shiners fall into Class 7 and shoe polish applicators containing shoe polish fall into Class 3. Any clarification will need to identify goods which fall into Class 21. Shoe shine cloths and shoe brushes are already included in the identification of goods, therefore applicant may delete this wording if clarification would create duplicate entries.

- The wording “tatami mats and the like;” in Class 27 is unacceptably vague due to the open-ended wording “and the like”. Applicant must either identify the specific types of similar items by their common commercial name, or delete this broad wording.
- The wording “wall hangings (not of textile)” in Class 27 is overbroad and may identify non-ornamental wall hangings which fall into other classes. Applicant may substitute “decorative wall hangings, not of textile”, if accurate.
- The wording “toys” in Class 28 is vague. Applicant must identify the types of toys, e.g., toy action figures, plush toys, balls for games, etc.
- The wording “game machines and apparatus” is vague. Applicant must clarify the nature of the goods, e.g., video game machines and controllers.
- The wording “sports equipment” is vague. Applicant must identify the types of sports equipment by their common commercial name.
- In addition, the identification of goods contains parentheses. 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, applicant must remove most of the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

Applicant may substitute the following wording, if accurate:

**Class 16:** Pastes and other adhesives for stationery or household purposes; hygienic hand towels of paper; towels of paper; table napkins of paper; hand towels of paper; handkerchiefs of paper; paper and cardboard; stationery; **printed matter in the nature of [applicant must identify the types of printed products] in the field of [applicant must identify the subject matter of the products, if applicable];** paintings and calligraphic works; **printed photographs;** photograph stands

**Class 21:** Cosmetic utensils, namely, [applicant must identify the specific types of goods by their common commercial name]; toilet utensils, namely, [applicant must identify the specific types of goods by their common commercial name]; gloves for household purposes; industrial packaging containers of glass or porcelain; **kitchen equipment, namely, [applicant must identify the specific types of goods by their common commercial name];** cleaning tools, namely, [applicant must identify the specific types of goods by their common commercial name]; washing utensils, namely, [applicant must identify the specific types of goods by their common commercial name]; stirrers for hot bathtub water (yukakibo); bathroom stools; bathroom pails; shoe brushes; shoe horns; shoe shine cloths; **shoe tree stretchers**

**Class 27:** Bath mats for wash places; **tatami mats;** floor coverings; **decorative wall hangings, not of textile;** artificial turf; gymnastic mats; wallpaper

**Class 28:** Toys for domestic pets; **toys, namely, [applicant must identify the specific types of goods by their common commercial name];** dolls; go games; Japanese chess (shogi games); Japanese playing cards (utagaruta); dice; Japanese dice games (sugoroku); dice cups; Chinese checkers; chess games; **checkers sets; magic tricks;** dominoes; playing cards; Japanese playing cards (hanafuda); mah-jong; **video game machines and controllers;** billiard equipment; **sports equipment, namely, [applicant must identify the specific types of goods by their common commercial name];** fishing tackle

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 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).

#### MARK DESCRIPTION AND COLOR CLAIM REQUIRED

Applicant must clarify whether color is a feature of the mark because, although the drawing shows the mark in color, the application does not explicitly state whether color is being used in the mark. 37 C.F.R. §§2.37, 2.52(b)(1), 2.61(b); see TMEP §807.07(a)-(b). Applications for marks depicted in color must include a color drawing and a statement (1) listing all the colors claimed as a feature of the mark and (2) describing where each color appears in the literal and design elements in the mark. 37 C.F.R. §§2.37, 2.52(b)(1); see TMEP §807.07(a)-(b). Because the application does not include an explicit statement about color, the record is not clear as to whether it is a feature of the mark.

To clarify whether color is claimed as a feature of the mark, applicant must satisfy one of the following:

- (1) If **color is not a feature of the mark**, applicant must submit (a) a new black-and-white drawing of the mark to replace the color drawing in the record, (b) a statement that no claim of color is made in the international registration, and (c) a description of the literal and design elements in the mark omitting any reference to color. 37 C.F.R. §2.37; TMEP §§807.07(b), 807.12(c); see TMEP §§808 et

seq.

The following description is suggested, if accurate:

**The mark consists of the stylized wording "UNI QLO" in a monospaced typeface within a square with the element "UNI" directly positioned above the element "QLO".**

- (2) If **color is a feature of the mark**, applicant must submit a statement (a) listing all the colors claimed as a feature of the mark and (b) describing where the colors appear in the literal and design elements in the mark. 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §§807.07(b), 807.12(c). 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 include a statement indicating that in the description. See TMEP §807.07(d), (d)(iii).

The following color claim and description are suggested, if accurate:

Color claim: **"The colors red and white are claimed as a feature of the mark."**

Description: **"The mark consists of the stylized wording "UNI QLO" in a white monospaced typeface within a red square with the element "UNI" directly positioned above the element "QLO".**

#### OWNER INFORMATION REQUIRED

Applicant must specify its legal entity type and national citizenship or foreign country of organization or incorporation, as applicant did not include this information in the application. See 37 C.F.R. §§2.32(a)(3)(i)-(v), 2.61(b); TMEP §§803.03, 803.04. This information is required for all U.S. trademark applications, including those filed under Trademark Act Section 66(a). See 37 C.F.R. §7.25(a)-(b); TMEP §1904.02(a).

Acceptable legal entity types include an individual, a partnership, a corporation, a joint venture, or the foreign equivalent. See TMEP §§803.03 *et seq.* If applicant's legal entity type is an individual, applicant must so specify and provide his or her national citizenship. 37 C.F.R. §2.32(a)(3)(i); TMEP §803.03(a). If applicant is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must so specify and provide the foreign country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §803.03(b)-(c). For an association, applicant must also specify whether the association is incorporated or unincorporated, unless the foreign country and the designation or description "association/associazione" appear in Appendix D of the *Trademark Manual of Examining Procedure* (TMEP). TMEP §803.03(c). If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. See TMEP §803.04.

#### 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); 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).

#### U.S. LICENSED ATTORNEY REQUIRED

**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 Japan. 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/my-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/cor/cor>. 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.

#### RESPONSE GUIDELINES

**How to respond.** [Click to file a response to this nonfinal 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.

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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.