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

U.S. Application Serial No. 79329052

Mark: PIONEER

Correspondence Address:
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Rosental 4
80331 Munich GERMANY

Applicant: Bio-Rad Europe GmbH

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION
Notice of Provisional Full Refusal

International Registration No. 1634330

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 "IB-1rst 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 issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Partial Section 2(d) Refusal: Likelihood of Confusion - Applies Only to Class 1
- Legal Entity Clarification Requirement
- Identification Requirement
- Email Requirement
- Domicile and Attorney Requirement

PARTIAL SECTION 2(D) REFUSAL: LIKELIHOOD OF CONFUSION - *APPLIES ONLY TO CLASS 1*

The stated refusal refers to International Class 1 only and does not bar registration in the other classes.

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 1099114. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Applicant's mark is: "PIONEER" for "Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents for scientific or research use" in Class 1

Registrant's mark is Reg. No. 1099114: "PIONEER" for "MICROBIAL CHEMICAL CULTURES FOR USE IN INDUSTRIAL APPLICATIONS INCLUDING FERMENTATION OF FEEDSTUFFS SUCH AS SILAGE AND FORAGES, AND FOODSTUFFS SUCH AS FEED FOR LIVESTOCK AND POULTRY AND OTHER FOOD USES.."

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

Comparison of the Marks

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arks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant's mark is "PIONEER".

Registrant's mark is "PIONEER".

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hese marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods and/or services. *Id.*

Based on the foregoing, the applicant's applied-for and registrant's marks are sufficiently similar to find a likelihood of confusion.

Comparison of Goods and/or Services

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Applicant's mark is "Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents for scientific or research use" in Class 1.

Registrant's mark is for "MICROBIAL CHEMICAL CULTURES FOR USE IN INDUSTRIAL APPLICATIONS INCLUDING FERMENTATION OF FEEDSTUFFS SUCH SILAGE AND FORAGES, AND FOODSTUFFS SUCH AS FEED FOR LIVESTOCK AND POULTRY AND OTHER FOOD USES."

In this case, the application use(s) broad wording to describe its goods, including "

biological preparations for scientific, industrial, and research use; antibodies for research use,"

which presumably encompasses all goods and/or services of the type described, including registrant(s)'s more narrow list relevant narrower goods. *See, e.g.*, *In re Solid State Design Inc*, 125 USPQ2d 1409, 1412-15(TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) Thus, applicant's and registrant's goods are legally identical. *See, e.g.*, *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEASys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods and/or services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905,1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d1001, 1005 (Fed. Cir. 2002)). Thus, applicant's and registrant's goods and/or services are related.

Further, w

here the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); TMEP §1207.01(a); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

Based on the analysis above, applicant's and registrant's goods and/or services are related.

Conclusion

Because applicant's and registrant's marks are similar and the goods and/or services are related, there is a likelihood of confusion and applicant's applied-for mark must be refused under Section 2(d) of the Lanham Act.

Applicant may respond to the stated refusal by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following:

(1) Deleting the class to which the refusal pertains;

(2) Filing a Request to Divide Application form (form #3) to divide out the goods and/or services that have not been refused registration, so that the mark may proceed toward publication for opposition in the classes to which the refusal does not pertain. *See* 37 C.F.R. §2.87. *See generally* TMEP §§1110 *et seq.* (regarding the requirements for filing a request to divide). If applicant files a request to divide, then to avoid abandonment, applicant must also file a timely response to all outstanding issues in this Office action, including the refusal. 37 C.F.R. §2.87(e).; or

(3) Amending the basis, if appropriate. TMEP §806.03(h). (The basis cannot be changed for applications filed under Trademark Act Section 66(a). TMEP §1904.01(a).)

However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

LEGAL ENTITY CLARIFICATION REQUIREMENT

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.

IDENTIFICATION REQUIREMENT

Applicant has identified the following goods:

Class 1: Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents for scientific or research use

Class 5: Biological preparations for medical use; pharmaceutical, biopharmaceutical and medical preparations, agents and

substances; diagnostic preparations, agents and substances for medical purposes; antibodies for medical purposes; immunoglobulins, antibodies, or fragments thereof, for medical use; antibody libraries, for medical and veterinary use; libraries of immunoglobulins, antibodies, or fragments thereof, for medical use; products containing immunoglobulins, antibodies, or fragments thereof, for use in medicine; diagnostic reagents for medical purposes; diagnostic reagents for medical use; diagnostic reagents for clinical or medical laboratory use

Class 40: Antibody generation and antibody production for others, antibody purification, antibody fragmentation, and manufacture of antibodies for others; custom production of cell cultures and biological products in the nature of antibodies and proteins and related reagents; custom antibody production; custom manufacturing for others, namely, manufacturing of chemical and biotechnological materials for others, namely, manufacturing of organisms, compounds and materials for use in the pharmaceutical, agrochemical, chemical, biotechnology industries

Class 42: Antibody generation services being research and development services; medical and scientific research for the identification, preparation, and development of antibody libraries; laboratory research and analysis services in the nature of preparation and screening of libraries of proteins and antibodies, libraries of cells producing antibodies and proteins, and libraries of vector coding for antibodies and proteins; design of antibody libraries for medical or veterinary use; scientific and technological services, namely, scientific and technological research, analysis, inspection, quality audit, consulting, design, engineering, development and laboratory testing services for others; chemical research and development services; testing or scientific research on biotechnology and providing scientific information and research consultancy relating thereto; providing information and consultancy on testing, inspection or research of pharmaceuticals, chemicals for use in medicines, reagents for use in medicines, cosmetics or foodstuffs; scientific or laboratory testing, inspection or research of nucleic acids, chemicals and pharmaceuticals for drug development and medical research purposes, and providing scientific information and research consultancy relating thereto; genomic experiments, analyses, research, assays, tests, inspection, detection or verification, namely, scientific genomic analyses, scientific genomic research, custom design and development of biochemical genomic assays, genome amplification and functional and structural analysis of genomes; laboratory services of a chemist, biologist, biochemist, biotechnologists, gene technologists, molecular biologists, pharmacists, protein chemist; industrial analysis and research services; pharmaceutical, medical, scientific and biopharmaceutical research and development; drug discovery services; research relating to medicines; research and development of medicines; development of pharmaceutical and biopharmaceutical preparations and medicines

In a Trademark Act Section 66(a) application, classification of goods 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 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).

In Class 1, applicant should clarify that the antibodies and

immunoglobulins

are a type of biological preparations for scientific or industrial use. This will sufficiently clarify the nature and limit the classification to Class 1.

See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Additionally, in Classes 1nad 5, applicant should clarify the nature of the libraries. If accurate, applicant should state that these are collections of goods sold together as a unit or kit.

See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

In Class 5, applicant must clarify what the various preparations are used to treat. Applicant must provide more information as to the nature of these goods. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

In Class 40, applicant must clarify the nature of the services provided and properly limit them to Class 40 only. In particular, applicant should clarify the nature and of the "

antibody purification, antibody fragmentation" services and how they properly fit within Class 40.

See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

In Class 42, applicant must clarify the identification for "

antibody generation services being research and development services," which appear to be overbroad. As stated above, the identifications must be clarified and limited to their current classification. Therefore, if accurate, applicant should amend this to "research and development in the field of antibody generation."

The wording "laboratory

research and analysis services

" in the identification of services is indefinite and must be clarified because the scope of these services is clear. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: "

Chemical, biochemical, biological and bacteriological research and analysis services..."

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The wording "chemical research and development services" is unclear. The scope of these services should be clarified. If accurate, applicant may amend this to "research and development services in the field of developing new chemicals."

See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant should also clarify that the "laboratory services" are "scientific laboratory services." Similarly, in the identification for "

genomic experiments, analyses, research, assays, tests, inspection, detection or verification, namely, scientific genomic analyses, scientific genomic research, custom design and development of biochemical genomic assays, genome amplification and functional and structural analysis of genomes," applicant should clarify that the "

scientific genomic analyses

" and "g

enome amplification and functional and structural analysis of genomes

" services are types of scientific laboratory services.

See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The scope and nature of "industrial analysis and research" is unclear. Applicant should be more clear and specific as to the field of analysis and research.

If accurate, applicant may adopt the suggestion below, which reflects the required changes discussed above:

> **Class 1:** Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; biological preparations in the nature of antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use, namely, biological preparations in the nature of antibodies sold together; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use, namely, biological preparations in the nature of immunoglobulins, antibodies, or fragments thereof sold together as a kit; biological preparations in the nature of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents, both for scientific or research use

> **Class 5:** Biological preparations for the treatment of {*specify disease or physical condition, e.g., cancer, etc.*}; pharmaceutical, biopharmaceutical and medical preparations for the treatment of {*specify disease or physical condition, e.g., cancer, etc.*}; diagnostic preparations for medical purposes; Colostral antibodies for medical purposes; biological preparations, namely, immunoglobulins, antibodies, or fragments thereof, for medical use; antibody libraries, for medical and veterinary use, namely, collections of colostral antibodies for medical purposes sold as a unit; libraries of immunoglobulins,

antibodies, or fragments thereof, for medical use, namely, collections of biological preparations in the nature of immunoglobulins, antibodies, or fragments thereof, for medical use, sold as a unit; biological preparations comprised of immunoglobulins, antibodies, or fragments thereof, for use in medicine; diagnostic reagents for medical purposes; diagnostic reagents for medical use; diagnostic reagents for medical clinician or medical use

Class 40: Antibody production for others, and manufacture of antibodies for others; custom manufacture of antibodies, namely, antibody purification, antibody fragmentation; custom production of cell cultures and biological products in the nature of antibodies and proteins and related reagents; custom antibody production; custom manufacturing for others, namely, manufacturing of chemical and biotechnological materials for others, namely, manufacturing of organisms, compounds and materials for use in the pharmaceutical, agrochemical, chemical, biotechnology industries

Class 42: Research and development in the field of antibody generation services; medical and scientific research for the identification, preparation, and development of antibody libraries; Chemical, biochemical, biological and bacteriological research and analysis services in the nature of preparation and screening of libraries of proteins and antibodies, libraries of cells producing antibodies and proteins, and libraries of vector coding for antibodies and proteins; design of antibody libraries for medical or veterinary use; scientific and technological services, namely, scientific and technological research, analysis, inspection, quality audit, consulting, design, engineering, development and laboratory testing services for others; research and development services in the field of developing new chemicals; testing or scientific research on biotechnology and providing scientific information and research consultancy relating thereto; providing information and consultancy on testing, inspection or research of pharmaceuticals, chemicals for use in medicines, reagents for use in medicines, cosmetics or foodstuffs; scientific or laboratory testing, inspection or research of nucleic acids, chemicals and pharmaceuticals for drug development and medical research purposes, and providing scientific information and research consultancy relating thereto; genomic experiments, analyses, research, assays, tests, inspection, detection or verification, namely, scientific laboratory services being scientific genomic analyses, scientific genomic research, custom design and development of biochemical genomic assays, genome amplification and functional and structural analysis of genomes; scientific laboratory services of a chemist, biologist, biochemist, biotechnologists, gene technologists, molecular biologists, pharmacists, protein chemist; chemical and biological analysis and research services; pharmaceutical, medical, scientific and biopharmaceutical research and development; drug discovery services; research relating to medicines; research and development of medicines; development of pharmaceutical and biopharmaceutical preparations and medicines

Applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). 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 narrowed. *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). Anyacceptable changes to the goods will further limit scope, and once goods are deleted, they are not permitted to be reinserted. 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 may not be changed from that assignedby the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-classSection 66(a) application, classes may not be added or goods 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.

EMAIL REQUIREMENT

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mail 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.

DOMICILE AND ATTORNEY REQUIREMENT

Applicant must be represented by a U.S.-licensed attorney to respondto 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 Attorneyfor Foreign-Domiciled Trademark Applicants & Registrants, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individualapplicant'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 sucha 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 athttps://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 onbehalf of a foreign-domiciled applicant. 37 C.F.R. §2.11(a). Accordingly, the USPTO will not communicate further withapplicant 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 orRepresentation form at https://teas.uspto.gov/wna/ccr/car. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form athttps://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).

RESPONSE AND ASSISTANCE

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.

Response guidelines. For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicantmay 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.

How to respond. Click to file a response to this nonfinal Office action.

/Kimberly Ray/
Kimberly Ray
Trademark Examining Attorney
Law Office 122
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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS 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.

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

U.S. Application Serial No. 79329052

Mark: PIONEER

Correspondence Address:
D YOUNG & CO LLP
Rosental 4
80331 Munich GERMANY

Applicant: Bio-Rad Europe GmbH

Reference/Docket No. N/A

Correspondence Email Address:

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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.

SUMMARY OF ISSUES:

- Partial Section 2(d) Refusal: Likelihood of Confusion - Applies Only to Class 1
- Legal Entity Clarification Requirement
- Identification Requirement
- Email Requirement
- Domicile and Attorney Requirement

PARTIAL SECTION 2(D) REFUSAL: LIKELIHOOD OF CONFUSION - *APPLIES ONLY TO CLASS 1*

The stated refusal refers to International Class 1 only and does not bar registration in the other classes.

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 1099114. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Applicant's mark is: "PIONEER" for "Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents for scientific or research use" in Class 1

Registrant's mark is Reg. No. 1099114: "PIONEER" for "MICROBIAL CHEMICAL CULTURES FOR USE IN INDUSTRIAL APPLICATIONS INCLUDING FERMENTATION OF FEEDSTUFFS SUCH AS SILAGE AND FORAGES, AND FOODSTUFFS SUCH AS FEED FOR LIVESTOCK AND POULTRY AND OTHER FOOD USES.."

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant's mark is "PIONEER".

Registrant's mark is "PIONEER".

These marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd,* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods and/or services. *Id.*

Based on the foregoing, the applicant's applied-for and registrant's marks are sufficiently similar to find a likelihood of confusion.

Comparison of Goods and/or Services

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Applicant's mark is "Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents for scientific or research use" in Class 1.

Registrant's mark is for "MICROBIAL CHEMICAL CULTURES FOR USE IN INDUSTRIAL APPLICATIONS INCLUDING FERMENTATION OF FEEDSTUFFS SUCH AS SILAGE AND FORAGES, AND FOODSTUFFS SUCH AS FEED FOR LIVESTOCK AND POULTRY AND OTHER FOOD USES."

In this case, the application use(s) broad wording to describe its goods, including "biological preparations for scientific, industrial, and research use; antibodies for research use," which presumably encompasses all goods and/or services of the type described, including registrant(s)'s more narrow list relevant narrower goods. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB

2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods and/or services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant's and registrant's goods and/or services are related.

Further, where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); TMEP §1207.01(a); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

Based on the analysis above, applicant's and registrant's goods and/or services are related.

Conclusion

Because applicant's and registrant's marks are similar and the goods and/or services are related, there is a likelihood of confusion and applicant's applied-for mark must be refused under Section 2(d) of the Lanham Act.

Applicant may respond to the stated refusal by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following:

(1) Deleting the class to which the refusal pertains;

(2) Filing a Request to Divide Application form (form #3) to divide out the goods and/or services that have not been refused registration, so that the mark may proceed toward publication for opposition in the classes to which the refusal does not pertain. *See* 37 C.F.R. §2.87. *See generally* TMEP §§1110 *et seq.* (regarding the requirements for filing a request to divide). If applicant files a request to divide, then to avoid abandonment, applicant must also file a timely response to all outstanding issues in this Office action, including the refusal. 37 C.F.R. §2.87(e).; or

(3) Amending the basis, if appropriate. TMEP §806.03(h). (The basis cannot be changed for applications filed under Trademark Act Section 66(a). TMEP §1904.01(a).)

However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

LEGAL ENTITY CLARIFICATION REQUIREMENT

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.

IDENTIFICATION REQUIREMENT

Applicant has identified the following goods:

Class 1: Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents for scientific or research use

Class 5: Biological preparations for medical use; pharmaceutical, biopharmaceutical and medical preparations, agents and substances; diagnostic preparations, agents and substances for medical purposes; antibodies for medical purposes; immunoglobulins, antibodies, or fragments thereof, for medical use; antibody libraries, for medical and veterinary use; libraries of immunoglobulins, antibodies, or fragments thereof, for medical use; products containing immunoglobulins, antibodies, or fragments thereof, for use in medicine; diagnostic reagents for medical purposes; diagnostic reagents for medical use; diagnostic reagents for clinical or medical laboratory use

Class 40: Antibody generation and antibody production for others, antibody purification, antibody fragmentation, and manufacture of antibodies for others; custom production of cell cultures and biological products in the nature of antibodies and proteins and related reagents; custom antibody production; custom manufacturing for others, namely, manufacturing of chemical and biotechnological materials for others, namely, manufacturing of organisms, compounds and materials for use in the pharmaceutical, agrochemical, chemical, biotechnology industries

Class 42: Antibody generation services being research and development services; medical and scientific research for the identification, preparation, and development of antibody libraries; laboratory research and analysis services in the nature of preparation and screening of libraries of

proteins and antibodies, libraries of cells producing antibodies and proteins, and libraries of vector coding for antibodies and proteins; design of antibody libraries for medical or veterinary use; scientific and technological services, namely, scientific and technological research, analysis, inspection, quality audit, consulting, design, engineering, development and laboratory testing services for others; chemical research and development services; testing or scientific research on biotechnology and providing scientific information and research consultancy relating thereto; providing information and consultancy on testing, inspection or research of pharmaceuticals, chemicals for use in medicines, reagents for use in medicines, cosmetics or foodstuffs; scientific or laboratory testing, inspection or research of nucleic acids, chemicals and pharmaceuticals for drug development and medical research purposes, and providing scientific information and research consultancy relating thereto; genomic experiments, analyses, research, assays, tests, inspection, detection or verification, namely, scientific genomic analyses, scientific genomic research, custom design and development of biochemical genomic assays, genome amplification and functional and structural analysis of genomes; laboratory services of a chemist, biologist, biochemist, biotechnologists, gene technologists, molecular biologists, pharmacists, protein chemist; industrial analysis and research services; pharmaceutical, medical, scientific and biopharmaceutical research and development; drug discovery services; research relating to medicines; research and development of medicines; development of pharmaceutical and biopharmaceutical preparations and medicines

In a Trademark Act Section 66(a) application, classification of goods 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 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).

In Class 1, applicant should clarify that the antibodies and immunoglobulinsare a type of biological preparations for scientific or industrial use. This will sufficiently clarify the nature and limit the classification to Class 1. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Additionally, in Classes 1nad 5, applicant should clarify the nature of the libraries. If accurate, applicant should state that these are collections of goods sold together as a unit or kit. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

In Class 5, applicant must clarify what the various preparations are used to treat. Applicant must provide more information as to the nature of these goods. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

In Class 40, applicant must clarify the nature of the services provided and properly limit them to Class 40 only. In particular, applicant should clarify the nature and of the "antibody purification, antibody fragmentation" services and how they properly fit within Class 40. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

In Class 42, applicant must clarify the identification for "antibody generation services being research and development services," which appear to be overbroad. As stated above, the identifications must be clarified and limited to their current classification. Therefore, if accurate, applicant should amend this to "research and development in the field of antibody generation."

The wording “laboratory research and analysis services” in the identification of services is indefinite and must be clarified because the scope of these services is clear. *See* 37 C.F.R. §2.32(a)(6); TMEP

§1402.01. Applicant may substitute the following wording, if accurate: "Chemical, biochemical, biological and bacteriological research and analysis services...".

The wording "chemical research and development services" is unclear. The scope of these services should be clarified. If accurate, applicant may amend this to "research and development services in the field of developing new chemicals." *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.Applicant should also clarify that the "laboratory services" are "scientific laboratory services." Similarly, in the identification for "genomic experiments, analyses, research, assays, tests, inspection, detection or verification, namely, scientific genomic analyses, scientific genomic research, custom design and development of biochemical genomic assays, genome amplification and functional and structural analysis of genomes," applicant should clarify that the "scientific genomic analyses" and "genome amplification and functional and structural analysis of genomes" services are types of scientific laboratory services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The scope and nature of "industrial analysis and research" is unclear. Applicant should be more clear and specific as to the field of analysis and research.

If accurate, applicant may adopt the suggestion below, which reflects the required changes discussed above:

Class 1: Chemicals for use in industry and science; biological preparations for scientific, industrial, and research use; biological preparations in the nature of antibodies for research use, other than for medical or veterinary purposes; antibody libraries, for scientific, industrial or research use, namely, biological preparations in the nature of antibodies sold together; libraries of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use, namely, biological preparations in the nature of immunoglobulins, antibodies, or fragments thereof sold together as a kit; biological preparations in the nature of immunoglobulins, antibodies, or fragments thereof, for scientific, industrial, and research use; assays and reagents for use in genetic research; diagnostic reagents for scientific and research use; reagents and kits comprising chemical reagents, both for scientific or research use

Class 5: Biological preparations for the treatment of {*specify disease or physical condition, e.g., cancer, etc.*}; pharmaceutical, biopharmaceutical and medical preparations for the treatment of {*specify disease or physical condition, e.g., cancer, etc.*}; diagnostic preparations for medical purposes; Colostral antibodies for medical purposes; biological preparations, namely, immunoglobulins, antibodies, or fragments thereof, for medical use; antibody libraries, for medical and veterinary use, namely, collections of colostral antibodies for medical purposes sold as a unit; libraries of immunoglobulins, antibodies, or fragments thereof, for medical use, namely, collections of biological preparations in the nature of immunoglobulins, antibodies, or fragments thereof, for medical use, sold as a unit; biological preparations comprised of immunoglobulins, antibodies, or fragments thereof, for use in medicine; diagnostic reagents for medical purposes; diagnostic reagents for medical use; diagnostic reagents for medical clinician or medical use

Class 40: Antibody production for others, and manufacture of antibodies for others; custom manufacture of antibodies, namely, antibody purification, antibody fragmentation; custom production of cell cultures and biological products in the nature of antibodies and proteins and related reagents; custom antibody production; custom manufacturing for others, namely, manufacturing of chemical and biotechnological materials for others, namely, manufacturing of

organisms, compounds and materials for use in the pharmaceutical, agrochemical, chemical, biotechnology industries

Class 42: Research and development in the field of antibody generation services; medical and scientific research for the identification, preparation, and development of antibody libraries; Chemical, biochemical, biological and bacteriological research and analysis services in the nature of preparation and screening of libraries of proteins and antibodies, libraries of cells producing antibodies and proteins, and libraries of vector coding for antibodies and proteins; design of antibody libraries for medical or veterinary use; scientific and technological services, namely, scientific and technological research, analysis, inspection, quality audit, consulting, design, engineering, development and laboratory testing services for others; research and development services in the field of developing new chemicals; testing or scientific research on biotechnology and providing scientific information and research consultancy relating thereto; providing information and consultancy on testing, inspection or research of pharmaceuticals, chemicals for use in medicines, reagents for use in medicines, cosmetics or foodstuffs; scientific or laboratory testing, inspection or research of nucleic acids, chemicals and pharmaceuticals for drug development and medical research purposes, and providing scientific information and research consultancy relating thereto; genomic experiments, analyses, research, assays, tests, inspection, detection or verification, namely, scientific laboratory services being scientific genomic analyses, scientific genomic research, custom design and development of biochemical genomic assays, genome amplification and functional and structural analysis of genomes; scientific laboratory services of a chemist, biologist, biochemist, biotechnologists, gene technologists, molecular biologists, pharmacists, protein chemist; chemical and biological analysis and research services; pharmaceutical, medical, scientific and biopharmaceutical research and development; drug discovery services; research relating to medicines; research and development of medicines; development of pharmaceutical and biopharmaceutical preparations and medicines

Applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). 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 narrowed. *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). 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 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 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.

EMAIL REQUIREMENT

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.

DOMICILE AND ATTORNEY REQUIREMENT

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. 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 at https://teas.uspto.gov/wna/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).

RESPONSE AND ASSISTANCE

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.

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.

How to respond. Click to file a response to this nonfinal Office action.

/Kimberly Ray/
Kimberly Ray
Trademark Examining Attorney
Law Office 122
(571) 272-7834
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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS 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.

(1) TYPED DRAWING

PIONEER

Mark Punctuated
PIONEER

Translation

Goods/Services

- IC 001. US 006.G & S: MICROBIAL CHEMICAL CULTURES FOR USE IN INDUSTRIAL APPLICATIONS INCLUDING FERMENTATION OF FEEDSTUFFS SUCH AS SILAGE AND FORAGES, AND FOODSTUFFS SUCH AS FEED FOR LIVESTOCK AND POULTRY AND OTHER FOOD USES. FIRST USE: 19770728. FIRST USE IN COMMERCE: 19770728

Mark Drawing Code
(1) TYPED DRAWING

Design Code

Serial Number
73137052

Filing Date
19770810

Current Filing Basis
1A

Original Filing Basis
1A

Publication for Opposition Date

Registration Number
1099114

Date Registered
19780815

Owner
(REGISTRANT) PIONEER HI-BRED INTERNATIONAL, INC. CORPORATION IOWA 7100 NW 62ND AVENUE JOHNSTON IOWA 501311014

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
C. Joe Miller