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

**U.S. Application Serial No.** 79323327

**Mark:** IQ-DESIGN

**Correspondence Address:**
*D YOUNG & CO LLP*
*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. 1620388**

**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.

**SEARCH RESULTS:**

The trademark examining attorney searched the USPTO database of registered and pending marks and found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

**SUMMARY OF ISSUES:**

- Legal Entity Clarification Requirement
- Identification Requirement
- Email Requirement
- Domicile and Attorney Requirement

**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:

> "Chemical reagents, other than for medical or veterinary purposes; chemical reagents for detecting pathogens in foodstuffs and the environment; kits consisting of diagnostic chemical reagents for scientific use; kits consisting of diagnostic chemical reagents for scientific use, namely, for detecting pathogens in foodstuffs and in the environment"

Chemical reagents for medical or veterinary e are in Class 5, while chemical reagents for other purposes are in Class 1. Applicant must make it clear that these goods are only in Class 1. While this is clear in some cases, applicant should append the phrase "not for medical or veterinary purpose" to the end of the intensifications "

chemical reagents for detecting pathogens in foodstuffs and the environment" and "kits consisting of diagnostic chemical reagents for scientific use, namely, for detecting pathogens in foodstuffs and in the environment

" to remove the possibility of them being overbroad or misclassifed.

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).

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

> "Chemical reagents, other than for medical or veterinary purposes; chemical reagents <u>not for medical or veterinary purpose</u> for detecting pathogens in foodstuffs and the environment; kits consisting of diagnostic chemical reagents for scientific use; kits consisting of diagnostic chemical reagents for scientific use <u>not for medical or veterinary purpose</u>, namely, for detecting pathogens in foodstuffs and in the environment"

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**

**E**

**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 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 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, 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
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kimberly.ray@uspto.gov

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- **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.

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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.

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/Kimberly Ray/
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- If needed, **find** contact information for the supervisor of the office or unit listed in the signature block.