

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

U.S. Application Serial No. 79333163

Mark: MERRACHI

Correspondence Address:

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Applicant: Nada Merrachi

Reference/Docket No. N/A

Correspondence Email Address:

**NONFINAL OFFICE ACTION
Notice of Provisional Full Refusal**

International Registration No. 1643763

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 "1B-1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Discussion of provisional full refusal. This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). See 15 U.S.C. §§1141f(a), 1141h(c).

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Summary of issues:

- Search results: No conflicting marks
- Requirement: Identification of goods and services clarification
- Requirement: Applicant's email address
- Requirement: U.S.-licensed attorney

Search results: No conflicting 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.

Requirement:

Identification of goods

and services clarification

First, t

he identification of goods and services is indefinite and must be clarified because some of the wording is too broad making the nature of the goods and services identified unclear. Applicant must clarify the identification by specifying the type of goods and services, in the assigned international classes, as is shown in the suggested identification below. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Second,

t

he word “clothing” in the identification of goods in International Class 25 is indefinite and too broad and must be clarified because the word does not make clear the nature of the goods and could identify goods in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although clothing can be classified in international classes other than International Class 25 (e.g., International Classes 9, 10, and 18), any modification to the identification must identify goods in International Class 25 only, the class specified in the application for such goods. *See* TMEP §1904.02(c)(ii).

Examples of acceptable identifications for clothing and/or apparel in International Class 25 include the following: “shirts,” “shorts,” “pants,” “coats,” “dresses,” “skirts,” and “socks.” Applicant may also amend the identification by inserting the word “namely,” after “clothing” and then listing the specific types of clothing items.

Third, a

pplicant is advised to delete or modify the duplicate entry in the identification of services in International Class 035 for “import and export agency service.” *See generally* TMEP §§1402.01, 1402.01(a). If applicant does not respond to this issue, be advised that the USPTO will remove duplicate entries from the identification prior to registration.

If modifying one of the duplicate entries, applicant may amend it 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. Also, generally, any deleted goods and/or services may not later be reinserted. TMEP §1402.07(e).

Fourth, t

he identification for “retail services” in International Class 35 is indefinite and must be clarified because retail services could include a wide array of retail support services – from accounting to advertising and marketing services. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.11.

If applicant’s retail services involve retail stores or outlets (online or brick-and-mortar), or distributorships, applicant should amend the identification to indicate (1) the nature of the retail activity provided (e.g., retail stores, retail distributorships, online retail outlets), and (2) the field or type of goods offered through those retail services, e.g., “retail online ordering services featuring {indicate field or type of goods, e.g., auto parts, clothing, jewelry},” “retail distributorships in the field of {indicate field or type of goods, e.g., auto parts, clothing, jewelry},” and “retail outlets featuring {indicate field or type of goods, e.g., auto parts, clothing, jewelry}.” *See* TMEP §§1301.01(a)(ii), 1402.11.

Suggested identification

Instructions and suggested changes are shown in bold text. Applicant may adopt the following identification, if accurate:

International Class 014: Precious metals and their alloys and trinkets **in the nature of {specify the nature of the trinkets, e.g., charms for key rings, rings}**, works of art, trophies, key rings, key holders **being key chains** and key chains made therefrom or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks; watches; key rings; medals; **{specify the type of coins, e.g., collectible, non-monetary, commemorative}** coins; jewellery boxes and watch boxes; parts for the aforesaid goods, included in this class, **namely, {specify the type of parts for the aforesaid goods, e.g., watch parts and fittings, jewellery chains}**

International Class 025: Clothing **namely, {specify the type of clothing, e.g., shirts, pants, jackets}**; hats; footwear; sportswear, **namely, {specify the type of sportswear, e.g., shorts, sweatshirts, sweatpants}**; bathing suits; shawls; headscarves

International Class 035: Import-export agency services; **{delete duplicate entry of "import and export agency services"}**, retailing and wholesaling services, **namely, {specify the type of retailing and wholesaling services, e.g., retail store services, online retail store services, wholesale store services}** featuring clothing, headwear and footwear and business intermediation **in the nature of {specify the nature of the business intermediation services, e.g., negotiation of business contracts for others, negotiation of commercial transactions for third parties}** and business consulting relating to the purchase and sale of clothing, headwear and footwear, also via the internet; retailing and wholesaling, **namely, {specify the type of retailing and wholesaling services, e.g., retail store services, online retail store services, wholesale store services}** featuring clothing, footwear and shoes, also via the internet; retailing and wholesaling, **namely, {specify the type of retailing and wholesaling services, e.g., retail store services, online retail store services, wholesale store services}** featuring clothing, headwear and footwear, also via the internet

Identification advisories

Applicant's goods and/or services 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 and/or services or add goods and/or services 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 and/or services 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 and/or services will further limit scope, and once goods and/or services 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 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).

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.

Requirement: Applicant's e

mail address

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.

Requirement: U.S.-licensed attorney

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).

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

/Tina Brown/
Tina Brown
Trademark Examining Attorney
Law Office 118
(571) 272-8864
tina.brown@uspto.gov

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.

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Applicant: Nada Merrachi

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- Requirement: Identification of goods and services clarification
- Requirement: Applicant's email address
- Requirement: U.S.-licensed attorney

Search results: No conflicting 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.

Requirement: Identification of goods and services clarification

First, the identification of goods and services is indefinite and must be clarified because some of the wording is too broad making the nature of the goods and services identified unclear. Applicant must clarify the identification by specifying the type of goods and services, in the assigned international classes, as is shown in the suggested identification below. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Second, the word “clothing” in the identification of goods in International Class 25 is indefinite and too broad and must be clarified because the word does not make clear the nature of the goods and could identify goods in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03, 1904.02(c), (c)(ii).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although clothing can be classified in international classes other than International Class 25 (e.g., International Classes 9, 10, and 18), any modification to the identification must identify goods in International Class 25 only, the class specified in the application for such goods. *See* TMEP §1904.02(c)(ii).

Examples of acceptable identifications for clothing and/or apparel in International Class 25 include the following: “shirts,” “shorts,” “pants,” “coats,” “dresses,” “skirts,” and “socks.” Applicant may also amend the identification by inserting the word “namely,” after “clothing” and then listing the specific types of clothing items.

Third, applicant is advised to delete or modify the duplicate entry in the identification of services in International Class 035 for “import and export agency service.” *See generally* TMEP §§1402.01, 1402.01(a). If applicant does not respond to this issue, be advised that the USPTO will remove duplicate entries from the identification prior to registration.

If modifying one of the duplicate entries, applicant may amend it 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. Also, generally, any deleted goods and/or services may not later be reinserted. TMEP §1402.07(e).

Fourth, the identification for “retail services” in International Class 35 is indefinite and must be clarified because retail services could include a wide array of retail support services – from accounting

to advertising and marketing services. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.11.

If applicant's retail services involve retail stores or outlets (online or brick-and-mortar), or distributorships, applicant should amend the identification to indicate (1) the nature of the retail activity provided (e.g., retail stores, retail distributorships, online retail outlets), and (2) the field or type of goods offered through those retail services, e.g., "retail online ordering services featuring {indicate field or type of goods, e.g., auto parts, clothing, jewelry}," "retail distributorships in the field of {indicate field or type of goods, e.g., auto parts, clothing, jewelry}," and "retail outlets featuring {indicate field or type of goods, e.g., auto parts, clothing, jewelry}." *See* TMEP §§1301.01(a)(ii), 1402.11.

Suggested identification

Instructions and suggested changes are shown in bold text. Applicant may adopt the following identification, if accurate:

International Class 014: Precious metals and their alloys and trinkets **in the nature of {specify the nature of the trinkets, e.g., charms for key rings, rings}**, works of art, trophies, key rings, key holders **being key chains** and key chains made therefrom or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks; watches; key rings; medals; **{specify the type of coins, e.g., collectible, non-monetary, commemorative}** coins; jewellery boxes and watch boxes; parts for the aforesaid goods, included in this class, **namely, {specify the type of parts for the aforesaid goods, e.g., watch parts and fittings, jewellery chains}**

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International Class 035: Import-export agency services; **{delete duplicate entry of "import and export agency services"}**, retailing and wholesaling services, **namely, {specify the type of retailing and wholesaling services, e.g., retail store services, online retail store services, wholesale store services} featuring clothing, headwear and footwear** and business intermediation **in the nature of {specify the nature of the business intermediation services, e.g., negotiation of business contracts for others, negotiation of commercial transactions for third parties}** and business consulting relating to the purchase and sale of clothing, headwear and footwear, also via the internet; retailing and wholesaling, **namely, {specify the type of retailing and wholesaling services, e.g., retail store services, online retail store services, wholesale store services} featuring clothing, footwear and shoes, also via the internet; retailing and wholesaling, namely, {specify the type of retailing and wholesaling services, e.g., retail store services, online retail store services, wholesale store services} featuring clothing, headwear and footwear, also via the internet**

Identification advisories

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the goods and/or services 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 and/or services will further limit scope, and once goods and/or services 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 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).

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.

Requirement: Applicant's email address

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.

Requirement: U.S.-licensed attorney

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.

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Examining Attorney Office Action form at <https://teas.uspto.gov/office/roa/> indicating that an appointment of attorney has been made and address all other refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii).

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

/Tina Brown/
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RESPONSE GUIDANCE

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