

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

U.S. Application Serial No. 79366887

Mark: FM ASIEN TO

Correspondence Address:

*Patent- und Rechtsanwälte Loesenbeck,
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Am Zwinger 2
33602 Bielefeld
GERMANY*

Applicant: fm Büromöbel GmbH

Reference/Docket No. N/A

Correspondence Email Address:

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

International Registration No. 1722899

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-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:

- Translation Requirement
- Disclaimer Requirement
- Legal Entity Requirement
- Email Address Requirement
- U.S. Counsel Requirement

SEARCH OF USPTO DATABASE OF MARKS

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

However, applicant must respond to the following requirements.

TRANSLATION REQUIREMENT

To permit proper examination of the application, applicant must submit an English translation of the foreign wording in the mark. 37 C.F.R. §§2.32(a)(9), 2.61(b); *see* TMEP §809. The following is suggested: **The English translation of “ASIENTO” in the mark is “SEAT”.** TMEP §809.03. See attached translation evidence. To respond to this requirement for information, open the appropriate Trademark Electronic Application System (TEAS) response form and enter the serial number, answer “yes” to question 3, and provide the information on the “Additional Statement(s)” page in the “Translation” text box(es) in the form.

Applicant has a duty to respond directly and completely to this requirement for information. *See In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *2 (TTAB 2019) (citing *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013)); TMEP §814. Failure to comply with a requirement for information is an independent ground for refusing registration. *In re SICPA Holding SA*, 2021 USPQ2d613, at *6 (TTAB 2021) (citing *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003) TMEP §814).

DISCLAIMER REQUIREMENT

Applicant must disclaim the wording “**ASIENTO**” because it is merely descriptive of a feature of applicant’s goods and/or services. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

The above-referenced translation evidence shows that this wording means "SEAT", which is defined as "Something, such as a chair or bench, that may be sat on." *See* <https://www.ahdictionary.com/word/search.html?q=seat>. Thus, the wording merely describes applicant’s goods and/or services because applicant's armchairs and swivel chairs are something that may be sat on, i.e., chairs.

Non-English wording that is merely descriptive, deceptively misdescriptive, geographically descriptive, generic, or informational in connection with the identified goods and/or services, is an unregistrable component of the mark that is subject to disclaimer. TMEP §§1213.03(a), 1213.08(d); *see Bausch & Lomb Optical Co. v. Overseas Fin. & Trading Co.*, 112 USPQ 6, 8 (Comm’r Pats. 1956). The disclaimer must refer to the actual non-English wording that appears in the mark, not the English translation of that wording. TMEP §1213.08(d).

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use “ASIENTO” apart from the mark as shown.

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

LEGAL ENTITY REQUIREMENT

Applicant's business name includes the foreign business designation "GmbH"; however, applicant set forth "Limited company" as the legal entity in the application. This business designation is generally considered the equivalent of a "Gesellschaft mit beschränkter Haftung" or "Limited Liability Company." See TMEP app. D. Therefore, applicant must clarify the entity type in the application. See 37 C.F.R. §§2.32(a)(3), 2.61(b); TMEP §803.03(i). Applicant may satisfy this requirement by amending the legal entity to one of those immediately listed above from Appendix D of the *Trademark Manual of Examining Procedure* (TMEP) for this business designation, as appropriate. See TMEP §803.03(i).

Alternatively, if applicant maintains that the legal entity in the application properly identifies applicant's entity type, applicant must provide an explanation as to why the identified entity type is more similar to a "Limited company" in this instance than to the legal entities listed in TMEP Appendix D. See *id.*

If, in response to the above request, applicant provides information indicating that it is not the owner of the mark, registration will be refused because the application was void as filed. See 37 C.F.R. §2.71(d); TMEP §§803.06, 1201.02(b). An application must be filed by the party who owns or is entitled to use the mark as of the application filing date. See 37 C.F.R. §2.71(d); TMEP §1201.02(b).

EMAIL ADDRESS 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); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. See TMEP §803.05(b).

U.S. COUNSEL REQUIREMENT

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

To appoint a U.S.-licensed attorney in this application, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at <https://teas.uspto.gov/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. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. *See* 37 C.F.R. §2.17(b)(1)(ii); TMEP §604.01.

Response guidelines. 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 the [Responding to Office Actions](#) webpage for more information and tips on responding.

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.

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

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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.

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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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vedi anche post: [English Forum](#).

Per altre informazioni, vai in [una nuova pagina](#).

▼ [Discussioni about "total" in the "English Forum"](#)

→ [20.000 euro di spesa per affitti e servizi per un anno](#)

Per il sign. De Cecco si pone il problema di "total".

Per la signora De Cecco si pone il problema di "total" (il sign. De Cecco ha un'azienda che produce e vende prodotti).

1992.

→ ["total" con il verbo "total" \(il sign. De Cecco ha un'azienda che produce e vende prodotti\)](#)