

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

U.S. Application Serial No. 79372630

Mark: UPI

Correspondence Address:

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No. 7-10, 20th Floor, East Tower,
World Financial Center,
100020 Beijing
CHINA*

Applicant: CHINA UNIONPAY CO., LTD.

Reference/Docket No. N/A

Correspondence Email Address:

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

International Registration No. 1736617

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).

Introduction

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.

By way of introduction, applicant submitted a voluntary mark description on June 22, 2023 in which Applicant states that "UPI" has no significance, or is it a term of art in the relevant trade or industry or as used in connection with the goods/ services/ collective membership organization listed in the application, or any geographical significance.

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.

Advisory: Summary of Issues

1. Requirement: Identification of Goods and Services
2. Requirement: Applicant's Email Address
3. Requirement: Foreign-domiciled Applicant U.S.-Licensed Attorney
4. Advisory: Response Guidelines

Requirement: Identification of Goods and Services

THIS PARTIAL REQUIREMENT APPLIES ONLY TO THE GOODS SPECIFIED THEREIN

The wording, "**face recognition device**," in the identification of goods for Class

009 needs clarification because it does not identify the goods with enough specificity, and it is too broad because it may identify goods in multiple International Classes. *See* TMEP §§1402.01, 1402.03.

In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a); *see* 37 C.F.R. §2.32(a)(6). If applicant uses indefinite words such as “apparatus,” “components,” “**devices**,” “materials,” or “parts,” such wording must be followed by “namely,” and a list of each specific product identified by its common commercial or generic name. *See* TMEP §§1401.05(d), 1402.03(a).

If accurate, applicant may adopt the following formulation for drafting an acceptable identification. **The suggested language has been bolded for applicant’s convenience.**

Class 009: Cash registers; money counting and sorting machines; dictating machines; fingerprint imagers; hemline markers; face recognition device, **namely, cameras, video cameras and computer hardware used for facial scanning and recognition, sold as a unit**; voting machines; counterfeit coin detectors; point-of-sale terminals; automated teller machines (ATM)

Class 036: [no changes]

TMEP §1402.01.

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 Email Address

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).

Requirement: Foreign-domiciled Applicant U.S.-Licensed Attorney

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](https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney) 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.

Advisory: Response Guidelines

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

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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.

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