



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

U.S. Application Serial No.: 79/007056
International Registration No.: 0838184

Attached is a **PROVISIONAL FULL REFUSAL** Office action that applies to all the goods and/or services in the U.S. application identified above application identified above: 15 U.S.C. §1141h(c).

The significance of the mark requirement, entity and citizenship clarification and likelihood of confusion refusal applies to all the goods and/or services in the application and therefore comprise a provisional full refusal of the entire application.

RESPONSE DUE:

A response to this provisional refusal is due within six (6) months from the mailing date of the Office action, i.e., within six months from 23 February 2005.

APPLICANT OR ATTORNEY CAN RESPOND TO PROVISIONAL REFUSAL:

Applicant can respond directly to this provisional refusal Office action, or applicant can hire an attorney to represent itself before the Office and that attorney can respond on applicant's behalf. The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

NOTE: Attorneys hired to represent an applicant in a trademark matter before the Office must be eligible under 37 C.F.R. §10.14:

Attorneys residing in the United States who are in good standing with the bar of any United States court or the highest court of any state, may practice before the Office in trademark matters.
A foreign attorney not residing in the United States who is in good standing before the patent or trademark office of the country in which he or she resides, may practice before the Office in trademark matters only in cases where the patent and trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the Office. Currently, Canadian attorneys are the only foreign attorneys recognized as meeting this criterion. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. TMEP §602.

Please note that non-attorneys are not permitted to practice before the Office except under the very limited circumstances specified in 37 C.F.R. §10.14(b).

Pages enclosed - 8

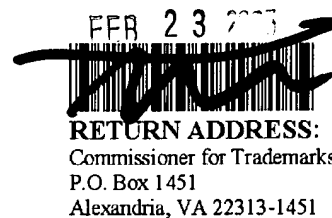
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/007056

APPLICANT: Heinzl Holding GmbH

CORRESPONDENT ADDRESS:

Dr. Thomas M. Haffner
Patentanwalt
Schottengasse 3a
A-1014 Wien AUSTRIA



RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: NOVO

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 79/007056

The assigned examining attorney has reviewed the referenced application and determined the following.

Section 2(d) - Likelihood of Confusion Refusal

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 2854887 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

A likelihood of confusion determination requires a two-part analysis. First the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

I. Similarities of the Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §§1207.01(b) *et seq.*

Applicant's mark, NOVO, and registrant's mark, NOVO, are identical in sound and appearance. The marks are phonetic equivalents and are thus similar sounding. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963); TMEP §1207.01(b)(iv).

The marks create the same overall commercial impression.

II. Comparison of the Goods

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Applicant's goods in International Class 016 are "paper, cardboard and goods made from these materials, not included in other classes; cardboard articles, collapsible cardboard boxes." Registrant's goods in International Class 016 are "paper, cardboard and goods made from these materials, namely, paper and cardboard boxes; photographs; stationery; adhesives for stationery or household purposes; artists' materials, namely, pencils, paints and paintbrushes; office requisites, namely, staplers and rubber bands; plastic bags for packaging; plastic wrap; playing cards; printers' fonts; printing blocks; letter openers; adhesive tape dispensers for household or stationery use; pens; pen stands; book marks; memo pad holders; pen holders not of precious metal." Likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Since the identification of the applicant's goods is very broad, it is presumed that the application encompasses all goods of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. TMEP §1207.01(a)(iii). Applicant's goods could include registrant's goods. Consumers could mistakenly believe that applicant's goods and registrant's goods come from a common source.

Accordingly, the examining attorney refuses registration under Trademark Act Section 2(d).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following issues.

Identification of Goods

The wording in the identification of goods is unacceptable as indefinite because it fails to indicate, with greater specificity, the particular type of goods being provided by the applicant. Specifically, the wording “goods made from these materials” and “cardboard articles,” without more, is unclear. Applicant must amend the identification to further clarify the nature of the indicated goods. The applicant may amend this wording to the following, if accurate. TMEP §1402.01.

“Paper, cardboard and goods made from these materials, **namely, [please insert the common commercial names, e.g. paper and cardboard boxes];** cardboard articles, **namely,** collapsible cardboard boxes,” in International Class 016.

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. *Guide to Implementation of Madrid Protocol in the United States*, Exam Guide 02-03, section IV.B2.

Significance of Mark

The applicant must indicate whether “NOVO” has any significance in the relevant trade, any geographical significance, or any meaning in a foreign language. 37 C.F.R. §2.61(b).

Entity

Applicant must specify its entity type and citizenship. For example, an applicant can apply as an individual, a partnership, a corporation or a joint venture. 37 C.F.R. §2.32(a)(3); TMEP §§802.03 *et seq.* If applicant is an individual, then applicant must indicate his or her national citizenship for the record. 37 C.F.R. §2.32(a)(3)(i). If applicant is a corporation or association, then applicant must set forth the U.S. state or country (for foreign applicants only) under whose laws applicant is organized. 37 C.F.R. §2.32(a)(3)(ii). If applicant is a partnership or joint venture, then applicant must list the names and the national citizenship or the U.S. state or country (for foreign applicants only) of organization or incorporation of all the general partners or joint venturers, as well as specify the state or country under whose laws the partnership or joint venture is organized. 37 C.F.R. §§2.32(a)(3)(ii) and (iii).

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. 15 U.S.C. §1141h(c).

APPLICANT OR ATTORNEY CAN RESPOND TO PROVISIONAL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant’s attorney may respond on applicant’s behalf.

NOTE: Attorneys hired to represent an applicant in a trademark matter before the Office must be eligible under 37 C.F.R. §10.14:

- (1) *Attorneys residing in the United States* who are in good standing with the bar of any United States court or the highest court of any state, may practice before the Office in trademark matters.
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Currently, Canadian attorneys are the only foreign attorneys recognized as meeting this criterion. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. TMEP §602.

The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If applicant is not represented by an attorney, applicant may appoint a domestic representative who would receive correspondence from the Office and be served process or notice of proceedings affecting the application. 15 U.S.C. §1141h(d); 37 C.F.R. §2.24.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

**Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451**

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at <http://www.uspto.gov/teas/index.html>.

/Steven W. Jackson/
Trademark Attorney
Law Office 112
571.272.9409
571.273.9112 (fax)

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action issued via email you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT
THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

Print: Feb 16, 2005

78059302

DESIGN MARK

Serial Number
78059302

Status
REGISTERED

Word Mark
NOVO

Standard Character Mark
No

Registration Number
2854887

Date Registered
2004/06/15

Type of Mark
TRADEMARK; SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner
Novo International Company Limited LTD LIAB CO HONG KONG Unit A, 9th Floor, CDW Building 388 Castle Peak Road, Tsuen Wan New Territories HONG KONG

Goods/Services
Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: Pen holders of precious metal; name card holders of precious metal; cigarette cases of precious metal; ashtrays of precious metal. First Use: 2001/04/00. First Use In Commerce: 2003/12/00.

Goods/Services
Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050. G & S: Paper, cardboard and goods made from these materials, namely, paper and cardboard boxes; Photographs; Stationary; Adhesives for stationary or household purposes; Artists' materials, namely, pencils, paints and paintbrushes; Office requisites, namely, staplers and rubber bands; plastic bags for packaging; plastic wrap; Playing cards; printers' fonts; printing blocks; letter openers; Adhesive tape dispensers for household or stationary use; pens; pen stands; book marks; memo pad holders; pen holders not of precious metal. First Use: 2001/04/00. First Use In Commerce: 2003/12/00.

Print: Feb 16, 2005

78059302

Goods/Services

Class Status -- ACTIVE. IC 006. US 002 012 013 014 023 025 050. G & S: Transportable building of metal; Non-electric cables and wires of common metal; Pipes and tubes of metal, Metal safes, Metal goods, namely metal key rings and tool boxes and excluding parts of machinery, namely, forms of metal and plastic for printing, coating or stamping of strip shaped metal. First Use: 2001/04/00. First Use In Commerce: 2003/12/00.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Design for others in the field of desktop products, desktop sets, golf series, name card holders, holders for desk accessories, money clips, name card cases, photo frames, bookmarks, key holders, letter openers, wine and cigar accessories, organizers and wallets; packaging design for others. First Use: 2001/04/00. First Use In Commerce: 2001/04/00.

Goods/Services

Class Status -- ACTIVE. IC 040. US 100 103 106. G & S: Manufacture of desktop products, desktop sets, business card holders and memo pad holders, business card cases, money clips, bookmarks, photo frames, key holders, letter openers, wine and cigar accessories, organizers and wallets to the order and specification of others. First Use: 2001/04/00. First Use In Commerce: 2001/04/00.

Translation Statement

The English translation of the subject mark is "NEW".

Filing Date

2001/04/19

Examining Attorney

LINCOSKI, JOHN

Attorney of Record

Mark I. Peroff

NOVO