

# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 79/022,570

**APPLICANT:** Joh. Wilh. von Eicken GmbH

**\*79022570\***

**CORRESPONDENT ADDRESS:**  
JOH. WILH. VON EICKEN GMBH  
PO BOX 33  
23582 LXXBECK FED REP GERMANY,

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

**MARK:** PUBLIC

**CORRESPONDENT'S REFERENCE/DOCKET NO:** N/A

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**

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

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 79/022,570

## INTERNATIONAL REGISTRATION NO. 0881548

This is a **PROVISIONAL PARTIAL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application that applies to only the following goods in the application: "lighters." 15 U.S.C. §1141h(c).

## WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL PARTIAL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the United States Patent and Trademark Office (USPTO)** in trademark matters are:

- (1) **Attorneys in good standing with the bar of any U.S. federal court or the highest court of any U.S. state, and**
- (2) **Canadian attorneys who have applied for and received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).**

37 C.F.R. §10.14; TMEP §602.

Foreign attorneys are *not* permitted to practice before the USPTO, other than properly authorized

Canadian attorneys. Preparing a paper, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. *A response signed by an unauthorized foreign attorney will be considered an incomplete response.* TMEP §§602, 602.03, 603.05.

## **THE APPLICATION HAS BEEN PROVISIONALLY PARTIALLY REFUSED AS FOLLOWS:**

NOTE: This is a partial refusal Office action. The requirement in this Office action applies only to specified goods in the U.S. application.

### **Applicant Must Amend The Identification Of Goods**

The wording “lighters” in the identification of goods needs clarification because it is too broad and could include goods classified in other international classes. Lighters are generally classified in Class 34, but lighters made of precious metal are classified in Class 14. Applicant may adopt the following identification, if accurate:

“Cigarettes, cigars, cigarillos, smoking tobacco, and lighters not of precious metal, in International Class 34.”

TMEP §§1402.01 and 1402.03.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

Applicant should note that the international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04 and 1904.02(b).

### **Partial Abandonment Advisory**

If applicant should fail to respond to this Office action within the six month time limit, then the following goods and/or services will be deleted from the application: lighters. The application will then proceed forward for the following goods and/or services only: cigarettes, cigars, cigarillos, and smoking tobacco. 37 C.F.R. §2.65(a).

Applicant is invited to call or email the assigned examining attorney with any questions regarding this application.

/Katherine S. Chang/  
Trademark Examining Attorney  
Law Office 115  
Phone: 571-270-1528  
Fax: 571-270-2528

## **HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond using the Office’s Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72

hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**

- **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. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.** To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**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.**