

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/026252

APPLICANT: Solar World AG

79026252

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CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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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

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 79/026252

INTERNATIONAL REGISTRATION NO. 0891411

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).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL 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 REFUSED AS FOLLOWS:

SEARCH RESULTS

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

IDENTIFICATION OF GOODS IN CLASS 009

The wording in the identification of goods in Class 009 needs clarification because it is too broad and could include goods classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must specify the components of the assembly and installation systems by common commercial name, in addition to the composition of such components. Applicant may substitute the following wording, if accurate: TMEP §§1402.01 and 1402.03.

- Class 009: Electrical apparatus and instruments for the generation of electrical energy from photovoltaic and/or solar sources, namely photovoltaic solar modules, parts and accessories thereof, namely racks, and assembly and installation systems comprised of [SPECIFY COMPONENTS OF THE SYSTEM BY COMMON COMMERCIAL NAME AND COMPOSITION OF SUCH COMPONENTS) for assembling and positioning of photovoltaic/solar modules.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

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.

IDENTIFICATION OF SERVICES IN CLASS 036

The wording “Financial and real estate affairs” in the identification of services needs clarification because it is too broad and includes services classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must specify the particular type of financial and real estate services being offered. Applicant may substitute the following wording for the entire identification of services, if accurate: TMEP §§1402.01 and 1402.03.

- Class 036: Financial planning, financial management, and financial consultation; appraisals of real estate; leasing of real estate; real estate agencies; real estate consultation.

PLEASE BE ADVISED: For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. It is **highly recommended** that applicant search the online Manual for acceptable identifications of goods and particularly, financial and real estate services.

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

CLASSIFICATION OF GOODS AND SERVICES

If applicant adopts the suggested amendment of the services, then applicant must amend the classification to International Classes 9 and/or 36. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§805 and 1401 *et seq.*

/janice kim/
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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.