

**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 79/064299

MARK: NCHZ

**\*79064299\***

**CORRESPONDENT ADDRESS:**

Novácke chemické závody, a.s.  
SK-972 71 Nováky  
SLOVAKIA

**RESPOND TO THIS ACTION:**

**<http://www.uspto.gov/teas/eTEASpageD.htm>**

**GENERAL TRADEMARK INFORMATION:**

**<http://www.uspto.gov/main/trademarks.htm>**

**APPLICANT:** Novácke chemické  
závody, a.s.

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:**

**INTERNATIONAL REGISTRATION NO. 0990554.**

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. See 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 USPTO** in trademark matters are as follows:

**(1) Attorneys in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and**

**(2) Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §11.14(c).

37 C.F.R. §§11.1, 11.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b). Filing written communications, 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 is considered an incomplete response. *See* TMEP §§602.03, 712.03.

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

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, 2.65(a); TMEP §§711, 718.03.

#### Office Records Search:

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

#### Identification of Goods and Services:

The identification of goods and services contains language that requires clarification and/or is overly broad, potentially encompassing goods and services in classes other than those currently included in the application. *See* TMEP §§1402.01, 1402.03. as to the goods in the identification, 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. If applicant uses indefinite words such as “accessories,” “components,” “devices,” “equipment,” “materials,” “parts,” “systems” or “products,” such words must be followed by “namely,” followed by a list of the specific goods identified by their common commercial or generic names. *See* TMEP §§1402.01, 1402.03(a).

As to the services in the identification, applicant must use the common commercial or generic names for the services, be as complete and specific as possible, and avoid the use of indefinite words and phrases. If applicant uses indefinite words and phrases such as “services in connection with,” “such as,” “including,” “and like services,” “systems,” “products,” “concepts,” or “not limited to,” such wording must be followed by “namely,” and a list of the specific services identified by their common commercial or generic names. *See* TMEP §§1402.01, 1402.03(a).

The identification of goods and services also contains parentheses. Generally, parentheses and brackets should *not* be used in identifications. Parenthetical information is permitted in identifications only if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12. Therefore, applicant must remove the parentheses from the identification and incorporate the parenthetical information into the description, or delete the information if appropriate, as suggested below.

Applicant may adopt the following identification, if accurate. Suggestions are in boldface italics, and the matter in braces { } or brackets [ ] is explanatory material:

International Class 1 – ***Inorganic and organic*** industrial chemicals; ***unprocessed*** plastic materials in granule, powder and emulsion form

International Class 3 – Products and additives for currying skins and hides, ***namely, {specify International Class 3 goods by common name}***; tensio-active agents for industrial use as textile auxiliaries, ***namely, {specify International Class 3 goods by common name}***

International Class 4 – Industrial oils and greases

International Class 7 – Machines and apparatus for the chemical industry, ***namely, {specify International Class 7 goods by common name, e.g., emulsifying machines, dissolving***

*machines, chemical fiber spinning machines, etc.}*

International Class 17 – *Synthetic plastic as semi-finished products in the form of sheets, foils, profiles, tubes, pipes, and pressed pieces, for use in the manufacture of floor coverings, floorings, and {specify other goods, if desired; alternatively, may simply delete language “for use in the manufacture of floor coverings, floorings, and”}*

International Class 37 – Construction of buildings; repair and maintenance of machines and installations for chemical construction purposes

International Class 42 – Services of engineers, *namely, providing expert reports in the nature of drawing up of expert technical opinions in the field of engineering, performing engineering research, and conducting of feasibility studies*; services provided by specialists, *namely, by engineers, chemists, and physicists*

Identifications of goods and/or services can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification. Please also note that the international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau assigned to the goods and/or services in the corresponding international registration. TMEP §§1401.03(d), 1904.02(b). Therefore, any modification to this wording must identify goods and/or services in International Classes 1, 3, 4, 7, 17, 37 and/or 42, the classifications specified in the application for these goods and/or services.

#### **General Inquiry on Significance:**

Applicant must explain whether “NCHZ” has any meaning or significance in the industry in which the goods and/or services are manufactured/provided, or if such wording is a “term of art” within applicant’s industry, or if such wording has any meaning as applied to the goods and/or services in the application. Applicant must also explain whether this wording identifies a geographic place or has any other meaning. *See* 37 C.F.R. §2.61(b); TMEP §814.

Failure to respond to this request for information can be grounds for refusing registration. *See In re DTI P’ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

#### **Applicant Must Clarify its Entity (Legal Nature) and Citizenship (Place Incorporated):**

The application identifies applicant as a “société anonyme,” but applicant’s entity designation from its name is “A.S.” According to Appendix “D” to the Office’s Trademark Manual of Examining Procedure, an “A.S” in Slovakia is a “Joint Stock Company.” Although a “société anonyme also equates to a “Joint Stock Company” according to the Appendix, there is no “S.A.” in Slovakia. Applicant must thus clarify its entity type. *See* TMEP §803.03(i). Applicant must indicate the U.S. equivalent of its entity type or provide a description of the nature of the foreign entity. *See id.*

In addition, applicant has provided its citizenship in a language other than English. Applicant must clarify whether its citizenship (“Place Incorporated”) is “Slovakia.” 37 C.F.R. §2.32(a)(3); TMEP §§803.03, 803.04.

#### **Description of the Mark:**

The applied-for mark is not in standard characters and applicant did not provide a description of the mark with the initial application. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any

design elements. *See* 37 C.F.R. §2.37; TMEP §§808 *et seq.*

Therefore, applicant must provide a description of the applied-for mark. The following is suggested:

**The mark consists of the letters “NCHZ” in stylized font, with the letters “N” and “C” connected to each other and the letters “H” and “Z” connected to each other, appearing in the middle of an oval, with the letters “N” and “Z” connected to the oval.**

**Designation of Domestic Representative (Advisory):**

Applicant may designate a domestic representative upon whom notices or process may be served. If applicant does not designate a domestic representative, notices or process in proceedings affecting the mark may be served on the Director of the United States Patent and Trademark Office. 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24; TMEP §604.

Applicant is encouraged to file a designation of domestic representative online via the Office’s website at <http://www.uspto.gov/teas/index.html>. In addition, the following format may be used to file a Designation of Domestic Representative on paper for submission via regular mail.

DESIGNATION OF DOMESTIC REPRESENTATIVE

_____ Identify the mark	_____ Serial No.
_____ Name of applicant	_____ Date of signature

\_\_\_\_\_  
(Name of domestic representative)

whose postal address is \_\_\_\_\_

is hereby-designated applicant’s representative upon whom notices or process in proceedings affecting the mark may be served.

\_\_\_\_\_  
(Signature of applicant)

**Section 66(a) Applicant May Wish to Seek Trademark Counsel (Advisory):**

Applicant may wish to hire a trademark attorney to assist in prosecuting this application because of the legal technicalities involved. The Office, however, cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

Please be advised that **the only attorneys who can practice before the USPTO** in trademark matters are as follows:

**(1) Attorneys in good standing with a bar of the highest court of any U.S. state,** the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and

**(2) Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §11.14(c).

37 C.F.R. §§11.1, 11.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b); *see* 37 C.F.R. §§11.14(c). Filing written communications, 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 is considered an incomplete response. *See* 37 C.F.R. §2.65(a)-(b); TMEP §§602.03, 712.03.

**TEAS Response Suggested:**

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/teas/index.html>.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

James W. MacFarlane  
/James W. MacFarlane/  
Trademark Examining Attorney  
Law Office 104  
Phone: 571-270-1512  
Fax: 571-270-2512

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

