

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 79085577

MARK: KETHO

79085577

CORRESPONDENT ADDRESS:

LINDNER / BLAUMEIER
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CLICK HERE TO RESPOND TO THIS LETTER:

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

APPLICANT: Duravit
Aktiengesellschaft

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

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1046387

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 if applicant is not represented by an authorized attorney. *See* 37 C.F.R. §2.193(e)(2)(ii). Otherwise, applicant's authorized attorney must respond on applicant's behalf. *See* 37 C.F.R. §2.193(e)(2)(i). However, **the only attorneys who are authorized to sign responses and 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 located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(e), 2.62(b), 11.1, 11.5(b)(2), 11.14(a), (c); TMEP §§602, 712.03.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO. *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(b). That is, foreign

attorneys may not file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal, among other things. *See* 37 C.F.R. §11.5(b)(2); TMEP §§602.03(c), 608.01. If applicant is represented by such a foreign attorney, applicant must respond directly to this provisional refusal Office action. *See* 37 C.F.R. §2.193(e)(2)(ii).

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(a), 2.65(a); TMEP §§711, 718.03.

Search Results of Office's Database of Registered and Pending Marks

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2 (d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

However, applicant must address the following procedural requirements:

Refusal: Limitation Exceeds Scope of International Registration

Registration is refused because the limitation provided with the application identifies goods and/or services that are broader in scope than those in the basic listing of goods and/or services in the international registration. *See* 37 C.F.R. §2.71(a); TMEP §§1904.03(g), 1906.01(e). Identifications 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.*

In addition, 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. 37 C.F.R. §2.85 (d); TMEP §§1402.01(c), 1904.02(b). The scope of the identification for purposes of permissible amendments is limited by the class. 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c).

The limitation identifies the following goods in particular: "decorative vinyl appliqués for attachment to wall surfaces and furniture, bathroom accessories and other goods for decorating purposes, namely, fixed paper towel dispensers not of metal, dowels not of metal, bath, shower and toilet grab bars not of metal." This wording is beyond the scope of the international registration because "vinyl appliqués" and "fixed paper towel dispensers not of metal, dowels not of metal, bath, shower and toilet grab bars not of metal" are limited to the wood and wood substitute composition clearly set forth within the international registration.

Applicant may respond to this refusal by deleting the unacceptable wording from the identification. However, once an application has been expressly amended to delete goods and/or services, those items may not be later re-inserted. TMEP §1402.07(e).

Applicant can record a new limitation that does not expand the scope of the goods and/or services beyond those identified in the basic listing of goods and/or services in the international registration. A request to record a limitation must be presented to the International Bureau in accordance with the requirements of the Common Regulations under the Madrid Agreement and Protocol. TMEP §1906.01(e).

Requests to record a limitation and notices of limitation are not considered responsive to an Office action issued by the USPTO. Applicant must file a complete response within six months of the date of issuance of the Office action to avoid abandonment of the U.S. application. *See* 15 U.S.C. §1062 (b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03.

Identification of Goods Must be Amended

Applicant must clarify the identification of goods. The identification in the international registration clearly sets forth that particular goods are “for bathrooms and washrooms” by specifying that the goods are “for bathrooms and washrooms,” “for furniture and sanitary installations for bathrooms and washrooms” and are “made of wood or wood substitutes.” See TMEP §1402.01. The limitation of goods included in the application does not clearly set forth these limitations on scope. Applicant must incorporate these limitations to be within the scope of the limitation of goods.

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. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b).

Therefore, any modification to this wording must identify goods and/or services in International Class 20, the classification specified in the application for these goods and/or services.

For the applicant’s convenience, the trademark examining attorney suggests an amendment of applicant’s identification of goods that complies with the above-mentioned clarification requirements, with any material additions and deletions highlighted in ***bold and italicized type***. Applicant may adopt the following identification, if accurate:

International Class 20: “Furniture for bathrooms, mirrors for bathrooms; mirrored cabinets for bathrooms and washrooms; goods made of wood or wood substitutes ***for bathrooms and washrooms***, namely, curtain rails, wall hooks, works of art; decorative objects ***made of wood or wood substitutes*** in the nature of wall plaques, mobiles, bead curtains, wind chimes, ***[clarify nature of “decorative vinyl appliqués for attachment to wall surfaces and furniture” that fits within scope of “goods made of wood and wood substitutes”]***, ***bathroom accessories and other goods for decorating purposes made of wood or wood substitutes [limitation required to remain within scope of international registration]***, namely, ***fixed paper towel dispensers not of metal, dowels not of metal, bath, shower and toilet grab bars not of metal***; goods made of plastic ***for bathrooms and washrooms***, namely, fittings for furniture, ***windows and doors*** in the nature of indoor window blinds and indoor window blinds for doors, door handles, furniture handles; non-metal fittings, ***for use with furniture and sanitary installations for bathrooms and washrooms***, in the nature of locks and wall handles for getting in and out of the bathtub, plastic and wood knobs and handles for doors and furniture; wall hooks not of metal for bathrooms and washrooms; shelves for storage for wash-hand basins and washstands; fixed towel dispensers not of metal.”

An applicant may amend an identification of goods and/or services 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.* In addition, for applications filed under Trademark Act Section 66(a), an applicant may amend the identification only to specify goods and/or services classified in the international class(es) designated in the application as filed. 37 C.F.R. §2.85(d); see TMEP §§1402.07(a), 1904.02(c).

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/netahhtml/tidm.html>. See TMEP §1402.04.

Significance Required

Applicant must explain whether “KETHO” 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. Applicant must also explain whether this wording identifies a geographic place. See 37 C.F.R. §2.61(b); TMEP §814.

Further, applicant must provide additional information about this wording to enable proper

examination of the application.

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.

Response Guidelines

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

Applicant's response must be properly signed by (1) the individual applicant (for joint individual applicants, both must sign) or (2) someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). *See* 37 C.F.R. §§2.62(b), 2.193(a), (e)(2)(ii); TMEP §§611.03(b), 611.06 *et seq.*, 712.01. If applicant retains an attorney, the attorney must sign the response. 37 C.F.R. §2.193(e)(2)(i); TMEP §§611.03(b), 712.01. The individual(s) signing must personally sign or personally enter his/her electronic signature. *See* 37 C.F.R. §2.193(a), (e)(2)(ii); TMEP §§611.01(b), 611.02.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. In such case, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to live status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

Trademark Counsel Suggested

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.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO. *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(b). That is, foreign attorneys may not file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal, among other things. *See* 37 C.F.R. §11.5(b)(2); TMEP §§602.03(c), 608.01.

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- (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
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See 37 C.F.R. §§2.17(e), 11.1, 11.5(b)(2), 11.14(a), (c); TMEP §602.

If applicant has questions about the application or this Office action, please telephone the assigned

trademark examining attorney at the telephone number below.

/Julie Thomas Veppumthara/
Examining Attorney
Law Office 107
Phone: 571-272-1582
Email: julie.veppumthara@uspto.gov

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.