

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

APPLICATION SERIAL NO. 79089368

MARK: AGEXP

79089368

CORRESPONDENT ADDRESS:

O.V. Shterz
P.O. box 242
RU-630132 Novosibirsk
RUSSIAN FED.

CLICK HERE TO RESPOND TO THIS LETTER:

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

APPLICANT: Obchtchestvo s
ogranichennoy otvetstvenn ETC.

**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. 1056757

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:**

Albuminous foodstuffs for medical purposes; albuminous preparations for medical purposes; biological preparations for medical purposes (including biologically active nutritional additives); dietetic beverages adapted for medical purposes (including biologically active nutritional additives); dietetic substances adapted for medical use; ferments for pharmaceutical purposes; herbs teas for medicinal purposes; liniments (including liniments for treatment of articulations); lotions for pharmaceutical purposes; medicinal infusions; mineral food-supplements (including biologically active nutritional additives); nervines; nutritional additives for medical purposes (including biologically active nutritional additives); opotherapy preparations; preparations of trace elements for human use (including biologically active nutritional additives); serums; styptic preparations; tonics (medicines). *See* 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 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).

DESIGNATION OF DOMESTIC REPRESENTATIVE:

The USPTO encourages applicants who do not reside in the U.S. to designate a domestic representative upon whom notices or process may be served. 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2); see TMEP §610. Such designations may be filed online at <http://www.uspto.gov/teas/index.html>.

THE APPLICATION HAS BEEN PROVISIONALLY PARTIALLY REFUSED AS FOLLOWS:

This is a partial refusal Office action; the refusal and/or requirement apply only to specified goods in the U.S. application.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

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.

The Identification of Goods is Indefinite

The identification of goods is indefinite and must be clarified because it is unclear from the current wording exactly what goods are used in conjunction with the mark. See TMEP §1402.01. Applicant may adopt the following identification, if accurate (suggested wording appears italicized print):

Medicated supplements in the form of albuminous foodstuffs for medical purposes; sanitary albuminous preparations for medical purposes; antiseptics; balms for medical purposes; bacterial preparations for medical and veterinary use; biocides; biological preparations for medical purposes; diabetic bread; dietetic beverages adapted for medical purposes; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use, namely, anti-diabetic preparations; digestives for pharmaceutical purposes; ferments for pharmaceutical purposes, namely, for _____ (indicate specific disease or condition); food for babies; germicides; herb teas for medicinal purposes; lacteal flour for babies; liniments; skin lotions for pharmaceutical purposes; medicinal

herbs; medicinal oils; medicinal roots; mineral food-supplements; nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; sea water for medicinal bathing; beauty serums; therapeutic preparations for the bath; vitamin preparations in Class 5.

TMEP Section 1402.01.

Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of goods. TMEP §1402.01(e). However, the trademark examining attorney is unable to suggest alternative wording because the nature of the following wording in the International Classes is unclear and does not appear to describe any goods *in Class 5*: “**medicinal infusions; nervines; ophotherapy preparations; preparations of trace elements for human use (including biologically active nutritional additives); styptic preparations; tonics (medicines).**” See TMEP §§1401.03(d), 1402.01(e).

Applicant must amend this wording to clarify the identification. However, 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). Therefore, any amendment must identify goods within International Class 5 only. See TMEP §§1402.01(c), 1402.07(a). Such an amendment would be compared to the original identification and the international class in the application as filed to ensure that it does not broaden the scope of the original identification. See TMEP §§1402.07(a), 1904.02(c). 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.*, 1402.07(a).

In the alternative, applicant may wish to delete 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 also submit a request to correct the identification in the international registration. Such a request must be filed with the International Bureau in accordance with the requirements of the Common Regulations under the Madrid Agreement and Protocol. See TMEP §1906.01(f).

Requests for correction and notices of correction 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.

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 classes designated in the application as filed. 37 C.F.R. §2.85(d); see TMEP §§1402.07(a), 1904.02(c).

The identification of goods and/or services 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 of goods and/or services and incorporate the parenthetical information into the description.

If the applicant has any questions or needs assistance in responding to this office action, please

telephone the assigned examining attorney.

/Jason F. Turner/
Examining Attorney
Law Office 108
(571) 272-9353
(571) 273-9108 (Fax for Official Responses)

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>.