

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

APPLICATION SERIAL NO. 79100213

MARK:

79100213

CORRESPONDENT ADDRESS:

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

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http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Obchtchestvo s
ogranichennoi otvetstven 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. 1084671

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).

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 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 – No Conflicting Marks Noted

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

Description of the Mark and Color Location Statement Required

Applicant has submitted a color drawing and provided a color claim, but has not provided a mark description of the literal and design elements that specifies where all the colors appear in those elements. Applications for marks depicted in color must include a description of all the literal and design elements in the mark that specifies where all the colors appear in those elements. 37 C.F.R. §§2.37, 2.52(b)(1); *see* TMEP §§807.07(a) *et seq.*

Therefore, applicant must provide a description of the literal and design elements in the mark that specifies where all the colors appear in those elements. The following description is suggested, if accurate: **“The mark consists of the following: a large fruit-bearing apple tree lined in light brown over white.”** TMEP §807.07(a)(ii).

Identification of Goods

The identification of goods is unacceptable as presently worded because certain goods are worded indefinitely, need clarification and may identify goods in more than one International Class. In the identification of goods, applicant must use the common commercial or generic names for the goods, be all-inclusive, as complete and specific as possible, and avoid the use of indefinite words and phrases. If applicant chooses to use indefinite terms such as "accessories," "components," "devices," "equipment," "materials," "parts," "apparatus" and "products," then such terms must be followed by the word **"namely"** and a list of the specific goods identified by their common commercial or generic names. TMEP §§1402.01 and 1402.03(a).

Further, the wording **“credit card imprinters, non-electric”** in the identification of goods is indefinite and must be clarified because the only non-electric, credit card imprinters are “manually-operated credit card imprinters” and they are classified in International Class 8. *See* TMEP §§1402.01, 1402.03.

In an application filed under Trademark Act Section 66(a), an applicant may not change the

classification of goods and/or services from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing international class to another. 37 C.F.R. §2.85(d); *see* TMEP §§1402.07(a), 1904.02(c).

Therefore, any modification to this wording must identify goods in International Class 16, the classification specified in the application for these goods.

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 there is no acceptable alternative wording in International Class 16. *See* TMEP §§1401.03(d), 1402.01(e).

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, those items may not be later re-inserted. TMEP §1402.07(e).

Applicant may 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.

For comparison purposes, the entries requiring amendment have been underlined, and the wording in **bold font** and/or brackets [] indicate information that **the applicant must supply**. Please be certain to supply all required information when amending the identifications below. Applicant may change this wording to the following, if accurate:

Class 16: Posters; albums **for [indicate purpose or type, e.g., photographs, coins, stamps];** almanacs; stationery; stickers; pamphlets **in the field of [indicate specific field of use];** calendars; notebooks; greeting cards; postcards; cardboard articles, **namely, [specify goods in International Class 16 only, e.g., cardboard, boxes of cardboard, cardboard packaging];** catalogues **in the field of [indicate specific field of use];** newsletters **in the field of [indicate specific field of use];** graphic prints; signboards of paper or cardboard; envelopes; labels, **not of textile, namely [identify the specific Class 16 labels, e.g., paper labels, adhesive labels, mailing labels, barcode labels];** forms, printed; printed matter, **namely, [specify goods in International Class 16 only, e.g., maps, printed guide books featuring travel];** writing instruments; newspapers; books **in the field of [indicate specific field of use];** booklets **in the field of [indicate specific field of use];** manuals **in the field of [indicate specific field of use];** teaching materials **except apparatus, namely [identify the specific Class 16 teaching materials, e.g., study guides];** writing cased sets **comprising writing instruments;** paper; periodicals **in the field of [indicate specific field of use];** prospectuses **in the field of [indicate specific field of use];** bags, envelopes **and** pouches of paper or plastics, for packaging.

TMEP §1402.01.

PLEASE NOTE: The international classification of goods and/or services 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). **Therefore, the applicant may only amend an identification to include goods or services, properly within the scope of the present wording, that are properly classified in the current classification.** While the identification of goods and services may be amended to clarify or limit the goods or services, adding to the goods or services broadening the scope of the goods or services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06.

For assistance with identifying 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>.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/RLF/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. 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. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

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>.

