

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

**APPLICATION SERIAL NO.** 79113019

**MARK:** OBNOVI

**\*79113019\***

**CORRESPONDENT ADDRESS:**

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RUSSIAN FED.

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**APPLICANT:** Obschestvo s  
ogranichennoy; otvetstvenno ETC.

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

**INTERNATIONAL REGISTRATION NO. 1116235**

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION ABOVE, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS REFUSAL WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

The "Mailing Date" appearing on the WIPO cover letter may also be found through the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please enter the U.S. Application Serial Number for this application and select "Documents." The "Mailing Date" is the "Create/Mail Date" of the "IB-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the 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.
- (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/trademarks/teas/index.jsp>.

### **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 of Office Records: No Conflicting 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).

Applicant must respond to the requirement(s) set forth below.

### **Identification of Goods**

The identification of goods and/or services is indefinite and must be clarified to specify the types of clothing applicant is providing, as set out in bold below. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

Specifically, the wording beach clothes, clothing, clothing of leather, outer clothing, ready-made clothing, and waterproof clothing in the identification of goods is indefinite and must be clarified because it does not specify the types of clothing for which the mark is used. *See* TMEP §§1402.01, 1402.03. Applicant must amend the identification by inserting the word "namely" and indicating the specific types of clothing items (e.g., shirts, pants, coats, dresses). *See* TMEP §§1402.01, 1402.03 (a). Applicant must also specify the type of combinations, furs, headgear, knitwear, and linings it is providing.

In addition, applicant must delete the unnecessary brackets from the identification.

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). Therefore, although clothing can be classified in international classes other than International Class 25 (e.g., International Classes 9, 10, and 18), any modification to the identification must identify goods in International Class 25 only, the class specified in the application for such goods.

The following substitute wording is suggested, if accurate:

Class 25: Babies' pants; bathing caps; bathing suits; beach clothes, **namely, {specify type, e.g., swimsuits, beach coverups}**; belts; boas; bodices; breeches for wear; camisoles; cap peaks; clothing, **namely, {specify type, e.g., pants, shirts, tops, bottoms, footwear}**; clothing of leather, **namely, {specify type, e.g., leather pants, shirts, headwear, shoes, boots, vests}**; coats; collar protectors; clothing in the nature of combinations; cuffs; dressing gowns; ear muffs; frocks; furs, **namely, {specify type, e.g., fur cloaks, coats and jackets}**; gaiters; garters; headbands; headgear for wear, **namely, {specify type, e.g., hats, caps}**; hoods; jackets; knitwear, **namely, {specify type, e.g., knit bottoms, knit tops, knit dresses, knitted caps and gloves}**; liveries; mantillas; masquerade costumes; money belts; neckties; overalls; overcoats; outer clothing, **namely, {specify type, e.g., jackets, coats, boots}**; parkas; pelisses; pocket squares; pullovers; pyjamas; ready-made clothing, **namely, {specify type, e.g., pants, shirts, tops, bottoms, footwear}**; ready-made linings, **namely, finished textile linings for garments**; saris; sashes for wear; scarves; shawls; shirts; shirt fronts; shower caps; skirts; skull caps; socks; stockings; suspenders; suits; sweaters; tee-shirts; tights; trousers; underpants; underwear; uniforms; veils; vests; waterproof clothing, **namely, {specify type, e.g., pants, shirts, tops, bottoms, jackets, coats, raincoats, footwear}**

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.* 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.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

### **Significance**

Applicant must specify whether the wording “OBNOVI” has any significance in the clothing trade or industry or as applied to the goods/services described in the application, or if such wording is a “term of art” within applicant’s industry or identifies a geographic location. *See* 37 C.F.R. §2.61(b); TMEP §§808.01(a), 814.

Failure to respond to a request for information is an additional ground for refusing registration. *See In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTIP’ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

### **Translation**

Applicant must specify whether “OBNOVI” in the mark has any meaning in a foreign language. *See* 37 C.F.R. §2.32(a)(9); TMEP §§809, 814. An applicant must submit an English translation of all foreign wording in a mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

Accordingly, if the wording has meaning in a foreign language, applicant should provide the following translation statement:

**The English translation of “OBNOVI” in the mark is “[insert translation]”.**

TMEP §809.03.

Alternatively, if the wording does not have meaning in a foreign language, applicant should provide the following statement:

**The wording “OBNOVI” has no meaning in a foreign language.**

*Id.*

## **Response**

To expedite prosecution of the 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/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at [http://www.uspto.gov/trademarks/teas/e\\_filing\\_tips.jsp](http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp) and email technical questions to [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

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.

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. Where the application has been abandoned for failure to respond to an Office action, 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).

If applicant has questions regarding this Office action, please email the assigned trademark examining attorney.

If applicant submits questions via email, 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 §§304.01-.02, 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.

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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](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](mailto: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>.