

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

U.S. APPLICATION SERIAL NO. 79120092

MARK: NOVESTA

79120092

CORRESPONDENT ADDRESS:

Ing. Mária Holoubková
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SLOVAKIA

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: NOVESTA, a.s.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1134831

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **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.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst 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). *See* below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2) (ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those 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. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §§11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

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

The assigned examining attorney reviewed the referenced application and determined the following:

No Conflicting Marks Found

The examining attorney searched the Office records and found no similar registered or pending mark that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02. The applicant, however, must respond to the following requirements.

Identification of Goods

The wording “Products made of gum included in this class (17); ready-made clothing; belts (clothing); beach clothes; gloves (clothing); headgear for wear; outerclothing (25)” in the identification of goods is indefinite because it must further specify each good and/or too broad because it could include goods classified in other international classes. See suggestions below. TMEP §§1402.01 and 1402.03.

Generally, parentheses and brackets should not be used in identifications of goods and services. The Post Registration Section of the Office uses single brackets to indicate that goods/services have been deleted from a registration either by amendment of a registration under 15 U.S.C. §1057, filing of a partial affidavit of continued use under 15 U.S.C. §1058, or filing of a partial renewal application under 15 U.S.C. §1059. The Post Registration Section also uses double parentheses to indicate that certain goods or services are not claimed in an affidavit of incontestability under 15 U.S.C. §1065. Therefore, to avoid confusion, applicants should not use parentheses and brackets in the identification of goods or services in an application. TMEP §1402.12. The applicant may adopt the following identification of goods, if accurate:

Products made of gum, **namely, [individually specify each item that is properly classified in International Class 17, e.g., resins in bars, blocks, pellets, rods, sheets and tubes for general industrial use]**; plastics in extruded form for use in manufacture; *in International Class 17*

Footwear made of leather, plastic materials, textile and other similar materials; half soles; original soles for footwear; non-orthopedic soles for footwear; welts for footwear; footwear uppers; heelpieces for footwear; ready-made clothing, **namely, [individually specify each article of clothing that is properly classified in International Class 25, e.g., pants, shorts, skirts, robes]**; shirts; suits; **belts**; neckties; raincoats; trousers; **beachwear**; pullovers; **gloves**; jackets; shawls; scarves; **headwear**; sweat-absorbent underclothing; tee-shirts; singlets; vests; outerclothing, **namely, [individually specify each article of outerwear that is properly classified in International Class 25, e.g., jackets, coats, scarves, hats]**; dressing gowns; mittens; sweat-absorbent stockings; slippers; bathing suits; socks; *in International Class 25*

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04, 1402.01(c) and 1904.02(b).

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

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/netahtml/tidm.html>.

Entity and Citizenship Required

The application does not contain the applicant’s entity type or citizenship. Therefore, the applicant must specify its entity type and citizenship. For example, acceptable entity types include an individual, a corporation or a limited liability company. 37 C.F.R. §2.32(a)(3); TMEP §§803.03 *et seq.* The applicant may indicate the accepted foreign designation (or an abbreviation therefor) of its legal entity.

If the applicant’s entity type is an individual, then the applicant must indicate his or her national citizenship for the record. 37 C.F.R. §2.32(a)(3)(i); TMEP §803.04. If the applicant is a corporation or association, then the applicant must set forth the country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §§803.03(c) and 803.04. If the applicant is a partnership or joint venture, the applicant must specify the country under whose laws the partnership or joint venture is organized. 37 C.F.R. §2.32(a)(3)(ii); TMEP §§803.03(b) and 803.04.

Description of Mark Necessary

Pursuant to Trademark Rule 2.37, the applicant must submit an accurate and complete description of the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The following is suggested:

The mark consists of __ **[the applicant must accurately and completely describe its mark, e.g., the stylized wording NOVESTA where the V forms a point on a star].**

Prior Registration

If the applicant is the owner of U.S. Registration No. 4214585, then the applicant must submit a claim of ownership. 37 C.F.R. §2.36; TMEP §812. A copy of the registration is attached for the applicant's convenience. The following standard format is suggested:

Applicant is the owner of U.S. Registration No. 4214585.

Translation of Mark

The applicant must specify whether the mark has any meaning in a foreign language. *See* 37 C.F.R. §2.32(a)(9); TMEP §§809 and 814. If this wording has meaning in a foreign language, the applicant must submit a statement translating the mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

Alternatively, if the mark does not have meaning in a foreign language, the applicant should provide the following statement: The wording "NOVESTA" has no meaning in a foreign language.

Response Guidelines

Please note that there is no required format or form for responding to this Office Action. However, the applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the examining attorney; (2) the serial number of this application; (3) the mailing date of this Office action; and, (4) the applicant's telephone number.

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action issued via email you must wait 72 hours after receipt of the Office Action to respond via TEAS).

When responding to this Office Action, the applicant must make sure to respond in writing to each refusal and requirement raised. If there is a refusal to register the proposed mark, then the applicant may wish to argue against the refusal, *i.e.*, explain why it should be withdrawn and why the mark should register. The applicant may also have other options for responding to a refusal and should consider such options carefully. If there are other requirements, then the applicant should simply set forth in writing the required changes or statements and request that the Office enter them into the application record. The applicant *must* sign and date its response.

If the applicant has questions about its application or needs assistance in responding to this Office Action, please telephone the assigned examining attorney at the number below.

/LeighLowry/
Leigh A. Lowry
Trademark Examining Attorney
leigh.lowry@uspto.gov (informal only)
Law Office 115
(571) 272-9725

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 the Trademark Electronic Application System (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 the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or 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/trademarks/teas/correspondence.jsp>.

Print: Dec 31, 2012

85179638

DESIGN MARK

Serial Number
85179638

Status
REGISTERED

Word Mark
NOVESTA

Standard Character Mark
No

Registration Number
4214585

Date Registered
2012/09/25

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner
Novesta a.s. AKCIOVA SPOLOCNOST SLOVAKIA Nitrianska 503/60 Partizánske
SLOVAKIA 95801

Goods/Services
Class Status -- ACTIVE. IC 025. US 022 039. G & S: Footwear,
namely, rubber footwear with lining, and stitched textile, neoprene,
and leather footwear; textile pressed footwear; stitched leather
footwear produced by pressing. First Use: 2012/02/13. First Use In
Commerce: 2012/02/13.

Description of Mark
The mark consists of the wording "NOVESTA" with a four-pointed shape
above the "O".

Colors Claimed
Color is not claimed as a feature of the mark.

Translation Statement
The wording "NOVESTA" has no meaning in a foreign language.

Filing Date

Print: Dec 31, 2012

85179838

2010/11/18

Examining Attorney
RINGLE, JIM

Attorney of Record
Carl Oppedahl

