

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

U.S. APPLICATION SERIAL NO. 79131047

MARK: TISIT UPGRADE YOUR VISION

**\*79131047\***

**CORRESPONDENT ADDRESS:**

JUDr. Marián Harsány  
Hlavná 31  
SK-917 01 Trnava  
SLOVAKIA

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[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

**APPLICANT:** Klaudia Smicková

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

INTERNATIONAL REGISTRATION NO. 1162567

**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-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). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

**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.

**Identification of Goods and Services**

In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a). Except in very limited instances (see the online searchable *Manual of Acceptable Identifications of Goods and Services* linked below for specific instances), if applicant uses indefinite words such as "accessories," "apparatus," "components," "devices," "equipment," "instruments," "materials," "parts," "systems," or "products," such words must be followed by "namely," followed by a list of the specific goods identified by their common commercial or generic names. See TMEP §§1401.05(d), 1402.03(a).

The wording "magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media" in the identification of goods is indefinite and must be clarified because applicant must indicate whether these are blank or pre-recorded, and if pre-recorded, must indicate the subject matter of the recordings. See TMEP §1402.01.

An identification for computer software must specify the purpose or function of the software. See TMEP §1402.03(d). If the software is field-specific, the identification must also specify the field of use. *Id.* Clarification of the purpose, function, or field of use of the software is necessary for the USPTO to properly examine the application and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. See *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

The wording "Scientific and technological services and research and design relating thereto" in the identification of services is indefinite and must be clarified because applicant must provide the specific common commercial name of each of these "scientific and technological services". See TMEP §1402.01.

The wording "industrial analysis and research services" in the identification of services is indefinite and must be clarified because applicant must specify the subject matter of these services. See TMEP §1402.01.

**Applicant may adopt the following format for its identification of goods and services, if accurate.**

"{**List specific class 9** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments, e.g., "**graduated rulers**"; {**List specific class 9** apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, e.g., "**light switches**"; apparatus for recording, transmission or reproduction of sound or images; {specify either "**blank**" or "**pre-recorded**"} magnetic data

carriers, recording discs, compact discs, DVDs and other digital recording media {if pre-recorded, specify subject matter, e.g., “all featuring music”}; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; Software for {specify function, e.g., “use as a spreadsheet”}; fire-extinguishing apparatus,” in International Class 9;

“Advertising; business management; business administration; office functions,” in International Class 35;

“{indicate specific Scientific and technological services and research and design relating thereto, e.g., “scientific research, analysis, and testing in the field of computer and software technologies”}; industrial analysis and research services in the field of {specify, e.g., “computer and software technologies”}; design and development of computers and software,” in International Class 42.

Although identifications of goods and/or services may be amended 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. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

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 given to the goods and/or services by the International Bureau in the corresponding international registration. TMEP §§1401.03(d), 1904.02(b).

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>. See TMEP §1402.04.

### Significance of Wording in Mark

Applicant must explain whether “TISIT” has any meaning or significance in connection with the goods and/or services, 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 or has any meaning in a foreign language. See 37 C.F.R. §2.61(b); TMEP §§809, 814.

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.

**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>.

/kristindahling/  
Kristin M. Dahling  
Trademark Examining Attorney, LO113  
kristin.dahling@uspto.gov  
(571) 272-8277

**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 at least 72 hours from the issue/mailling 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](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 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](mailto: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>.