

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

U.S. APPLICATION SERIAL NO. 79136476

MARK: GUBAL

79136476

CORRESPONDENT ADDRESS:

BOVARD LTD
Patent- and Trademark Attorneys
Optingenstrasse 16
CH-3000 Bern 25
SWITZERLAND

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APPLICANT: PANArt Hangbau AG

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1176482

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID PARTIAL ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL PARTIAL 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 partial refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL PARTIAL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application that **applies to only the following goods and services in the application:**

Class 9 - Pre-recorded electronic, optical and/or magnetic data media of all kinds; magnetic data carriers, recording disks; compact disks, DVDs and other digital recording media.

Class 41 - Entertainment and cultural activities; performances by musicians and artists as entertainment services; entertainment services in the form of concert performances; services in the field of publishing; recorded music; provision of movie, television and music video entertainment via an interactive web site; entertainment provided via a global communication network.

See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional partial refusal.

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.

NO CONFLICTING REGISTERED 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).

OTHER ISSUES

Although the examining attorney has not refused registration, Applicant must respond to the following requirement(s) set forth below.

IDENTIFICATION OF GOODS & SERVICES – INTERNATIONAL CLASSES 9 AND 41

The identification of goods and services is indefinite and must be clarified. See TMEP §1402.01.

In particular, for international class 9, Applicant must provide greater specificity with regard to the subject matter of the recordings and nature of the goods.

International class 15 is acceptable as written.

For international class 41, Applicant must provide greater specificity with regard to, "Entertainment and cultural activities", "performances by musicians and artists as entertainment services", "entertainment services in the form of concert performances", "services in the field of publishing", "recorded music", "provision of movie, television and music video entertainment via an interactive web site", and "entertainment provided via a global communication network."

Please note that failure to address this issue shall result in all specified indefinite terms being deleted from the identification. For Applicant's convenience, all indefinite terms and phrases, including suggestions by the examining attorney, have been highlighted.

For assistance with identifying and classifying goods and 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/netathtml/tidm.html>. See TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

International class 9 –

Pre-recorded electronic, optical *discs* and/or magnetic data media of all kinds *featuring music*;

Blank magnetic data carriers *and* recording disks;

Compact disks, DVDs and other digital recording media, all featuring music, musical performances and music instruction.

International class 41 –

Organizing and hosting of exhibitions for cultural or educational purposes;

Live performances by musicians and artists as entertainment services;

Entertainment services in the form of *live music* concert performances;

Music publishing;

Digital video, audio and multimedia entertainment publishing services;

Publication of printed matter for entertainment and teaching purposes;

Providing entertainment services in the form of live musical performances and **non-downloadable** recorded music;

Provision of **non-downloadable** movies and television *shows* featuring music and musical artists and musical videos via an interactive web site;

Provision of information relating to education, entertainment and cultural activities, including by electronic means;

Entertainment provided via a global communication network, *namely, providing online non-downloadable computer games*;

Production of sound, music and video recordings.

NOTE: 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 §1904.02(c)(iv). In an application filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends the identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods and/or services will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

In addition, in a Section 66(a) application, 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), 1402.01(c). Further, in a multiple-class Section 66(a) application, an applicant may not transfer services from one existing international class to another. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c).

RESPONSE GUIDELINES

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.

If applicant does not respond to this Office action within the six-month period for response, the following goods and services will be deleted from the application:

Class 9 - Pre-recorded electronic, optical and/or magnetic data media of all kinds; magnetic data carriers, recording disks; compact disks, DVDs and other digital recording media.

Class 41 – Entertainment and cultural activities; performances by musicians and artists as entertainment services; entertainment services in the form of concert performances; services in the field of publishing; recorded music; provision of movie, television and music video entertainment via an interactive web site; entertainment provided via a global communication network.

The application will then proceed with the following goods and services only:

Class 15 – idiophones and musical instruments.

Class 41 – Digital video, audio and multimedia entertainment publishing services; Publication of printed matter for entertainment and teaching purposes; Providing entertainment services in the form of live musical performances; Provision of information relating to education, entertainment and cultural activities, including by electronic means; Production of sound, music and video recordings.

See 37 C.F.R. §2.65(a); TMEP §718.02(a). In such case, applicant's only option would be to file a timely petition to revive the abandoned goods services and class, which, if granted, would allow for the reinsertion of these goods services and class into the application. *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 the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL PARTIAL 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>.

/VJ/

Gene V.J. Maciol, II
Attorney-advisor
Law Office 103
gene.maciol@uspto.gov
571-273-9280 fx
571-272-9280 ph

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>.