

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

U.S. APPLICATION SERIAL NO. 79152106 MARK: MOVYCHEM	*79152106*
CORRESPONDENT ADDRESS: Ing. Róbert Porubčan Puskinova 19 SK-900 28 Ivanka pri Dunaji	CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp
APPLICANT: Jiri Vylimec – MOVYCHEM	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS:	

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1216191

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 "1B-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.

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.

SUMMARY OF ISSUES that applicant must address:

- Identification of Goods
- Explanation of Mark's Significance Required
- Wording in Mark – Inquiry

SEARCH OF OFFICE'S DATABASE OF 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).

IDENTIFICATION OF GOODS

Some of the wording in the identification of goods is indefinite and must be clarified because applicant must indicate with greater specificity the type of goods. See TMEP §1402.01. Applicant must amend the identification to specify the common commercial name of the goods. If there is no common commercial name, applicant must describe the product and its intended uses. See *id.*

In addition, the word "products" in the identification of goods is indefinite and must be clarified because it is too broad and could refer to goods in multiple international classes. Applicant must amend the identification by stating the common generic name of each item or by describing the nature, purpose and intended use of each item. See TMEP §§1402.01, 1402.03.

The identification of goods in International Class 17 includes a duplicate entry of the wording "insulating paints," "foils of metal for insulating" and "insulating coatings." Also, the identification of goods in International Class 19 includes a duplicate entry of the wording "building materials, not of metal" and "pitch." Applicant may either (1) modify one of the two identical descriptions of goods such that it will no longer be duplicative, or (2) delete one entry. See TMEP §707.02. However, if applicant modifies the goods, applicant may do so only to clarify or limit them; 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.*

Additionally, the identification of goods contains parentheses. Generally, parentheses and brackets should *not* be used in identifications. Parenthetical information is permitted in identifications only if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12.

Therefore, applicant must remove the parentheses from the identification of goods and incorporate the parenthetical information into the description.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 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 an 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 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 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 goods from one existing international class to another. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c).

Therefore, any modification to this wording must identify goods in International Classes 17 or 19, the classifications specified in the application for these goods.

Applicant should note that any wording in **bold**, in *italics*, underlined, and/or in ALL CAPS below offers guidance and/or shows changes being proposed for the identification of goods and/or services. If there is wording in the applicant’s version of the identification of goods and/or services which should be removed, it will be shown with a line through it such as this: ~~struckthrough~~. When making its amendments, applicant should enter them in standard font, not in **bold**, in *italics*, underlined, and/or in ALL CAPS.

Applicant may adopt the following identification, if accurate:

International Class 17: Insulating paints; insulating coatings; ~~insulating paints~~; insulating varnish; insulators **FOR** *{please specify purpose or use, e.g., electrical cables, electric mains}*; substances for insulating buildings against moisture, **NAMELY, BUILDING INSULATION**; insulating plates and sheets; insulating ~~products~~ **MATERIALS FOR USE IN INSULATION** against moisture; insulating sealant compounds for joints; insulating bitumen varnish; foils of metal for insulating; plastic film, other than for wrapping, **NAMELY,** *{please specify use of plastic film, e.g., plastic film for industrial and commercial packing use, tinted plastic film for use on windows}*; plastic sheeting for agricultural use; gum, raw or partly processed; sealant compounds for joints; ~~foils of metal for insulating~~; insulating oils; insulating bands; ~~insulating coatings~~; insulating gloves; insulating fabrics; insulating paper; insulating materials; raw or semi-worked rubber; water-tight rings **FOR PLUMBING PIPES**; asbestos millboards; adhesive tapes other than stationery and not for medical or household purposes; **SEMI-PROCESSED** synthetic resins (~~semi-finished products~~); packing (~~cushioning, stuffing~~) materials **BEING CUSHIONING AND STUFFING** of rubber or plastics; caulking materials; waterproof packings **FOR** *{please indicate use}*.

International Class 19: Waterproof cardboard, **NAMELY, WATERPROOF PAPER BOARD FOR BUILDING**; paperboard for building; bitumen; tar; pitch (~~building material~~); materials for making and coating roads, **NAMELY,** *{please specify goods in International Class 19 only, using common commercial or generic names, e.g., road asphalt, concrete road pavement boards, polymeric bitumen emulsions for road surfaces}*; bituminous products for building, **NAMELY,** *{please specify goods in International Class 19 only, using common commercial or generic names, e.g., bituminous roof coatings, polymeric bitumen emulsion for waterproofing buildings}*; building cardboard, **NAMELY, ASPHALTED PAPER BOARD FOR BUILDING** (~~asphalted~~); bituminous coatings for roofing; asphalt paving **COMPOSITIONS**; tarred strips **FOR USE IN CONSTRUCTION** (~~construction~~); reinforcing materials not of metal for building; geotextiles **FOR USE IN CONNECTION WITH** *{please specify use of goods, e.g., road construction, building construction, waterway construction}*; wood pulp board **FOR USE IN CONSTRUCTION** (~~construction~~); building paper, **NAMELY, ASPHALT AND TARRED ROOFING PAPER**; building materials, not of metal, **NAMELY,** *{please specify goods in International Class 19 only, using common commercial or generic names, e.g., semi-worked woods, cementitious material, marble}*; non-metal pipes for building, **NAMELY,** *{please indicate type of pipes in International Class 19 only, using common commercial or generic names, e.g., water pipes, gutter pipes, rigid pipes}*; asphalt, pitch and bitumen; transportable buildings, not of metal; busts of stone, concrete or marble; concrete; concrete building elements, **NAMELY,** *{please specify goods in International Class 19 only, using common commercial or generic names, e.g., blocks, bricks, slabs, panels}*; road marking sheets and plates, of synthetic material, **NAMELY,** *{please specify goods in International Class 19 only, using common commercial or generic names, e.g., glass granules, plastic road studs}*; tiles not of metal for building; framework, not of metal, for building; ~~building materials, not of metal~~; laths not of metal; cladding not of metal **FOR**

BUILDING (for building); pitch; binding material for road repair, **NAMELY**, [please specify goods in International Class 19 only, using common commercial or generic names, e.g., patching compound made of a tar base]; roofing not of metal; roof coverings, not of metal; roofing shingles; tiles not of metal; coal tar.

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

For assistance with identifying and classifying goods 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.

EXPLANATION OF MARK'S SIGNIFICANCE REQUIRED

Applicant must specify whether the wording "MOVYCHEM" has any significance in the building materials trade or industry or as applied to the goods described in the application, or if such wording is a "term of art" within applicant's industry. See 37 C.F.R. §2.61(b); TMEP §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.

INQUIRY ON WORDING IN MARK

Applicant must specify whether "MOVYCHEM," "MOVY" or "CHEM" 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 any of the wording has meaning in a foreign language, applicant should provide one of more of the following translation statements:

The English translation of the word "MOVYCHEM" in the mark is "{insert translation statement}".

The English translation of the word "MOVY" in the mark is "{insert translation statement}".

The English translation of the word "CHEM" in the mark is "{insert translation statement}".

TMEP §809.03.

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

The wording "MOVYCHEM" has no meaning in a foreign language.

Id.

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 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 active 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 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 §§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.

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>.

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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 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>.