

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

U.S. APPLICATION SERIAL NO. 79155402 MARK: SWAN	*79155402*
CORRESPONDENT ADDRESS: SCHMIT-CHRETIEN 29, rue de Lisbonne F-75008 PARIS FRANCE	CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp -
APPLICANT: SAGEMCOM BROADBAND SAS	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS:	

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1223814

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.

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 Clause

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/Services

The identification of goods and services is indefinite and must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods and services. If there is no common commercial or generic name, applicant must describe the product and intended consumer as well as its main purpose and intended uses.

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).

Applicant may adopt the following identification, if accurate:

International Class 9; Software and software suites **comprised of computer software** for the digital distribution of audio content, video content and the transmission of sound, images and data; software platforms for Internet and home automation networks enabling interoperability between the different terminals and applications; residential multimedia gateways, **namely, gateway routers in the nature of computer control hardware**; apparatus for the receipt, recording, transmission, reproduction, storage, encryption and decryption of sound or images, namely, decoders for the receipt of multimedia content, **namely, video decoders and audio decoders**; modems; telecommunications routers, **namely, computer network routers**; connected home **computer terminals; wireless network extenders**; online carrier currents (OCC) (**this item is indefinite; the applicant must provide the common commercial name of the goods**); digital wireless telephones; **computer applications** for smart phones,

namely, software for _____ (applicant must specify the function of the software; e.g., database management); software for _____ (applicant must specify the function of the software); computer hardware; communications equipment, namely, _____ (the applicant must provide the common commercial name of the equipment); computer devices, namely, _____ for saving, storing and accessing electronic data via local and remote computer networks; universal serial bus (USB) operating software and hardware; **pre-recorded flash drive networks featuring _____ (the applicant must provide the subject matter of the flash drives)**; data storage apparatus and equipment, namely, _____; devices for mobile and wireless communications, namely, _____;

International Class 38; Electronic transmission of voice, data and images by television and video broadcasting, *services for the distribution of information electronically and via data communication, especially global telecommunication networks such as the Internet or private or restricted-access networks (THIS ITEM IS INCORRECTLY CLASSIFIED AND INDEFINITE; IT'S CORRECT CLASSIFICATION IS INTERNATIONAL CLASS 41; IT CANNOT BE RECLASSIFIED UNDER SECTION 66A; UNLESS THE APPLICANT CAN FIND AN APPROPRIATE IDENTIFICATION IN INTERNATIONAL CLASS 38, THIS ITEM SHOULD BE REMOVED)*; providing telecommunication connectivity services for transfer of images, messages, audio, visual, audiovisual and multimedia works; provision of access to a **global computer network on a cloud server** which acts as a proxy for subscriber premises equipment (CPE) devices; transmission and exchange of messages and data via wired and wireless services over a global computer information network or a private network; AND,

International Class 42; *Computer Services, namely, provision of a multimedia gateway on a cloud server; Computer Services, namely, provision of a cloud server which acts as a proxy for subscriber premises equipment (CPE) devices;* (THESE ITEMS ARE INCORRECTLY CLASSIFIED AND INDEFINITE; THEY CANNOT BE RECLASSIFIED UNDER SECTION 66A; UNLESS THE APPLICANT CAN FIND AN APPROPRIATE IDENTIFICATION IN INTERNATIONAL CLASS 42, THESE ITEMS SHOULD BE REMOVED); technical support services, **namely, providing technical advice related to the installation of** multimedia gateways and cloud servers; **computer design and development** and research in the field of multimedia gateways and cloud servers; technical advice **relating to the operation of computers** in the field of video and communication networks; providing temporary use of non-downloadable software **in the field of _____ (the applicant must provide the specific use of the software)**; design and development of computer **hardware** and software.

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

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/netahhtml/tidm.html>. *See* TMEP §1402.04.

Mark Description Required

The applied-for mark is not in standard characters and applicant did not provide a description of the mark with the initial application. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. *See* 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b).

Therefore, applicant must provide a description of the applied-for mark. The following is suggested:

The mark consists of the word SWAN with an S design consisting of two brush strokes broken in the middle, to the right of the word SWAN.

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>.