

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

**U.S. APPLICATION SERIAL NO.** 79165343

**MARK:** MINI SO

**\*79165343\***

**CORRESPONDENT ADDRESS:**

Unitalen Attorneys At Law  
7th Floor, Scitech Place,  
No. 22 Jian Guo Men Wai Ave.,  
100004 Beijing  
CHINA

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**APPLICANT:** Guangdong Saiman Investment Co., Ltd.

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

N/A

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**OFFICE ACTION**

**INTERNATIONAL REGISTRATION NO. 1247434**

**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.

The referenced application has been reviewed by the assigned trademark examining attorney.

**Search Results**

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).

**Summary of Issues Requiring Response**

Applicant must respond timely and completely to the following issues:

- Registration Refused - Limitation in International Class 21 Not Accepted
- Clarification of Identification of Goods and Services Required
- Disclaimer Required

15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### **Registration Refused - Limitation in International Class 21 Not Accepted**

The wording “*wine glasses; wine jugs*” in the limitation to the identification in International Class 21 included in the Section 66(a) application is refused because it exceeds the scope of the basic goods in the international registration. See 37 C.F.R. §2.71(a); TMEP §§1904.03(g), 1906.01(e); *Common Regulations under the Madrid Agreement Concerning the Int’l Registration of Marks & the Protocol Relating to that Agreement*, Common Reg. 27(5)(a) (2013), [http://www.wipo.int/treaties/en/text.jsp?file\\_id=355319](http://www.wipo.int/treaties/en/text.jsp?file_id=355319). Specifically, the basic goods specifies “liqueur sets” and “crystal [glassware],” and the limitation could include goods that are not for liqueur, or are not crystal glassware. As the limitation results in an expansion, rather than a narrowing, of the basic goods listed in the Section 66(a) application as originally extended to the United States, the wording “*wine glasses; wine jugs*” has no effect in the United States and will not be part of the Section 66(a) application. See TMEP §1904.03(g).

An acceptable identification of goods and/or services is required in a U.S. application based on Trademark Act Section 66(a). See 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01(c). For Section 66(a) applications, the scope of the identification for purposes of amendment is limited by the international class assigned to the goods and/or services 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). Additionally, 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 §§1402.06 *et seq.*, 1402.07.

Applicant may respond to this refusal by satisfying one of the following:

- (1) **Delete the unacceptable wording** from the identification. See TMEP §1904.02(c)(iv). However, once an application has been expressly amended to delete goods and/or services, those items generally may not later be re-inserted. TMEP §1402.07(e).
- (2) **Record a new limitation with the International Bureau** that does not broaden the scope of the basic goods and/or services listed in the Section 66(a) application as originally extended to the United States. TMEP §1906.01(e). However, filing a request to record a limitation is not considered a formal response to this Office action. TMEP §1904.02(e)(iii). If applicant files a new request for a limitation, applicant must also file a timely and complete response to this Office action, stating that applicant has recorded a new limitation that will resolve the outstanding issue. See 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03, 1904.02(e)(iii). An example of an acceptable limitation would be “*crystal glassware, namely, wine glasses and wine jugs.*”
- (3) **Submit arguments** in support of giving effect to the limitation. If this issue is being made final, file an appeal to the Trademark Trial and Appeal Board under 37 C.F.R. §§2.141, 2.142, or petition the Director under 37 C.F.R. §2.146 if permitted by 37 C.F.R. §2.63(b)(2). TMEP §1904.03(g).

### **Clarification of Identification of Goods and Services Required**

#### *International Class 9*

No changes are required in International Class 9.

#### *International Class 18*

No changes are required in International Class 18.

*International Class 21*

The wording "*boxes for dispensing paper towels*" in the identification of goods is too broad because it could include dispensers in other classes, to be in International Class 21 the goods must be for household use. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. As applicant has also identified "*boxes for dispensing paper towels for household use*," applicant may also delete "*boxes for dispensing paper towels*" since clarification to specify household use would merely duplicate the previous entry.

In an application filed under Trademark Act Section 66(a), 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), 1904.02(b). 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); see TMEP §§1402.07(a), 1904.02(c). Therefore, any modification to this wording must identify goods in International Class 21, the classification specified in the application for these goods.

*International Class 25*

No changes are required in International Class 25.

*International Class 35*

No changes are required in International Class 35.

*Sample Amended Identification*

Applicant may adopt the following identification, *if accurate*:

International Class 9: Sleeves for laptops; lap-counting devices, namely, counters for use during sporting activities; facsimile machines; weighing machines; portable telephones; cabinets for loudspeakers; cameras; magnifying glasses; remote control telemetering machines and apparatus; anti-glare glasses; electric locks; eyeglasses; batteries, electric.

International Class 18: Umbrellas; imitation leather; key cases; pocket wallets; textile shopping bags; reusable shopping bags; canes; haversacks; pouch baby carriers; leather laces

International Class 21: Cosmetic brushes; cosmetic spatulas; ***boxes for dispensing paper towels for household use***; combs; toothbrushes, electric and non-electric; toothpicks; tea cosies; gloves for household purposes.

International Class 25: Clothing, namely, skirts, coats, tops, blouses, sweatshirts, suits, vests, dresses, sweaters, sweatpants, shorts and pants; shoes; hats; hosiery; gloves; scarfs; girdles; shower caps; sleep masks.

International Class 35: Advertising services; business organization and management consulting; business management consultation; commercial administration of the licensing of the goods and services of others; goods import-export agencies; sales promotion for others provided through the distribution and the administration of privileged user cards; marketing services; retail pharmacy services

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/netahtml/tidm.html>. See TMEP §1402.04.

### **Disclaimer Required**

Applicant must disclaim the wording “MINI” in International Classes 9, 18, 21, and 25 because it merely describes a feature of applicant's goods and the non-Latin characters that transliterate to “CHUANG” in International Class 35 because it merely describes a feature of the services, and thus is an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

The wording “MINI” means “something that is distinctively smaller than other members of its type or class,” and this wording could describe that the goods are small in size. The transliterated characters “CHUANG” mean “create” which is defined as “to produce through artistic or imaginative effort,” and this merely describes that the services include the production of advertising. Non-English wording that is merely descriptive, deceptively misdescriptive, geographically descriptive, generic, or informational in connection with the identified goods and/or services, is an unregistrable component of the mark that is subject to disclaimer. TMEP §§1213.03(a), 1213.08(d); see *Bausch & Lomb Optical Co. v. Overseas Fin. & Trading Co.*, 112 USPQ 6, 8 (Comm'r Pats. 1956). The disclaimer must refer to the non-Latin characters and the transliteration in Latin characters (“the non-Latin characters that transliterate to “<specify>”). TMEP §1213.08(d).

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. See *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

A “disclaimer” is a statement in the application record that an applicant does not claim exclusive rights to an unregistrable component of the mark; a disclaimer of unregistrable matter does not affect the appearance of the mark or physically remove disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive of an applicant's goods and/or services. 15 U.S.C. §1052(e); see TMEP §§1209.03(f), 1213.03 *et seq.* Such words or designs need to be freely available for other businesses to market comparable goods or services and should not become the proprietary domain of any one party. See *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire

mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit the following standardized format for a disclaimer:

**No claim is made to the exclusive right to use “MINI” for International Classes 9, 18, 21, and 25, and the non-Latin characters that transliterate to “CHUANG” in International Class 35 apart from the mark as shown.**

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493, 494 (Comm’r Pats. 1983).

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

### **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).

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a private attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant’s legal rights. TMEP §§705.02, 709.06.

For attorney referral information, applicant may consult the American Bar Association’s Consumers’ Guide to Legal Help at <http://www.abanet.org/legalservices/findlegalhelp/home.cfm>, an attorney referral service of a state or local bar association, or a local telephone directory. The USPTO may not assist an applicant in the selection of a private attorney. 37 C.F.R. §2.11.

In addition, foreign attorneys, other than authorized Canadian 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. §§2.17 (e), 11.14(c), (e); TMEP §602.03-.03(c).

**The only attorneys who may practice before the USPTO in trademark matters are as follows:**

- (1) **Attorneys 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
- (2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are

registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO

*See* 37 C.F.R. §§2.17(a), (e), 11.1, 11.14(a), (c); TMEP §602.

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. §§2.62(c), 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.

/April K. Roach/  
April K. Roach  
Trademark Examining Attorney  
Law Office 115  
(571) 272-1092  
april.roach@uspto.gov

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**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.

**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>.

**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>.

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mini- (min'ē) *n.* pl. min-i-s



mini

1.

Something that is distinctively smaller than other members of its type or class.



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2.

A miniskirt.

[From mini- -Sense 2, short for miniskirt.]

mini<sup>1</sup> adj.

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Mini. (2011). In The Editors of the American Heritage Dictionaries, The Editors of the American Heritage Dictionaries, & The Editors of the American Heritage Dictionaries (Eds.), *The American Heritage Dictionary of the English language*. Boston, MA: Houghton Mifflin. Retrieved from <http://search.credoreference.com/content/entry/hmdictenglang/mini/0>

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cre•ate (krē-āt) *tr.v.* cre•at•ed, cre•at•ing, cre•ates



create

1.

To cause to exist; bring into being: created a new music school. See Synonyms at establish.

2.

To give rise to; produce: That remark created a stir.

3.

To produce through artistic or imaginative effort: create a poem: create a dramatic role

4.

To invest with an office or title, appoint: He was created a baron.

adj. Archaic

Created.

[Middle English createn , from Latin créare , créât- ; see ker-2 in Indo-European roots.]

cre-at'a-ble adj.

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