

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

U.S. APPLICATION SERIAL NO. 79174501

MARK: VLBE.MAC.

79174501

CORRESPONDENT ADDRESS:

CON LOR SPA
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http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: VLBE.MAC. S.p.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 0869856

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. 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:

- Prior-Filed Applications
- Identification of Goods
- Description of the Mark

SEARCH OF OFFICE'S DATABASE OF MARKS – PRIOR-FILED APPLICATION(S)

The trademark examining attorney has searched the USPTO's database of registered and pending marks and has found no similar registered marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d). However, marks in prior-filed pending applications may present a bar to registration of applicant's mark.

The filing dates of pending U.S. Application Serial Nos. 86501278 and 86501282 precede applicant's filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

IDENTIFICATION OF GOODS

The identification of goods in International Class 7 includes a duplicate entry of the wording "sewing robots." Applicant may either (1) modify one of these two identical descriptions of goods and/or services 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.

In addition, the identification of goods contains parentheses. Generally, parentheses and brackets should *not* be used in identifications. TMEP §1402.12. 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).” *Id.*

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

Finally, applicant must clarify the identification of goods by (1) specifying that the “tape readers for use with embroidery machines are “sewing machine parts”; and (2) specifying that the “structural parts and attachments” are “for sewing machines.” See TMEP §1402.01.

In the following proposed amendments, changes are noted in **bold**. Where indicated, applicant needs to specify the nature of the goods and/or services provided in accordance with the guidelines set out below. Applicant may accept any of the suggested amendments, if accurate. However, any other amendments must conform to the same level of specificity and structure set out in the USPTO’s *Acceptable Identification of Goods and Services Manual*.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://ess2.uspto.gov/regaffairs/tadm.html>. See TMEP §1402.04.

Applicant may amend to the following, if accurate:

International Class 7:

Machines namely, sewing machines; sewing robots; industrial sewing machines; electric sewing machines; **sewing robots, namely {specify to distinguish from other entry or delete entire wording}**; sewing machine installations, namely, sewing machines; embroidery robots; embroidery machines; leather-working machines; leather and hide tanning machines; darning machines; tacking machines; quilting machines for use in the manufacture of upholstery; quilting machines for use in the manufacture of mattresses; textile and leather sewing equipment, namely, textile and leather sewing machines; motors and engines **not for land vehicles** (~~except for land vehicles~~), namely, sewing machine motors; servo motors for sewing machines; machine couplings and transmissions, except for land vehicles; sewing machines and their parts, namely, tambours for embroidery machines; **sewing machine parts, namely**, tape readers for use with embroidery machines; pedal drives for sewing machines; structural parts and attachments **for sewing machines** ~~thereof~~, namely, fabric loaders, fabric stackers and unloaders, fabric and thread cutters, bobbin winders, fabric folders, fabric feeding attachments, fabric pullers, thread trimmers.

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).

DESCRIPTION OF MARK REQUIRED

The description of the mark uses broad, vague language that does not accurately describe the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description that identifies all literal elements as well as any design elements in the mark. See 37 C.F.R. §2.37; TMEP §808.02.

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

The mark consists of the red stylized wording “VLBE.MAC.” with gray shading to the right of a design consisting of red intersecting stylized diagonal lines to form a stylized “X” shape with three red lines forming a stylized “Y” shape overlapping the “X” shape, surrounded by a gray rectangular border with an opening in the bottom where the bottom of the “Y” shape protrudes. The color white is background and not claimed as a feature of the mark.

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 specified in this Office action for responding to a refusal, and should consider those 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 date on which the USPTO sends this Office action to the International Bureau, 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 §§711, 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(15), 2.66(b)(1).

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a qualified U.S. 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>. The USPTO may not assist an applicant in the selection of an attorney. 37 C.F.R. §2.11.

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>.

/Erica Jeung Dickey/
Examining Attorney
Law Office 112
571-270-3517
erica.dickey@uspto.gov

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>.

DESIGN MARK

Serial Number

86501278

Status

NOTICE OF ALLOWANCE - ISSUED

Word Mark

VIBRA-MAX

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

General Kinematics Corporation CORPORATION ILLINOIS 5050 Rickert Road
Crystal Lake ILLINOIS 60014

Goods/Services

Class Status -- ACTIVE. IC 007. US 013 019 021 023 031 034 035. G
& S: Electric vibrating motors, and their parts, for industrial
machines.

Filing Date

2015/01/12

Examining Attorney

BIBBINS, ODESSA

Attorney of Record

Paul C. Craane

VIBRA-MAX

DESIGN MARK

Serial Number

86501282

Status

NOTICE OF ALLOWANCE - ISSUED

Word Mark

VIBRAMAX

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

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