

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

U.S. APPLICATION SERIAL NO. 79176504

MARK: VOLVO

79176504

CORRESPONDENT ADDRESS:

Advokatfirman Lindahl KB
Box 1065
SE-101 39 STOCKHOLM
SWEDEN

CLICK HERE TO RESPOND TO THIS LETTER:

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APPLICANT: Volvo Trademark Holding Aktiebolag

CORRESPONDENT'S REFERENCE/DOCKET NO.:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1274024

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, 2.65(a); TMEP §§711, 718.03.

OFFICE SEARCH REVEALS PRIOR PENDING APPLICATION - ADVISORY

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, a mark in a prior-filed pending application may present a bar to registration of applicant's mark.

Information regarding pending Application Serial No. 76707186 is enclosed. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

DESCRIPTION OF MARK REQUIRED

Applicant must submit an accurate and concise description of the literal and design elements in the mark. 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. The following is suggested, if accurate:

The mark consists of the wording "VOLVO" appearing inside of the design of a circle containing an arrow and a horizontal bar.

IDENTIFICATION UNACCEPTABLE - REQUIREMENT

Applicant has identified the following:

"Chemicals used in industry, in particular for use in the operation, repair, servicing and maintenance of vehicles, engines/motors and machines (including drive units and construction machines), including brake fluids, fluids for hydraulic systems, antifreeze compositions, *defrosting compositions*, rubber and plastic cements, plastics, adhesives, compositions for repairing surfaces, sealing compositions, saturants, water-repellent and spot-repellent agents (finishers), impregnation agents; coolants for vehicle engines, coolants (anti-boil preparations for engine); chemicals used in science and photography, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fertilizers; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; *tanning substances*; putties; adhesives used in industry; hydraulic oils" in Class 001;

"Paints, varnishes, *diluents* for colorants and lacquers, also in spray or pen form; *preservatives against rust*, *anti-corrosive agents*; coating compositions and preservatives for metal (painting), metal and lacquer conservation agents; preservatives against deterioration of wood; colorants, dyes; mordants, including metal mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; anti-rust oils" in

"Bleaching preparations and other substances for laundry use; cleaning, care, preservation, polishing, scouring and abrasive agents, in particular such for vehicles, engines/motors and machines (including drive units and construction machines), including detergents, windscreen/windshield washer fluids, wax compositions, cleaning sprays, auto shampoos, *spray preservatives*, interior cleaning agents, *motor cleaning agents*, *light metal or metal alloy wheel rim care agents*; soaps; perfumery, essential oils, cosmetics, hair lotions, including *perfume atomisers*, toilet waters, *non-medicated toilet preparations*, *powder boxes*, shaving and after-shave preparations, oils, creams and lotions for the skin; dentifrices" in Class 003;

"Industrial oils and greases, including penetrating oils (also being lubricants) and lubricants, including lock lubricants; lubricating oils; dust absorbing, wetting and binding agents; fuels (including motor spirit); solid, liquid and gaseous fuels; *illuminants*; candles, *wicks*" in Class 004;

"Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; materials for dressings; first-aid kits (filled); material for stopping teeth, dental wax; *desinfectants*; preparations for destroying vermin; fungicides, herbicides" in Class 005;

"Common metals and their alloys; *metal building materials*; transportable buildings of metal; materials of metal for railway tracks; non-electrical wires, cables and cable terminals, and speedometer cables of common metal; *ironmongery, small items of metal hardware and goods of common metal (included in this class)*, including locks, latches, metallic tubes, *metallic hoses*, *metallic valves for pipes*, pipes, pipe connections, screws, bolts, nuts, rivets, lock washers, spring washers, flat washers, chains (except drive chains for vehicles), plugs, split pins, shims, spacer rings, and *clips*, *woodruff keys*, screw unions, spring bolts, *shackles*, *ball joints*, hinges, *brackets*, tanks for liquids, *tank accessories*, nipples, fuel cans, ladders, *handles*, *metallic signs*, *wire baskets*, *metal wires*, *badges for vehicles*, *fasteners*, tow ropes of metal, *canisters*, *badges*, *keys*, key blanks, *key ring pendants and pins*, vehicle registration plates, *non-luminous signs*, boxes, luggage labels of metal, *ornaments*, safes, ores; *blinds of metal*" in Class 006;

"Motors and engines (except for land vehicles), including marine engines, aircraft engines, engines for industrial, agricultural and forestry machines, stationary combustion engines, turbines, *electric motors*; electric generators and alternators; *high-frequency generators*; air cleaners (air filters) for engines and anti-pollution devices for motors and engines; carburettors, converters for liquid fuels, injectors, injection pumps, fuel pumps, speed governors, injection nozzles and nozzle holders, machine valves, vaporizers, starters, ignition systems, ignition coils, glow plugs, spark plugs, spark plug connectors, lambda probes, magnetos, silencers/mufflers and spark arresters for combustion engines; fuel filters, oil filters, air filters; rolling bearings, plain bearings, shafts, shaft seals, gearwheels, drive wheels, speed change gear, pulleys, drive chains and belts, springs, filters, pumps, regulators, relief valves, controls, fans and fan belts, all for engine cooling radiators; cooling fans, cooling radiators, starters, fuel feed apparatus, oil cooling apparatus, brakes, caps for cooling radiators, accelerators, hydraulic pumps, hydraulic cylinders, hydraulic reservoirs, hydraulic filters, hydraulic motors, hydraulic pipes, hydraulic valves, boost units for hydraulic transmission, all for machines, engines and motors; machine coupling and transmission components (except for land vehicles), including power transmissions, gearboxes/transmissions, reverse gears, reduction gears, gearbox controllers, traction control systems, vehicle dynamics control systems, shaft connections, couplings and clutches, exhausts, couplings and transmission belts; *power transmission take-off units for motor vehicle engines, for use as prime movers*; inboard/outboard drive units and sailing boat drive units for inboard engines; hydraulic pumps and motors and components thereof, *air pumps as vehicle accessories*; *bushes and bearings (machine parts)*; *power steering systems*, *control valves (machine parts)*, *braking valves (machine parts)*; exhaust-gas turbo-chargers; *compressors*, *compressed air brakes*, *compressed air reservoirs*, *compressed air cylinders and compressed air motors*, bilge pumps; metal and plastics working machines; *machines for the chemical industry, for agriculture, mining, textile machines, machines for the beverage industry*; incubators for eggs; *agricultural implements (not hand operated)*; *construction machines*; *electronic control devices for production technology and servo drives*; *machines for the automobile industry*; *machine tools and tools therefore*; *electric power tools and their plug-in tools*; electric can openers; hydraulic lift jacks, *body and frame aligners*; packing and labelling machines, conveyors, conveyor belts; loading and handling machines for pressing plants and foundries and machines for the tooling of blanks; *loaders, dumper bodies, excavators as well as parts, including components, and accessories to such products*; *hydraulic lifting apparatus, cranes, winches*; bucket, *grapple and fork type implements for machines*; wood working machines, including delimbing, slashing and debarking equipment; teeth and cutting edges for machines; car vacuum cleaners; *car wash facility*; *parts, fittings and accessories for the abovementioned goods and for motor land vehicles*; *bushings*; automatic vending machines; *cooling radiators, radiators, radiator caps, exhausts, compressed air motors, fans, fan belts, bearings*" in Class 007;

"Hand tools and implements (hand operated), including manually handled lifting jacks, *hand tools sets*, rim crosses, ice scrapers, non-electric can openers; *hand operated implements for use in agriculture, horticulture and forestry, for the construction, maintenance and repair of apparatus, vehicles, engines/motors and machines (including drive units and construction machines)*, and for the building industry; *parts of all aforementioned goods*; cutlery, including knives, pocket knives; *side arms*; scissors, manicure sets and manicure tools; razors and travel razors; clamps" in Class 008;

"Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; programmable controllers electric and electronic apparatus and instruments, including electric batteries, *charging devices*, battery testers, electric mountings, electric blowers; electric accumulators, electric compasses, electric circuit breakers, commutators, electric condensers, electric wiring harnesses, capacitors, *relays*, electronic time relays, *switches*, fuses, electrical contacts, electric cables, electric fuses; electric fuse boxes, electrical sensors, electrical sockets, printed electrical circuits, integrated circuits; leads for electric, electronic and optical signals; cable connections, *cable drums*; transformers; *electronic headlamp beam adjustment*; sensors, detectors, switching devices/switch boxes, solar cells and solar generators; analysers for motor vehicles, namely, for exhaust gas analysis, soot particle analysis, brake function analysis, *diagnostic instruments and equipment for simulations*, engine testers, workshop test devices; *high-frequency generators*, power supply devices, *electric filters*, *semiconductor components*, *optoelectronic components*; *testing apparatus*; apparatus for recording, transmission or reproduction of data, sound or images and data processing equipment and computers, including *radio apparatus*, video screens, tape players, loudspeakers, amplifiers, *telecommunication equipment*, *car telephone installations*, compact disc players, *telematic terminals*, *distress signal terminals*, navigation and radar terminals, traffic control systems, transport supervision system, locating devices, toll terminals for electronic toll detection in traffic, *black box (accident data monitoring and recording device)*, auto-computers and on-board computers, calculators and pocket calculators; *magnetic data carriers*; *computer software*; computer hardware; video games software; *recorded and non-recorded data carriers and recording media of all kinds, including compact discs, tape cassettes; storage boxes for recording media*; data processing equipment; *highway emergency warning equipment*; interference suppressors, aerials/antennas; gauges, measuring instruments and apparatus, including such for fuel, oil pressure, tyre pressure, compressed air, temperatures, amperage, speed and engine revolutions; mileage recorders, odometers, tachometers; voltage regulators, voltmeters; time recorders, rudder indicators, instrument panels and clusters, dipsticks, thermostats, signal lamps; dynamometers, brake testers, electrical and mechanical instruments and apparatus for control and testing for vehicles, engines/motors and machines (including drive units and construction machines); automatic alarm units, anti-theft warning

devices, electronic anti-theft devices, including vehicle immobilizing units; electronic parking assistance systems; warning reflectors; fire extinguishing apparatus; electronic monitors and regulators for engines and motors; magnets; tape measures; thermometers; compasses; optical apparatus and instruments, including binoculars, magnifying glasses, spectacles, sun glasses and goggles, lenses for lamps sun-proof optical lenses; sun glasses and goggles, ophthalmic frames; warning triangles; clothing for protection against accidents, including footwear, special clothing as lifesaving equipment, workmen's protective face-shields, protective eye pieces and masks; registers; level controllers electrical apparatus, warning triangles, jumper cables, starter cables, safety nets" in Class 009;

"Lighting apparatus and installations (also for vehicles), including headlights/headlamps, lamp assemblies, lanterns, bulbs, lamp fittings, flashlights, electrical torches, reading lights; anti-dazzle devices for vehicles, motors and machines, reflectors for lightning devices; installations and apparatus for air filtering and air conditioning, ventilation, refrigerating or heating, including electric and non-electric radiators, ventilators, fans, metallic valves for pipes, parts for the aforementioned goods; compressed air ventilators, apparatus for steam generating, cooking, drying, water supply and sanitary purposes; parts and fittings for vehicles, engines/motors and machines (including drive units and construction machines)" in Class 011;

"Vehicles, including cars, vans, sport-utility vehicles (including golf carts), buses, trucks, tractor units/prime movers, on and off road vehicles/dump trucks and parts, including components, and accessories to these items which do not pertain to other classes, including vehicle chassis, vehicle bodies, braking installations, brake calipers, draw bars, bumper bars, clutches, engines, electric engines, motors, electric motors, turbines, combustion engines, starting devices for internal combustion engines, hydraulic cylinders and motors, silencers/mufflers, spark eliminators, power transmissions, gearboxes/transmissions, transmission shafts, differential gears, drive gears, drive shafts, gear change selectors, exhaust cowl, axles, shafts and couplings, machine coupling and transmission components, manual and power steering apparatus, power steering systems, hydraulic steering systems, as well as component parts of these items, compressed air reservoirs, compressed air cylinders and anti-pollution devices, air pumps, anti-dazzle devices, anti-theft devices and alarms, vehicle immobilizing units, trailer hitches, power take-offs, springs, shock absorbers, wheels, wheel bearings, wheel trims, balance weights for wheels, engine mountings, tanks and fuel tanks, engine noise shields, protective covers, radiators grilles, front grills, fluid reservoirs, deflectors, direction indicators, hatches, upholstery, handles for doors, hoods, horns, hubs, hub caps, hydraulic circuits, tyres, non-skid devices for tyres, mud flaps, brakes, servo brakes and compressed-air brakes, antilock brake systems, brake pads and brake linings, bumpers, mudguards/fenders, cabs, cab tilt mechanisms, reversing alarms, mechanical controls, head rests for seats, arm rests, doors, seats, safety-seats, personal safety restraints seats, safety seats for children, tables for seats, seat covers, headrest covers, seat belts, devices for collision protection, parking assistance systems, sliding roofs, sun roofs, vehicle steering columns, steering wheels, steering linkages, stabiliser bars, suspensions, suspension lowering outfits, torsion bars, tow bars, windows, window winding mechanisms, power windows, windscreens/windshields (also of safety glass), windscreen/windshield and headlight wipers, defrosting systems for windscreens, wiper blades, vehicle window blinds, driving mirrors, mirrors (retrovisors), tank caps, cover caps for extra headlights, warning lamps, luggage restraints for vehicles, luggage nets, luggage carriers, wheel carriers, bicycle carriers, surfboard carriers, boat carriers, mud-guards, snow chains, pet screens, stone screens, storage screens, roof racks and ski racks, stowage boxes, deposit boxes, stowage compartments, trim panels, spoilers, side and rear skirts, safety cushions, air bags, breakdown cases, holders for mirrors, sun shades, mobile telephone mounting equipment; restraining systems for installation in motor vehicles, namely, belt tensioners, airbags and sensors; tires, pneumatic tires; adhesive rubber patches for repairing inner tubes; baby carriages, wheeled chairs for invalids; bicycles; rudders, propellers, trimming vanes, steering units, steering wheels and fittings for boats as well as component parts of these items; vehicles for locomotion by land, air or water; electrical lighters for automobiles; starter motors for land vehicles" in Class 012;

"Precious metals and their alloys and goods made from these materials, and jewellery and precious stones, including cuff-links, tie clips, coins, medals, lapel pins, rings, model figures (ornaments) coated with precious metal and other decorative goods; horological and chronometric instruments, including clocks and watches, travel alarm clocks; key fobs, key rings of common metal" in Class 014;

"Paper, cardboard and goods made from these materials, including paper cubes and notes; printed matter, including books, instruction books, (computer/computer software) manuals, periodicals, magazines, newspapers, calendars, posters, stickers, banners and pennants of paper, country and road maps, spare parts lists, maintenance manuals, advertising materials, printed publications relating to automotive subjects; bookbinding material; adhesives for stationery or household purposes; artists' materials, paint brushes; photographs; stationery, including pens and pencils; typewriters and office requisites (except furniture), including pen stands, letter holders, storage boxes for recording media and paper knives; instructional and teaching material (except apparatus); plastic materials for packaging, including plastic carrier bags; printers' type; printing blocks; money clips" in Class 016;

"Rubber, gutta-percha, gum, asbestos, mica and goods made of these materials; plastics in extruded form for use in manufacture; rubber supports for motors/engines, reflex tape, felt rings, sealing compound, non-metallic tubes, pipe connection parts for radiator systems, radiator sealing compounds, fasteners and connectors, all made of plastic materials, for pipes and cables; flexible covers made of rubber or of plastic materials for protecting mechanical components; mountings made of rubber or of plastics materials for engines, transmission assemblies and for exhausts; plastic materials in the form of sheets (non-textiles) for use in the manufacture of roof coverings for vehicles; clutch linings; gaskets (other than fibrous gaskets for ships); washers (other than washers for water taps) made of rubber, plastics materials or of vulcanised fibre; grommets made of rubber or of plastics material; non-metallic hoses; strips made of rubber or of plastics materials for sealing joints; packing and stopping materials, including oil seals (packing), sealing, locking and caulking compounds and fluids (in the nature of jointings or packings); stuffings for engines/motors and machines; insulating materials; flexible pipes (not of metal); parts and fittings for vehicles, engines/motors and machines (including drive units and construction machines)" in Class 017;

"Leather and imitations of leather, and goods made of these materials; animal skins, hides; boxes of artificial leather, bags, baggage bags, trunks and travelling bags, handbags, sports bags, conference folders, umbrellas, pocket wallets, purses, back-packs, document cases, briefcases, card cases; vanity cases, not fitted; key cases, walking sticks, parasols, tool bags (empty); whips, harness and saddlery" in Class 018;

"Locks (not of metal), for vehicles; mirrors (looking glasses); air cushions, not for medical purposes; non-luminous signs; vehicle registration plates (not of metal); storage containers, storage boxes for recording media (included in class 20), boxes, canisters; seat cushions, pillows; non-metal clamps; all aforesaid goods also as parts and fittings of vehicles; furniture; mirrors; furniture frames; indoor blinds; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics" in Class 020;

"Articles for cleaning purposes, including cleaning utensils for vehicles, in particular sponges, car wash leather, cleaning cloths and hand operated cleaning devices; steel wool; unworked and semi-worked glass (except glass used in building), including glass and safety glass for vehicles; household or kitchen utensils and vessels/containers (not of precious metals or coated therewith), namely, mugs, cups, cooling bags, drinking bottles, bottle openers and

trays; combs and sponges; brushes (except paint brushes); brush-making materials; *glassware, porcelain ware and stoneware*” in Class 021;

“Ropes, towropes, string, *spare wheel cover, nets, tents, awning, tarpaulins, sails, sacks and bags for packaging, storage and transport; padding and stuffing materials not of rubber or plastics; raw fibrous textile materials*” in Class 022;

“*Blankets, plaids, winter seat covers, towels, pennants, flags, bed covers, table covers; (roller) blinds; textiles and textile goods; pennants of textile*” in Class 024;

“*Clothing (also outer clothing, leisure wear and sportswear), including belts, jackets, coats, pullovers, shawl, shirts, waistcoats, socks, scarves, ties, sweaters, T-shirts, overalls, coveralls, waterproof clothing, rain wear, trousers, sleep wear; headgear, including caps, hats; footwear, including casual shoes; belts*” in Class 025;

“Lace and embroidery, ribbons, and braid; buttons, hooks and eyes, *pins*, and needles; *sewing kit*; artificial flowers” in Class 026;

“Carpets, rugs, *mats and matting*, linoleum, and other floor coverings, in particular for vehicles; door mats; *wall hanging (non-textile)*” in Class 027;

“*Games, playthings and toys, including models, scale model vehicles, plush animals, games equipment, balloons, and beach balls; decoration for Christmas trees; gymnastic and sporting articles, including clubs, gloves, bags and balls for golf, sports racquets, and fishing tackle; golf bags*” in Class 028;

“*Retail services and wholesale, namely, in respect of vehicles, engines/motors and machines (including drive units and construction machines), as well as of parts, fittings and accessories for the aforesaid goods, and of tools and workshop equipment, and of merchandise products; advertising, organisation of promotional programs, office functions, business administration (including bookkeeping), business management and business management advisory services, in particular relating to the design, development, manufacture, sale, distribution, repair or maintenance of vehicles, engines/motors and machines (including drive units and construction machines), and of parts, fittings and accessories for the aforesaid; consultancy in the field of vehicle fleet management*” in Class 035;

“*Real estate affairs; monetary and financial affairs, including credit card services; insurance, warranty, financing (including hire purchase and lease purchase financing services and leasing), in particular relating to vehicles, engines/motors and machines (including drive units and construction, transport, agricultural and forestry machines), to parts, fittings and accessories for the aforesaid, and to tools and workshop equipment*” in Class 036;

“Building construction; installation services related to vehicles, motors and machines (including drives and contract machines); installation, service, repair, inspection, restoration, maintenance, reconditioning, diagnostic tuning, cleaning, painting, polishing and preservation services in relation to vehicles, engines/motors and machines (including drive units and construction, agricultural and forestry machines), power hand tools, workshop appliances and devices, or parts, fittings and accessories (including telecommunication equipment) for the aforesaid; emergency road side vehicle repair assistance; *rental of tools and workshop equipment; looking after and overhauling of motor vehicles in motor-sport events; reservation of garage services for the maintenance and repair of motor vehicles; technical assistance related to motor vehicles during motorsports events*” in Class 037;

“Internet, telecommunication and satellite communication services, in particular telephone services relating to vehicle radio telephones, paging services, logistic services, telematic services, collection and supply of information as well as provision of a service-hotline (in particular with respect to traffic and technical information, and with respect to sports and entertainment); telematic assistance using GPS and GSM/3G technology via a service and alarm center for transport and traffic, in particular checking (supervision), positioning and (remote) control/automatic control of land vehicles, air vehicles, watercraft and locomotion systems, the load thereof as well as of engines/motors and machines (including drive units and transport machines) as well as intervention and help for persons and vehicles in the case of accident, breakdown, raid or theft; unidirectional or bi-directional transmission of text, voice and alarm messages and of signal, measuring, sound, image, video, position, movement, state and working hour data between land vehicles, air vehicles, watercraft and locomotion systems, the load/cargo thereof as well as between engines/motors and machines (including drive units and construction machines) and a wide variety of service points (also in the Internet), for emergency services, breakdown services and traffic information as well as for the remote checking (supervision) and remote control/remote automatic control of land vehicles, air vehicles, watercraft and locomotion systems, the load/cargo thereof as well as between engines/motors and machines (including drive units and construction machines); communication via the Internet, communications by computer terminals, computer aided transmission of messages and images; providing telecommunication channels for teleshopping services and chatrooms” in Class 038;

“Transport, also of persons; salvaging, transportation, warehousing and other rescue services and operations in an emergency and provision of this; packaging, warehousing and distribution of goods; rental of vehicles, engines/motors and machines (including drive units and construction and transport machines); consultation in the field of traffic and transport, including mobile telematics applications; logistic services; traffic information and control services; route guidance services; travel arrangement and tourist information services” in Class 039;

“Treatment of materials, namely, engraving, surface treatment and finishing, in particular of metals, plastics, textiles, glass, wood, leather, rubber and of ceramics, in particular for use for vehicles, engines/motors and machines (including drive units and construction machines), and for parts, fittings and accessories thereof; recycling, incineration and destruction, in particular of vehicles, engines/motors and machines (including drive units and construction machines), and of parts and accessories thereof; sorting of waste and recyclable material, in particular from vehicles, engines/motors and machines (including drive units and construction machines), and from parts and accessories thereof” in Class 040;

“Education and training services; organisation of exhibitions for educational purposes; entertainment; arrangement of prize competitions; conduct of sporting and cultural activities and events services in connection with the organisation, and conduct of sports, recreational and entertainment competitions and functions; sport camp services; camp services for sport activities; museum services; rental of sports equipment (except vehicles)” in Class 041;

“Scientific and technological services and research and design relating thereto; technical consultation and preparation of expert opinions; engineering services; services in connection with research development and testing of new products; programming of data processing software, computer programming, installation, maintenance and care of computer programs, in particular in the field of technical engineering, logistics and traffic and transport telematic; information technology services; design and development of computer hardware and software, IT services via data processing centers, service and alarm centers for transport and traffic, in particular the detection, checking (supervision), evaluation and processing of

alarm messages, and signal, measuring, sound, image, video, position, movement, state and working hour data and (remote) control/automatic control of land vehicles, air vehicles and aircraft, locomotion systems, the load/cargo thereof as well as between engines/motors and machines (including drive units and construction machines); technical consultation in the field of recycling; technical consultation in the field of environmental protection; scientific research, also relating to the ocean; meteorological research; industrial analysis and research” in Class 042.

Unfortunately, as discussed below, the italicized wording above is insufficiently definite for registration purposes. See TMEP §1402.01.

Use of broad terms: In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a). If applicant uses indefinite words such as “accessories,” “apparatus,” “components,” “devices,” “equipment,” “materials,” “parts,” “systems,” or “products,” such words must be followed by “namely,” followed by a list of the specific goods identified by their common commercial or generic names. See TMEP §§1401.05(d), 1402.03(a).

Use of “including” and similar terms: Where italicized above, the identification is indefinite and must be clarified because it contains the open-ended wording “including.” See TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with “namely.”

Use of parentheses: The identification contains parentheses (see underlined areas above). Generally, parentheses and brackets should *not* be used in identifications. TMEP §1402.12. The USPTO generally uses brackets to indicate goods and/or services that have been deleted from registrations. See *id.* 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 identification.

Class 001

Chemicals used in industry, in particular for use in the operation, repair, servicing and maintenance of vehicles, engines/motors and machines (including drive units and construction machines), including brake fluids, fluids for hydraulic systems, antifreeze compositions, *defrosting compositions*, rubber and plastic cements, plastics, adhesives, compositions for repairing surfaces, sealing compositions, saturants, water-repellent and spot-repellent agents (*finishers*), impregnation agents; coolants for vehicle engines, coolants (anti-boil preparations for engine); chemicals used in science and photography, agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fertilizers; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; *tanning substances*; *putties*; adhesives used in industry; hydraulic oils

The particular type of defrosting compositions must be specified, e.g., defrosting compositions being chemicals used in industry.

The purpose of the rubber and plastic cement must be specified, e.g., Rubber and plastic cement for repairing pneumatic tyres, rubber and plastic cement being adhesives for use in industry, etc

The particular type of plastics, adhesives, surface repair compositions, sealing compositions, saturants, water-repellent and spot-repellent agents, and impregnation agents must be specified, e.g., plastics in unprocessed form, industrial adhesives, Industrial adhesives for use in coating and sealing, stain repellents, chemical agents for impregnating, binding or coating of textiles, furs and leather, non-wovens and fabrics etc.

The type of tanning substances must be specified, e.g., tanning agents for use in the manufacture of leather, enzymes for use in the tanning of leather, etc.

The particular type of putty must be specified, e.g., putty being oil cement, molding compound in the nature of a synthetic putty for use in the manufacture of printing inks in the printing industry, etc.

Class 002

Paints, varnishes, *diluents* for colorants and lacquers, also in spray or pen form; *preservatives against rust*, *anti-corrosive agents*; *coating compositions and preservatives for metal (painting)*, *metal and lacquer conservation agents*; preservatives against deterioration of wood; colorants, *dyes*; *mordants*, including *metal mordants*; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; anti-rust oils

The common commercial name of the diluents must be specified, e.g., textured additives for colorants and lacquers.

The type or form of the anti-rust preservatives and anti-corrosive agents must be specified, e.g., anti-rust greases, rust preventatives in the nature of a coating, anti-corrosive coatings etc.

The common commercial name of the “coating compositions and preservatives for metal (painting), metal and lacquer conservation agents” must be specified, e.g., anti-tarnishing preparations for coating metals.

The type of dyes must be specified, e.g., oil soluble dyes, natural dyes, mordant dyes, etc.

The type of mordants must be identified, etc., mordant dyes, mordants for use in the painting industry, etc.

Class 003

Bleaching preparations *and other substances for laundry use*; cleaning, *care*, preservation, polishing, scouring and abrasive agents, in particular such for vehicles, engines/motors and machines (including drive units and construction machines), including detergents, windscreen/windshield washer fluids, *wax compositions*, cleaning sprays, auto shampoos, *spray preservatives*, interior cleaning agents, *motor cleaning agents*, *light metal or metal alloy wheel rim care agents*; soaps; perfumery, essential oils, cosmetics, hair lotions, including *perfume atomisers*, toilet waters, *non-medicated toilet preparations*, *powder boxes*, shaving and after-shave preparations, oils, creams and lotions for the skin; dentifrices

The particular type of laundry substances must be specified, e.g., laundry bleach.

The wording “care” must be amended to clarify the function of the agents or by specifying the particular type of care agent by its common commercial name, e.g., bleaching preparations for household use.

The type of wax compositions, spray preservatives, motor cleaning agents, and rim care agents must be specified, e.g., Automobile wax, Preparations for preserving vehicle surfaces including the surface areas of motors to keep them looking clean, Rust removing preparations for vehicle rims, etc.

The perfume atomizers must be identified as being “sold filled with perfume.”

The type of non-medicated toilet preparations must be specified, e.g., cosmetics.

The type of powder boxes must be specified, e.g., powder boxes being cosmetic compacts.

Class 004

Industrial oils and greases, including penetrating oils (also being lubricants) and lubricants, including lock lubricants; lubricating oils; dust absorbing, wetting and binding agents; fuels (including motor spirit); solid, liquid and gaseous fuels; *illuminants*; candles, *wicks*

The type of illuminants and micks must be specified, e.g., illuminants being candles, candle wicks, etc.

Class 005

*Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; materials for dressings; first-aid kits (filled); material for stopping teeth, dental wax; *desinfectants*; preparations for destroying vermin; fungicides, herbicides*

The condition or disease treated by the preparations must be specified, e.g., pharmaceutical preparations for the treatment of warts.

The particular type of dietetic substances must be specified, e.g., Dietetic foods, namely, {indicate types of food, e.g., pasta, crackers, etc.} adapted for medical use.

The particular type of dressing materials must be specified, e.g., medical dressings.

The type of disinfectants must be specified, e.g., all-purpose disinfectants.

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Class 006

Common metals and their alloys; *metal building materials*; transportable buildings of metal; materials of metal for railway tracks; non-electrical wires, cables and cable terminals, and speedometer cables of common metal; *ironmongery, small items of metal hardware and goods of common metal (included in this class), including* locks, latches, metallic tubes, *metallic hoses, metallic valves for pipes*, pipes, pipe connections, screws, bolts, nuts, rivets, lock washers, spring washers, flat washers, chains (except drive chains for vehicles), plugs, split pins, shims, spacer rings, and *clips, woodruff keys, screw unions*, spring bolts, *shackles, ball joints*, hinges, *brackets, tanks for liquids, tank accessories*, nipples, fuel cans, ladders, *handles, metallic signs, wire baskets, metal wires, badges for vehicles, fasteners*, tow ropes of metal, *canisters, badges, keys*, key blanks, *key ring pendants and pins*, vehicle registration plates, *non-luminous signs*, boxes, *luggage labels of metal, ornaments*, safes, ores; *blinds of metal*

The particular type of metal building materials must be specified, e.g., metal building materials in the nature of screws.

The particular type of metal railway materials must be specified, e.g., metal railroad ties.

The wording “ironmongery, small items of metal hardware and goods of common metal” must be amended to specify the particular common commercial name of each good, e.g., ironmongery being iron strips and iron gates, small metal hardware being screws, etc. Please see paragraph above regarding use of “including.”

The type of metallic hoses must be specified, e.g., industrial metal hoses.

“Metallic valves for pipes” must be amended to clarify that the valves/pipes are not parts of machines, e.g., metallic valves for pipes not being parts of machines.

The purpose or type of metal clips, woodruff keys, screw unions, shackles, brackets, liquid tanks, tank accessories, handles, metallic signs, wire baskets, metal wire, badges for vehicles, fasteners, canisters, badges, keys, key ring pendants, and pins must be specified, e.g., metal cable clips, metal clips for general use, metal woodruff keys being parts of metal screws and bolts, screw unions being connectors and parts of metal screws, metal shackles for lifting and rigging, metal hardware brackets for general use, metal liquid storage tanks, metal tank accessories being metal screws and bolts, ratchet handles, door handles of metal, road signs of metal, non-luminous and non-mechanical metal signs, wire baskets being hardware baskets of common metal, not electric wire of common metal, metal cable wire, metal badges for vehicles being metal license plates, fasteners of metal being metal bars and chains, canisters being metal cans, metal name badges, metal keys for locks, key ring pendants being key rings of common metal that may be worn around the neck, metal pins being cotter pins.

The particular Class 006 type and purpose of the ball joints must be specified, e.g., ball joints being ball bearings as metal components for metal protective and security window shutters, ball joints being hinges of metal not for use with machines or vehicles.

The non-luminous signs must also be identified as being non-mechanical.

The particular type of ornaments and their particular material composition must be specified, e.g., holiday ornaments of common metal, bronze holiday ornaments.

The type of metal blinds must be specified, e.g., metal *exterior* blinds.

Motors and engines (except for land vehicles), including marine engines, aircraft engines, engines for industrial, agricultural and forestry machines, stationary combustion engines, turbines, *electric motors*; electric generators and alternators; *high-frequency generators*; air cleaners (*air filters*) for engines and anti-pollution devices for motors and engines; carburetors, converters for liquid fuels, injectors, injection pumps, fuel pumps, speed governors, injection nozzles and nozzle holders, machine valves, vaporizers, starters, ignition systems, ignition coils, glow plugs, spark plugs, spark plug connectors, lambda probes, magnetos, silencers/mufflers and spark arresters for combustion engines; fuel filters, oil filters, air filters; rolling bearings, plain bearings, shafts, shaft seals, gearwheels, drive wheels, speed change gear, pulleys, drive chains and belts, springs, filters, pumps, regulators, relief valves, controls, fans and fan belts, all for engine cooling radiators; cooling fans, cooling radiators, starters, fuel feed apparatus, oil cooling apparatus, brakes, caps for cooling radiators, accelerators, hydraulic pumps, hydraulic cylinders, hydraulic reservoirs, hydraulic filters, hydraulic motors, hydraulic pipes, hydraulic valves, boost units for hydraulic transmission, all for machines, engines and motors; machine coupling and transmission components (*except for land vehicles*), including power transmissions, gearboxes/transmissions, reverse gears, reduction gears, gearbox controllers, traction control systems, vehicle dynamics control systems, shaft connections, couplings and clutches, exhausts, couplings and transmission belts; *power transmission take-off units for motor vehicle engines, for use as prime movers*; inboard/outboard drive units and sailing boat drive units for inboard engines; hydraulic pumps and motors and components thereof, *air pumps as vehicle accessories*; *bushes and bearings (machine parts)*; *power steering systems, control valves (machine parts), braking valves (machine parts)*; exhaust-gas turbo-chargers; *compressors, compressed air brakes, compressed air reservoirs, compressed air cylinders and compressed air motors*; bilge pumps; metal and plastics working machines; *machines for the chemical industry, for agriculture, mining, textile machines, machines for the beverage industry*; incubators for eggs; *agricultural implements (not hand operated)*; construction machines; *electronic control devices for production technology and servo drives*; *machines for the automobile industry*; *machine tools and tools therefore*; *electric power tools and their plug-in tools*; electric can openers; hydraulic lift jacks, *body and frame aligners*; packing and labelling machines, conveyors, conveyor belts; loading and handling machines for pressing plants and foundries and machines for the tooling of blanks; *loaders, dumper bodies, excavators as well as parts, including components, and accessories to such products*; *hydraulic lifting apparatus, cranes, winches*; bucket, *grapple and fork type implements for machines*; wood working machines, including delimbing, slashing and debarking equipment; teeth and cutting edges for machines; car vacuum cleaners; *car wash facility*; *parts, fittings and accessories for the abovementioned goods and for motor land vehicles*; *bushings*; automatic vending machines; *cooling radiators, radiators, radiator caps, exhausts, compressed air motors, fans, fan belts, bearings*

The wording “Motors and engines (except for land vehicles)” must be amended to incorporate the parenthetical information into the identification.

The electric motors must be identified as being not for land vehicles.

The particular type of high-frequency generators must be specified, e.g., high frequency generators being electric generators.

The type of converters for liquid fuels must be specified, e.g., catalytic convertors for liquid fuels.

The wording “power transmission take-off units for motor vehicle engines, for use as prime movers” must be amended to specify that the motor vehicles are not land vehicles, e.g., power transmission take-off units for motor vehicle engines, for use as prime movers, not for use in connection with land vehicles.

The type of air pump must be further specified, e.g., compressed air pumps as vehicle accessories not being for use with vehicles.

The types of bushings and bearings must be identified, e.g., bushings and bearings for engines and machines.

The particular type of Class 007 power steering system and valves must be identified and applicant must indicate that they are used in connection with, e.g., power steering systems in the nature of pneumatic controls and machine valves for machines that aid in guiding the machine in the right direction.

The particular type of compressors, compressed air brakes, compressed air reservoirs, compressed air cylinders and compressed air motors must be specified as well as what they are used in connection with, e.g., compressors, compressed air brakes, compressed air reservoirs, compressed air cylinders and compressed air motors all being compressors as parts of machines, motors and engines.

The function of the various industry machines must be specified, e.g., bottling machines for the beverage industry.

The type of agricultural implements and construction machines must be identified, e.g., agricultural implements being agricultural seeding machines and reapers, construction machines being concrete construction machines.

The particular type of controls must be specified, e.g., electronic control devices for production technology and servo drives being AC variable frequency drives that are used to control small and medium-sized motors in applications such as manufacturing processes, HVAC and pumps.

The type of machine tools and power tools must be specified, e.g., machine and power tools being gear cutters.

The type of body and frame aligners must be specified, e.g., body and frame aligners being Vehicle body and frame alignment machines and structural replacement parts therefor

“Loaders, dumper bodies, excavators as well as parts, including components, and accessories to such products” must be amended to specify the common commercial name of the goods as well as the name of each part or accessory, e.g., Lifting and dumping machines for {indicate what is being lifted and dumped, e.g., containers, trash dumpsters, etc.} and replacement parts therefor, earth moving machines, namely, excavators and replacement parts therefor.

The type of hydraulic lifting apparatus must be specified, e.g., hydraulic lift tables.

“Grapple and fork type implements for machines” must be amended to clarify the purpose or type of machine they are used with, e.g., attachments for earth moving machines, namely, {indicate specific attachment, e.g., grapple buckets, etc.}, Tractor-towed agricultural instruments, namely, grapples, etc.

The particular car wash facilities must be specified, e.g., car washing installations.

The parts, fittings and accessories must be identified by their common commercial names (“replacement parts and replacement fittings” is acceptable).

The wording “cooling radiators, radiators, radiator caps” must be amended to clarify that the goods are or are used with radiators for vehicles, motors or engines, e.g., cooling radiators for vehicles motors and engines, radiator caps being replacement parts of radiators for vehicles, motors and engines.

The type of exhausts must be specified, e.g., exhausts for motors and engines.

The compressed air motors must be identified as being not for land vehicles.

The type of fans, fan belts, bearings must be specified, e.g., fans, fan belts and bearings for motors and engines.

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Class 008

Hand tools and implements (hand operated), including manually handled lifting jacks, hand tools sets, rim crosses, ice scrapers, non-electric can openers; hand operated implements for use in agriculture, horticulture and forestry, for the construction, maintenance and repair of apparatus, vehicles, engines/motors and machines (including drive units and construction machines), and for the building industry; parts of all aforementioned goods; cutlery, including knives, pocket knives; side arms; scissors, manicure sets and manicure tools; razors and travel razors; clamps

The particular hand tools and implements must be identified by their common commercial names. See note above regarding use of “including.”

The type of hand tool sets must be specified (e.g., hand tools, namely socket sets) or the particular items comprising the set should be specified and applicant should indicate that they are sold as a unit (e.g., hand tool sets comprised of screwdrivers, ratchet wrenches and hammers sold as a unit).

The wording “rim crosses” should be amended to specify the common commercial name, e.g., rim crosses being wrenches for use in loosening bolts and nuts.

The particular parts must be identified (see paragraph on broad terms above). However, if these goods are replacement parts, applicant so state.

The types of cutlery must be specified, e.g., cutlery being forks, spoons and knives.

“Side arms” must be amended to specify the particular goods and that they don’t include firearms, e.g., side arms, not including firearms, namely hunting knives.

The type of manicure tools must be indicated, e.g., manicure tools being nail buffers, nail files, nail clippers, cuticle pushers, tweezers, nail and cuticle scissors.

The type of clamps must be satisfied, e.g., clamps being hand tools.

Class 009

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; programmable controllers electric and electronic apparatus and instruments, including electric batteries, charging devices, battery testers, electric mountings, electric blowers; electric accumulators, electric compasses, electric circuit breakers, commutators, electric condensers, electric wiring harnesses, capacitors, relays, electronic time relays, switches, fuses, electrical contacts, electric cables, electric fuses; electric fuse boxes, electrical sensors, electrical sockets, printed electrical circuits, integrated circuits; leads for electric, electronic and optical signals; cable connections, cable drums; transformers; electronic headlamp beam adjustment; sensors, detectors, switching devices/switch boxes, solar cells and solar generators; analysers for motor vehicles, namely, for exhaust gas analysis, soot particle analysis, brake function analysis, diagnostic instruments and equipment for simulations, engine testers, workshop test devices; high-frequency generators, power supply devices, electric filters, semiconductor components, optoelectronic components; testing apparatus; apparatus for recording, transmission or reproduction of data, sound or images and data processing equipment and computers, including radio apparatus, video screens, tape players, loudspeakers, amplifiers, telecommunication equipment, car telephone installations, compact disc players, telematic terminals, distress signal terminals, navigation and radar terminals, traffic control systems, transport supervision system, locating devices, toll terminals for electronic toll detection in traffic, black box (accident data monitoring and recording device), auto-computers and on-board computers, calculators and pocket calculators; magnetic data carriers; computer software; computer hardware; video games software; recorded and non-recorded data carriers and recording media of all kinds, including compact discs, tape cassettes; storage boxes for recording media; data processing equipment; highway emergency warning equipment; interference suppressors, aerials/antennas; gauges, measuring instruments and apparatus, including such for fuel, oil pressure, tyre pressure, compressed air, temperatures, amperage, speed and engine revolutions; mileage recorders, odometers, tachometers; voltage regulators, voltmeters; time recorders, rudder indicators, instrument panels and clusters, dipsticks, thermostats, signal lamps; dynamometers, brake testers, electrical and mechanical instruments and apparatus for control and testing for vehicles, engines/motors and machines (including drive units and construction machines); automatic alarm units, anti-theft warning devices, electronic anti-theft devices, including vehicle immobilizing units; electronic parking assistance systems; warning reflectors; fire extinguishing apparatus; electronic monitors and regulators for engines and motors; magnets; tape measures; thermometers; compasses; optical apparatus and instruments, including binoculars, magnifying glasses, spectacles, sun glasses and goggles, lenses for lamps sun-proof optical lenses; sun glasses and goggles, ophthalmic frames; warning triangles; clothing for protection against accidents, including footwear, special clothing as lifesaving equipment, workmen's protective face-shields, protective eye pieces and masks; registers; level controllers electrical apparatus, warning triangles, jumper cables, starter cables, safety nets

In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a). If applicant uses indefinite words such as “accessories,” “apparatus,” “components,” “devices,” “equipment,” “materials,” “parts,” “systems,” or “products,” such words must be followed by “namely,” followed by a list of the specific goods identified by their common commercial or generic names. See TMEP §§1401.05(d), 1402.03(a).

The type of electric mountings and blowers must be specified, e.g., electric mountings being mounting racks for computer hardware, electric blowers being internal cooling fans for computers.

The type of relays and switches must be specified, e.g., electric relays, electrical switches.

“Cable drums” must be amended to specify the common commercial name, e.g., cable drums being reels for electric cables.

“Electronic headlamp beam adjustment” must be amended to specify the common commercial name for the goods, e.g., electronic headlamp beam adjustment, namely electronic reflective mirrors to prevent accidents.

The type of sensors, detectors, switching devices and switch boxes must be specified, e.g., sensors for determining position, radar detectors, switching devices being electronic switches, switch boxes being electronic switches.

The wording “solar generators” must be amended to specify the particular Class 009 goods, e.g., Silicon solar cell material for electricity generation incorporated into pavement materials.

The diagnostic instruments and equipment for simulations must be identified by their common commercial names, e.g., Simulators for driving or control of vehicles

The common commercial name of the frequency generators must be specified, e.g., Radio frequency generators for supplying radio-frequency energy.

The type of electric filters, semiconductor components and optoelectronic components must be specified, e.g., electronic components in the nature of filters, semiconductors and optoelectric conductors.

The type of testing apparatus must be specified, e.g., Apparatus for testing gas, liquids and solids.

The type of radio apparatus, telecommunication equipment, and car telephone installations must be specified, e.g., radios, telephones, car phones, In-car telephone handset cradles.

The common commercial name of the terminals must be specified, e.g., computer terminals, telephone terminals.

The primary components of the control and supervision systems must be specified, e.g., traffic control systems primarily composed of computers, video cameras and telephones for controlling traffic, transport supervision systems primarily composed of computers, video cameras and telephones for supervising transport.

The type of locating devices must be specified, e.g., GPS navigation systems.

The toll terminals for electronic toll detection in traffic must be identified by the common commercial name, e.g., systems for collecting tolls and detecting traffic comprised of computer and video cameras.

The common commercial name of the black boxes must be specified, e.g., computer recording devices for vehicles and aircraft composed of computers, cameras and audio recorders.

The type and subject matter of the data carriers must be specified, e.g., compact discs and DVDs sold blank.

The function and field, if field specific, of the software must be specified.

The type of storage boxes for recording media must be specified, e.g., cd cases.

The type of interference suppressors must be specified, e.g., Filters for radio interference suppression.

The type of gauges, measuring instruments and apparatus must be specified, e.g., gauges and sensors for measuring fuel, oil pressure, tyre pressure, compressed air, temperatures, amperage, speed and engine revolutions.

The type of time recorders must be specified, e.g., watchman's time recorders, namely, a device for recording the activities of security guards to insure that the security guard arrives at scheduled checkpoints.

The common commercial name of the rudder indicators must be specified, e.g., electrical sensors for rudders.

The wording “instrument panels and clusters” must be amended to specify the common commercial name for the goods, e.g., electronic indicator panels.

The type of Class 009 dipsticks must be specified, e.g., dipsticks, namely battery testers for electronic equipment.

The type of signal lamps must be specified, e.g., Vehicle breakdown warning lamps.

The type of brake testers must be specified, e.g., brake fluid testers.

The wording “electrical and mechanical instruments and apparatus for control and testing for vehicles, engines/motors and machines (including drive units and construction machines); automatic alarm units, anti-theft warning devices, electronic anti-theft devices, including vehicle immobilizing units; electronic parking assistance systems” must be amended in accordance with the “use of broad terms” guidelines above. Additionally, the word “system” in the identification of goods is indefinite and must be amended to (1) list the primary parts or components of the system and (2) describe the nature, purpose, or use of the system. TMEP §1401.05(d). Applicant should use common generic terms to specify the parts or components of the system. See TMEP §§1402.01, 1402.03(a). Applicant should also classify the system in the same international class as its primary parts or components. TMEP §1401.05(d).

The type of warning reflectors must be specified, e.g., reflectors for traffic signals.

The type of electronic monitors and regulators for engines and motors must be specified, e.g., computers.

The type of thermometers must be specified, infrared thermometers not for medical purposes.

The wording “optical apparatus and instruments, including” must be amended to specify the particular goods, e.g., optical discs sold blank.

The wording “lenses for lamps” must be amended to clarify the particular goods provided, e.g., lenses for optical lamps.

The type of registers must be specified, e.g., cash registers.

The type of level controllers, electrical apparatus and starter cables must be specified, e.g., level switches for controlling liquids in tanks and vessels, electrical apparatus being computers, battery starter cables.

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Class 011

Lighting apparatus and installations (also for vehicles), including headlights/headlamps, lamp assemblies, lanterns, bulbs, lamp fittings, flashlights, electrical torches, reading lights; anti-dazzle devices for vehicles, motors and machines, reflectors for lightning devices; installations and apparatus for air filtering and air conditioning, ventilation, refrigerating or heating, including electric and non-electric radiators, ventilators, fans, metallic valves for pipes, parts for the aforementioned goods; compressed air ventilators, apparatus for steam generating, cooking, drying, water supply and sanitary purposes; parts and fittings for vehicles, engines/motors and machines (including drive units and construction machines)

The particular type of apparatus and installation must be identified by the common commercial name, e.g., lighting apparatus being automotive headlamps and lamps.

The type of headlights and headlamps must be specified, e.g., automotive headlamps and automobile headlights.

The particular type or kind of lamp assemblies must be specified, e.g., lamp assemblies being LED light assemblies for street lights, signs, commercial lighting, automobiles, buildings, and other architectural uses.

The purpose or type of lantern and electric torch must be specified, e.g., lanterns for lighting, electric lanterns, electric torches for lighting. etc.

The type of lamp fittings must be specified, e.g., lamp fittings for incandescent lamps, replacement fittings for lamps.

The common commercial name of the anti-dazzle devices must be specified, e.g., vehicle headlights comprised of LED light bulbs.

The common commercial name of the “reflectors for lightning devices” must be specified, e.g., vehicle reflectors reflecting lights.

The particular type of apparatus and installation must be identified by the common commercial name, e.g., air heating apparatus being radiators.

The purpose of the ventilators and fans must be specified, e.g., ventilators for air conditioners, electric fans.

The purpose of the valves must be identified, e.g., metal valves for air conditioners and radiators.

The particular parts must be identified by their common commercial names; however “replacement parts” is acceptable.

The purpose of the compressed air ventilators must be identified, e.g., compressed air ventilators for use in air conditioners and radiators.

The particular apparatus must be identified by the common commercial names, e.g., steam apparatus being steam generators, cooking apparatus being gas stoves, drying apparatus being clothes dryers, water supply apparatus being tankless water heaters, sanitary apparatus being toilets.

The wording “parts and fittings for vehicles, engines/motors and machines (including drive units and construction machines)” must be amended to specify the particular Class 011 goods, e.g., parts for vehicles being vehicle headlights.

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Class 012

Vehicles, including cars, vans, sport-utility vehicles (including golf carts), buses, trucks, tractor units/prime movers, on and off road vehicles/dump trucks and parts, including components, and accessories to these items which do not pertain to other classes, including vehicle chassis, vehicle bodies, braking installations, brake calipers, draw bars, bumper bars, clutches, engines, electric engines, motors, electric motors, turbines, combustion engines, starting devices for internal combustion engines, hydraulic cylinders and motors, silencers/mufflers, spark eliminators, power transmissions, gearboxes/transmissions, transmission shafts, differential gears, drive gears, drive shafts, gear change selectors, exhaust cowl, axles, shafts and couplings, machine coupling and transmission components, manual and power steering apparatus, power steering systems, hydraulic steering systems, as well as component parts of these items, compressed air reservoirs, compressed air cylinders and anti-pollution devices, air pumps, anti-dazzle devices, anti-theft devices and alarms, vehicle immobilizing units, trailer hitches, power take-offs, springs, shock absorbers, wheels, wheel bearings, wheel trims, balance weights for wheels, engine mountings, tanks and fuel tanks, engine noise shields, protective covers, radiators grilles, front grills, fluid reservoirs, deflectors, direction indicators, hatches, upholstery, handles for doors, hoods, horns, hubs, hub caps, hydraulic circuits, tyres, non-skid devices for tyres, mud flaps, brakes, servo brakes and compressed-air brakes, antilock brake systems, brake pads and brake linings, bumpers, mudguards/fenders, cabs, cab tilt mechanisms, reversing alarms, mechanical controls, head rests for seats, arm rests, doors, seats, safety-seats, personal safety restraints seats, safety seats for children, tables for seats, seat covers, headrest covers, seat belts, devices for collision protection, parking assistance systems, sliding roofs, sun roofs, vehicle steering columns, steering wheels, steering linkages, stabiliser bars, suspensions, suspension lowering outfits, torsion bars, tow bars, windows, window winding mechanisms, power windows, windscreens/windshields (also of safety glass), windscreen/windshield and headlight wipers, defrosting systems for windscreens, wiper blades, vehicle window blinds, driving mirrors, mirrors (retrovisors), tank caps, cover caps for extra headlights, warning lamps, luggage restraints for vehicles, luggage nets, luggage carriers, wheel carriers, bicycle carriers, surfboard carriers, boat carriers, mud-guards, snow chains, pet screens, stone screens, storage screens, roof racks and ski racks, stowage boxes, deposit boxes, stowage compartments, trim panels, spoilers,

side and rear skirts, safety cushions, air bags, breakdown cases, holders for mirrors, sun shades, mobile telephone mounting equipment; restraining systems for installation in motor vehicles, namely, belt tensioners, airbags and sensors; tires, pneumatic tires; adhesive rubber patches for repairing inner tubes; baby carriages, wheeled chairs for invalids; bicycles; rudders, propellers, trimming vanes, steerage units, steering wheels and fittings for boats as well as component parts of these items; vehicles for locomotion by land, air or water; electrical lighters for automobiles; starter motors for land vehicles

The wording “vehicles, including” must be amended to specify the particular type of vehicles, e.g., vehicles, namely motorcycles and automobiles. Please see paragraph above about use of the term “including.”

The particular type of golf carts, tractor units/prime movers, and on road vehicleless must be specified, e.g., motorized golf carts, tractor units being tractors, prime movers being tractors, on road vehicles being cars.

The particular “parts” must be identified by their common commercial names; however “replacement parts” and “structural parts therefor” are acceptable listings of parts when used in connection with vehicles. Additionally, the goods following the wording “*including components, and accessories to these items which do not pertain to other classes, including*” are indefinite because applicant has not clearly specified what these goods are used in connection with. Applicant must either clearly identify the common commercial name of each item or may conclude this section of goods listing with the wording “all of the foregoing being structural and replacement parts of land vehicles.”

The wording “sensors” must be amended to specify that the goods are sold as part of the restraining systems, e.g., restraining systems for installation in motor vehicles, comprised primarily of belt tensioners, airbags and also containing airbag and belt detection sensors sold as a component of the system.

The particular fittings and component parts of the boats must be specified, e.g., rudders, propellers, trimming vanes, steerage units, and steering wheels for boats as well as replacement and structural component parts for boats and replacement parts for rudders, propellers, trimming vanes, steerage units, and steering wheels for boats.

Class 014

- Precious metals and their alloys *and goods made from these materials*, and jewellery and precious stones, including cuff-links, tie clips, *coins*, medals, lapel pins, rings, model figures (ornaments) coated with precious metal *and other decorative goods*; horological and chronometric instruments, including clocks and watches, travel alarm clocks; *key fobs*, key rings of common metal

The wording “goods” must be amended to identify the common commercial name, e.g., earrings.

The coins must be amended to clarify that they are for non-monetary purposes, e.g., non-monetary coins, collectible coins, monetary coin sets for collecting purposes, etc.

The type and material composition of the “other goods” must be specified, e.g., ornaments of precious metal.

The material composition of the key fobs must be specified, e.g., *key fobs and key rings both being* of common metal

Class 016

Paper, cardboard and *goods made from these materials, including paper cubes and notes; printed matter, including books, instruction books, (computer/computer software) manuals, periodicals, magazines, newspapers, calendars, posters, stickers, banners and permants of paper, country and road maps, spare parts lists, maintenance manuals, advertising materials, printed publications relating to automotive subjects; bookbinding material; adhesives for stationery or household purposes; artists' materials, paint brushes; photographs; stationery, including pens and pencils; typewriters and office requisites (except furniture), including pen stands, letter holders, storage boxes for recording media and paper knives; instructional and teaching material (except apparatus); plastic materials for packaging, including plastic carrier bags; printers' type; printing blocks; money clips*

The particular “goods” must be identified.

The common commercial name of the paper cubes must be specified, e.g., note pads of paper in the shape of a cube.

The type of notes must be specified, e.g., note paper, not cards featuring calligraphy, etc.

The particular types of printed matter, (and the subject matter of any publication or periodical or the like) must be specified. See note above about use of “including.”

The subject matter of the books, instruction books, manuals, periodicals, magazines, newspapers and maintenance manuals must be specified.

“Spare parts lists” must be amended to specify that they are in the nature of printed products, e.g., printed products, namely lists featuring spare parts.

The type of advertising materials must be specified, e.g., posters.

The type of printed publication must be identified, e.g., books in the field of automotive subjects.

The type of artists materials must be specified, e.g., pencils.

The type of office requisites must be identified, e.g., pens and pencils.

The material composition of the storage boxes must be specified, e.g., paper storage containers for recording media and paper knives.

The type of instructional and teaching materials must be specified or applicant may specify their subject matter and that they are printed and, e.g., Printed instructional, educational, and teaching materials in the field of {specify area of use}.

The type of plastic packaging materials must be specified, e.g., plastic bags and films for packaging.

The wording “including plastic carrier bags” must be amended to specify the particular Class 016 goods by their common commercial names, e.g., plastic carrier packaging bags being plastic bags for packaging.

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Class 017

Rubber, gutta-percha, gum, asbestos, mica and goods made of these materials; plastics in extruded form for use in manufacture; rubber supports for motors/engines, reflex tape, felt rings, sealing compound, non-metallic tubes, pipe connection parts for radiator systems, radiator sealing compounds, fasteners and connectors, all made of plastic materials, for pipes and cables; flexible covers made of rubber or of plastic materials for protecting mechanical components; mountings made of rubber or of plastics materials for engines, transmission assemblies and for exhausts; plastic materials in the form of sheets (non-textiles) for use in the manufacture of roof coverings for vehicles; clutch linings; gaskets (other than fibrous gaskets for ships); washers (other than washers for water taps) made of rubber, plastics materials or of vulcanised fibre; grommets made of rubber or of plastics material; non-metallic hoses; strips made of rubber or of plastics materials for sealing joints; packing and stopping materials, including oil seals (packing), sealing, locking and caulking compounds and fluids (in the nature of jointings or packings); stuffings for engines/motors and machines; insulating materials; flexible pipes (not of metal); parts and fittings for vehicles, engines/motors and machines (including drive units and construction machines)

The form of the rubber and gum must be identified, e.g., raw rubber, raw gum.

The type or purpose of the reflex tape must be specified, e.g., reflex tape being masking and insulating tape.

The type of felt must be specified, e.g., asbestos felt rings.

The type of sealing compound must be specified, e.g., Polymer-based patching and sealing compounds for masonry and wood.

The material composition of the tubes must be specified, e.g., rubber tubes.

The type and material composition of the pipe connections must be specified, e.g., rings of rubber for use as pipe connection seals for radiator pipes.

The particular type of fasteners and connectors, all made of plastic materials, for pipes and cables must be specified, e.g., plastic fasteners and connectors for pipes and cables, namely plastic insulators for electrical cables and plastic connections being plastic seals for rubber pipes.

The type of covers must be specified, e.g., Insulation covers of rubber or plastic for protecting mechanical components.

The mountings made of rubber or of plastics materials for engines, transmission assemblies and for exhausts, must be identified by their common commercial names, e.g., mounting tape of rubber and plastic materials for engines...

The material composition and purpose of the gaskets must be specified, e.g., non-metal gaskets for pipes, excluding fibrous gaskets for ships.

The “plastics materials” in the wording “washers (other than washers for water taps) made of rubber, plastics materials or of vulcanised fibre” and “grommets made of rubber or of plastics material” must be identified as being in the form of vulcanized fibers because plastic washers are not Class 017 goods, e.g., washers other than washers for water taps, made of rubber or of vulcanised fibre, grommets made of rubber or of vulcanized fibers.

The wording “packing and stopping materials, including oil seals (packing),” must be amended to specify the common commercial name for the goods, e.g., packing and stopping materials, namely oil based adhesive sealant and caulking compound.

The type of “stuffings for engines/motors and machines” must be specified, e.g., stuffing of plastic and rubber for engines and motors.

The parenthetical information must be incorporated into the general identification for “flexible pipes (not of metal)”

The common commercial name of each part and fitting must be specified or applicant may state that the goods are replacement parts and replacement fittings.

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Class 018

Leather and imitations of leather, and goods made of these materials; animal skins, hides; boxes of artificial leather, bags, baggage bags, trunks and travelling bags, handbags, sports bags, conference folders, umbrellas, pocket wallets, purses, back-packs, document cases, briefcases, card cases; vanity cases, not fitted; key cases, walking sticks, parasols, tool bags (empty); whips, harness and saddlery

The particular leather goods must be identified by their common commercial names, e.g., leather bags.

The particular type of conference folder must be specified, e.g., briefcase-type leather business folders.

The type of card cases is required, e.g., business and credit card cases, leather cases for credit cards.

The parenthetical information must be incorporated into the tool back entry to clarify that the goods are tool bags sold empty.

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Class 020

Locks (not of metal), for vehicles; mirrors (looking glasses); air cushions, not for medical purposes; non-luminous signs; vehicle registration plates (not of metal); storage containers, storage boxes for recording media (included in class 20), boxes, canisters; seat cushions, pillows; non-metal clamps; all aforesaid goods also as parts and fittings of vehicles; furniture; mirrors; furniture frames; indoor blinds; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics

The parenthetical “not of metal” must be incorporated into the identification, e.g., non-metal locks for vehicles.

The particular type of non-luminous signs must be identified, e.g., inflatable plastic signs.

The particular type and purpose of the registration plates must be specified, e.g., registration plates being identity plates not of metal, registration plates being plastic novelty license plates.

The particular type of storage containers must be specified, e.g., plastic storage containers for commercial or industrial use.

Applicant must clarify the type and purpose of the boxes for recording media, e.g., memorabilia display frames to hold record albums.

The type of boxes and canisters must be identified, e.g., boxes in the nature of crates and plastic boxes, canisters being novelty gift items in the nature of empty cans.

The particular “goods” must be identified, e.g., furniture of wood, cork...

Class 021

Articles for cleaning purposes, including cleaning utensils for vehicles, in particular sponges, car wash leather, cleaning cloths and hand operated cleaning devices; steel wool; unworked and semi-worked glass (except glass used in building), including glass and safety glass for vehicles; household or kitchen utensils and vessels/containers (not of precious metals or coated therewith), namely, mugs, cups, cooling bags, drinking bottles, bottle openers and trays; combs and sponges; brushes (except paint brushes); brush-making materials; glassware, porcelain ware and stoneware

The particular cleaning articles, utensils and devices must be specified, e.g., Acid-proof wash brushes used for the application of acid to vehicles for cleaning purposes. Please refer to the paragraph above regarding use of the term “including” and the paragraph regarding use of broad terms.

The type of cooling bags must be specified, e.g., insulated bags for food or beverage for domestic use.

The type of sponges and brushes must be specified, e.g., cleaning sponges, dusting brushes.

The common commercial name or items of glassware, porcelain ware and stoneware must be specified, e.g., beverage glassware, porcelain mugs, stone beverage ware.

Class 022

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Ropes, towropes, string, spare wheel cover, nets, tents, awning, tarpaulins, sails, sacks and bags for packaging, storage and transport; padding and stuffing materials not of rubber or plastics; raw fibrous textile materials

The wording “spare wheel cover” must be amended to clarify that the goods are unfitted and must also be amended to clarify exactly what the goods are, e.g., unfitted spare wheel covers in the nature of unfitted tarpaulins and unfitted lashing straps of synthetic textile materials, excluding leather.

The type of nets must be specified, e.g., snare nets.

The material composition of the sacks and bags must be specified and the particular type of goods with which they are used must be identified, e.g., bags and sacks of textile for packaging, storage and transportation of materials in bulk.

The wording “padding and stuffing materials not of rubber or plastics” must also be amended to specify that they are not of paper.

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Class 024

Blankets, plaids, winter seat covers, towels, pennants, flags, bed covers, table covers; (roller) blinds; textiles and textile goods; pennants of textile

The type or purpose of the blankets must be specified, e.g., lap blankets, traveling blankets, blankets for outdoor use, etc.

“Plaids” must be amended to specify the common commercial name of the goods, e.g., plaid traveling blankets.

The seat covers must be identified as being unfitted and their material composition must be specified, e.g., unfitted winter seat covers of textile.

The material composition of the pennants and flags must be specified, e.g., cloth pennants and flags.

The material composition of table covers must be specified, e.g., plastic table covers, table cloths not of paper, table cloths of textile, etc.

Roller blinds are either Class 006 or 020 goods depending on their material composition and 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). Because there appears to be no way to amend this wording to stay within the scope of “roller blinds” and to stay within Class 024, the examining attorney cannot suggest any acceptable amendment to this wording and it is suggested that applicant delete this phrase.

The type of textiles and particular common commercial name of the textile goods must be specified, e.g., textile tablecloths.

Class 025

Clothing (also outer clothing, leisure wear and sportswear), including belts, jackets, coats, pullovers, shawl, shirts, waistcoats, socks, scarves, ties, sweaters, T-shirts, overalls, coveralls, waterproof clothing, rain wear, trousers, sleep wear; headgear, including caps, hats; footwear, including casual shoes; belts

The particular items of “clothing” (and outer clothing, leisure wear and sportswear) must be specified by their common commercial names (applicant may alternatively state “clothing, namely” and amend the goods as indicated below). See entry above regarding use of “including.”

The particular items of headgear must be specified, e.g., hats. See entry above regarding use of “including.”

Class 026

Lace and embroidery, ribbons, and braid; buttons, hooks and eyes, pins, and needles; sewing kit; artificial flowers

The types of pins must be specified, e.g., safety pins, sewing pins, etc.

The primary components of the sewing kit must be specified, e.g., Sewing kits comprised of needles, thimbles, scissors and thread, sold as a unit.

Class 027

Carpets, rugs, mats and matting, linoleum, and other floor coverings, in particular for vehicles; door mats; wall hanging (non-textile)

The type or purpose of the mats and matting must be specified, e.g., mats and matting for covering existing floors.

Applicant must specify that the wall hangings are non-textile by incorporating the parenthetical information.

Class 028

Games, playthings and toys, including models, scale model vehicles, plush animals, games equipment, balloons, and beach balls; decoration for Christmas trees; gymnastic and sporting articles, including clubs, gloves, bags and balls for golf, sports racquets, and fishing tackle; golf bags

The particular common commercial name of the games, playthings and toys must be specified (see use of word “including” in the advisory above).

The “models” must be identified by their type, e.g., toy models.

The particular games equipment must be identified, e.g., dice.

The particular gymnastic and sporting articles must be identified, e.g., balance beams and soccer balls.

Class 035

Retail services and wholesale, namely, in respect of vehicles, engines/motors and machines (including drive units and construction machines), as well as of parts, fittings and accessories for the aforesaid goods, and of tools and workshop equipment, and of merchandise products; advertising, organisation of promotional programs, office functions, business administration (including bookkeeping), business management and business management advisory services, in particular relating to the design, development, manufacture, sale, distribution, repair or maintenance of vehicles, engines/motors and machines (including drive units and construction machines), and of parts, fittings and accessories for the aforesaid; consultancy in the field of vehicle fleet management

The type of retail and wholesale services must be specified, e.g., retail and wholesale store services featuring...

The particular common commercial name of the organization of promotional programs services must be specified, e.g., Arranging and conducting incentive reward programs to promote the sale of {indicate goods or services that are the subject matter of the reward program}

The particular type of fleet management consultation services must be identified, e.g., fuel management consulting services in the field of vehicle fleets.

Class 036

Real estate affairs; monetary and financial affairs, including credit card services; insurance, warranty, financing (including hire purchase and lease purchase financing services and leasing), in particular relating to vehicles, engines/motors and machines (including drive units and construction, transport,

agricultural and forestry machines), to parts, fittings and accessories for the aforesaid, and to tools and workshop equipment

The particular real estate, monetary, financial, insurance and warranty services must be identified, e.g., real estate consultation services and brokerage, monetary exchange services, financial services being money lending.

The particular type and field of the insurance services must be specified, e.g., underwriting auto insurance.

The particular warranty services must be identified, e.g., warranty claims administration services, namely, processing warranty claims for vehicle warranties.

Class 037

Building construction; installation services related to vehicles, motors and machines (including drives and contract machines); installation, service, repair, *inspection*, restoration, maintenance, reconditioning, diagnostic tuning, cleaning, painting, polishing and *preservation* services in relation to vehicles, engines/motors and machines (including drive units and construction, agricultural and forestry machines), power hand tools, workshop appliances and devices, or parts, fittings and accessories (including telecommunication equipment) for the aforesaid; emergency road side vehicle repair assistance; *rental of tools and workshop equipment*; *looking after and overhauling of motor vehicles in motor-sport events*; *reservation of garage services for the maintenance and repair of motor vehicles*; *technical assistance related to motor vehicles during motorsports events*

The particular type of inspection and preservation services must be specified by their common commercial names. Please note, only inspection done in the course of a construction project can be classified in Class 037, e.g., Inspection services in the course of construction of {indicate construction project}, preservation services being cleaning and reconditioning services for vehicles, engines...

The particular tools and equipment rented must be specified, e.g., rental of hand and power tools.

The wording "looking after and overhauling" must specify the particular services provided, e.g., looking after and overhauling services in the nature of repair and maintenance of motor vehicles.

The wording "reservation of garage services for the maintenance and repair of motor vehicles", is to be amended to clarify the services provided, e.g., making reservations for others for vehicle maintenance and repair provided at garages.

"Technical assistance related to motor vehicles during motorsports" must be amended to specify the nature of the assistance, e.g., providing vehicle repair consultation during motorsports.

Class 038

Internet, telecommunication and satellite communication services, in particular telephone services relating to vehicle radio telephones, paging services, *logistic services, telematic services, collection and supply of information as well as provision of a service-hotline (in particular with respect to traffic and technical information, and with respect to sports and entertainment)*; telematic assistance using GPS and GSM/3G technology via a service and alarm center for transport and traffic, in particular checking (supervision), positioning and (remote) control/automatic control of land vehicles, air vehicles, watercraft and locomotion systems, the load thereof as well as of engines/motors and machines (including drive units and transport machines) as well as intervention and help for persons and vehicles in the case of accident, breakdown, raid or theft; unidirectional or bi-directional transmission of text, voice and alarm messages and of signal, measuring, sound, image, video, position, movement, state and working hour data between land vehicles, air vehicles, watercraft and locomotion systems, the load/cargo thereof as well as between engines/motors and machines (including drive units and construction machines) and a wide variety of service points (also in the Internet), for emergency services, breakdown services and traffic information as well as for the remote checking (supervision) and remote control/remote automatic control of land vehicles, air vehicles, watercraft and locomotion systems, the load/cargo thereof as well as between engines/motors and machines (including drive units and construction machines); *communication via the Internet*, communications by computer terminals, computer aided transmission of messages and images; providing telecommunication channels for teleshopping services and chatrooms

The particular logistics services must be specified, e.g., telecommunication and internet logistics services being internet access consultation services.

The type of telematics services must be specified, e.g., telematic sending of information.

Provision of information and providing hot line counseling are services that are classified based on their underlying subject matter. Here, applicant appears to have specified subject matter not in Class 038 which is unacceptable. However, if applicant's information is provided in data form that is transmitted, these services are classified in Class 038 regardless of the subject matter. Applicant must clarify the particular type of services provided, e.g., Computer aided transmission and telematics transmission of information in the fields of traffic, technical information, sports and entertainment.

The wording "telematic assistance must be amended to specify the particular common commercial name of the services, e.g., telematics sending of information provided to and on behalf of alarm centers that use GPS and GSM/3G for providing safety and routing services for air and land vehicles.

The particular internet and telecommunication services must be specified, e.g., internet access provider services, telecommunication access services, etc.

The particular type of internet communications services must be provided, e.g., internet communications being email services.

Class 039

Transport, also of persons; salvaging, transportation, warehousing and other rescue services and operations in an emergency and provision of this; packaging, warehousing and distribution of goods; rental of vehicles, engines/motors and machines (including drive units and construction and transport machines); consultation in the field of traffic and transport, *including mobile telematics applications; logistic services; traffic information and*

control services; route guidance services; travel arrangement and tourist information services

The goods transported, the method of transportation, or both, must be specified, e.g., railway transport, passenger transport of persons, etc.

The goods salvaged must be specified, e.g., automobile salvage services.

The wording “and operations” must be clarified to specify the particular services provided, e.g., rescue operation services, namely rescue services provided via automobile and boat salvage, transport of passengers, warehousing of the salvaged vehicles and vessels, and rescue services.

The type of goods packaged must be specified and the particular distribution services must be identified, e.g., packaging, warehousing and distribution of goods, namely transport, delivery, packaging, and storage of {specify, e.g., goods, food, machine tools, valuables, etc.}.

The types of machines rented must be specified, e.g., rental of machines being air, land and sea vehicles.

“Including mobile telematics applications” must be amended to specify the common commercial name of the services, e.g., mobile telematics consultation, namely providing GPS navigation consultation.

The type of logistics services must be specified, e.g., Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of documents, packages, raw materials, and other freight for others by air, rail, ship or truck.

The type of traffic control services must be specified, e.g., air traffic control services, vehicle traffic control services in the nature of providing GPS navigation services.

The type of routes must be specified, e.g., providing travel route planning services.

The type of Class 039 tourist information must be specified, e.g. providing tourist information in the nature of providing information about arranging travel tours and providing travel route planning information.

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Class 040

Treatment of materials, namely, engraving, surface treatment and finishing, in particular of metals, plastics, textiles, glass, wood, leather, rubber and of ceramics, in particular for use for vehicles, engines/motors and machines (including drive units and construction machines), and for parts, fittings and accessories thereof; recycling, incineration and destruction, in particular of vehicles, engines/motors and machines (including drive units and construction machines), and of parts and accessories thereof; sorting of waste and recyclable material, in particular from vehicles, engines/motors and machines (including drive units and construction machines), and from parts and accessories thereof

The underlined parenthetical wording should be incorporated into each service listing in accordance with the advisory paragraph above.

Class 041

Education and training services; organisation of exhibitions for educational purposes; entertainment; arrangement of prize competitions; conduct of sporting and cultural activities and events services in connection with the organisation, and conduct of sports, recreational and entertainment competitions and functions; sport camp services; camp services for sport activities; museum services; rental of sports equipment (except vehicles)

The manner of instruction and subject matter of the education services must be specified and the subject matter of the training must be identified, e.g., education being classes and training in the field of vehicle repair and safe driving.

The particular entertainment services must be specified, e.g., entertainment in the nature of live musical concerts and auto racing competitions.

The type of prize competitions must be specified, e.g., arranging of prize competitions in the nature of auto racing competitions.

The wording “conduct of sporting and cultural activities and events services in connection with the organisation, and conduct of sports, recreational and entertainment competitions and functions” must be amended to identify the common commercial name of the services as well as the particular type of competitions and functions, e.g., arranging and conducting special events for social entertainment purposes, arranging auto racing competitions, etc.

The colon preceding “museum services” should be replaced with a semicolon.

The wording “except vehicles” must be incorporated into the sports equipment rental services listing.

Class 042

Scientific and technological services and research and design relating thereto; technical consultation and preparation of expert opinions; engineering services; services in connection with research development and testing of new products; programming of data processing software, computer programming, installation, maintenance and care of computer programs, in particular in the field of technical engineering, logistics and traffic and transport telematic; information technology services; design and development of computer hardware and software, IT services via data processing centers, service and alarm centers for transport and traffic, in particular the detection, checking (supervision), evaluation and processing of alarm messages, and signal, measuring, sound, image, video, position, movement, state and working hour data and (remote) control/automatic control of land vehicles, air vehicles and aircraft, locomotion systems, the load/cargo thereof as well as between engines/motors and machines (including drive units and construction machines); technical consultation in the field of recycling; technical consultation in the field of environmental protection; scientific research, also relating to the ocean; meteorological research; industrial analysis and research

The particular scientific and technological services must be specified (e.g., engineering services, computer software design, etc.) and the field of the technological

research must be specified (e.g., technological research in the field of computer design. Please note, “scientific research” is acceptable.)

The particular field of the opinions must be specified, e.g., technical opinions being engineering advice, technical opinions, namely providing advice in the field of computer design.

The particular “services” that are provided “in connection with research development and testing of new products” must be specified, e.g., providing product research, development and testing services.

The type of information technology services must be specified, e.g., information technology consulting services, planning, design and management of information technology systems, etc.

The particular common commercial name of the IT services via data processing centers, detection, checking, evaluation and processing services must be specified, e.g., IT services for data processing centers, namely monitoring of computer systems by remote access to ensure proper functioning of computer systems that detect, check, evaluate and process alarms and data concerning land and air vehicles.

The particular type of recycling technical consultation must be specified, e.g., technical consultation about software design and computer programming in the recycling field. Please note, “technical consultation” is not considered to be different from the wording “consulting” and since consultation services are classified based on the underlying subject matter, applicant must amend this identification to specify Class 042 subject matter.

The particular type of recycling technical consultation must be specified, e.g., technical consultation about software design and computer programming in the recycling field. Please note, “technical consultation” is not considered to be different from the wording “consulting” and since consultation services are classified based on the underlying subject matter, applicant must amend this identification to specify Class 042 subject matter.

The field or type industrial research and analysis must be specified, e.g., industrial research and analysis in the field of computer design, industrial analysis and research provided in the nature of engineering advice.

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.

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

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).

RESPONSE GUIDELINES

There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the title “Response to Office Action” and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant’s name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

The response should address each refusal and/or requirement raised in the Office action. If a refusal has issued, applicant can argue against the refusal; i.e., applicant can submit arguments and evidence as to why the refusal should be withdrawn and the mark should register. To respond to requirements, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

The response must be personally signed or the electronic signature manually entered by applicant or someone with legal authority to bind applicant (i.e., a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). TMEP §§605.02, 712.

PRO SE APPLICANT MAY WISH TO SEEK TRADEMARK COUNSEL

Applicant may wish to hire an attorney to assist in prosecuting this application because of the legal technicalities involved. The Office, however, cannot aid in the selection of an attorney. 37 C.F.R. §2.11. Applicant may wish to consult a local telephone directory for a listing of attorneys specializing in trademark or intellectual property law, or seek guidance from a local bar association attorney-referral service.

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 U.S. commonwealths or U.S. territories. 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_form.jsp. Please wait 48-72 hours from the issue/mailling 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

76707186

Status

REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

Word Mark

VOLVO

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Olde Granddad Industries, Inc. CORPORATION NEW JERSEY 160 Passaic Avenue, Bldg. 31 B Kearny NEW JERSEY 07032

Goods/Services

Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S: Fragrance products for land vehicles, aircraft, watercraft, personal, commercial, industrial, industrial and home use, namely, air fresheners, deodorizers.

Filing Date

2011/04/08

Examining Attorney

FRENCH, CURTIS

Attorney of Record

Ernest D. Buff

VOLVO