

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

U.S. APPLICATION SERIAL NO. 79182214

MARK: FAST TRACK

79182214

CORRESPONDENT ADDRESS:

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APPLICANT: Etihad Airways

CORRESPONDENT'S REFERENCE/DOCKET NO.:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1286951

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

Search Results

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

Identification of Goods and Services

The wording in the identification of goods and/or services is indefinite and must be clarified. See TMEP §1402.01. The indefinite language is set forth in *italics* below with suggested amending language set forth in **bold** type. Wording that must be deleted is set forth between brackets. Applicant may adopt the following identification, if accurate:

"Airline services for the transportation of passengers and cargo; air transportation of passengers and cargo; handling of passengers luggage; passenger cargo services; *baggage handling*, **namely baggage check-in services**; cargo handling; *garaging services*, **namely rental of garage space**; *storage services*, [including] **namely**, storing of vehicles and goods; *rental services* [including] **namely**, vehicle, garage and parking place rental; *transport services*, [including] **namely, transport of travelers by** chauffeur, car, taxi, bus **and** rail; [and place services;] transportation of vehicles, passengers, luggage, furniture and cargo; towing of vehicles; *travel services*, **namely** [including the] provision of **travel** reservations [services]; **coordinating travel arrangements for individuals and groups**; travel information and tourism information in relation to all modes of travel; airport services including services connected with processing passengers through an airline terminal, processing passengers' luggage and cargo, portage and services relating to loading and unloading cargo; air traffic control services, including control of flight paths for arriving and departing aircraft and design of departure and approach procedures; arranging hanger storage facilities for aircraft; provision of warehouses including rental of warehouse storage space and storage of freight; provision of information in relation to all these services including provision of information on these services via global computer network" in Class 39.

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

Goods and Services Manual

The identification of goods and/or services includes language from the "Alphabetical List" of goods and services from the *International Classification*

of Goods and Services for the Purposes of the Registration of Marks Under the Nice Agreement, published by the World Intellectual Property Organization in Switzerland. This list was developed for the purpose of classifying goods and/or services, not for the purpose of identifying goods and/or services in U.S. applications. TMEP §1401.02(c).

The USPTO generally requires more definite identifications of goods and/or services than those set forth in the "Alphabetical List." TMEP §1401.02(c); see 37 C.F.R. §2.32(a)(6); *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007). Descriptions of goods and/or services in applications must be specific, explicit, clear, and concise. TMEP §1402.01; see *In re Cardinal Labs., Inc.*, 149 USPQ 709, 711 (TTAB 1966); *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954).

Therefore, the USPTO recommends that applicants use the USPTO's *U.S. Acceptable Identification of Goods and Services Manual* to assist in writing identifications for U.S. applications. See TMEP §1402.04. This online searchable manual is available at <http://tess2.uspto.gov/etahtml/tidm.html>.

In a Trademark Act Section 66(a) application, classification of goods and/or services may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Mark Description

Applicant must submit a concise description of the mark. 37 C.F.R. §2.37; see TMEP §§808 et seq. The following is suggested:

The mark consists of the words FAST TRACK on a dark rectangular background with the words separated by a square with rounded corners containing two arrows pointing to the right.

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>.

/John M. Wilke/
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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/mailed 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>.