

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

U.S. APPLICATION SERIAL NO. 79183763

MARK: VITRA

**\*79183763\***

**CORRESPONDENT ADDRESS:**

Meyerlustenberger Lachenal  
Forchstrasse 452,  
P.O. Box 1432  
CH-8032 Zürich  
SWITZERLAND

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**APPLICANT:** VITRA PATENTE AG

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**INTERNATIONAL REGISTRATION NO. 1290408**

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal. The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Search

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 identification of goods and/or services contains parentheses. 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 description of the goods and/or services.

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

The identification of services is indefinite and must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the services. If the services have no common commercial or generic name, applicant must describe the nature of the services as well as their main purpose, channels of trade, and the intended consumer(s).

The applicant should note that the wording "the aforesaid goods included in this class" should be deleted as it fails to lend any specificity to the identification of goods and services.

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," "and their 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).

Applicant may adopt the following identification, if accurate:

#### Class 6

shelf brackets, in particular shelf brackets with hanging fittings **in the nature of {applicant must identify specific class 6 fittings e.g., metal supports}** for clothes shops; panels indicating prices and sizes, **namely, {the applicant must identify specific class 6 panels by common commercial name e.g., wall panels of metal}**; poster holders, **namely, {applicant must identify specific class 6 goods by common commercial name e.g., metal holders for signboards}**; partition walls, in particular for shop fittings and parts for shop fittings, **namely, {applicant must identify specific class 6 goods by common commercial name e.g. metal partitions for buildings}**; all the aforesaid goods of metal

#### Class 9

Electric cables, wires, conductors and fittings **{the applicant must replace the wording fittings by listing specific class 9 goods by common commercial name}** for related connections and switches; brightness regulators; electrical components, included in this class, **namely, switches, resistors, batteries, plugs, sockets, plug connectors**; parts of the aforesaid articles **{the applicant must replace the wording listing specific class 9 goods by common commercial name or specifying the parts are sold as component of the aforesaid articles e.g., parts sold as an integral component of the aforesaid articles}**; electric wires; cable ducts, **namely, {identify specific class 9 goods by common commercial name}**; starter motors for fluorescent tubes, **namely, {identify specific class 9 goods by common commercial name}**; cable junction unit **comprised of {identify class 9 components by common commercial name}**, electric fuse boxes, energy distribution installations, **namely, installations for the distribution of electricity to lamps and sockets in the nature of {identify specific goods by common commercial name e.g., electrical power distribution units}**; energy distribution units **in the nature of {identify specific goods by common commercial name e.g., electrical power distribution units}**, lighting control installations for turning lights on and off, reducing brightness of lamps **in the nature of {identify specific goods by common commercial name e.g., electric dimmer switches}**; electronic controllers for reducing the consumption of lamps; power regulators **for {indicate use}**, transformers.

#### Class 11

Lighting installations and apparatus and their parts, in particular lamps and lighting units for commercial, industrial and private use, lamps and their accessories **in the nature of {applicant must identify specific class 11 accessories}** and mounting devices for lamps, in particular wall or ceiling fasteners **specially adapted for mounting lighting devices**, lamps, lighting articles, particularly light bulbs, fluorescent tubes, halogen lamps; lamp shades; lighting apparatus **in the nature of {applicant must identify specific class 11 lighting apparatus}**; beacons, **namely, {identify specific class 11 goods}**, solar lamps, street lamps, workshop and warehouse lamps, mobile projector installations consisting of beacons and electronic voltage transformers; office lamps.

#### Class 19

**{the applicant must specify the partitions are nonmetal for classification in International Class 19}** partitions, in particular for shop fittings and parts for shop fittings; advertisement columns not of metal.

#### Class 20

Furniture, in particular showcases; shelf supports **for furniture, namely, {identify specific class 20 goods by common commercial name}**; curtain rods and rods for clothing as **parts of furniture, namely, {identify specific goods by common commercial name}**; shelves, in particular for shops and display stands; **shelves; nonmetal shelf brackets**, in particular shelf brackets with hanging fittings **in the nature of {identify specific fittings by common commercial name}** for clothes shops, tray holders and bars for clothing; panels for indicating price and size, **namely, {identify specific class 20 goods by common commercial name}**; angled tables, in particular for shops, building elements as **furniture** for display stands window, decorations and sales stores, **namely, {identify specific class 20 goods by common commercial name}**; lower tray parts and separating walls not of metal, in particular for shop fittings, **namely, {identify specific class 20 goods by common commercial name}**; display boards of wood or plastic; tray holders and bars of metal for clothing, **namely, {identify specific class 20 goods by common commercial name}**; lower tray parts of metal, in particular for shop fittings and parts for shop fittings, **namely, {identify specific class 20 goods by common commercial name}**; deflection mirrors **for {specify the class 20 use}**.

#### Class 35

Shop window and shop dressing; consultancy in **{the wording shops is broad. The applicant must identify specific class 35 field for the consultancy services e.g., business management consultancy for shops}** shops and shop window dressing.

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#### Class 42

Architectural services; industrial design; design of packaging; interior design services; services of an interior decorator; technical project study, **namely, {identify services by common commercial name e.g., conducting scientific feasibility studies}**; technical design and planning of lighting apparatus, installations and concepts; **engineering services in the field of lighting**; lighting planning; drafting of lighting installations.

Applicant is strongly encouraged to consult the online searchable Manual of Acceptable Identifications of Goods and Services for assistance with identifying and classifying goods and/or services in trademark applications <http://tess2.uspto.gov/netathtml/tidm.html>. See TMEP §1402.04.

Although identifications of goods and/or services may be amended to clarify or limit the goods and/or services, adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 et seq., 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

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).

#### Significance Inquiry

Applicant must explain whether "VITRA" has any meaning or significance in the industry in which the goods and/or services are manufactured/provided, or if such wording is a "term of art" within applicant's industry. Applicant must also explain whether this wording identifies a geographic place. See 37 C.F.R. §2.61(b); TMEP §814.

Failure to respond to a request for information is an additional ground for refusing registration. See *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTIP'ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

**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>

/enkajubi/  
Elizabeth N. Kajubi  
Examining Attorney  
Law Office 107  
(571) 272-2727  
[elizabeth.kajubi@uspto.gov](mailto:elizabeth.kajubi@uspto.gov)

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.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](mailto: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](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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