

Certificate of Transmission
I hereby Certify that this correspondence being
facsimile transmitted to the Patent and
Trademark Office:

On 06.23.04 Date
Shen Laurel I Signature
SHAY CONFICCO
Typed or printed name of person signing certificate

BOX TTAB -- NO FEE
TRADEMARK
1880-0124T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT: UMICORE
APPL. NO.: 76/361,192
FILED: January 23, 2002
MARK: "UMICORE"
CLASS: Intl. Classes 1, 2, 6, 9, 14, 40, 42
TRADEMARK ATTORNEY: Verna Beth Ririe
LAW OFFICE: 105

REQUEST TO REMAND TO TRADEMARK ATTORNEY

ATTN: ROCHELLE RICKS
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

June 23, 2004

Sir:

Further to your telephone conversation with Todd Hardy of our office on June 22, 2004, this is a request that the Trademark Trial and Appeal Board suspend the appeals proceedings and remand the above-identified application to the Examiner for consideration of the Amendment filed on December 4, 2003.

Attorney Dock No.: 1880-0124T
Serial No.: 76/361,192
Law Office: 105
Page 2

It is noted that a Communication was mailed by the Trademark Trial and Appeal Board on May 11, 2004, vacating the holding of abandonment, re-instituting the appeals proceeding and resetting the due date for submitting the appeal brief.

It is noted, however, that the filing of an appeal brief should not be necessary. Since amending the Identification of Goods was the only issue raised by the Trademark Attorney in her January 24, 2003 Office Action and October 7, 2003 Communication, and the Amendment filed on December 4, 2003 addressed this issue, it is believed that all the requirements of the Trademark Attorney have been complied with for the purpose of placing the present application in condition for publication. Therefore, it is believed that it is not necessary to file an Appeal Brief.

Again, it is respectfully requested that the Trademark Trial and Appeal Board suspend the appeals proceeding and remand this application to the Trademark Attorney for consideration of the Amendment filed on December 4, 2003.

Attorney Dock No.: 1880-0124T

Serial No.: 76/361,192

Law Office: 105

Page 3

Please charge any fees or credit any overpayment pursuant to 37 C.F.R. § 2.6 to Deposit Account No. 02-2448.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

Certificate of Transmission
I hereby Certify that this correspondence is being
facsimile transmitted to the Patent and
Trademark Office:

On 06.23.04

Date

Shawn Lawfield

Signature

SHAWN LAWFIELD

Typed or printed name of person signing certificate

By: James M. Slattery

James M. Slattery

Registration No.: 28,380

P.O. Box 747

Falls Church, Virginia 22040-0747

Telephone: (703) 205-8000

JMS:BG/asc

 * P. 01 *
 * TRANSACTION REPORT *
 * JUN-23-2004 WED 04:29 PM *
 * FOR: BSKB 7032058050 *

 * SEND *
 * DATE START RECEIVER TX TIME PAGES TYPE NOTE M# DP *
 * JUN-23 04:28 PM 1518801248#970374671 1'01" 4 FAX TX OK 682 *
 * 16 *

 * TOTAL : 1M 1S PAGES: 4 *

P.O. Box 747
 Falls Church, Virginia 22040-0747
 Phone: (703) 205-8000
 Fax: (703) 205-8050
 (703) 698-8590 (GV)



Fax

To: Ms. Rochelle Ricks
 Trademark Trial and Appeal Board
 U.S. Patent and Trademark Office

From: James M. Slattery

Fax: (703) 746-7116 **Date:** June 23, 2004

Phone: **Pages:** 4 (including cover sheet)

Your Ref: **Our Ref:** 1880-0124T

Re: U.S. Appl. No. 76/361,192 **CC:**

Urgent For Review Please Comment Please Reply Please Recycle

P.O. Box 747
Falls Church, Virginia 22040-0747
Phone: (703) 205-8000
Fax: (703) 205-8050
(703) 698-8590 (GIV)

Birch, Stewart, Kolasch & Birch, LLP

Fax

To: Ms. Rochelle Ricks
From: James M. Slattery
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office

Fax: (703) 746-7116

Date: June 23, 2004 *Resend 8/5/04*

Phone:

Pages: 4 (including cover sheet)

Your Ref.:

Our Ref.: 1880-0124T

Re: U.S. Appl. No. 76/361,192

CC:

Urgent For Review Please Comment Please Reply Please Recycle

This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential, and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution, or duplication of this transmission by someone other than the intended addressee or its designated agent is strictly prohibited. If your receipt of this transmission is in error, please notify this firm immediately by collect call to (703) 205-8000, and send the original transmission to us by return mail at the address above.

Comments:



BOX RESPONSES -- NO FEE
TRADEMARK
188C-0124T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: UMICORE
APPL. NO.: 76/361,192
FILED: January 23, 2002
MARK: "UMICORE"
INT'L CLASSES: 1, 2, 6, 9, 14, 40 and 42
TRADEMARK ATTORNEY: Verna Beth Ririe
LAW OFFICE: 105



AMENDMENT

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

December 4, 2003

Sir:

In response to the Trademark Attorney's Communication dated October 7, 2003, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

IN THE APPLICATION:

Page 1

In the second paragraph, delete the entire Identification of Goods and Recitation of Services and substitute therefor the following:



12-04-2003

International Class 1

Chemicals used in the metal plating industry, namely, tempering and soldering preparations for use in metalworking or soldering in the nature of abrasives, acids, actinium, caustic alkali, alkaline-earth metals, alkaline iodides for industrial purposes, alkaline metals, salts of alkaline metals, alkalis, alumina, antimony, antimony oxide, antimony sulphide, silver nitrates, silver salt, solutions for silvering, lead arsenate, arsenic, arsenious acid, bacteria, galvanizing bath solutions, barium, barium compounds, agglutinants for concrete, manganese dioxide, bismuth, basic gallate of bismuth, carbide, and ceramic glazings; chemical preparations for use in the manufacture of metal alloys; chemical reagents for performing analyses in laboratories; industrial chemicals, namely, chlorine, cobalt oxide for use in ceramics and chemicals; corrosive catalysts for use in the metalworking industry; chemicals for use in the manufacture of paints, vitriol, and enamel; bichloride of tin, iron salts, and binding and molding chemicals for use in the metal foundry industry; gadolinium, gallium, germanium tetrachloride, germanium dioxide and salts for use in optics and plastic galvanizing baths and galvanizing preparations; polyethylene terephthalate for use in chemicals for fireproofing preparations; iodine for use in the chemical industry; lanthanum, lithium, magnesium carbonate, magnesite, magnesium chloride, manganate, manganese dioxide, mercury, mercuric oxide, and mercury salts for use in the manufacture of pharmaceuticals, chemicals and batteries; metalloids, tempering chemicals for use in metal hardening in the metalworking industry; metal annealing chemicals, salts from rare earth metals, salts of precious metals, and mineral acids for use in nuclear reactors; chemicals for use in the manufacture of mordants for metals; neodymium, nitrates, gold salts, chromium oxide, lead oxide, palladium chlorides, persulphuric acid and phosphates for use in the manufacture of fertilizers; lead acetate, water purifying chemicals for use in water purification installations; rhenium, rubidium, samarium, scandium, selenium, sodium selenite, chemical salts for use in the manufacture of fertilizer; metal plating compositions in the nature of silver salts, gold salts, salts for galvanic cells, silicon, sodium, sodium salts, calcined soda and caustic soda for industrial operations; sulphur, flowers of sulphur, strontium, sulphates, sulphides, sulphurous acid, sulphuric acid, tellurium, chemical vulcanization accelerators, ytterbium, yttrium, zirconia, silver nitrate, nickel sulphates, zinc selenide, gallium

arsenide, thallium salts, and high purity cobalt, all for use in the optical, chemical and agricultural industries, and in electronics; chemicals used in photography, namely, silver nitrate.

International Class 2

Paints, varnishes, lacquers, preservatives against rust, mordants, metals in foil and powder form for painters, decorators, printers and artists, namely, aluminum paints against corrosion aluminum powder for inhibition, corrosion aluminum powder for inhibitors in the nature of a coating, rust preservatives in the nature of a coating, silver emulsion pigments; silver paint for artist use on ceramics, silver leaf foil, silver paste in the nature of a paint-type coating for printing, silver powder, bactericidal interior paints, white and blue colorants for use in the manufacture of paints, wood preservatives, paint for use in the manufacture of ceramics, cobalt oxide colorants for use in the ceramic pigments, paint for use in gilding, clear and zinc oxide pigmented coatings used in the nature of paint, litharge pigments, coatings used as a protectant for metals, metal foil for painters, decorators, printers and artists, aluminum pigments, enamels in the nature of house and industrial paint, bacterial house paints, fireproof house paints, pigments, bright platinum paint for ceramics, protective paint-type coatings for metals and titanium dioxide pigments.

International Class 6

Common metals and their alloys unwrought or semi-wrought, in ingots, namely, zinc, cobalt, copper, nickel, lead ore, silver-nickel alloys, common metal alloys, aluminum, antifriction common metal, beryllium, bronze, cadmium, chromium, tin, galena ore, germanium, cesium, indium, iron, steel, brass, magnesium, manganese, pyrophoric metals, molybdenum, nickel, niobium, tantalum, titanium, tungsten, vanadium, wolfram, and zirconium; metal building material, namely, fascia; transportable buildings of metal; metal tracks for rail vehicles; non-electric cables and wire of common metal; ironmongery in the nature of metal hardware, namely, nuts and washers; pipes and tubes of metal; metal safes; tinfoil; wire of common metal; bungs of metal; flange collars of metal for armour plating; clips of metal for cables and pipes; rings of metal; aluminum foil; aluminum non-insulated wire; copper wire; wire, except fuse wire, of common metal alloys; metal junctions for pipes;

zinc and copper in sheet form for covering roofs; ornamental and decorative articles for buildings in zinc, copper and other metals; namely door and window frames, parts of roofs, weather cocks and gutters; metal scaffolding; manually operated metal water pipe valves; metal cornice mouldings; metal cornices; elbows of metal for pipes; metal roof coverings; metal hardware, namely, clamps and hooks; non-insulated copper wire; metal gutter pipes; metal gutters, metal building material, namely, fascia and wall linings; metal clips for cables and wires; junctions of metal for pipes; metal cladding for construction and building; metal tubes; tiles of metal; pipe muffs of metal; ferrules of metal; metal building material, namely, iron slabs; metal fittings for coffins, namely, hinges; hand-operated metal reels for flexible hoses; metal fittings for windows, namely, clasps; metal weather vanes; pre-fabricated metal buildings, namely, porches; metal building flashing; metal building material, namely, aluminum sheets and plates; ducts of metal for ventilating and air conditioning installations; low melting point metal alloys for lens blocking and turbine blade manufacturing; and sculptures made of non-precious metal.

International Class 9

Scientific apparatus and instruments, namely, lasers not for medical purposes and laser accessories, namely, infrared lasers, fiber optics for use in lasers, fiber optics, fiber-optic cables, thermal imaging systems comprised of fiber optic light and image conduits, optical lenses and coated optical lenses, optical lens sights, optical inspection subassemblies for industrial use composed of optical beam splitters and optical mirrors, solar collector cells, and panels, optical lenses composed of chalcogenide glass, silicon and germanium wafers, silicon insulating and multi-layer wafers, semiconductors and semiconductor substrates, and germanium substrates for space solar collector cells.

International Class 14

Precious metals and their alloys, namely, silver, iridium, gold, osmium, palladium, platinum, rhodium and ruthenium; and precious stones, namely, diamonds.

International Class 40

Treatment of materials, namely, the custom manufacture of metal building materials; chromium plating; tin plating; blacksmithing; laminating of metal plates; metal casting; silver plating; destruction of waste and trash; gliding; water treatment; electroplating; galvanizing; fireproofing of cloth; incineration of waste and trash; metal plating; metal tempering; nickel plating; gold plating; recycling of waste and trash; cadmium plating; burnishing by abrasion; optical glass grinding; production of energy; waste and trash refining treatment in oil; soldering; vulcanization; custom manufacture of dust and zinc powder; and custom manufacture of zinc oxide.

International Class 42

Legal services; scientific and industrial research; engineering; patent licensing; chemical research; chemist services; consultation services in the field of architectural design; intellectual property consultation; construction drafting; consultancy in the field of computer hardware; consultancy in the field of compliance with environmental protection laws; industrial design; material testing; conducting of technical project feasibility studies; geological surveying; underwater exploration; engineering drawing; geological prospecting; intellectual property licensing; computer software design for others; research and development of new products for others; and technical research in the field of metallurgy.

REMARKS

The Applicant thanks the Trademark Attorney for the very thorough consideration given the present application and the courtesy extended during an interview with regard to the present application.

Identification of Goods and Recitation of Services

The Trademark Attorney objected to the wording "silver salts" and "selenium" in International Class 1 as being indefinite. During an interview with the Trademark Attorney, it appears that the Trademark Attorney accepted the rest of the Identification of Goods and Recitation of Services. As set forth hereinabove, the Applicant has deleted the terms "silver salts" and "selenium" from the Identification of Goods in International Class 1. The Identification of Goods is now believed to be definite and accurately identifies the goods of the Applicant.

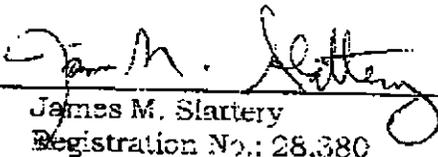
On October 20, 2003, a Request for an Extension of Time for Filing an Appeal Brief was filed before the Trademark Trial and Appeal Board. The Applicant requested an additional two (2) month extension of time, in order to amend the Identification of Goods as requested by the Trademark Attorney. Therefore, the present Amendment is within the time period allowable for the Applicant to file a response to the Trademark Attorney's action of October 7, 2003.

It is believed that the present application is in condition for publication. An early Notice of Publication is respectfully requested.

Please charge any fees or credit any overpayment pursuant to 37 C.F.R.
§2.6 to Deposit Account No. 02-2448.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

James M. Slattery
Registration No.: 28,380

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000

JMS/BG/asc