

OCT 27 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/366454

APPLICANT: KICKZ AG

76366454

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If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: KIX

CORRESPONDENT'S REFERENCE/DOCKET NO: 11124/4

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 76/366454

In its communication filed June 18, 2004, applicant is requesting reconsideration of a final refusal mailed April 20, 2004. TMEP section 715.03.^[1]

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue. Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

AMENDMENTS TO IDENTIFICATION OF GOODS AND SERVICES

Applicant's requested amendments to the identification of goods and services have been entered as set forth below, but certain wording, as indicated in discussion of Class 28 and Class 41 below, remains unacceptable as indefinite and/or too broad.

CLASS 25

Applicant's requested amendment to "Clothing, namely, shoes, hats, caps and t-shirts" is accepted as stated.

CLASS 28.

Certain wording in applicant's requested amendment to "Gym and sport articles, sport devices for training improvement, namely, basketballs, dumb-bell shafts, running machines, rowing machines for physical exercise (other than for medical use, knee guards (sports articles), bar bells, batting gloves

(accessories for games), belt vibrators, abdomen protectors (parts of sports suits), sport supporters (for wrist, knee, etc.), dumb-bells, baseballs, baseball gloves, baseball bat cases, baseball batting gloves, baseball masks, baseball mitts, baseball bats, baseball bases, baseball helmets, chest protectors (for baseball), weight lifting machines, weight lifting gloves, weight lifting belts (sports articles), rosin used by athletes, bicycle training wheels, stationary exercise bicycles, rollers for stationary exercise bicycles, chest expanders (sports articles), gymnastic and training stools, horizontal bar (for gymnastics), benches for exercises, spring boards (for gymnastics), vaulting horses (for gymnastics), rings for gymnastics, soccer balls, chinning bars, balance beams (for gymnastics), parallel bars (for gymnastics), home bases, American football helmets, American footballs" is not accepted.

The wording "gym and sport articles, sports devices for training improvement" is unacceptable because it is indefinite and too broad. The applicant may amend this wording, if accurate, to "gym and sports articles and sports devices for training improvement." TMEP §§1401.04(b), 1402.01 and 1402.03.

The wording "rowing machines for physical exercise (other than for medical use)" is unacceptable because the parenthesis is incomplete. The applicant may amend this wording, if accurate, to "rowing machines for physical exercise (other than for medical use)." TMEP section 1402.03(a).

The wording "etc." is indefinite. The identification must be complete and all-inclusive. Applicant must delete "etc." and specify each of the sport supporters by common name. TMEP section 1402.03 (a). If accurate, the applicant may amend the wording "sport supporters (for wrist, knee, etc.)" to "sport supporters for wrist, knee, elbow and ankle."

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

CLASS 35

Applicant's requested amendment to "advertising, namely, dissemination of advertising matter, rental of advertising space, merchandising services, namely, product merchandising, marketing services, namely, direct marketing advertising for others, conducting marketing studies; distribution services, namely, distributorship in the field of clothing, sporting goods" is accepted as stated.

CLASS 41

Certain wording in applicant's requested amendment to "performing house fairs for cultural or educational purposes, namely, conducting entertainment exhibitions in the nature of sport festivals; conducting sports tournaments in the field of basketball, baseball, American football, golf tennis, and soccer; entertainment in the nature of basketball games and baseball games, sport camps, in particular soccer, baseball, and basketball camps; summer-camps" is not accepted.

Not within scope of original identification

The wording " sport camps, in particular soccer, baseball, and basketball camps; summer-camps" is unacceptable because it refers to services that are not within the scope of the identification that was set forth in the application at the time of filing. While the identification of goods and/or services may be amended to clarify or limit the goods and/or services, additions to the identification or a broadening of the scope of the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07. Therefore, the applicant must delete this wording from the identification.

Not within scope of foreign registration

The wording "sport camps, in particular soccer, baseball, and basketball camps; summer-camps" is unacceptable because it refers to services that are not within the scope of the foreign registration. This wording of the identification of services in the application for the Section 44 basis is not acceptable because it designates services that are broader in scope than the identification set forth in the foreign registration. 37 C.F.R. §2.32(a)(6). If applicant chooses to amend the identification of services in the application to correspond to the foreign registration, then these services must be deleted.

Applicant must amend the identification of services in the application to correspond to the services identified in the foreign certificate of registration. The applicant may not in this case merely delete the Section 44 basis for these services that are beyond the scope of the foreign registration and rely solely on the Section 1(b) basis for these services, because, as indicated above, these services are also outside scope of original identification. 15 U.S.C. §1051(b); 37 C.F.R. §§2.32(a)(6) and 2.34(b); TMEP §§806.02 *et seq.*, 1012 and 1402.01(b); *see Marmark Ltd. v. Nutrexp S.A.*, 12 USPQ2d 1843 (TTAB 1989); *In re Lowenbrau München*, 175 USPQ 178 (TTAB 1972).

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

My Law Office will move on November 2, 2004. To reach me by phone after that date call (571) 272-9213. To submit a **fax** response to this Office action after that date, send your response to the Law Office fax number, namely (571) 273-9108.

/Mary Rossman/, Trademark Attorney
Law Office 108
703 308 9108 x 298; Fax: 703 746 8108

How to respond to this Office Action:

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm> and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) CANNOT currently be filed via TEAS.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

[1] Note that filing a request for reconsideration does not stay the time for responding to a final refusal. 15 U.S.C. §1062 (b); 37 C.F.R. §2.142(a). The deadline for appeal runs from the mailing date of the final action. If this deadline has expired and the applicant has not filed a notice of appeal, the application is abandoned. The applicant may not file a petition to revive under 37 C.F.R. §2.66. See TMEP §1714.01(f)(ii).