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**To:** OC Oerlikon Corporation AG, Pfäffikon (trademark@jhip.com)  
**Subject:** TRADEMARK APPLICATION NO. 77090199 - OERLIKON FAIRFIELD D - T36354US0  
**Sent:** 4/16/2008 1:54:56 PM  
**Sent As:** ECOM102@USPTO.GOV  
**Attachments:**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/090199

**MARK:** OERLIKON FAIRFIELD D

**CORRESPONDENT ADDRESS:**  
GEORGE W. LEWIS  
JACOBSON HOLMAN PLLC  
400 7TH ST NW STE 600  
WASHINGTON, DC 20004-2218



**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** OC Oerlikon Corporation  
AG, Pfäffikon

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

T36354US0

**CORRESPONDENT E-MAIL ADDRESS:**  
trademark@jhip.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 4/16/2008

Applicant is requesting reconsideration of a final refusal issued/mailed 09/19/2007.

The following requirement has been satisfied: The definite wording requirements for the identification of goods in Class 012. TMEP §§713.02, 714.04.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration for the Class 007 goods and adhere to the final action as written for the Class 007 goods since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Applicant must specify the exact use of each piece or type of machinery, and use the generic or commercial name for each piece of machinery; applicant may not merely provide a list of the general

field of uses of the machinery because the type of machinery is unclear and the specific use for each type of machinery is unclear.

The identification of goods is indefinite and must be clarified because it includes the open-ended wording "including." TMEP §§1402.01 and 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "namely."

Applicant may amend the identification to list only those items that are within the scope of the goods set forth in the application or within the scope of a previously accepted amendment to the identification. 37 C.F.R. §2.71(a); TMEP §§1402.01 and 1402.03(a).

Specifically, the following terms in bold remain indefinite in class 007:

**"machines, namely off-highway mobile machinery for use in all types of construction, agricultural, mining, on / off- shore marine, utility, exploration, recreational, and service activities, and speciality industrial machinery for use in all types of utility, municipal industrial services , energy and power transmission, materials and materials handling, and related processing activities, and stationary machinery and machine tools used in processing activities including cutting, grinding, sawing, milling and profiling, as well as mixing and agitating machine tools, namely for off-highway mobile machinery and speciality industrial machinery, and replacement parts therefor;** motors and engines not for land use, namely, planetary gear motors, machine couplings and transmission components, namely gears for machines; parts for motors not for land use, namely, brushes; transmission parts for machines, namely gears and speed change gears, planetary gears, angular gears, two-speed change gears, gearheads and associated intermediate gears for machines; intermediate gears for machines; parts of machines, namely force transfer mechanisms for mechanical branch drives in the form of an intermediate gear, static and dynamic brakes that are applied and released by hydraulic springs, rear wheel drives and planetary drives for industrial machines; gears, shafts, differentials of all types and replacement parts therefor, for machines; hydraulic and mechanical apparatus for gear changing, namely clutches for machines; torque converters for machines, reduction gears for machines, gear and engine torque reducers, for machines, apparatus for gear synchronization, namely clutches for machines; combustion engines for boats

Accordingly, applicant's request for reconsideration is *denied for the class 007 goods*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

/Anthony M. Rinker/  
Trademark Examining Attorney  
Law Office 102  
571-272-5491

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.



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**Subject:** TRADEMARK APPLICATION NO. 77090199 - OERLIKON FAIRFIELD D - T36354US0  
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**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 4/16/2008 FOR**  
**APPLICATION SERIAL NO. 77090199**

Please follow the instructions below to continue the prosecution of your application:

**VIEW OFFICE ACTION:** Click on this link [http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77090199&doc\\_type=REC&mail\\_date=20080416](http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77090199&doc_type=REC&mail_date=20080416) (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to **access** the Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this notification.

**RESPONSE MAY BE REQUIRED:** You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable **response time period**. Your response deadline will be calculated from **4/16/2008**.

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**