To: Bundesdruckerei GmbH (mscariati@mwpatentlaw.com)

Subject: TRADEMARK APPLICATION NO. 79032311 - VISOTEC - N/A

Sent: 3/12/2008 6:15:16 PM

Sent As: ECOM112@USPTO.GOV

Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/032311

MARK: VISOTEC

CORRESPONDENT ADDRESS:
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251 North Avenue West
Westfield NJ 07090

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

APPLICANT: Bundesdruckerei GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
CORRESPONDENT E-MAIL ADDRESS:
mscariati@mwpatentlaw.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/12/2008

Applicant is requesting reconsideration of a final refusal issued August 3, 2007.

This Denial of the Request for Reconsideration responds to applicant's communication dated February 07, 2008.

The applicant:

(1) Filed a request for reconsideration of the final action and a notice of appeal.

The assigned trademark examining attorney has reviewed the response to the office action and has determined the following:

(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 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).

REFUSAL TO REGISTER MAINTAINED – AMENDMENT TO THE IDENTIFICATION OF GOODS AND SERVICES REQUIRED

The wording, "*wireless, namely WLAN, transmitters and receivers*" and "*WLAN interface devices,*" used to describe the applicant's goods is indefinite because it fails to identify specific goods. In this case, applicant has not specified the common commercial or generic name. 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. If applicant uses indefinite words such as "accessories," "components," "**devices**," "equipment," "materials," "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**. TMEP §§1402.01 and 1402.03(a).

The wording, "*instructional software,*" used to describe the applicant's goods is indefinite because it fails to identify the subject matter, function and/or field of the instructional software. Applicant is required to specify the function of the software, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use.

The wording, "*instructional and teaching material in the form of books, journals, flyers, handbooks, manuals, circuit drawings, repair manuals, service manuals, information cards, case studies, and charts,*" used to describe the applicant's goods is indefinite because it fails to specify the field of use or subject matter for the instructional and teaching material.

Additionally, the wording "*ink cartridges*" and "*printer toners*" in the identification of goods in International Class 009 is indefinite because it is too broad and includes goods in International class 002. TMEP §§1402.01 and 1402.03. As such, this wording must be deleted from the application.

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods and/or services in the corresponding international registration. TMEP §§1401.03(d) and 1904.02(b).

Moreover, the proposed amendment to the identification in International Class 045 cannot be accepted because the wording "*providing transport security for persons, value and security documents and identity documents; computer network security services*" 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, this wording should be deleted from the identification.

Finally, the wording "*value and security documents, namely banknotes, currencies, passports, visas on optical, electronic or magnetic data carriers,*" and "*printed value and security documents, namely banknotes, currencies, passports, visas, IDS cards, money orders,*" in the identification of goods is indefinite and must be clarified because it is too broad. TMEP §§1402.01 and 1402.03. However, any modification to this wording must identify goods in International Class 009 and 016, respectively, the classifications specified in the application for these goods. In this case, the examining attorney is unable

to suggest wording that is both sufficiently definite and properly classified. Therefore, applicant is advised to 1) substitute its own definite wording in the proper class or 2) delete this language from the identification. **If applicant requires assistance with identifying acceptable goods and/or services please refer to the online searchable Manual of Acceptable Identifications of Goods and Services at <http://tess2.uspto.gov/netahtml/tidm.html>.**

Recommended changes have been highlighted in **bold** and suggestions for amending applicant's identification of goods and services are in brackets.

PLEASE NOTE: If applicant adopts the recommended identification of goods, applicant must remove any brackets from the identification of goods and incorporate the bracketed information into the amended description. Generally, parentheses and brackets should not be used in identifications. Parenthetical information is only permitted in identifications 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)." TMEP §1402.12.

Applicant may adopt the following identification of goods and services, if accurate:

> **International Class 009**: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely circuits, microcircuits, circuit boards, wires, batteries, battery chargers, and transformers; apparatus for recording, transmission or reproduction of sound or images, namely scanners, electronic cameras, optical sensors, optical displays, analog-digital-converters, digital-analog-converters, processors for processing digitalized acoustic or optical information; wireless **devices**, namely, WLAN **(wireless local area network)** transmitters and receivers; blank optical, electronic or magnetic data carriers, namely CDs, DVDs, CD-ROMs, holograms, storage chips, magnetic strips, magnetic tapes, hard disk drives, and floppy disks; pre-recorded optical, electronic or magnetic data carriers, namely holograms, storage chips, and magnetic strips, that are integrated into value and security documents and containing clear or coded information regarding the value and security document or regarding a person entitled to carry the value and security document; data processing equipment, namely processors, processor circuit boards, and computers; electronic computer accessories, namely computer cables, keyboards, **mouse**, monitor screens, mouse pads, memory stick **cards**, external hard disks, chip card readers, magnetic card readers, hand held scanners, chip card readers, magnetic card readers, computer network servers, and WLAN interface devices, **namely, interfaces and peripheral devices for computers and peripheral component interface (PCI) hardware;** software for apparatus for automated control of identity documents; software for apparatus for reading out, authenticating, verifying and identifying value and security documents; instructional software; **pre-recorded optical, electronic and magnetic data carriers featuring electronic value and security documents, namely**, ID cards, electronic lock cards, titles, licenses, registrations, checks, money orders, original documents, certificates of authority, event tickets and gift certificates; apparatus for reading out, authenticating, verifying and identifying value and security documents, namely scanners, chip card readers, magnetic card readers, computers and computer network servers; apparatus for automated control of identify documents, namely scanners, chip card readers, magnetic card readers, computers and computer network servers; none of the aforementioned goods relating to accessories for photography
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> **International Class 016**: **Printed value and security documents, namely, blank**

forms in the nature of titles, licenses, registrations, original documents, and certificates of authority; printed **matter, namely, bank** checks, event tickets and gift certificates; photographs; instructional and teaching material in the form of books, journals, flyers, handbooks, manuals, circuit drawings, repair manuals, service manuals, information cards, case studies, and charts **in the field of _____ [applicant to specify the subject matter or field of use, e.g., math, architecture, engineering, etc.]**.

International Class 035: Advertising, namely preparing and placing advertisements for the benefit of third parties; business management; business administration; office functions, namely word processing, data processing, bookkeeping, accounting, photocopying, sending and receiving faxes and electronic mails and letters, preparing correspondence, secretarial services and reimbursement calculations

International Class 037: Installation, repair and servicing of computer hardware and software; installation, repair and servicing of apparatus for reading out, authenticating, verifying and identifying value and security documents, and of apparatus for automated control of identify documents; installation and service of central and decentralized computer networks for executing specialized services, namely identification, verification and authentication of value and security documents and of identify documents

International Class 038: Telecommunications, namely mobile telephone communications services, local and long distance telephone services, telecommunications gateway services, paging services, wireless digital messages services, personal communication services, providing multiple user access to a global computer network; transmitting and receiving data and information related to value and security documents and to identify documents using wireless or wire-based telecommunication networks.

International Class 042: Scientific, technological, industrial, analysis and research services, namely in the fields of generation, evaluation, detection, verification and authentication of security features in value and security documents and in identity documents, and of apparatus for reading out, identifying, verifying and authenticating value and security documents and identity documents, and research and design related thereto; design and development of computer hardware and software; providing legal advice and legal representation.

International Class 045: Security services for protecting value matters and persons, namely identification, verification and authentication of persons, of value and security documents and of identity documents.

TMEP §1402.01.

Please note that, while the identification of goods and/or services may be amended to clarify or limit the goods and/or services, adding to the goods and/or services or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. 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.

For assistance with identifying and classifying goods and/or services in trademark applications, please

see the online searchable *Manual of Acceptable Identifications of Goods and Services* at http://tess2.uspto.gov/netahtml/tidm.html.

Therefore, based on the foregoing, applicant's request for reconsideration is denied and the requirement is continued. 37 C.F.R. §2.64(b); TMEP §715.04. The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

Charisma Hampton
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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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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 3/12/2008 FOR APPLICATION SERIAL NO. 79032311

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

VIEW OFFICE ACTION: Click on this link **http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=79032311&doc_type=REC&mail_date=20080312** (or copy and paste this URL into the address field of your browser), or visit **http://tmportal.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 **3/12/2008**.

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**. 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.