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Subject: U.S. TRADEMARK APPLICATION NO. 79086139 - RIPASSO ENERGY -
ALBS.T112WOU - Request for Reconsideration Denied - Return to TTAB

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

APPLICATION SERIAL NO. 79086139

MARK: RIPASSO ENERGY



CORRESPONDENT ADDRESS:

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

APPLICANT: Ripasso Energy AB

CORRESPONDENT'S REFERENCE/DOCKET NO:

ALBS.T112WOU

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/20/2012
INTERNATIONAL REGISTRATION NO. 1047833

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated August 26, 2011 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP

§715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

Prosecution History

On September 16, 2010, the Office received an Extension of Protection regarding the mark RIPASSO ENERGY plus design for “Electricity generating apparatus utilising solar power; solar collector for electricity generation; solar battery chargers; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, production and distribution of electricity including electricity distribution nets; apparatus and instruments for supervision, remote control, control and measurement of electricity and energy consumption and for operating power stations; electricity cables and connectors and poles and transformers for distribution and operating electricity and energy” in International Class 9.

On September 22, 2010, the examining attorney required a disclaimer of “ENERGY”, a mark description, a correctly worded color claim, translation of “RIPASSO” and a clarification of the identification of goods.

On January 28, 2011, the applicant entered a response to Office action with a disclaimer of “ENERGY”, mark description, color claim, negative translation statement, and amended identification of goods.

On February 17, 2011, the examining attorney inadvertently issued an irrelevant final Office Action to the applicant. On the same day, the examining attorney issued a subsequent non-final Office action to the applicant accepting the disclaimer of “ENERGY”, color claim, and negative translation statement. However, the examining attorney required an accurate mark description referencing all the colors in the mark and a definite and acceptable recitation of goods.

In response, on August 16, 2011, applicant proposed amended wording for its identification of goods and entered another mark description.

On August 26, 2011, the examining attorney issued a partial final Office Action as to the wording “solar thermal power plants” in Class 9 because the proposed amendment identified goods that were not acceptable in the International Class 9.

Despite the explanation as to the requirement for definite wording that belonged in Class 9, on February 21, 2012, the applicant proposed the wording “Electricity generating apparatus utilizing solar power, namely stirling engine powered electrical generators, for production of electricity; Electricity generating apparatus utilizing solar power, namely stirling engines for production of electricity; Electricity generating apparatus utilizing solar powered stirling engines for production of electricity; Electricity generating apparatus utilizing solar power for production of electricity”. This wording is unacceptable because it does not identify goods that are within the classification assigned by the International Bureau for applicant’s goods. Therefore, Applicant’s request for

reconsideration as to the wording “Electricity generating apparatus utilizing solar power, namely, solar thermal power plants” is **denied** for the reasons set forth below.

Final PARTIAL Requirement for Acceptable Identification of Goods Continued and Maintained

The stated refusal refers to the following goods and/or services and does not bar registration for the other goods and/or services: "Electricity generating apparatus utilizing solar power, namely stirling engine powered electrical generators, for production of electricity; Electricity generating apparatus utilizing solar power, namely stirling engines for production of electricity; Electricity generating apparatus utilizing solar powered stirling engines for production of electricity; Electricity generating apparatus utilizing solar power for production of electricity".

In response to the rejection of the wording "Electricity generating apparatus utilizing solar power, namely, solar thermal power plants", applicant proposed the wording "Electricity generating apparatus utilizing solar power, namely stirling engine powered electrical generators, for production of electricity; Electricity generating apparatus utilizing solar power, namely stirling engines for production of electricity; Electricity generating apparatus utilizing solar powered stirling engines for production of electricity; Electricity generating apparatus utilizing solar power for production of electricity".

The wording “Electricity generating apparatus utilizing solar power, namely stirling engine powered electrical generators, for production of electricity; Electricity generating apparatus utilizing solar power, namely stirling engines for production of electricity; Electricity generating apparatus utilizing solar powered stirling engines for production of electricity; Electricity generating apparatus utilizing solar power for production of electricity” in the amended identification of goods and/or services is definite but unacceptable because it does not set forth goods and/or services in the international class assigned by the International Bureau (IB). *See* 37 C.F.R. §2.71(a); TMEP §1904.02(c)(iv).

In an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and/or services from that assigned by the IB in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). The scope of the identification for purposes of permissible amendments is limited by the assigned international class. 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends the identification to a class other than that assigned by the IB, the amendment will not be accepted because it will exceed the scope and those goods and/or services will no longer have a basis for registration under U.S. law. TMEP §1402.01(c). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing international class to another. 37 C.F.R. §2.85(d); *see* TMEP §§1402.07(a), 1904.02(c).

Therefore, applicant must amend this wording to identify goods and/or services in International Class 9, the classification specified in the application for these goods and/or services.

For the applicant's convenience, the trademark examining attorney suggests an amendment of applicant's identification of goods that complies with the above-mentioned clarification requirements, with any material additions and deletions highlighted in **bold and italicized type**. Applicant may adopt the following identification, if accurate:

International Class 9: "Electricity generating apparatus utilizing solar power, namely, ~~solar thermal power plants~~ [**specify common commercial name of goods acceptable in Class 9, e.g., photovoltaic solar modules**]; Solar collector for electricity generation; Solar battery chargers; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, production and distribution of electricity, namely, electricity distribution nets in the nature of electrical power distribution units; Apparatus and instruments for supervision, remote control, control and measurement of electricity and energy consumption and for operating power stations, namely, software for monitoring and measuring output of power stations, electrical current and voltage sensors, thermal and pressure sensors; Electricity cables, electric connectors and electric transformers for distribution of electricity and energy for operating power plants"

An applicant may amend an identification of goods and/or services only 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.* In addition, in an application filed under Trademark Act Section 66(a), an applicant may not change the classification of goods and/or services from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and/or services from one existing international class to another. 37 C.F.R. §2.85(d); *see* TMEP §§1402.07(a), 1904.02(c).

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/netahhtml/tidm.html>. *See* TMEP §1402.04.

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.

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