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ETF0424TUS - 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. 79086908

MARK: BFXPERT



CORRESPONDENT ADDRESS:

GEORGE A. PELLETIER; JAMIE E. PLATKIN
CANTOR COLBURN LLP
20 CHURCH STREET, 22ND FLOOR
HARTFORD, CT 06103

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

APPLICANT: PAUL WURTH S.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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CORRESPONDENT E-MAIL ADDRESS:

TM-CT@cantorcolburn.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 11/29/2011
INTERNATIONAL REGISTRATION NO. 1049854

PARTIAL REFUSAL

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) made final in the Office action dated May 05, 2011 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

Based on the applicant's amendments and arguments, the examining attorney has withdrawn the refusal under §2(d) and request for information requirement. However, in the present case, applicant's request has not resolved all the outstanding issue(s) as to the identification of goods and services in the final Office action. Accordingly, the request is denied. As noted below, the following portions of the applicant's identification of goods and services remain unacceptable.

Identification of Goods and Services – Clarification Required:

The identification of goods and/or services contains parentheses. Generally, parentheses and brackets should *not* be used in identifications. Parenthetical information is permitted in identifications only 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. Therefore, applicant must remove the parentheses from the identification of goods and/or services and incorporate the parenthetical information into the description.

The wording “and/or” from the listing “support, control and/or drive mechanisms for loading machines for blast furnace throats, namely, loading mechanisms for throats without bells for the iron and steel industry, ferrous and non-ferrous metallurgical industry” in the International Class 07 identification of goods needs clarification because it is indefinite. TMEP §§1402.01 and 1402.03.

The wording “machinery and machine tools for steelworks for the iron and steel industry, ferrous and non-ferrous metallurgical industry” in the International Class 07 identification of goods needs clarification because it is indefinite and does not adequately describe the function of the goods. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of goods to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. TMEP §1402.01. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify goods by generic or common commercial name and field of use*].”

The wording “blowing nozzles” in the International Class 07 identification of goods needs clarification because it is too broad and could include goods classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of goods to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. TMEP §1402.01. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify goods by generic or common commercial name and field of use*].”

The wording “machinery for producing steel” in the International Class 07 identification of goods needs clarification because it is indefinite and does not adequately describe the function of the goods. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of goods to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. TMEP §1402.01. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify goods by generic or common commercial name and field of use*].”

The wording “electric scissors and saws” in the International Class 07 identification of goods needs clarification because it is too broad and could include goods classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of goods to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. TMEP §1402.01. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify goods by generic or common commercial name and field of use*].”

The wording “components” from the listing “and components of turbines” in the International Class 07 identification of goods needs clarification because it is too broad and could include goods classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of goods to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. TMEP §1402.01. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify goods by generic or common commercial name and field of use*].”

The wording “evaporating steal” in the International Class 07 appears to be a misspelling of “evaporating steel” in identification of goods. Clarification is required.

The wording in the International Class 11 identification of goods needs clarification because it is also found in International Class 07. TMEP §§1402.01 and 1402.03. It should be noted that the goods are properly classified in International Class 07. Therefore, the examining attorney recommends International Class 11 should be deleted from the application.

The wording “fitting suspension cables and transport cables, aerial cables and overhead transmission lines for the iron and steel industry, ferrous and non-ferrous metallurgical industry” in the International Class 37 identification of services needs clarification because it is too broad and could include services classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of services to specify the nature of the services as well as their main purpose and their particular field of use or channels of trade. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify services by generic or common commercial name and field of use*].” 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 services in the corresponding international registration. TMEP §§1401.03(d) and 1904.02(b). Therefore, any modification to this wording must identify services in properly classified in the original International Class specified in the application for these services.

The underlined wording “building and repair services for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, improving efficiency and performance for existing power generation equipment the erection of fittings for primary and secondary emission reduction measures, increasing the service life and the level of automation of industrial machinery, environmental technology machinery and power generating plants” in the International Class 37 identification of services needs clarification because it is too broad and could include services classified in other international classes. TMEP §§1402.01 and 1402.03. Applicant must clarify the identification of services to specify the nature of the services as well as their main purpose and their particular field of use or channels of trade. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [*specify services by generic or common commercial name and field of use*].”

The wording “consulting in the field of the metallurgy and steel” and “consulting services in the field of building and technical project studies for the iron and steel industry, ferrous and non-ferrous metallurgical industry for industrial installations, power plants and environmental technology installations” in the International Class 42 identification of services needs clarification because it is too broad and could include services classified in other international classes. TMEP §§1402.01 and 1402.03. The wording “consulting” or “consultation” in the identification of services is indefinite and must be clarified. *See* TMEP §1402.01. Consulting services are classified according to the subject matter of the consulting service. TMEP §1402.11(e). Following are examples of proper classification: “business consultation” -- International Class 35; “financial consultation” -- International Class 36; and “computer consultation” -- International Class 42.

Therefore, in order to enable proper classification and examination of the application, applicant must specify the subject matter of the “consulting” or “consultation” services.

Please note: In accordance with the abovementioned requirements, the examining attorney has indicated acceptable changes to the applicant’s identification of goods and services below in bold font. Applicant may adopt the following identification of goods and services, if accurate:

Class 07: “Steel and metalworking machines and machine tools; motors, other than for land vehicles; machine coupling and transmission components except for land vehicles, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry; equipment for blast furnaces, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, equalization valves for blast furnace installations and closing mechanisms for blast furnace throats; **support, control and/or drive mechanisms for loading machines for blast furnace throats, namely, loading mechanisms for throats without bells for the iron and steel industry, ferrous and non-ferrous metallurgical industry**; equalization valves and gates for blast furnaces, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely; exhaust valves for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, valves as part of machine components; machines for stopping the taphole, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry; borers for holes for casting for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, tap hole drilling machines; lubrication machines for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machines for processing and filtering slag for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machines for transport and injection of powdered materials by pneumatic means in a tank furnace for the iron and steel industry, ferrous and non-ferrous metallurgical industry; slag granulation machines for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machinery and machine tools for steelworks **in the**

nature of metalworking for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machinery and machine tools for vacuum ladle treatment of cast iron and steel for the iron and steel industry, ferrous and non-ferrous metallurgical industry; continuous casting machines for steel for the iron and steel industry, ferrous and non-ferrous metallurgical industry; crushing and screening machines and machine tools for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machines for blowing refining gases into steel converters not for land vehicles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; **machine parts, namely**, blowing nozzles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; installations and apparatus for changing blowing nozzles, namely, brushes being parts of machines, roller bearings for changing blower nozzles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; steel and metalworking machine tools for fitting a refractory lining on the interior walls of a furnace for the iron and steel industry, ferrous and non-ferrous metallurgical industry; rolling cranes and bridges for special use for metallurgy; machinery for processing fine ore particles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machinery for producing pig iron using direct reduction for the iron and steel industry, ferrous and non-ferrous metallurgical industry; **metal working machines, namely**, machinery for producing steel for the iron and steel industry, ferrous and non-ferrous metallurgical industry; processing and agglomerating plants for iron ores and non-iron ores, coal, lime, dolomite, magnesite and cryolith, fluidized beds, and sintering plants for the iron and steel industry, ferrous and non-ferrous metallurgical industry; steel and metalworking machines and installations for producing moulded refractory forms, for making briquettes and stopper heads and granulating, mixing machines for pig iron, steel, alloys and slag, converters for manufacturing steel and iron alloys, loaders for use in metallurgy, machine parts, namely, nozzles for blowers and heaters for use in metallurgy for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machinery for collecting and suction of lost gas for use in metallurgy for the iron and steel industry, ferrous and non-ferrous metallurgical industry; casting ladles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; power-operated dispensers for pig iron and steel for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machinery for regulating and oscillating chill-moulds for the iron and steel industry, ferrous and non-ferrous metallurgical industry; dummy bars for the iron and steel industry, ferrous and non-ferrous metallurgical industry; machines for rolling steel and non-ferrous metal alloys; rolling mills for the iron and steel industry, ferrous and non-ferrous metallurgical industry; cages for rolling mills for the iron and steel industry, ferrous and non-ferrous metallurgical industry; metal welding machines and abrading machines for the iron and steel industry, ferrous and non-ferrous metallurgical industry; **machine parts, namely** electric scissors and saws

for the iron and steel industry, ferrous and non-ferrous metallurgical industry for shearing billets from continuous casting, sheet metal, strips, sections, joists, tubes and cables; mechanical winders and machines for forming coils of metal strips for the iron and steel industry; steel and metalworking machine tools; machine for tools, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, lathes, drilling machines, hydraulic powered engines and motors for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, hydraulic controls for machines, motors and engines; turbines, namely, turbines using hydraulics, gas and steam and components of turbines, **namely, {indicate specific components}** other than land vehicles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; shut-off devices and speed controllers for turbines other than for land vehicles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; rotors and guide vanes for turbines other than for land vehicles for the iron and steel industry, ferrous and non-ferrous metallurgical industry; locks, namely, control and shutdown components for turbines, **namely, {indicate specific components}** other than for land vehicles; screen-cleaning machines; elevating and descending work platforms; cranes; trucks for roller bridges; winches; capstans and pulleys for machines; machines for processing and recovering waste; dust removal machines for the purpose of blowing dust off industrial parts, workstations or wherever necessary; composting machines; dust extraction machines for the iron and steel industry, ferrous and non-ferrous metallurgical industry; thickening and evaporating steel and metalworking machines for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electricity generators, namely, generators using turbines, hydraulics, motor-driven and turbogenerators, three-phase motors, direct and alternating current motors; plants using gas and steam, namely, gas and steam operated power generators for the iron and steel industry, ferrous and non-ferrous metallurgical plants; electric motors for machines” and

Class 09: “Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, **checking/supervision**, life-saving and teaching apparatus and instruments for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, computer software for analyzing, optimizing and controlling the operation of blast furnaces; computer software for checking, controlling, monitoring, measuring, regulating, weighing, and metering blast furnace installations and metallurgy installations for the iron and steel industry, ferrous and non-ferrous metallurgical industry; profilometers for the iron and steel industry, ferrous and non-ferrous metallurgical industry; probing installations and apparatus for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, gas probes, solid material sampling probes, and mechanical probes for blast furnaces; mechanical

profilometers for the iron and steel industry, ferrous and non-ferrous metallurgical industry; transformers; electric batteries, batteries, electric switches, without contact with gas; electric switches; power-line transmission machines and apparatus; electric conductors, especially braided or twisted wires, bars for transposed electric conductors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; braided electrical conductors, insulated electrical cables; electric installations for the remote control of industrial operations; rectifiers, converters, inverters; test instruments for the iron and steel industry, ferrous and non-ferrous metallurgical industry for measuring for physical parameters, especially, temperature, pressure and humidity, and for chemical analyses not included in other classes; computer hardware apparatus for controlling, regulating, simulating, visualizing and monitoring parameters of industrial installations, environmental protection installations, installations for producing, distributing and transmitting power, machines and components thereof; computer programs for controlling, regulating, visualizing and monitoring processes in industrial installations, environmental technology installations, power plants and machines and components thereof; computer programs for computers for simulating and visualizing industrial installations, especially metallurgy installations, environmental technology installations, power plants, machines and apparatus; personal computers, minicomputers, microcomputers, computer monitors, keyboards and computer mice, printers, modems, volatile and non-volatile semi-conductor computer memory, blank disks, blank floppy disk drives, fiber optics, namely, fiber optics cables for use in the iron and steel industry, ferrous and non-ferrous metallurgical industry, all above-mentioned goods for controlling, regulating, simulating, visualizing and monitoring parameters of industrial installations, environmental protection installations, installations for producing, distributing and transmitting power, as well as machines and components thereof; electronic components, namely, integrated circuits and printed circuits for use in industrial installations, environmental protection installations, installations for producing, distributing and transmitting power, as well as in machines and components thereof” and

Class 11: ~~“[Duplicate listing from Class 07] Support, control and/or drive mechanisms for loading machines for blast furnace throats, namely, loading mechanisms for throats without bells for the iron and steel industry, ferrous and non-ferrous metallurgical industry” and~~

Class 37: “Maintenance and repair of metalworking machines and tools; installation services, namely, of metalworking machines and tools for the iron and steel industry, ferrous and non-ferrous metallurgical industry; providing technical support concerning the installation, repair and maintenance of electric or electronic apparatus, equipment and devices used for automated or partly automated industrial operations for the iron and steel industry,

ferrous and non-ferrous metallurgical industry; installation of electrical apparatus, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry; installation of pipes for liquid or gaseous mediums, namely, for the iron and steel industry, ferrous and non-ferrous metallurgical industry; servicing of products and/or apparatus, namely, steel and metalworking products and/or apparatus for the electricity and electronics industry, the precision engineering industry and general mechanics; maintenance and repair of environmental technology machinery for the iron and steel industry, ferrous and non-ferrous metallurgical industry; maintenance and repair of power plants, buildings, dwellings, tall buildings, hydraulic buildings, bridge building, electrical installations, water purification installations, waste water treatment, and waste gas purification plants for the iron and steel industry, ferrous and non-ferrous metallurgical industry, as well as biomass and composting plants for the iron and steel industry, ferrous and non-ferrous metallurgical industry; installing, servicing and repair of installations for metallurgy, steel and metalworking machines, bridges, cranes and ducts; demolition of buildings while recovering materials from industrial, nuclear, metallurgy and environmental protection installations; servicing, maintenance and repair of electric and electronic machines for industrial installations, metallurgy installations, environmental protection installations, installations for producing, distributing and transmitting power; **installation of** suspension cables and transport cables, aerial cables and overhead transmission lines for the iron and steel industry, ferrous and non-ferrous metallurgical industry; maintaining, and repair of computer and data processing installations being computer hardware for industrial installations, metallurgy installations, environmental technology installations, installations for producing, distributing and transmitting power and machines; **modification** and repair services for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, **modification and repair services for** improving efficiency and performance for existing power generation equipment **and the installation** of fittings for primary and secondary emission reduction measures, **for** increasing the service life and the level of automation of industrial machinery, environmental technology machinery and power generating plants” and

Class 42: “Research and analysis for the iron and steel industry, ferrous and non-ferrous metallurgical industry; design and development of computer hardware and software; architectural design drawing by computer for the iron and steel industry, ferrous and non-ferrous metallurgical industry; research and design services in the field of the metallurgy and steel; **technology consultation in the field of** metallurgy and steel; data conversion of computer programs and data; computer programming; drafting of reports in the field of blast furnaces in the metallurgy and steel industry; material testing, namely, analysis services for mechanical,

physical and chemical properties of materials in connection with activities in the area of metallurgy; design and development of data-processing programs, especially via computing, for others; **technology consultation in the field of** building and technical project studies for the iron and steel industry, ferrous and non-ferrous metallurgical industry for industrial installations, power plants and environmental technology installations; drafting and design of metallurgic installations, machines, bridges, cranes and conduits; design of technical process models for the iron and steel industry, ferrous and non-ferrous metallurgical industry for industrial installations, power plants and environmental technology installations; drafting of technical plans in the field of data processing for industrial installations, metallurgy installations, environmental protection installations, installations for producing, distributing and transmitting power and machines; computer software consultancy for industrial installations, metallurgy installations, environmental protection installations, installations for producing, distributing and transmitting power and machines; computer programming for computer installations for the purpose of controlling, regulating, simulating, visualizing and monitoring parameters of industrial installations, environmental protection installations, installations for producing, distributing and transmitting power, machines and components thereof; consulting services in the fields of implementation of computer hardware and software systems for others for the iron and steel industry, ferrous and non-ferrous metallurgical industry for industrial installations, metallurgic installations, environmental protection installations, installations for producing, distributing and transmitting power, and machines; rental of computer installations and computer software for controlling, regulating, simulating, visualizing and monitoring parameters of industrial installations, technical installations, installations for producing, distributing and transmitting power, machines and components thereof; installation and maintenance of software for controlling, regulating, simulating, visualizing and monitoring parameters of industrial installations, installations for producing, distributing and transmitting power, machines and components thereof; creation of intranet and internet pages in the field of industrial installations, environmental protection installations, installations for producing, distributing and transmitting power, and machines; technical development and design of electrical installations; drafting of plans for technical project studies regarding components for insertion for primary and secondary measures for emission reduction, increasing the life and degree of automation of industrial and environmental technology installations and power plants; product quality inspection for industrial installations, materials testing, waste water quality control, exhaust gas and air quality control”

§66 (a) Applications – Classification for Good/Services cannot be Changed (Advisory)

Please note: 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 in the corresponding international registration. TMEP §§1401.03(d) and 1904.02(b). Therefore, any modification to this wording must identify goods in properly classified in the original International Class specified in the application for these goods.

PTO Online Searching Manual:

For aid in selecting acceptable identifications of goods and services and determining proper classification, the searchable Manual of Acceptable Identifications of Goods and Services is available on the PTO website at <http://tess2.uspto.gov/netathtml/tidm.html>.

Please also 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 or services that are not within the scope of the goods and services recited in the present identification.

Request for Reconsideration Advisory:

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).

/Dominic Fathy/
Trademark Examining Attorney
Law Office 104
571-272-8801 (phone)
571-273-8801 (fax)
dominic.fathy@uspto.gov