

From: Rosenberg, Miah

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Subject: U.S. TRADEMARK APPLICATION NO. 79118716 - SILSON - UDLZ 500084U - Request for  
Reconsideration Denied - Return to TTAB

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Files: 79118716.doc

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

**U.S. APPLICATION SERIAL NO.** 79118716

**MARK:** SILSON



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**APPLICANT:** SILSON LIMITED

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

UDLZ 500084U

**CORRESPONDENT E-MAIL ADDRESS:**

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 12/6/2013

**INTERNATIONAL REGISTRATION NO.** 1131234

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)(2)(B), (a)(2)(E), 715.04(a). The partial requirement(s) and/or refusal(s) made final in the Office action dated May 9, 2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 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.

Applicant's amended identification of goods and services is still indefinite. In particular, the wording "membranes" in International Class 9 is indefinite as is "x-ray filters" and "diffractive optics such as gratings and zoneplates" for the reasons specified in the earlier Office actions. Applicant may amend to the following:

International Class 9: Scientific instruments, namely, **cellular mixed ester** membranes of silicon nitride, silicon carbide, boron nitride, polysilicon **all used in the science and research industry; X-ray apparatus not for medical purposes, namely, x-ray filters for filtering out some or all wavelengths in the x-ray spectrum;** diffractive optics **being [specify the common commercial name of these goods, e.g., fiber diffractive optics or delete this entry]** such as gratings and zoneplates; scientific instruments, namely, microfluidic cells in the nature of small devices that allow fluids to flow through channels and membranes, heater cells being two membranes having heaters patterned into their surfaces, and test specimens being patterned membranes used to test the resolution and aberrations of an optical system, all for use in synchrotrons, accelerator mass spectrometers, electron and optical microscopes; ultra-thin membranes of silicon nitride, silicon carbide, boron nitride, polysilicon, **for use in** x-ray microscopy, electron and optical microscopy and accelerator mass spectrometry; optical specimen carriers for use in optical instruments; laboratory equipment, namely, microscope slides; vacuum windows, namely, ultra-thin membranes of silicon nitride, silicon carbide, boron nitride, polysilicon **for use in** x-ray microscopy, electron and optical microscopy and accelerator

mass spectrometry; filter carriers, namely, carriers for **x-ray apparatuses not for medical purposes, namely, x-ray filters for filtering out some or all wavelengths in the x-ray spectrum**; structural and replacement parts for all the aforesaid goods;

International Class 37: Installation, maintenance and repair of scientific and optical apparatus and instruments, namely, synchrotrons, microscopes, x-ray microscopes, optical microscopes, electron microscopes and spectrometers; installation, maintenance and repair of structural and replacement parts for the aforesaid goods;

International Class 42: Scientific research; technology research, namely, research and development of technology in the field of ultra-thin membranes, lithographic products and microelectromechanical technology; and design relating thereto, namely, design of ultra thin membranes, lithographic products; technology research, namely, research and development of technology in the field of microelectromechanical technology and micro-fluidic and heater cells

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 §1904.02(c)(iv). In an application filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 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 International Bureau, 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), 1904.02(c).

In addition, in a Section 66(a) application, 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), 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); TMEP §§1401.03(d), 1402.01(c).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

## RESPONSE

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, (a)(2)(B), (a)(2)(E), (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)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

/Miah Rosenberg/

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