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Subject: U.S. TRADEMARK APPLICATION NO. 79122826 - FLUTEC - N/A - 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**

U.S. APPLICATION SERIAL NO. 79122826

MARK: FLUTEC



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Hydac Fluidtechnik GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/31/2016

INTERNATIONAL REGISTRATION NO. 1141942

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. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement made final in the Office action dated September 21, 2015 is maintained and continue to be final: identification of goods. See TMEP §§715.03(a)(ii)(B), 715.04(a). The Section 2(d) refusal is withdrawn based on the deletion of International Class 9. See TMEP §§715.03(a)(ii)(B), 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.

Clarification of Identification of Goods Required

International Class 4

No changes are required in International Class 4.

International Class 6

The wording " *housings and parts therefor in particular in the form of storage housings and filter housings for pneumatic and hydraulic apparatus, namely, metal storage tanks and housings*" in the identification of goods is too broad because it could include housings for pneumatic and hydraulic machines in International Class 7; applicant must amend this wording to specify items in International Class 6 only or delete "housings". See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

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). Therefore, any modification to this wording must identify goods in International Class 6, the classification specified in the application for these goods.

International Class 7

The wording "*hydropneumatic storage units being parts of pneumatically and hydraulically operated machines*" in the identification of goods is indefinite and must be amended to specify the type of machine that the units are parts of, merely specifying the means by which the machines operate is not sufficiently definite. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

The wording “*hydraulic accumulators, as parts of a wide variety of machines used in power applications, lubricators and coolers, namely, piston accumulators, bladder accumulators, diaphragm accumulators, bellows accumulators, spring accumulator*” in the identification of goods is outside the scope of the original wording, which specifies the goods are for “including in the field of offshore and deep sea applications,” while the proposed amendment does not contain this limitation. See 37 C.F.R. §2.71(a); TMEP §§1402.01(c), 1904.02(c)(iv). Therefore, the original identification in the U.S. application as filed, or as acceptably amended, remains operative for purposes of future amendment. See 37 C.F.R. §2.71(a); TMEP §§1402.01(b), 1402.07(d).

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).

Therefore, any modification to this wording must identify goods in International Class 7, the classification specified in the application for these goods.

International Class 11

No changes are required in International Class 11.

International Class 16

No changes are required in International Class 16.

Sample Amended Identification

Applicant may adopt the following identification, *if accurate*:

International Class 4: Industrial oils and greases; motor oils; lubricants, namely, all purpose lubricants and industrial cooling lubricants, and refrigeration lubricants; dust absorbing, wetting,

and binding compositions, namely, dust-binding compositions; fuels, including motor and spirit fuels, and illuminants, namely, lighting fuel; lubricating oils

International Class 6: Ironmongery and small items of metal hardware, namely screws; fittings of metal for fastening storage units, filters, valves and control blocks, and gas, liquid and electronic conduits, namely, metal screws; mechanical fastening elements of metal; metal clips for connecting hydraulic and pneumatic system parts; hose couplings and connections, namely, metal hose connection fittings; metal storage tanks, namely hydraulic tanks; *housings and parts therefor in particular in the form of storage housings and filter housings for pneumatic and hydraulic apparatus, namely, metal storage tanks and ___ [specify type of housing in this class, e.g., prefabricated metal structures for storing pneumatic and hydraulic apparatus]*

International Class 7: Fluid-engineering, gas-engineering and lubrication-engineering installations and components of all kinds, in this class, in particular for use in the automobile industry, including mobile hydraulics, the semiconductor industry, the food industry, aeronautics, medicine, pharmacy, oil and gas transport technology, environmental engineering, laboratory and testing technology, household and sanitary systems, machine tools, transfer presses and plastic injection moulding machines, namely, hydraulic and pneumatic valve actuators and power pumps for power applications, lubricating pumps for lubrication applications, and cooling pumps for cooling machines; *hydropneumatic storage units being parts of pneumatically and hydraulically operated ___ [specify function of machines, e.g., mechanical discharging hopper machines, bottling machines, hoisting machines]; hydraulic accumulators, as parts of a wide variety of machines used in power applications, lubricators and coolers, namely, piston accumulators, bladder accumulators, diaphragm accumulators, bellows accumulators, spring accumulators, in the field of offshore and deep sea applications;* accumulator installations consisting of hydraulic accumulators, being parts of machines including for offshore and deep sea machines; hydraulic, hydropneumatic and reflective sound, vibration and pressure dampers, namely, shock absorbers for machines and silencers for machines; shut-off equipment, shut-off apparatus, shut-off valves and switch-over devices, namely valves being parts of machines for pneumatic and hydraulic fuels and media, namely, flow control valves, priority valves, shuttle valves, seat valves and slide valves, throttle valves, directional control valves, check valves, pressure valves, pressure control valves and pressure limiting valves, and vent valves; hydraulic and pneumatic control apparatus being parts of machines, in particular for hydraulic and pneumatic installations, namely, hydraulic and pneumatic valve control blocks for controlling hydraulic and pneumatic machines; power and mechanically operated clamping apparatus, clamping machines and clamping tools, namely, clamps with movable jaws for retaining parts and workpieces on industrial machines; motor-driven hydraulic pressure and feed pumps, adjustable and non-adjustable, as parts of machines; hydraulic drive units for elevator controllers, transport controllers and lift controllers, in particular including a hydraulic pump, a drive motor and a liquid container of metal or plastic; machines for industrial washing and cleaning, namely, pressure washers for cleaning industrial equipment; electric motors for industrial machines

International Class 11: Gas-technical installations and components, all the aforesaid goods included in this class, in particular for use in the automobile industry, including mobile hydraulics, the semiconductor industry, the food industry, aeronautics, medicine, pharmacy, oil and gas transport technology, environmental engineering, laboratory and testing technology, household and sanitary systems, and in mining and in the field of steelworks, power plants, wind-power installations, machine tools, transfer presses and plastic injection moulding machines, namely, pressure regulators for gas installations; heat exchangers for stationary and mobile applications for exchanging heat between liquid and/or gaseous media; cooling and heating installations for media therein, namely, heat exchangers not as parts of machines

International Class 16: Filter materials of paper for liquid, gaseous and paste media

An applicant may only amend an identification to clarify or limit the goods and/or services, but not to add to or broaden the scope of the goods and/or services. 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 an 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/netahhtml/tidm.html>. See TMEP §1402.04.

Appeal Resumed

As applicant has filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

/April Roach/

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