

To: Börner Distribution; International GmbH (docketingtm@hdp.com)
Subject: U.S. TRADEMARK APPLICATION NO. 79143258 - BÖRNER GERMANY - 16810-200007
Sent: 7/26/2015 9:39:51 AM
Sent As: ECOM112@USPTO.GOV
Attachments:

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

U.S. APPLICATION SERIAL NO. 79143258

MARK: BÖRNER GERMANY

79143258

CORRESPONDENT ADDRESS:

ELIZABETH K BROCK
HARNESS DICKEY & PIERCE PLC
5445 CORPORATE DRIVE SUITE 200
TROY, MI 48098

CLICK HERE TO RESPOND TO THIS 1
<http://www.uspto.gov/trademarks/teas/response>

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Börner Distribution; International GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO :

16810-200007

CORRESPONDENT E-MAIL ADDRESS:

docketingtm@hdp.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 7/26/2015

THIS IS A FINAL ACTION.

INTERNATIONAL REGISTRATION NO. 1193799

This Office action is in response to applicant's communication filed on June 16, 2015, in which applicant submitted:

1. Clarification of its legal entity type and country of organization; and,

2. A proposed amended identification of goods

Applicant's response to number 1 above is accepted and made of record in satisfaction of the previously issued requirement therefor. For the reasons below, however, the requirement for clarification of the identification of goods/services must be maintained and made final with respect to particular wording in International Class 005, as amended. 37 C.F.R. §2.63(b).

PARTIAL FINAL REQUIREMENT FOR CLARIFICATION OF THE IDENTIFICATION OF GOODS/SERVICES – PARTICULAR INDICATED WORDING IN CLASS 005 ONLY

As amended, the identification of goods/services in International Class 005 appears as follows:

- *International Class 005*: Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; **supplemental dietetic beverages, namely, weight loss beverages and health beverages adapted for medical purposes; dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, supplemental weight loss beverages and supplemental health beverages; beverages adapted for medical purposes, namely, supplemental weight loss beverages and supplemental health beverages**; medicinal drinks; medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss

The above-bolded wording in the identification of goods and/or services is indefinite and must be clarified because the wording "health beverages" is vague and does not adequately specify the type of applicant's goods. 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 and/or services in International Class 032, the classification specified in the application for these goods and/or services.

The following substitute wording is suggested, if accurate:

- *International Class 005*: Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; **supplemental dietetic beverages, namely, weight loss beverages and health beverages for {further clarify purpose or type of "health beverages," such as for "promoting digestion"}; dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, supplemental weight loss beverages**

and supplemental health beverages for {further clarify purpose or type of “health beverages,” such as for “promoting digestion”}; beverages adapted for medical purposes, namely, supplemental weight loss beverages and supplemental health beverages for {further clarify purpose or type of “health beverages,” such as for “promoting digestion”}; medicinal drinks; medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss

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).

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

PROPER RESPONSE TO FINAL OFFICE ACTION – PARTIAL ABANDONMENT ADVISORY

Applicant must respond within six months of the date of issuance of this final Office action or the following goods to which the final refusal(s) and/or requirement(s) apply will be **deleted** from the application by Examiner’s Amendment:

- *From International Class 005: supplemental dietetic beverages, namely, weight loss beverages and health beverages adapted for medical purposes; dietetic foods adapted for medical purposes, namely, dietary and nutritional supplements, dietary and nutritional supplements used for weight loss, supplemental weight loss beverages and supplemental health beverages; beverages adapted for medical purposes, namely, supplemental weight loss beverages and supplemental health beverages*

37 C.F.R. §2.65(a); *see* 15 U.S.C. §1062(b).

The application will then proceed for the following goods:

- *International Class 005: Pharmaceutical and veterinary preparations, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; foodstuffs and dietetic substances for medical or veterinary purposes, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss; food for babies; dietary supplements for humans and animals; medical preparations for slimming purposes; appetite suppressants for medical purposes; medicinal drinks; medicinal additives, namely, dietary and nutritional supplements, and dietary and nutritional supplements used for weight loss*
- *International Class 032: non-alcoholic beverages, namely, fruit juice, whey beverages ; fruit beverages and fruit juices; syrups and other preparations for making beverages in the nature of syrup substitutes for making beverages; energy drinks not for medical purposes; beverages in the nature of fruit juice, whey beverages enriched with additional minerals not being for medical use;*

beverages enriched with added trace elements in the nature of fruit juice, whey beverages not for medical purposes; beverages enriched with added vitamins in the nature of fruit juice, whey beverages not for medical purposes; isotonic beverages not for medical purposes

- *International Class 033*: Alcoholic beverages except beers
- *International Class 035*: Advertising; business management; business administration; business consultancy in relation to others engaged in the business distribution industry; wholesale retail store services, retail store services and online retail store services in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages; arranging of trading and economical contacts, namely, business networking, and conducting trade show exhibitions and online trade show exhibitions in the fields of chemicals and medical products, cosmetics, household apparatus and household goods, printed matter, foodstuffs and beverages

Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements and/or resolves all outstanding refusals.
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.63(b)(1)-(2); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Kevin S. Corwin/
Trademark Examining Attorney
Law Office 112
571-270-1521 (Voice)
571-270-2521 (Fax)
Kevin.Corwin@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **7/26/2015** FOR U.S. APPLICATION SERIAL NO. 79143258

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **7/26/2015** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.