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Subject: U.S. TRADEMARK APPLICATION NO. 79149213 - TETRA - 056476.09575 - 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. 79149213

MARK: TETRA



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Tetra GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:

056476.09575

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/21/2015

INTERNATIONAL REGISTRATION NO. 1208960

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reason stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following partial requirement made final in the Office action dated March 10, 2015 is maintained and continues to be final: partial identification amendment requirement. *See* TMEP

§§715.03(a)(ii)(B), 715.04(a). The disclaimer withdrawal and the Section 2(f) in part claim are accepted and have been made of record. The refusal made final in the Office action is withdrawn: Section 2(d) refusal. See TMEP §§715.03(a)(ii)(B), 715.04(a).

Identification of Goods

THIS REQUIREMENT APPLIES ONLY TO THE GOODS SPECIFIED HEREIN.

The wording “heating apparatus with integrated thermostats for use in indoor aquaria and terraria, namely, water heaters and thermostats to be used in indoor aquaria, terraria and garden ponds” in the identification of goods is indefinite and must be clarified because applicant has removed the limitation that the thermostats be integrated, resulting in separate goods, namely, water heaters and thermostats, and thermostats are in a different international class. See TMEP §1402.01.

The wording “electrical water filters and systems composed thereof and of filters, filter cartridges, filter pads and water pumps for use in indoor aquaria, terraria and garden ponds” and “water filter and systems composed thereof and of filters, filter cartridges, filter pads and water pumps for use in indoor aquaria, garden ponds and terraria” in the identification of goods is indefinite and must be clarified because the type of filters, filter cartridges, and filter pads must be specified. See TMEP §1402.01.

The wording “fountain filtration sets comprised of filters, filter cartridges, water pumps and fountains” in the identification of goods is indefinite and must be clarified because (1) the type of filters and filter cartridges must be specified; and (2) a fountain would not be part of a fountain filtration set. Accordingly, this wording is beyond the scope of the original identification, as amended. See TMEP §1402.01.

Particular wording in the proposed amendment to the identification is not acceptable because it is indefinite and the change in classification of such goods exceeds the scope of the identification in the initial application. See 37 C.F.R. §§2.71(a), 2.85(d), (f); TMEP §§1401.03(d), 1402.07(a), 1904.02(b)-(c), (c)(iv). The original identification in the application, and any previously accepted amendments, remain operative for purposes of future amendment. See TMEP §§1402.07(d), 1904.02(c)(iv).

An acceptable identification of goods and/or services is required in a U.S. application based on Trademark Act Section 66(a). See 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01(c). For Section

66(a) applications, the scope of the identification for purposes of amendment is limited by the international class assigned to the goods and/or services 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). Thus, in a Section 66(a) application, the classification of goods and/or services may not be changed from that assigned by the International Bureau. See 37 C.F.R. §2.85(d), (f); TMEP §§1401.03(d), 1402.07(a), 1904.02(b)-(c). Further, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Specifically, applicant proposed amending the wording “decoration material for use in indoor aquaria, terraria and garden ponds” in International Class 21 to “decoration material, namely, artificial landscapes, artificial plants and flowers, water lilies, ornaments, for use in indoor aquaria, terraria and garden ponds.” However, some of these revised goods are normally classified in a different international class; i.e., International Class 26, 31, and others. Thus, the proposed amendment is beyond the scope of the original identification because it references goods in a class different from that originally assigned by the International Bureau.

In addition, the proposed amended wording “ornaments, for use in...garden ponds” is indefinite because it is broad and includes goods in other international classes. See TMEP §1402.01.

Applicant may respond by deleting the unacceptable goods in International Class 21. See TMEP §1904.02(c)(iv). If this issue is being made final, applicant may appeal to the Trademark Trial and Appeal Board under 37 C.F.R. §§2.141, 2.142, or petition the Director under 37 C.F.R. §2.146 if permitted by 37 C.F.R. §2.63(b)(2). TMEP §1904.02(c)(iv).

If applicant believes classification by the International Bureau was in error, applicant may contact the International Bureau and request correction of, or recordation of a limitation to, the international registration. TMEP §1904.02(c)(iv), (e)(i)-(e)(ii). However, filing such a request with the International Bureau is not considered a formal response to this Office action. See TMEP §1904.02(c)(iv), (e)(iii). Applicant must also file a timely and complete response to this Office action, stating that applicant has filed a request for a correction or to record a limitation with the International Bureau that will resolve the outstanding issue. See 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03, 1904.02(c)(iv), (e)(iii).

Applicant may adopt the following identification, if accurate:

Fertilizers for aquatic plants for use in indoor aquaria, terraria and garden ponds; fertilizers for ornamental plants; water conditioners for use in indoor aquaria and garden ponds; chemical test kits for testing ammonia, nitrite, nitrate, pH alkalinity, hardness and/or calcium in water for non-medical and non-veterinary use; water softeners and decalcifiers for use in indoor aquaria, terraria and garden ponds; bacteria and preparations containing bacteria for use in water treatment for non-medical and non-veterinary use; test strips for testing water in indoor aquaria, garden ponds and terraria. International Class 1.

Electric membrane pumps for use in indoor aquaria; electric air pumps and water pumps for use in indoor aquaria, terraria and garden ponds; water aeration systems comprising water pumps and air compressors for use in indoor aquaria, terraria and garden ponds; draining apparatus, namely, electric pumps for use in garden ponds. International Class 7.

Electrical timers for filters used in indoor aquaria, terraria and garden ponds. International Class 9.

Lighting, heating and aerating apparatus to be used in indoor aquaria, terraria and garden ponds, namely, aquarium lights, terrarium lights and lights to be used in garden ponds, water heaters to be used in indoor aquaria, terraria and garden ponds, electric heaters to be used in terraria, water treatment units for aerating and circulating water in indoor aquaria, terraria and garden ponds; automatic temperature regulators to be used in indoor aquaria, terraria and garden ponds; air filters, water filters to be used in indoor aquaria, terraria and garden ponds; heating apparatus with integrated thermostats for use in indoor aquaria and terraria, namely, water heaters ~~and~~ **with integrated** thermostats to be used in indoor aquaria, terraria and garden ponds, electric heaters to be used in terraria; electrical water filters and systems composed thereof and of **water** filters, **water** filter cartridges, **water** filter pads and water pumps for use in indoor aquaria, terraria and garden ponds; UV light bulbs for use in indoor aquaria, terraria and garden ponds; string lights for use in garden ponds; water filter and systems composed thereof and of **water** filters, **water** filter cartridges, **water** filter pads and water pumps for use in indoor aquaria, garden ponds and terraria; fountain filtration sets comprised of **water** filters, **water** filter cartridges, water pumps ~~and fountains~~; filter pads in the nature of replacement pads for water filters for use in water filters in indoor aquaria, terraria and garden ponds; artificial waterfalls and fountains. International Class 11.

Planting baskets for use in garden ponds; decoration material, namely, artificial landscapes, ~~artificial plants and flowers, water lilies~~, ornaments, for use in indoor aquaria, terraria and garden ponds; **decoration material, namely, ornaments of _____ (specify china, crystal, glass, porcelain, terra cotta)**

for use in garden ponds; decoration material, namely, basking platforms for use in terraria; indoor aquarium bowls; aquaria and tanks for fish keeping; artificial reefs to be used as decorative material in indoor aquaria. International Class 21.

Foam sealant for use in garden ponds and pond liners. International Class 17.

Fish nets for use in indoor aquaria and garden ponds. International Class 22.

In a Trademark Act Section 66(a) application, classification of goods and/or services may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

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 §§1402.06 *et seq.*, 1402.07.

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.

Accordingly, in the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. Accordingly, the request is denied.

If applicant has already 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).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any

outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

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