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Subject: U.S. TRADEMARK APPLICATION NO. 85769283 - HYCLONE - 66247-0181 - 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. 85769283

MARK: HYCLONE



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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: HyClone Laboratories, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

66247-0181

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 4/14/2014

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 limited requirements made final in the Office action dated July 9, 2013, are maintained and continue to be final with respect to the following goods only:

International Class 9

Laboratory, biological pilot plant and biological production equipment, namely, bags of plastic for use in holding biological material and related reagents for the purpose of producing biological materials for medical therapeutic or clinical diagnostic use

See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

International Class 9, in this instance, is limited to laboratory goods and apparatus for scientific research. The inclusion of the wording "biological pilot plant and biological production equipment" as well as the presence of the wording "for medical therapeutic or clinical diagnostic use" suggests either equipment used in a production environment, or medical apparatus. As such, these goods would not be classified in International Class 9 alone.

Applicant may adopt one of the following identifications of goods with respect to the identified wording, if accurate:

International Class 9

Laboratory, biological pilot plant and biological production equipment for medical laboratory use, namely, plastic laboratory bags for use in holding biological material and related reagents for the purpose of producing biological materials for medical therapeutic or clinical diagnostic use

International Class 10

Biological pilot plant and biological production equipment for medical therapeutic use, namely, plastic bags for use in holding biological material and related reagents for medical therapeutic or clinical diagnostic use

Identifications of goods can be amended only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

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

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all the requirements below for those international classes based on use in commerce:

- (1) LIST GOODS BY INTERNATIONAL CLASS: Applicant must list the goods by international class.
- (2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of goods not covered by the fee(s) already paid (confirm current fee information at http://www.uspto.gov/trademarks/tm_fee_info.jsp).
- (3) SUBMIT REQUIRED STATEMENTS AND EVIDENCE: For each international class of goods, applicant must also submit the following:
 - (a) DATES OF USE: Dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class. The dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application.

- (b) SPECIMEN: One specimen showing the mark in use in commerce for each international class of goods. Applicant must have used the specimen in commerce at least as early as the filing date of the application. If a single specimen supports multiple international classes, applicant should indicate which classes the specimen supports. Examples of specimens for services are signs, photographs, brochures, website printouts, or advertisements that show the mark used in the actual sale or advertising of the services. See TMEP §§1301.04 *et seq.*
- (c) STATEMENT: The following statement: **“The specimen was in use in commerce on or in connection with the goods listed in the application at least as early as the filing date of the application.”**
- (d) VERIFICATION: Applicant must verify the statements in 3(a) and 3(c) (above) in an affidavit or signed declaration under 37 C.F.R. §2.20. Verification is not required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, and (2) the original specimens are acceptable for the added class(es).

See 15 U.S.C. §§1051(a), 1112, 1127; 37 C.F.R. §§2.32(a)(5), 2.34(a)(1), 2.56(a), 2.71(c), 2.86(a), 2.193(e)(1); TMEP §§1403.01, 1403.02(c).

With respect to the specimen requirement in 3(b) above in which a specimen is required for each international class of goods, the specimen(s) of record is acceptable for International Classes 1, 9, and 10 only. Applicant must submit additional specimens if different international classes are added to the application.

Note: Applicant has paid for **two (2)** classes.

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.

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 or overcome any outstanding final requirement(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).

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