
To: C.S. Lewis Pte Ltd. (lisa.w.rosaya@bakernet.com)
Subject: TRADEMARK APPLICATION NO. 77219331 - THE VOYAGE OF THE DA - 56187370-12
Sent: 3/31/2009 8:19:16 PM
Sent As: ECOM117@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/219331

MARK: THE VOYAGE OF THE DA

CORRESPONDENT ADDRESS:
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RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: C.S. Lewis Pte Ltd.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**
56187370-12
CORRESPONDENT E-MAIL ADDRESS:
lisa.w.rosaya@bakernet.com

OFFICE ACTION

TO AVOID PARTIAL ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 3/31/2009

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on March 16, 2009. The examining attorney has reviewed applicant's request for reconsideration and determined the following: Applicant's amended identification of goods in Class 3 has been accepted and made of record. In addition, the examining attorney has carefully reviewed applicant's arguments with regard to the identification refusals in Classes 14 and 20 and has found them unpersuasive for the reasons given below. Therefore the refusal that portions of the identification exceed the scope of the identification as originally filed is now made FINAL.

SCOPE ISSUES CLASSES 14 AND 20

The proposed amendment to the identification cannot be accepted because it refers to goods and/or services that are not within the scope of the identification that was set forth in the application at the time of filing. See 37 C.F.R. §2.71(a).

The amendment identifies the following goods and/or services: "beads for use in the manufacture of jewelry" in Class 14 and "throw pillows, cushions, sleeping bags" in Class 20. This wording is beyond the scope of the original wording because "jewelry" does not encompass items used in the manufacture of jewelry and "throw pillows, cushions, sleeping bags" cannot be considered "furniture or goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics".

Identifications can be amended 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. *Id.*; see TMEP §§1402.06 *et seq.*, 1402.07. Therefore, this wording should be deleted from the identification.

APPLICANT'S ARGUMENTS

Applicant contends that the amendments to the identification should be allowed because the application was filed prior to the September 2007 update to TMEP §1402.07(a). As such applicant argues that under TMEP §1402.14 the identification must be examined on the basis of the facts and evidence that existed at the time of filing.

The examining attorney agrees with the proposition that the identification must be examined according to the rules in place at the time of filing. However, the update and additions to TMEP §1402.07(a) merely reflect the codification of generally accepted Office practice and relevant case law. In addition, the update does not contradict the policies in place at the time of applicant's filing. Specifically, the "ordinary meaning" test which states that "for the purpose of determining the scope of an identification, the examining attorney should consider the ordinary meaning of the wording apart from the class designation" was in place as of applicant's filing date. TMEP §1402.07(a) (4th ed. 2005). Moreover, applicant has provided no evidence of any prior existing policy enabling applicants to amend to any item in a particular class when the original identification of goods includes the entire class heading. Therefore registration must be refused for the items listed above.

"TMEP" refers to the Office's *Trademark Manual of Examining Procedure* (5th ed. 2007), available on the United States Patent and Trademark Office website at www.uspto.gov/main/trademarks.htm. The TMEP is a detailed administrative manual written by the Office to explain the laws and procedures that govern the trademark/service mark application, registration and post registration processes.

This refusal is now made FINAL.

RESPONSE TO FINAL ACTION

If applicant does not respond within six months of the mailing date of this final Office action, the following goods to which the final refusal(s) and/or requirement(s) apply will be **deleted** from the application by Examiner's Amendment: "beads for use in the manufacture of jewelry" in Class 14 and "throw pillows, cushions, sleeping bags" in Class 20. The application will then proceed for the remaining goods. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a).

Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); 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).

/Blake Lovelace/
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RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 3/31/2009 FOR
APPLICATION SERIAL NO. 77219331

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77219331&doc_type=OOA&mail_date=20090331 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable **response time period**. Your response deadline will be calculated from **3/31/2009**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

1. The USPTO will NOT send a separate e-mail with the Office action attached.
2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.