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Subject: Request for Remand SN 78519745

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/519745

APPLICANT: ZOE International Ministries



CORRESPONDENT ADDRESS:

Ken Dallara
Law Office of Ken Dallara
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21704 Golden Triangle Road
Santa Clarita CA 91350

**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: ZOE

CORRESPONDENT'S REFERENCE/DOCKET NO: ZOE

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

kdallara@dallaralaw.com

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S REQUEST FOR REMAND

The trademark examining attorney requests that the Trademark Trial and Appeal Board remand this case to the examining attorney under 37 C.F.R. §2.142(d) for the following reasons(s):

The amended recitation of services in International Classes 41 and 43 is outside the scope of the original identification, but was not addressed in the final office action. Thus, the examining attorney requests remand to issue a subsequent non-final office action to correct the recitation of services (see the attached proposed office action).

Respectfully submitted,

Gina Hayes
Trademark Examining Attorney
Law Office 112
571-272-9407

(Angela Wilson, Managing Attorney)

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Commissioner for Trademarks
P.O. Box 1451
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MARK: ZOE

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OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

RE: Serial Number 78/519745

Case Remanded to Examining Attorney

The Trademark Trial and Appeal Board remanded the case to the examining attorney for issuance of this non-final office action addressing the recitation of services. The examiner apologizes for the inconvenience and delay caused by this subsequent action.

Recitation of Services

The applicant applied to register the mark ZOE (and design) for "language instruction, religious instruction services, vocational education, production of radio and television programs, production & distribution of motion pictures, presentation of live show performances, and publishing of books, magazines, and

newspapers” in International Class 41 and “charitable services, namely, housing for children” in International Class 35.

The first office action advised the applicant that “vocational education” in International 41 was indefinite. In addition, the examiner noted that the Class 35 services were improperly classified and that the recitation was indefinite. In response the applicant sought to amend its services in International Class 41 as indicated below (the italicized wording represents wording determined to be outside the scope of the initial identification):

International Class 41

Language Instruction, Religious Instructional Services, Vocational education in the field of husbandry, and basic home building skills, Charitable services, namely, providing training in the field of languages, religion *and hygiene skills, development and dissemination of educational materials of others in the field of languages, religion and hygiene skills, Education services, namely, providing classes in the field of languages, religion and hygiene skills, Production of radio and television programs, Publication of books, of magazines, of journals, of newspapers, of periodicals, of catalogs, of brochures, Charitable services, namely, providing arts and crafts and educational materials to needy and underprivileged children, and presentation of live show performances.*

The proposed amendment of the identification is unacceptable because the italicized wording above designates services that are not within the scope of the identification that was set forth in the application. While an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07.

The applicant may amend to adopt the following in International Class 41, if accurate:

- **Language instruction, religious instructional services, vocational education in the field of husbandry and basic home building skills; charitable services, namely, providing training in the field of languages and religion; production of radio and television programs; publication of books, magazines, and newspapers; presentation of live show performances.**

International Class 43

In addition, the applicant sought to amend its recitation in International Class 43 to “providing temporary housing accommodation for children and young adults / arranging temporary housing accommodations for children and young adults, charitable services, namely, *providing food, clothing* and housing to needy persons, Emergency shelter services, namely, providing temporary housing, *clothing and food, Providing temporary accommodation.”* This proposed amendment is unacceptable because providing food and clothing is outside the scope of the identification that was set forth in the application. Also, the applicant’s initial identification indicated that the services were specifically directed towards children. Thus, the amended identification must be similarly narrowed.

The applicant may amend to adopt the following in International Class 43, if accurate:

- **Charitable services, namely, providing housing to needy children; emergency shelter services, namely, providing temporary housing for children; providing temporary accommodations for children.**

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

Assistance

Applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the trademark examining attorney; (2) the serial number of this application; (3) the mailing date of this Office action; and, (4) applicant's telephone number. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action through the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov/teas/index.html>.

/Gina C. Hayes/
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<<http://www.uspto.gov/teas/index.html>> (file responses)
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