

Response to Office Action SATA App. No. 88233620

Applicant SATA Tool (Shanghai) Ltd. (“Applicant”) hereby responds to the United States Patent and Trademark Office Action dated March 14, 2019 with respect to the mark SATA, application No. 88/233,623 (the “Application”). The Applicant responds to the issues raised in the Office Action as follows.

I. **Incorrect Classification**

Applicant agrees to delete the goods “vice bench of metal” from the Application.

II. **Identification of Goods**

Applicant proposes the following revisions to some of the specification of goods that the Examiner believes are indefinite:

- Applicant agrees with the Examiner’s request to revise “nipple” to “metal nipple”
- Applicant agrees with the Examiner’s request to revise “shims” to “metal shims”
- Applicant agrees with the Examiner’s request to revise “ironmongery” to “ironmongery in the nature of small items of metal hardware, namely, screws, fasteners, nuts, bolts, washers”
- Applicant agrees with the Examiner’s request to revise “tool chests of metal” to “tool chests of metal sold empty”
- Applicant proposes revising “tool handles of metal” to “tool handles of metal for hand-held hand tools”
- Applicant proposes revising “containers of metal” to “containers of metal for storing tools”

Applicant has also noted the Examiner’s request to revise “colophony wire” to “colophony solder wire.” However, Applicant would like to draw the Examiner’s attention to the original specification of goods as filed being “colophony soldering wire” which should satisfy the Examiner’s request.

However, Applicant respectfully disagrees that the following enumerated goods are indefinite and require clarification: “props of metal; nozzles of metal; sleeves; jets of metal; building materials of metal; washers of metal.”

First, all of the aforementioned goods are enumerated using standard descriptions under Nice Classification, as shown below:

- ☞ 060372 **props** of metal
- ☞ 060014 **nozzles** of metal
- ☞ 060092 **sleeves** [metal hardware]
- ☞ 060021 **jets** of metal
- ☞ 060291 **building** materials of metal
- ☞ 060037 **washers** of metal

Second, TMEP rules states that the identification of goods “should set forth common names, using terminology that is generally understood,” and specifically states that “lengthy descriptions of characteristics or uses are not appropriate.” TMEP § 1402.01. The goods “props,” “nozzles,” “sleeves,” “jets,” and “washers” are all already specified using a common commercial or generic name, as should be

evidenced in part by their listing in Nice (discussed above). Any attempt to further explain these goods would simply overcomplicate the description of a good that is commonly known and used by consumers, which is precisely what TMEP § 1402.01 advises against.

Finally, the USPTO has accepted most of these goods in other registrations without requiring any unnecessary clarification, including the following:

- HUANUO, Reg. No. 5338637 and PERLESMITH, Reg. No. 5322179, both covering “props of metal” in Class 6
- WILD TRIBE, Reg. No. 5305624 and XALOY, Reg. No. 4981693, both covering “nozzles of metal” in Class 6
- GIRAFFE TOOLS, Reg. No. 5338764, and GNUTTI, Reg. No. 4374057, both covering “jets of metal” in Class 6
- X'TRA, Reg. No. 5277419, covering “washers of metal” in Class 6

Copies of these registration certifications and TSDR pages showing the registrations are still active are attached hereto as Exhibit A. The Examiner should follow the precedent of these registrations and approve the goods props of metal; nozzles of metal; sleeves; jets of metal; building materials of metal; washers of metal” without any need for unnecessary clarification.

III. Multiple-Class Application

Based on the deletions and revisions of the goods set forth in Applicant’s response, the Application does not identify goods in more than one international class. All of the remaining goods are properly classified in international class 006.

IV. Translation of Foreign Certificate

A translated copy of the underlying foreign registration is included with Applicant’s response.

V. Conclusion

Applicant has responded to the Office Action in full and believes this response addresses and satisfies all of the issues raised by the Examiner. Applicant requests that the Application now be approved for publication.