

# **Chapter 1400**

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### **1401 Classification**

#### **1401.01 Statutory Authority**

Section 30 of the Trademark Act, 15 U.S.C. §1112, provides authority for establishing a classification system. That section states, in part, as follows:

The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights.

#### **1401.02 International Trademark Classification Adopted**

As of September 1, 1973, the international classification of goods and services is the primary classification used by the United States, and it applies to all applications filed on or after September 1, 1973, and their resulting registrations, for all statutory purposes. See 37 C.F.R. §2.85(a). Unless otherwise indicated, references in this manual to class refer to the international class.

Prior to September 1, 1973, the United States used its own classification of goods and services, which is different from the international classification. The prior United States classification continues to govern for all statutory purposes for trademark applications filed on or before August 31, 1973, and all registrations issued on the basis of an application filed on or before August 31, 1973, unless the owner of the registration amends the registration to adopt international classification. 37 C.F.R. §2.85(b).

If a registration issued under the United States classification system, the owner of the registration may voluntarily amend to reclassify under the international classification system, pursuant to §7(e) of the Trademark Act, 15 U.S.C. §1057(e), if the owner pays the required fee. 37 C.F.R. §§2.6 and 2.85(e)(3). See TMEP §1609.04.

Classification schedules are set forth in Part 6 of the Trademark Rules of Practice. See 37 C.F.R. §6.1 for the international classification schedule for goods and services, 37 C.F.R. §6.2 for the prior United States classification schedule for goods and services, 37 C.F.R. §6.3 for certification marks, and 37 C.F.R. §6.4 for collective membership marks.

#### **1401.02(a) Headings of International Trademark Classes**

International trademark classification, and the headings of the international trademark classes, are established by the Committee of Experts of the Nice Union and set forth in the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (9th ed. 2006), published by the World Intellectual Property Organization ("WIPO"). See TMEP §1401.02(c) for further information.

The general remarks, class numbers, class headings, and explanatory notes for each international trademark class are as follows. (The word or words in parentheses following the class numbers are short titles for the classes that are used exclusively in the United States Patent and Trademark Office ("USPTO") and are not part of the official text of the Nice Union classes. See TMEP §1401.02(b).)

## **GENERAL REMARKS**

The indications of goods or services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to ascertain the exact classification of each individual product or service.

### *Goods*

If a product cannot be classified with the aid of the List of Classes, the Explanatory Notes and the Alphabetical List, the following remarks set forth the criteria to be applied:

- (a) A finished product is in principle classified according to its function or purpose. If the function or purpose of a finished product is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.
- (b) A finished product which is a multipurpose composite object (e.g., clocks incorporating radios) may be classified in all classes that correspond to any of its functions or intended purposes. If those functions or purposes are not mentioned in any class heading, other criteria, indicated under (a), above, are to be applied.
- (c) Raw materials, unworked or semi-worked, are in principle classified according to the material of which they consist.
- (d) Goods intended to form part of another product are in principle classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, the criterion indicated under (a), above, applies.
- (e) When a product, whether finished or not, is classified according to the material of which it is made, and it is made of different materials, the product is in principle classified according to the material which predominates.
- (f) Cases adapted to the product they are intended to contain are in principle classified in the same class as the product.

## *Services*

If a service cannot be classified with the aid of the List of Classes, the Explanatory Notes and the Alphabetical List, the following remarks set forth the criteria to be applied:

- (a) Services are in principle classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List.
- (b) Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Cl. 38).
- (c) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.

## **GOODS**

### **CLASS 1**

#### **(Chemicals)**

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

#### *Explanatory Note*

Class 1 includes mainly chemical products used in industry, science and agriculture, including those which go to the making of products belonging to other classes.

*This Class includes, in particular:*

- compost;
- salt for preserving other than for foodstuffs.

*This Class does not include, in particular:*

- raw natural resins (Cl. 2);
- chemical products for use in medical science (Cl. 5);
- fungicides, herbicides and preparations for destroying vermin (Cl. 5);
- adhesives for stationery or household purposes (Cl. 16);
- salt for preserving foodstuffs (Cl. 30);
- straw mulch (Cl. 31).

## **CLASS 2**

### **(Paints)**

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

#### *Explanatory Note*

Class 2 includes mainly paints, colorants and preparations used for the protection against corrosion.

*This Class includes, in particular:*

- paints, varnishes and lacquers for industry, handicrafts and arts;
- dyestuffs for clothing;
- colorants for foodstuffs and beverages.

*This Class does not include, in particular:*

- unprocessed artificial resins (Cl. 1);
- laundry blueing (Cl. 3);
- cosmetic dyes (Cl. 3);
- paint boxes (articles for use in school) (Cl. 16);
- insulating paints and varnishes (Cl. 17).

## **CLASS 3**

### **(Cosmetics and cleaning preparations)**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

#### *Explanatory Note*

Class 3 includes mainly cleaning preparations and toilet preparations.



*This Class includes, in particular:*

- deodorants for personal use;
- sanitary preparations being toiletries.

*This Class does not include, in particular:*

- chemical chimney cleaners (Cl. 1);
- degreasing preparations for use in manufacturing processes (Cl. 1);
- deodorants other than for personal use (Cl. 5);
- sharpening stones and grindstones (hand tools) (Cl. 8).

## **CLASS 4**

### **(Lubricants and fuels)**

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.

#### *Explanatory Note*

Class 4 includes mainly industrial oils and greases, fuels and illuminants.

*This Class does not include, in particular:*

- certain special industrial oils and greases (consult the Alphabetical List of Goods).

## **CLASS 5**

### **(Pharmaceuticals)**

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

#### *Explanatory Note*

Class 5 includes mainly pharmaceuticals and other preparations for medical purposes.

*This Class includes, in particular:*

- sanitary preparations for personal hygiene, other than toiletries;
- deodorants other than for personal use;
- cigarettes without tobacco, for medical purposes.

*This Class does not include, in particular:*

- sanitary preparations being toiletries (Cl. 3);
- deodorants for personal use (Cl. 3);
- supportive bandages (Cl. 10).

## **CLASS 6**

### **(Metal goods)**

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

#### *Explanatory Note*

Class 6 includes mainly unwrought and partly wrought common metals as well as simple products made of them.

*This Class does not include, in particular:*

- bauxite (Cl. 1);
- mercury, antimony, alkaline and alkaline-earth metals (Cl. 1);
- metals in foil and powder form for painters, decorators, printers and artists (Cl. 2).

## **CLASS 7**

### **(Machinery)**

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

#### *Explanatory Note*

Class 7 includes mainly machines, machine tools, motors and engines.

*This Class includes, in particular:*

- parts of motors and engines (of all kinds);
- electric cleaning machines and apparatus.

*This Class does not include, in particular:*

- certain special machines and machine tools (consult the Alphabetical List of Goods);
- hand tools and implements, hand-operated (Cl. 8);
- motors and engines for land vehicles (Cl. 12).

## **CLASS 8**

### **(Hand tools)**

Hand tools and implements (hand-operated); cutlery; side arms; razors.

#### *Explanatory Note*

Class 8 includes mainly hand-operated implements used as tools in the respective professions.

*This Class includes, in particular:*

- cutlery of precious metals;
- electric razors and clippers (hand instruments).

*This Class does not include, in particular:*

- certain special instruments (consult the Alphabetical List of Goods);
- machine tools and implements driven by a motor (Cl. 7);
- surgical cutlery (Cl. 10);
- paper knives (Cl. 16);
- fencing weapons (Cl. 28).

## **CLASS 9**

### **(Electrical and scientific apparatus)**

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

### *Explanatory Note*

*This Class includes, in particular:*

- apparatus and instruments for scientific research in laboratories;
- apparatus and instruments for controlling ships, such as apparatus and instruments for measuring and for transmitting orders;
- the following electrical apparatus and instruments:
  - (a) certain electrothermic tools and apparatus, such as electric soldering irons, electric flat irons which, if they were not electric, would belong to Class 8;
  - (b) apparatus and devices which, if not electrical, would be listed in various classes, i.e., electrically heated clothing, cigar-lighters for automobiles;
- protractors;
- punched card office machines;
- amusement apparatus adapted for use with an external display screen or monitor;
- all computer programs and software regardless of recording media or means of dissemination, that is, software recorded on magnetic media or downloaded from a remote computer network.

*This Class does not include, in particular:*

- the following electrical apparatus and instruments:
  - (a) electromechanical apparatus for the kitchen (grinders and mixers for foodstuffs, fruit presses, electrical coffee mills, etc.), and certain other apparatus and instruments driven by an electrical motor, all coming under Class 7;
  - (b) electric razors and clippers (hand instruments) (Cl. 8);
  - (c) electric toothbrushes and combs (Cl. 21);
  - (d) electrical apparatus for space heating or for the heating of liquids, for cooking, ventilating, etc. (Cl. 11);
- clocks and watches and other chronometric instruments (Cl. 14);
- control clocks (Cl. 14).

## **CLASS 10**

### **(Medical apparatus)**

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

#### *Explanatory Note*

Class 10 includes mainly medical apparatus, instruments and articles.

*This Class includes, in particular:*

- special furniture for medical use;
- hygienic rubber articles (consult the Alphabetical List of Goods);
- supportive bandages.

## **CLASS 11**

### **(Environmental control apparatus)**

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

#### *Explanatory Note*

*This Class includes, in particular:*

- air conditioning apparatus;
- bedwarmers, hot water bottles, warming pans, electric or non-electric;
- electrically heated cushions (pads) and blankets, not for medical purposes;
- electric kettles;
- electric cooking utensils.

*This Class does not include, in particular:*

- steam producing apparatus (parts of machines) (Cl. 7);
- electrically heated clothing (Cl. 9).

## **CLASS 12**

### **(Vehicles)**

Vehicles; apparatus for locomotion by land, air or water.

### *Explanatory Note*

*This Class includes, in particular:*

- motors and engines for land vehicles;
- couplings and transmission components for land vehicles;
- air cushion vehicles.

*This Class does not include, in particular:*

- certain parts of vehicles (consult the Alphabetical List of Goods);
- railway material of metal (Cl. 6);
- motors, engines, couplings and transmission components other than for land vehicles (Cl. 7);
- parts of motors and engines (of all kinds) (Cl. 7).

## **CLASS 13**

### **(Firearms)**

Firearms; ammunition and projectiles; explosives; fireworks.

### *Explanatory Note*

Class 13 includes mainly firearms and pyrotechnical products.

*This Class does not include, in particular:*

- matches (Cl. 34).

## **CLASS 14**

### **(Jewelry)**

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

### *Explanatory Note*

Class 14 includes mainly precious metals, goods in precious metals not included in other classes and, in general jewellery, clocks and watches.

*This Class includes, in particular:*

- jewellery (i.e., imitation jewelry and jewelry of precious metal and stones);
- cuff links, tie pins.

*This Class does not include, in particular:*

- goods in precious metals classified according to their function or purpose, for example, metals in foil and powder form for painters, decorators, printers and artists (Cl. 2), amalgam of gold for dentists (Cl. 5), cutlery (Cl. 8), electric contacts (Cl. 9), pen nibs of gold (Cl. 16), teapots (Cl. 21), gold and silver embroidery (Cl. 26), cigar boxes (Cl. 34);
- objects of art not of precious metals (classified according to the material of which they consist).

## **CLASS 15**

### **(Musical Instruments)**

Musical instruments.

#### *Explanatory Note*

*This Class includes, in particular:*

- mechanical pianos and their accessories;
- musical boxes;
- electrical and electronic musical instruments.

*This Class does not include, in particular:*

- apparatus for the recording, transmission, amplification and reproduction of sound (Cl. 9).

## **CLASS 16**

### **(Paper goods and printed matter)**

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

#### *Explanatory Note*

Class 16 includes mainly paper, goods made from that material and office requisites.

*This Class includes, in particular:*

- paper knives;
- duplicators;

- plastic sheets, sacks and bags for wrapping and packaging.

*This Class does not include, in particular:*

- certain goods made of paper and cardboard (consult the Alphabetical List of Goods);
- colours (Cl. 2);
- hand tools for artists (for example, spatulas, sculptors' chisels) (Cl. 8).

## **CLASS 17**

### **(Rubber goods)**

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

#### *Explanatory Note*

Class 17 includes mainly electrical, thermal and acoustic insulating materials and plastics, being for use in manufacture in the form of sheets, blocks and rods.

*This Class includes, in particular:*

- rubber material for recapping tyres;
- padding and stuffing materials of rubber or plastics;
- floating anti-pollution barriers.

## **CLASS 18**

### **(Leather goods)**

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

#### *Explanatory Note*

Class 18 includes mainly leather, leather imitations, travel goods not included in other classes and saddlery.

*This Class does not include, in particular:*

- clothing, footwear, headgear (consult the Alphabetical List of Goods).



## **CLASS 19**

### **(Nonmetallic building materials)**

Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

#### *Explanatory Note*

Class 19 includes mainly non-metallic building materials.

*This Class includes, in particular:*

- semi-worked woods (for example, beams, planks, panels);
- veneers;
- building glass (for example, floor slabs, glass tiles);
- glass granules for marking out roads;
- letter boxes of masonry.

*This Class does not include, in particular:*

- cement preservatives and cement-waterproofing preparations (Cl. 1);
- fireproofing preparations (Cl. 1).

## **CLASS 20**

### **(Furniture and articles not otherwise classified)**

Furniture, mirrors, picture frames; 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.

#### *Explanatory Note*

Class 20 includes mainly furniture and its parts and plastic goods, not included in other classes.

*This Class includes, in particular:*

- metal furniture and furniture for camping;
- bedding (for example, mattresses, spring mattresses, pillows);
- looking glasses and furnishing or toilet mirrors;
- registration number plates not of metal;
- letter boxes not of metal or masonry.

*This Class does not include, in particular:*

- certain special types of mirrors, classified according to their function or purpose (consult the Alphabetical List of Goods);
- special furniture for laboratories (Cl. 9);
- special furniture for medical use (Cl. 10);
- bedding linen (Cl. 24);
- eiderdowns (Cl. 24).

## **CLASS 21**

### **(Housewares and glass)**

Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

#### *Explanatory Note*

Class 21 includes mainly small, hand-operated utensils and apparatus for household and kitchen use as well as toilet utensils, glassware and articles in porcelain.

*This Class includes, in particular:*

- utensils and containers for household and kitchen use, for example, kitchen utensils, pails, pans of iron, of aluminum, of plastics or of other materials, small hand-operated apparatus for mincing, grinding, pressing, etc.;
- electric combs;
- electric toothbrushes;
- dish stands and decanter stands.

*This Class does not include, in particular:*

- certain goods made of glass, porcelain and earthenware (consult the Alphabetical List of Goods);
- cleaning preparations, soaps, etc. (Cl. 3);
- small apparatus for mincing, grinding, pressing, etc., driven by electricity (Cl. 7);
- razors and shaving apparatus, clippers (hand instruments), metal implements and utensils for manicure and pedicure (Cl. 8);
- cooking utensils, electric (Cl. 11);
- toilet mirrors (Cl. 20).

## **CLASS 22**

### **(Cordage and fibers)**

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

#### *Explanatory Note*

Class 22 includes mainly rope and sail manufacture products, padding and stuffing materials and raw fibrous textile materials.

*This Class includes, in particular:*

- cords and twines in natural or artificial textile fibres, paper or plastics.

*This Class does not include, in particular:*

- certain nets, sacks and bags (consult the Alphabetical List of Goods);
- strings for musical instruments (Cl. 15).

## **CLASS 23**

### **(Yarns and threads)**

Yarns and threads, for textile use.

## **CLASS 24**

### **(Fabrics)**

Textiles and textile goods, not included in other classes; bed and table covers.

#### *Explanatory Note*

Class 24 includes mainly textiles (piece goods) and textile covers for household use.

*This Class includes, in particular:*

- bedding linen of paper.

*This Class does not include, in particular:*

- certain special textiles (consult the Alphabetical List of Goods);
- electrically heated blankets, for medical purposes (Cl. 10) and not for medical purposes (Cl. 11);
- table linen of paper (Cl. 16);

- horse blankets (Cl. 18).

## **CLASS 25**

### **(Clothing)**

Clothing, footwear, headgear.

#### *Explanatory Note*

*This Class does not include, in particular:*

- certain clothing and footwear for special use (consult the Alphabetical List of Goods).

## **CLASS 26**

### **(Fancy goods)**

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

#### *Explanatory Note*

Class 26 includes mainly dressmakers' articles.

*This Class includes, in particular:*

- slide fasteners.

*This Class does not include, in particular:*

- certain special types of hooks (consult the Alphabetical List of Goods);
- certain special types of needles (consult the Alphabetical List of Goods);
- yarns and threads for textile use (Cl. 23).

## **CLASS 27**

### **(Floor coverings)**

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

#### *Explanatory Note*

Class 27 includes mainly products intended to be added as furnishings to previously constructed floors and walls.

*This Class does not include, in particular:*

- wooden flooring (Cl. 19)

## **CLASS 28**

### **(Toys and sporting goods)**

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

#### *Explanatory Note*

*This Class includes, in particular:*

- fishing tackle;
- equipment for various sports and games.

*This Class does not include, in particular:*

- Christmas tree candles (Cl. 4);
- diving equipment (Cl. 9);
- amusement apparatus adapted for use with an external display screen or monitor (Cl. 9);
- electrical lamps (garlands) for Christmas trees (Cl. 11);
- fishing nets (Cl. 22);
- clothing for gymnastics and sports (Cl. 25);
- confectionery and chocolate decorations for Christmas trees (Cl. 30).

## **CLASS 29**

### **(Meats and processed foods)**

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

#### *Explanatory Note*

Class 29 includes mainly foodstuffs of animal origin as well as vegetables and other horticultural comestible products which are prepared for consumption or conservation.

*This Class includes, in particular:*

- milk beverages (milk predominating).

*This Class does not include, in particular:*

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);

- baby food (Cl. 5);
- dietetic substances adapted for medical use (Cl. 5);
- salad dressings (Cl. 30);
- fertilised eggs for hatching (Cl. 31);
- foodstuffs for animals (Cl. 31);
- live animals (Cl. 31).

## **CLASS 30**

### **(Staple foods)**

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

#### *Explanatory Note*

Class 30 includes mainly foodstuffs of plant origin prepared for consumption or conservation as well as auxiliaries intended for the improvement of the flavour of food.

*This Class includes, in particular:*

- beverages with coffee, cocoa or chocolate base;
- cereals prepared for human consumption (for example, oat flakes and those made of other cereals).

*This Class does not include, in particular:*

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- salt for preserving other than for foodstuffs (Cl. 1);
- medicinal teas and dietetic substances adapted for medical use (Cl. 5);
- baby food (Cl. 5);
- raw cereals (Cl. 31);
- foodstuffs for animals (Cl. 31).

## **CLASS 31**

### **(Natural agricultural products)**

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

### *Explanatory Note*

Class 31 includes mainly land products not having been subjected to any form of preparation for consumption, live animals and plants as well as foodstuffs for animals.

*This Class includes, in particular:*

- raw woods;
- raw cereals;
- fertilised eggs for hatching;
- mollusca and crustacea (live).

*This Class does not include, in particular:*

- cultures of micro-organisms and leeches for medical purposes (Cl. 5);
- semi-worked woods (Cl. 19);
- artificial fishing bait (Cl. 28);
- rice (Cl. 30);
- tobacco (Cl. 34).

## **CLASS 32**

### **(Light beverages)**

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

### *Explanatory Note*

Class 32 includes mainly non-alcoholic beverages, as well as beer.

*This Class includes, in particular:*

- de-alcoholised drinks.

*This Class does not include, in particular:*

- beverages for medical purposes (Cl. 5);
- milk beverages (milk predominating) (Cl. 29);
- beverages with coffee, cocoa or chocolate base (Cl. 30).

## **CLASS 33**

### **(Wine and spirits)**

Alcoholic beverages (except beers).

*Explanatory Note*

*This Class does not include, in particular:*

- medicinal drinks (Cl. 5);
- de-alcoholised drinks (Cl. 32).

**CLASS 34**

**(Smokers' articles)**

Tobacco; smokers' articles; matches.

*Explanatory Note*

*This Class includes, in particular:*

- tobacco substitutes (not for medical purposes).

*This Class does not include, in particular:*

- cigarettes without tobacco, for medical purposes (Cl. 5);

**SERVICES**

**CLASS 35**

**(Advertising and business)**

Advertising; business management; business administration; office functions.

*Explanatory Note*

Class 35 includes mainly services rendered by persons or organizations principally with the object of:

- (1) help in the working or management of a commercial undertaking, or
- (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

*This Class includes, in particular:*

- the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through mail order catalogues or by



means of electronic media, for example, through web sites or television shopping programmes.

- services consisting of the registration, transcription, composition, compilation, or systematization of written communications and registrations, and also the compilation of mathematical or statistical data;
- services of advertising agencies and services such as the distribution of prospectuses, directly or through the post, or the distribution of samples. This Class may refer to advertising in connection with other services, such as those concerning bank loans or advertising by radio.

*This Class does not include, in particular:*

- services such as evaluations and reports of engineers which do not directly refer to the working or management of affairs in a commercial or industrial enterprise (consult the Alphabetical List of Services).

## **CLASS 36**

### **(Insurance and financial)**

Insurance; financial affairs; monetary affairs; real estate affairs.

#### *Explanatory Note*

Class 36 includes mainly services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds.

*This Class includes, in particular:*

- services relating to financial or monetary affairs comprise the following:
  - (a) services of all the banking establishments, or institutions connected with them such as exchange brokers or clearing services;
  - (b) services of credit institutions other than banks such as co-operative credit associations, individual financial companies, lenders, etc.;
  - (c) services of “investment trusts,” of holding companies;
  - (d) services of brokers dealing in shares and property;
  - (e) services connected with monetary affairs vouched for by trustees;
  - (f) services rendered in connection with the issue of travellers’ cheques and letters of credit;

- services of realty administrators of buildings, i.e., services of letting or valuation, or financing;
- services dealing with insurance such as services rendered by agents or brokers engaged in insurance, services rendered to insured, and insurance underwriting services.

## **CLASS 37**

### **(Building construction and repair)**

Building construction; repair; installation services.

#### *Explanatory Note*

Class 37 includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings, as well as services rendered by persons or organizations engaged in the restoration of objects to their original condition or in their preservation without altering their physical or chemical properties.

*This Class includes, in particular:*

- services relating to the construction of buildings, roads, bridges, dams or transmission lines and services of undertakings specializing in the field of construction such as those of painters, plumbers, heating installers or roofers;
- services auxiliary to construction services like inspections of construction plans;
- services of shipbuilding;
- services consisting of hiring of tools or building materials;
- repair services, i.e., services which undertake to put any object into good condition after wear, damage, deterioration or partial destruction (restoration of an existing building or another object that has become imperfect and is to be restored to its original condition);
- various repair services such as those in the fields of electricity, furniture, instruments, tools, etc.;
- services of maintenance for preserving an object in its original condition without changing any of its properties (for the difference between this Class and Class 40 see the Explanatory Note of Class 40).

*This Class does not include, in particular:*

- services consisting of storage of goods such as clothes or vehicles (Cl. 39);
- services connected with dyeing of cloth or clothes (Cl. 40).

**CLASS 38**  
**(Telecommunications)**

Telecommunications.

*Explanatory Note*

Class 38 includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which:

- (1) allow one person to talk to another,
- (2) transmit messages from one person to another, and
- (3) place a person in oral or visual communication with another (radio and television).

*This Class includes, in particular:*

- services which consist essentially of the diffusion of radio or television programmes.

*This Class does not include, in particular:*

- radio advertising services (Cl. 35).

**CLASS 39**  
**(Transportation and storage)**

Transport; packaging and storage of goods; travel arrangement.

*Explanatory Note*

Class 39 includes mainly services rendered in transporting people or goods from one place to another (by rail, road, water, air or pipeline) and services necessarily connected with such transport, as well as services relating to the storing of goods in a warehouse or other building for their preservation or guarding.

*This Class includes, in particular:*

- services rendered by companies exploiting stations, bridges, rail-road ferries, etc., used by the transporter;
- services connected with the hiring of transport vehicles;
- services connected with maritime tugs, unloading, the functioning of ports and docks and the salvaging of wrecked ships and their cargoes;
- services connected with the functioning of airports;

- services connected with the packaging and parcelling of goods before dispatch;
- services consisting of information about journeys or the transport of goods by brokers and tourist agencies, information relating to tariffs, timetables and methods of transport;
- services relating to the inspection of vehicles or goods before transport.

*This Class does not include, in particular:*

- services relating to advertising transport undertakings such as the distribution of prospectuses or advertising on the radio (Cl. 35);
- services relating to the issuing of travellers' cheques or letters of credit by brokers or travel agents (Cl. 36);
- services relating to insurances (commercial, fire or life) during the transport of persons or goods (Cl. 36);
- services rendered by the maintenance and repair of vehicles, nor the maintenance or repair of objects connected with the transport of persons or goods (Cl. 37);
- services relating to reservation of rooms in a hotel by travel agents or brokers (Cl. 43).

## **CLASS 40**

### **(Treatment of materials)**

Treatment of materials.

#### *Explanatory Note*

Class 40 includes mainly services not included in other classes, rendered by the mechanical or chemical processing or transformation of objects or inorganic or organic substances.

For the purposes of classification, the mark is considered a service mark only in cases where processing or transformation is effected for the account of another person. A mark is considered a trade mark in all cases where the substance or object is marketed by the person who processed or transformed it.

*This Class includes, in particular:*

- services relating to transformation of an object or substance and any process involving a change in its essential properties (for example, dyeing a garment); consequently, a maintenance service, although usually in Class 37, is included in Class 40 if it entails such a change (for example, the chroming of motor vehicle bumpers);

- services of material treatment which may be present during the production of any substance or object other than a building; for example, services which involve cutting, shaping, polishing by abrasion or metal coating.

*This Class does not include, in particular:*

- repair services (Cl. 37).

## **CLASS 41**

### **(Education and entertainment)**

Education; providing of training; entertainment; sporting and cultural activities.

#### *Explanatory Note*

Class 41 covers mainly services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention.

*This Class includes, in particular:*

- services consisting of all forms of education of persons or training of animals;
- services having the basic aim of the entertainment, amusement or recreation of people;
- presentation of works of visual art or literature to the public for cultural or educational purposes.

## **CLASS 42**

### **(Computer and scientific)**

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

#### *Explanatory Note*

Class 42 includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer programmers, etc.

*This Class includes, in particular:*

- the services of engineers who undertake evaluations, estimates, research and reports in the scientific and technological fields;

- scientific research services for medical purposes.

*This Class does not include, in particular:*

- business research and evaluations (Cl. 35);
- word processing and computer file management services (Cl. 35);
- financial and fiscal evaluations (Cl. 36);
- mining and oil extraction (Cl. 37);
- computer (hardware) installation and repair services (Cl. 37);
- services provided by the members of professions such as medical doctors, veterinary surgeons, psychoanalysts (Cl. 44);
- medical treatment services (Cl. 44);
- garden design (Cl. 44);
- legal services (Cl. 45).

### **CLASS 43**

#### **(Hotels and restaurants)**

Services for providing food and drink; temporary accommodation.

#### *Explanatory Note*

Class 43 includes mainly services provided by persons or establishments whose aim is to prepare food and drink for consumption and services provided to obtain bed and board in hotels, boarding houses or other establishments providing temporary accommodation.

*This Class includes, in particular:*

- reservation services for travellers' accommodation, particularly through travel agencies or brokers;
- boarding for animals.

*This Class does not include, in particular:*

- rental services for real estate such as houses, flats, etc., for permanent use (Cl. 36);
- arranging travel by tourist agencies (Cl. 39);
- preservation services for food and drink (Cl. 40);
- discotheque services (Cl. 41);
- boarding schools (Cl. 41);
- rest and convalescent homes (Cl. 44).

## **CLASS 44**

### **(Medical, beauty & agricultural)**

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

#### *Explanatory Note*

Class 44 includes mainly medical care, hygienic and beauty care given by persons or establishments to human beings and animals; it also includes services relating to the fields of agriculture, horticulture and forestry.

*This Class includes, in particular:*

- medical analysis services relating to the treatment of persons (such as x-ray examinations and taking of blood samples);
- artificial insemination services;
- pharmacy advice;
- animal breeding;
- services relating to the growing of plants such as gardening;
- services relating to floral art such as floral compositions as well as garden design.

*This Class does not include, in particular:*

- vermin exterminating (other than for agriculture, horticulture and forestry) (Cl. 37);
- installation and repair services for irrigation systems (Cl. 37);
- ambulance transport (Cl. 39);
- animal slaughtering services and taxidermy (Cl. 40);
- timber felling and processing (Cl. 40);
- animal training services (Cl. 41);
- health clubs for physical exercise (Cl. 41);
- scientific research services for medical purposes (Cl. 42);
- boarding for animals (Cl. 43);
- retirement homes (Cl. 43).

## **CLASS 45**

### **(Personal)**

Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

### *Explanatory Note*

*This Class includes, in particular:*

- services rendered by lawyers to individuals, groups of individuals, organizations and enterprises;
- investigation and surveillance services relating to the safety of persons and entities;
- services provided to individuals in relation with social events, such as social escort services, matrimonial agencies, funeral services.

*This Class does not include, in particular:*

- professional services giving direct aid in the operations or functions of a commercial undertaking (Cl. 35);
- services relating to financial or monetary affairs and services dealing with insurance (Cl. 36);
- escorting of travellers (Cl. 39);
- security transport (Cl. 39);
- services consisting of all forms of education of persons (Cl. 41);
- performances of singers and dancers (Cl. 41);
- computer services for the protection of software (Cl. 42);
- services provided by others to give medical, hygienic or beauty care for human beings or animals (Cl. 44);
- certain rental services (consult the Alphabetical List of Services and General Remark (b) relating to the classification of services).

### **1401.02(b) Short Titles for International Trademark Classes**

The USPTO associates the following word titles with the respective international trademark class numbers:

#### *GOODS*

1. Chemicals
2. Paints
3. Cosmetics and cleaning preparations
4. Lubricants and fuels
5. Pharmaceuticals
6. Metal goods
7. Machinery
8. Hand tools
9. Electrical and scientific apparatus
10. Medical apparatus
11. Environmental control apparatus
12. Vehicles
13. Firearms



14. Jewelry
15. Musical instruments
16. Paper goods and printed matter
17. Rubber goods
18. Leather goods
19. Non-metallic building materials
20. Furniture and articles not otherwise classified
21. Housewares and glass
22. Cordage and fibers
23. Yarns and threads
24. Fabrics
25. Clothing
26. Fancy goods
27. Floor coverings
28. Toys and sporting goods
29. Meats and processed foods
30. Staple foods
31. Natural agricultural products
32. Light beverages
33. Wines and spirits
34. Smokers' articles

#### SERVICES

35. Advertising and business
36. Insurance and financial
37. Building construction and repair
38. Telecommunications
39. Transportation and storage
40. Treatment of materials
41. Education and entertainment
42. Computer and scientific
43. Hotels and restaurants
44. Medical, beauty and agricultural
45. Personal and legal

These short titles are not an official part of the international classification. Their purpose is to provide a means to quickly identify the general content of numbered international classes. By their nature, these titles will not necessarily disclose the classification of specific items. The titles are not designed to be used for classification, but only as information to assist in the identification of numbered classes. To determine the classification of particular goods and services, it is necessary to refer to the Alphabetical List of Goods and Services, the class headings of the international classes, and Explanatory Notes in the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (9th ed. 2006), published by WIPO. The full names of international classes are set forth in 37 C.F.R. §6.1.

The short titles are printed in the *Official Gazette* in association with the international class numbers under MARKS PUBLISHED FOR OPPOSITION, Sections 1 and 2; TRADEMARK REGISTRATIONS ISSUED, PRINCIPAL REGISTER, Section 1; TRADEMARK REGISTRATIONS ISSUED UNDER SECTION 1(d), Sections 1 and 2; and SUPPLEMENTAL REGISTER, Sections 1 and 2.

The international trademark classification was adopted by the United States as its system of classification as of September 1, 1973. See 911 TMOG 210 (June 26, 1973). The use of short titles was announced in a notice at 924 TMOG 155 (July 16, 1974).

#### **1401.02(c) International Alphabetical List**

Additional general guidance concerning identifications may be found in the “Alphabetical List” of goods and services appearing in the *International Classification of Goods and Services for the Purposes of the Registration of Marks Under the Nice Agreement-Part I* (9<sup>th</sup> ed. 2006), published by the World Intellectual Property Organization, 34, chemin des Colombettes, 1211 Geneva 20 Switzerland. (Specify the English edition when ordering.) The *International Classification* is available at <http://www.wipo.int/classifications/en/index.html>. However, because the international list was developed to *classify* goods and services and not to identify specific goods and services, most entries will not be sufficiently definite to use in an *identification* of goods and/or services. If such entries are provided as identifications, the USPTO exercises its discretion to require greater particularity. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007).

The USPTO’s [Acceptable Identification of Goods and Services Manual](#) (“USPTO ID Manual”) should be used to determine whether an identification is sufficiently definite. See TMEP §1402.04.

#### **1401.03 Designation of Class**

In an application for registration of a mark, the applicant should designate the international class number(s) that are appropriate for the identified goods and/or services whenever the information is known. 37 C.F.R. §2.32(a)(7). See TMEP §1401.02(a) for the international classification schedule with explanatory notes.

In an application under §1 or §44, incorrect classification will be corrected by amendment. See TMEP §1401.03(b).

**1401.03(a) Designation of Class by Applicant Normally Initially Accepted in Applications Under §§1 and 44**

Sometimes, a product could be classified in more than one class. Some products are classified differently depending on the type of material of which the product is composed, or a particular use of the product. For example, plastic statuettes are in Class 20 while glass statuettes are in Class 21; reagents for research purposes are in Class 1 while reagents for medical use are in Class 5. Generally, in applications under §1 or §44 of the Trademark Act, prior to their assignment to an examining attorney, the USPTO retains the class number designated by the applicant, in the absence of any information clearly contradicting that classification. The applicant may be asked for further clarification for classification of goods of this type during the examination of the application. If the wording in the identification is broad enough to encompass more than one class, amendment will be required. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (“chronographs” held indefinite because it includes both time recording devices in Class 9 and watches in Class 14). Also, if the examining attorney determines that the class designated by the applicant is incorrect, the examining attorney will require reclassification.

**1401.03(b) Designation of Class by USPTO When Class Number Is Not Designated or Is Inaccurate in Application Under §1 or §44**

In an application under §1 or §44 of the Trademark Act, if the applicant does not designate a class number(s), the USPTO will do so. If the class number(s) indicated by the applicant is clearly wrong (e.g., goods are classified in a service class), the USPTO will change the classification, either prior to or during examination.

Upon examination, the classification must be amended if the class numbers are incorrect. When the examining attorney requires or recommends an amendment of the identification of goods and/or services that would necessitate an amendment of the classification, the examining attorney should also require the applicant to amend the classification.

If an incorrect class number was designated by the Pre-Examination Section, and the examining attorney must issue an Office action, he or she must also inform the applicant of the correct class number for the identified goods and/or services, and require amendment of the classification. If it is unnecessary to issue an Office action, the examining attorney must ensure that the correct classification is entered into the electronic records of the USPTO.

The examining attorney may amend or correct classification through an examiner’s amendment, without prior authorization by the applicant.

*Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601 (Comm'r Pats. 1999). See TMEP §707.02.

Before approving an application for publication, the examining attorney must check to make sure that the properly assigned class is reflected in the electronic records of the USPTO.

#### **1401.03(c) Failure to Classify May Delay Action in Applications Under §§1 and 44**

The applicant should make an initial effort at classification, using the Alphabetical List of Goods and Services. In an application under §1 or §44 of the Trademark Act, when an application and fee is filed for a single class, but the identification lists a large number of items that obviously involve many classes, the examining attorney will require the applicant to properly classify the items. Class designations must be determined and fees for multiple classes must be paid before an examining attorney does an extensive search in a large number of classes. See TMEP §810.01.

#### **1401.03(d) Classification Determined by World Intellectual Property Organization in §66(a) Applications**

*37 C.F.R. §2.85(d). Section 66(a) applications and registered extensions of protection. In an application under section 66(a) of the Act or registered extension of protection, the classification cannot be changed from the classification assigned by the International Bureau of the World Intellectual Property Organization, unless the International Bureau corrects the classification. Classes cannot be added, and goods or services cannot be transferred from one class to another in a multiple-class application.*

In an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), i.e., a request for protection of an international registration to the United States pursuant to the Madrid Protocol, the International Bureau of the World Intellectual Property Organization ("IB") controls classification. Article 3(2) of the Protocol. The §66(a) application (and any resulting registration) remains part of the international registration, and a change of classification in the United States would have no effect on the international registration. Therefore, the international classification of goods and/or services in a §66(a) application **cannot be changed** from the classification given to the goods/services by the IB, even if the IB's classification of goods/services in the §66(a) application is different from the classification set forth in the USPTO ID Manual. Classes cannot be added, and goods or services cannot be transferred from one class to another in a multiple-class application. 37 C.F.R. §2.85(d).

Accordingly, if the mark in a §66(a) application appears to be a certification or collective membership mark, the USPTO **will not** reclassify it into United

States Class A, B, or 200. However, the applicant must comply with all other United States requirements for certification and collective membership marks, regardless of the classification chosen by the IB. See TMEP §§1304 *et seq.*, regarding collective membership marks, TMEP §§1306 *et seq.* regarding certification marks, and TMEP §§1904.02(d) regarding §66(a) applications for these types of marks.

For purposes of *identification* of goods or services, the examining attorney will examine a §66(a) application according to the same standards of specificity used in examining applications under §§1 and 44 of the Trademark Act. That is, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the USPTO ID Manual whenever possible. See TMEP §§1904.02(c) *et seq.*

See *also* TMEP §§1402.01(c) and 1904.02(b).

#### **1401.04 Classification Determines Number of Fees**

*Extract from 15 U.S.C. §1112. \*\*\* The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: Provided, That if the Director by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Director may issue a single certificate of registration for such mark.*

Classification is the basis for determining the number of fees that must be paid. In an application under §1 or §44 of the Trademark Act, a fee is required for each class.

In an application under §1 or §44, if the application sets forth goods or services in more than one class and pays insufficient fees to cover all the classes, the applicant must either amend the application to restrict the goods or services to the number of classes for which the fee has been paid, or submit additional fees to cover all the goods or services set forth in the identification. The fees for multiple classes must be paid before an examining attorney does an extensive search in a large number of classes. See TMEP §810.01.

If, with the original application, the applicant submits fees for more classes than are validly represented in the application, the fees that have been overpaid in error will be refunded. See TMEP §405.04 regarding refunds.

In a §66(a) application, the amount of the filing fee will be determined by the IB, who will collect the fee and send it to the USPTO pursuant to the provisions of the Madrid Protocol and the *Common Regulations Under the*

*Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* ("Common Regs."). The examining attorney will not question the sufficiency of the filing fee in a §66(a) application. The classification in a §66(a) application cannot be changed, and classes cannot be added. See TMEP §1401.03(d) for further information.

#### **1401.04(a) Prior United States Classification System**

Prior to the adoption of the International Classification in 1973, the United States Classification was the primary classification used in the USPTO. After adoption of the International Classification, the United States Classification became a secondary classification system. United States classes are still assigned to all applications by a computerized system. Each international class is coordinated with the United States classes that are most frequently associated with it. Neither examining attorneys nor any other USPTO personnel have the authority or capability of altering these automatically assigned secondary United States Classification designations.

#### **1401.04(b) Limiting Goods and Services to the Number of Classes for Which Filing Fees Are Paid**

An application may list, in connection with each international class number designated, only goods or services that fall within that class. An applicant may apply to register a mark for any or all of the goods and/or services on or in connection with which the applicant is using or has a bona fide intent to use the mark in commerce, if the applicant submits a filing fee for each class. See 15 U.S.C. §1112; 37 C.F.R. §2.86(a). An application that includes more than one class of goods or services is called a combined or multiple-class application. See TMEP §§1403 *et seq.*

The applicant should designate only the number of classes for which a filing fee is submitted and should limit the specified goods and services to those within the particular class(es) designated. Thus, if a single filing fee is submitted, the applicant should designate only one class and should limit the goods or services specified in the identification to items in that class.

The examining attorney must require any necessary amendments to ensure that the classification is correct for the specified goods or services. In an application under §1 or §44 of the Trademark Act, if the applicant identifies goods or services that are classified in a greater number of classes than the classes for which filing fees have been paid, the examining attorney must require that the applicant either: (1) pay the additional fees; or (2) amend the identification to restrict the application to the number of classes for which fees have already been paid. See TMEP §§810.01 and 1403.02(c).

In a §66(a) application, the amount of the filing fee will be determined by the IB, who will collect the fee and send it to the USPTO, pursuant to the

provisions of the Madrid Protocol and the Common Regs. The examining attorney will not question the sufficiency of the filing fee in a §66(a) application. The classification in a §66(a) application cannot be changed, and classes cannot be added. See TMEP §1401.03(d).

#### **1401.05 Criteria on Which International Classification Is Based**

The Alphabetical List of Goods and Services according to the International Classes contains information about the appropriate class for particular products and services. See TMEP §1401.02(c). See *also* the Explanatory Notes at the end of each class heading of goods or services. TMEP §1401.02(a). These notes explain the principles and differentiating lines on which the international classes are based.

Some general criteria have been formulated for placing goods or services in the international classes:

- A finished product is, in principle, classified according to its function or purpose. If the function or purpose of a finished product is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.
- A finished product which is a multipurpose composite object (e.g., clocks incorporating radios) may be classified in all classes that correspond to any of its functions or intended purposes. If those functions or purposes are not mentioned in any class heading, other criteria, indicated under (a), above, are to be applied.
- Raw materials, unworked or semi-worked, are classified, in principle, according to the material of which they consist.
- Goods intended to form part of another product are, in principle, classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases, the criterion indicated under (a), above, applies.
- When a product, whether finished or not, is classified according to the material of which it is made, and it is made of different materials, the product is, in principle, classified according to the material which predominates.
- Cases adapted to the product they are intended to contain are, in principle, classified in the same class as the product.
- Services are, in principle, classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List.

- Rental services are, in principle, classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, in Cl. 38).
- Services that provide advice, information, or consultation are, in principle, classified in the same classes as the services that correspond to the subject matter of the advice, information, or consultation, for example, transportation consultancy in Class 39, business management consultancy in Class 35, financial consultancy in Class 36, and beauty consultancy in Class 44. The rendering of the advice, information, or consultancy by electronic means (such as telephone or computer) does not affect the classification of these services. See TMEP §§1402.11(b) and (e).

See TMEP §1401.02(a).

As indicated above, in the international classification, considerable weight is given to the material of which goods are made.

A product may comprise items that are sold as a unit and that, if sold separately, would be classified in different classes. The identification in such cases should include wording to indicate that the goods are “sold as a unit.” The predominant elements should be listed first and the item will be classified accordingly.

*Example* - Computer software is classified in Class 9. Instructional manuals are classified in Class 16. The item “Computer software for investment management and instructional manuals related thereto, sold as a unit” would be classified in Class 9. “Instructional manuals in the field of investment management and computer software relating thereto, sold as a unit” would be classified in Class 16.

#### **1401.05(a) Identification and Classification of Kits and Gift Baskets**

The USPTO permits registration of a kit or gift basket in a single international class, even if the identification of goods lists items that are classified in other classes. Generally, kits are identified and classified in two ways. If the kit is for the purpose of making a single object, it would be classified by the item it is intended to make (e.g., kits for making bird feeders would be classified in Class 21, even though the individual components would be classified in other classes). If the applicant is willing to call its kit a “hobby craft kit” and indicate its purpose (e.g., hobby craft kit for making pot holders), the item can be classified in Class 28 as a kind of toy or amusement product.

If the kit is a combination of a number of items around a theme (e.g., first-aid kits, nail care kits, student “survival” kits), the class that includes the majority of individual items in the kit controls the classification for the entire kit. Thus,



a first-aid kit comprising primarily bandages for skin wounds, antiseptic, and aspirin is classified in Class 5 even if it also includes tweezers (Class 8) and an instruction manual (Class 16). In such cases, the identification must indicate the type of kit and list the components, with the items in the predominant class listed first. If the components of the kit do not appear to have a predominant class (e.g., the kit contains two or three items, each in a different class), the applicant may elect which class(es) the kit should be in, but the identification must still list the goods that control the class first in the list of components. A few specific types of kits are listed in the USPTO ID Manual; other kits are classified on a case-by-case basis.

The same criteria are applied to the classification of gift baskets.

#### **1401.05(b) Medical vs. Non-Medical Goods**

It is sometimes difficult to determine whether certain pieces of apparatus are classified in Class 9 or Class 10. Class 9 goods include those used for scientific research or industrial purposes, while Class 10 goods are used for medical treatment or diagnostic purposes. This distinction may mean that the same goods could be classified in either class depending upon their use. However, even if the goods perform the same function, they are often different in nature, depending on whether they are for industrial or research use, or for medical treatment or diagnostic use. For example, a thermometer for medical use is in Class 10, while thermometers other than for medical use are in Class 9. While both items measure temperature, they are usually very different in nature.

Some goods are classified in Class 10 when they are for medical use and in another class when they are not for medical use. An item should be specified as being for medical use if it could be in a class other than Class 10 when not for medical use. For example, lasers for medical use are in Class 10, while lasers not for medical use are in Class 9. Items for use by invalids or handicapped individuals are also classified in Class 10. Thus, toilets adapted for handicapped persons are in Class 10, while toilets (without any further specification) are in Class 11. Finally, if an item is normally not classified in Class 10 (see the Class 11 example above), it is not necessary to specify that it is not for medical use when it is classified in its normal class. When that item is used for medical purposes, the medical use must be specified in order to justify its classification in Class 10. If it is possible for an item to be commonly used for medical or non-medical purposes, its purpose must be specified in the identification in order for it to be classified appropriately (see the example regarding lasers above).

#### **1401.06 Specimen(s) as Related to Classification**

As a general rule, the specimen(s) in an application under §1 of the Trademark Act helps to determine the correct classification. The examining

attorney should carefully review the specimen to ensure that the identification and classification of the goods and/or services is accurate. If the information on the specimen and the wording of the identification differ, or if some significant characteristic shown in the specimen is omitted from the identification, the assigned class number may be incorrect. See TMEP §1402.05. However, the examining attorney must remember that, generally, a specimen need only support use of the mark on one item in each class of goods or services set forth in an application. See TMEP §904.01(a).

#### **1401.06(a) Specimen Discloses Special Characteristics**

The classification of goods could be affected if the specimen shows that the mark identifies a composition, an ingredient, or a part that exists in the market only as a component of another product, but the identification does not reveal that the item exists only as a component of a specified product.

If the specimen indicates that the goods are promoted for industrial use only, this should be reflected in the identification when it affects the designation of the correct class. For example, detergents for use in industrial and manufacturing processes are classified in Class 1, not in Class 3 where other detergents are classified.

If the specimen shows that the mark identifies a structural part of a machine, this should be reflected in the identification, because parts for machines are generally classified with the machine if the part has no applicability elsewhere.

If the mark is used or intended to be used on raw materials such as plastics or resins which may be marketed in a variety of forms (such as sheets, powders, or solutions, or as materials that may be either natural or synthetic), these facts should be indicated in the identification of the goods. This is important because some raw materials are classified in several international classes; for example, plastic in sheet form is in a different class from plastic in powder form, and synthetic materials are in a different class from those that are natural. Usually, a specimen will disclose these characteristics of raw materials.

If the specimen indicates that a product is made of a particular material, the identification should specify the material, because many finished products are classified on the basis of the material composition of the article. Generally, if a classification is dedicated to a particular type of goods, the material composition for those goods does not have to be indicated in the identification. For example, Class 20 is the proper class for furniture. This is true even when the furniture is made of metal. Metal furniture is not classified in Class 6 with other metal products because there is an acceptable class (Class 20) for all furniture regardless of material composition. On the other hand, ladders do not have a specifically designated class, and therefore they

are classified by material composition: metal ladders are in Class 6; wood or plastic ladders are in Class 20; and rope ladders are in Class 22.

#### **1401.07 Classification and Plurality of Uses**

A product or service that has a plurality of uses or aspects is ordinarily classified in a single class. *Ex parte Schatz*, 87 USPQ 374 (Comm'r Pats. 1950). However, if it can be shown that a product or service has a plurality of uses or aspects so that two or more classes apply, multiple classification may be permissible. However, identical language cannot be used as the identification of goods in more than one class. The identification must clearly indicate the basis for multiple classification with language that is appropriate for the respective classes. For example, the USPTO will not accept the identification "clock radios," because it is unclear what the goods are and in which class the goods fall—Class 9 for radios or Class 14 for clocks. However, the applicant may adopt either or both of the following identifications-- "radios incorporating clocks" in Class 9 or "clocks incorporating radios" in Class 14.

In an application under §1 of the Trademark Act, the specimen(s) should reflect acceptable use of the mark for each of the specified classes or should be of a general utility nature (e.g., labels for goods). In the case of general-utility specimens, there must be nothing in the record indicating only one use or aspect. See *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); *In re International Salt Co.*, 166 USPQ 215 (TTAB 1970); *Mead Johnson Co. v. Watson*, 112 USPQ 284 (D.D.C. 1957), *aff'd* 253 F.2d 862, 117 USPQ 13 (D.C. Cir. 1958).

Where a single product or service is classified in more than one class, the applicant must file an acceptable specimen for each class with an application under §1(a) of the Act, or an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or statement of use under 15 U.S.C. §1051(d)) in an application under §1(b). However, where a single specimen supports multiple classes, the examining attorney need not require multiple copies of the specimen. See TMEP §904.01.

Where a single product or service is classified in more than one class, the applicant must also comply with all other requirements for multiple-class applications. See TMEP §1403.01.

If an item is consistently classified in a particular class, the applicant cannot obtain registration in another class by adding language that indicates the other class.

*Example* - Essential oils are classified in Class 3. This item cannot be classified in Class 1 with an indication that it is used in the manufacture of other finished products. Raw or unfinished

materials that are used in the manufacture of other finished products may be classified in Class 1. However, an item like essential oils, which is always classified in Class 3 regardless of its ultimate use, cannot be transferred to Class 1 by adding Class 1 qualifying language.

#### **1401.08                    Classification and the Identification of Goods and Services**

The items listed in the identification of goods and services must be limited to those on or in connection with which the applicant uses or has a bona fide intention to use the mark in commerce. The entire contents of a class, as represented by the short title of the class, should not be set forth as the identification of goods or services. The short titles of the classes indicate the general scope of the classes and are generally too broad and inclusive to be used to identify particular goods or services.

#### **1401.09                    Changes in Practice Based on the Restructuring of International Class 42 in the 8<sup>th</sup> Edition of the Nice Agreement**

Effective January 1, 2002, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks ("Nice Agreement") was amended to add three new service classes (Classes 43 through 45). These new classes arose from the extensive restructuring of Class 42. In the course of that restructuring, many activities were removed from Class 42 and placed in one of the three new classes.

The purpose of the Nice Classification is to group, as much as possible, like goods or services in a single class. Generally, the system is successful in achieving that purpose. However, over the years, it became apparent that Class 42 included many disparate services. This was due in large part to the inclusion of the language "services that cannot be classified in other classes" in the class heading for Class 42. This language allowed services as different as "chemical research" and "horoscope casting" to be included in the class. Therefore, after much study and discussion, the Committee of Experts for the Nice Agreement approved the restructuring of Class 42. The restructuring amended Class 42 by limiting the scope of the services included in this class to computer, scientific, and legal services, and created three additional classes that grouped services previously classified in Class 42 into new classes that kept like services grouped together. See TMEP §1401.02(a); see also TMEP §1401.10(a) regarding later reclassification of legal services to Class 45.

Effective January 1, 2002, the language "services that cannot be classified in other classes," which previously appeared in the class heading of Class 42, was eliminated. See TMEP §1401.09(a).

#### **1401.09(a) Elimination of “Miscellaneous Class Designation”**

Prior to January 1, 2002, the language “services that cannot be classified in other classes” appeared in the class heading of Class 42. Effective January 1, 2002, this language no longer appears in any of the class headings or explanatory notes of the Nice Agreement. The Committee of Experts found that the revision of the Nice Agreement created an adequate number of well-defined classes so that this language was no longer necessary. Services must now be identified with sufficient clarity and precision to allow for appropriate classification in one of the eleven service classes.

See TMEP §§1402.11 *et seq.* for further information about the changes in identification and classification of services.

#### **1401.10 General Summary of Major Changes in Practice Based on the 9<sup>th</sup> Edition of the Nice Agreement**

Effective January 1, 2007, the Nice Agreement was amended. The requirements of the 9<sup>th</sup> edition of the Nice Agreement apply only to applications filed on or after January 2, 2007. The most notable changes are: the transfer of all legal services from Class 42 to Class 45; the determination that items made of precious metals should be classified according to their function rather than in Class 14 merely because they are made of precious metal; and the transfer of aquaria and related items from Class 16 to Class 21. These changes are discussed below.

#### **1401.10(a) Legal Services Transferred to International Class 45**

Effective January 1, 2007, legal services were transferred from Class 42 to Class 45. Class 42 is now limited to purely computer, scientific, technological, engineering, and design services.

In 2002, when the Nice Agreement was amended to add three new service classes, Class 42 was restructured, but legal services remained in Class 42. However, over the five-year revision period that led to the 9<sup>th</sup> edition, it became apparent that Class 42 was not the most appropriate class for these services. The ultimate decision to include these services in Class 45 was based on an item in the class heading for Class 45 - “security services for the protection of property and individuals.” The Committee of Experts reasoned that legal services are an extension of the security services already in Class 45. Security services provide for the protection of property and individuals, and the enforcement of that security is in the hands of the legal profession.

#### **1401.10(b) Goods Made of Precious Metal are Classified According to Their Function**

Class 14 went through the most extensive revision of all of the classes in the 9<sup>th</sup> edition of the Nice Agreement. The Committee of Experts decided that items made of precious metal that were classified in other classes based on their function when not made of precious metal, should also be classified in those classes. Goods made of precious metal that are not classified by function, but rather by material composition, e.g., statues, figurines, and key holders, are still classified in Class 14. This decision eliminated much of the confusion in this class caused by some goods being listed in Class 14 when made of precious metal and in other classes when not made of precious metal, while other goods were classified according to function without reference to any particular material composition. For example, nutcrackers were classified in Class 14 when made of precious metal and in Class 8 when not made of precious metal. However, cutlery, namely forks, knives, and spoons were classified only in Class 8, even if made of precious metal, even though it is not uncommon for cutlery to be made of precious metal. The changes in the 9<sup>th</sup> edition were intended to eliminate this inconsistency.

#### **1401.10(c) Transfer of Aquaria and Related Items**

Indoor aquaria, its related accessory aquarium hoods, and indoor terrariums [vivariums] were previously classified in Class 16 because they were considered educational. This may have been true when they were first introduced into the Nice Agreement list, but that is a minimal or secondary use today. Most often, these goods are found in homes or offices as hobby or decorative items. They are traditionally made of glass so that the contents are visible. Therefore, they were transferred to Class 21, the main class for other glass items. Other aquarium items with specific uses or functions remain in their 8<sup>th</sup> edition classes. These items include aerating pumps for aquaria in Class 7, aquarium gravel and sand in Class 19, and aquarium lights, heaters, and filtering apparatus in Class 11. However, large public aquaria that are, in fact, structures are classified in Class 19, since they are made primarily from nonmetallic materials. The aquaria transferred from Class 16 to Class 21 are those that may be found in homes or offices and would not be considered structures in the nature of a building.

#### **1401.11 Implementation of Changes to the Nice Agreement**

When the Nice Agreement changes, the new requirements apply only to applications filed on or after the effective date of the change. 37 C.F.R. §2.85(e)(1). In a §1 or §44 application filed before the effective date of the change, the examining attorney may give the applicant the option of remaining in compliance with the edition of the Nice Agreement that was in effect on the application filing date, or amending the application to comply with the requirements of the current edition. The applicant may, of its own

accord, submit an amendment to its application that brings it into compliance with the current edition of the Nice Agreement. However, if an applicant chooses to comply with the current edition, the applicant must comply with the current edition for all the goods and/or services in the application, and the applicant must pay the fees for any added class(es) resulting from changes in the current edition. 37 C.F.R. §2.85(e)(2). An applicant cannot choose to have some items comply with the current edition and other items comply with the requirements of a previous edition.

## **1401.12                    Effective Date of Changes to USPTO ID Manual**

The “Effective Date” field in the USPTO ID Manual indicates the date on which the status (i.e., Added, Modified, or Deleted) of a particular entry went into effect. When the “effective date” field in the manual changes, the new requirements established by that particular entry apply only to applications filed on or after the date of the change. In a §1 or §44 application filed before the effective date of the change, the examining attorney may give the applicant the choice to either keep the existing identification and/or class or amend to the new identification and/or class. However, if an applicant chooses to comply with the new identification and/or class, the applicant must pay the fees for any added class(es) resulting from the change. 37 C.F.R. §2.6(a)(1). Therefore, if an Office action is issued on or before the effective date, and the action is inconsistent with the new or modified entry, the applicant should be given the choice to either keep the existing identification and/or class or amend to the new identification and/or class. However, if an Office action is issued after the effective date, any *amendment* to the specific portion of the identification or classification that relates to a previously acceptable identification and/or classification must comply with the new or modified entry.

## **1402                        Identification of Goods and Services**

### **1402.01                    Specifying the Goods and/or Services - in General**

A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §§1051(a)(2) and 1051(b)(2); 37 C.F.R. §2.32(a)(6). To “specify” means to name in an explicit manner. The identification should set forth common names, using terminology that is generally understood. For products or services that do not have common names, the applicant should use clear and succinct language to describe or explain the item. Technical or esoteric language and lengthy descriptions of characteristics or uses are not appropriate.

The language used to describe goods and/or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field. An identification may include terms of art in a

particular field or industry, but, if these terms are not widely understood by the general population, the identification should include an explanation of the specialized terminology.

The identification of goods and/or services must be specific, definite, clear, accurate, and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte The A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The USPTO has discretion to require the degree of particularity deemed necessary to clearly identify the goods and/or services covered by the mark. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007).

Terminology that includes items in more than one class is considered indefinite, even with such additional wording as “included in this class” at the end of the identification. See *id.* (“chronographs” held indefinite because it includes both time recording devices in Class 9 and watches in Class 14 and because merely classifying the goods in only one of the classes does not preclude a requirement for further specificity in the identification).

*Example:* “Blankets” is not acceptable without qualifying wording because it is not particular enough to identify the kind of blanket on which the mark is used, e.g., fire blankets (Class 9), electric blankets (Class 11), horse blankets (Class 18), and bed blankets (Class 24).

However, the conclusion that a term would clearly include items classified in more than one class should not be drawn unless reasonable, in light of the evidence of record. See *In re Thor Tech, Inc.*, 85 USPQ2d 1474 (TTAB 2007) (“park trailer” held to be an acceptable identification, where the applicant’s evidence showed that it is a term of art generally understood by those in the industry and by consumers as a designation for a type of recreational vehicle, which unambiguously places it in Class 12; Board was not persuaded by the examining attorney’s argument that the identification was indefinite because it could also encompass mobile homes in Class 19.).

The accuracy of identification language in the original application is important because the identification cannot later be expanded. See 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07 *et seq.*; *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991).



See TMEP §1306.06(e) regarding the identification of goods and services in certification mark applications.

#### **1402.01(a) General Guidelines for Acceptable Identifications of Goods or Services**

With few exceptions, an identification of goods and services will be considered acceptable if it:

- Describes the goods and/or services so that an English speaker could understand what the goods and/or services are, even if the grammar or phrasing is not optimal;
- Meets the *standards* (not necessarily the language) set forth in the USPTO ID Manual;
- Is not a class heading; and
- Is in the correct class, i.e., there is no language in the identification that makes classification difficult or ambiguous; each class lists goods or services that are clearly in a single class.

Deference should be given to the language set forth by the applicant in the original application.

If an identification contains spelling errors, the examining attorney must require correction. Obvious spelling errors in an identification may be corrected by examiner's amendment without contacting the applicant. See TMEP §707.02. However, British variants of American spellings (e.g., colour, vapour, and organise) are acceptable and need not be changed.

In general, commas should be used in the identification to separate items within a particular category of goods or services. When the items are preceded by the word "namely," a comma should always be used before and after that term. For example, "clothing, namely, hats, caps, sweaters, and jeans" is an acceptable identification of goods in Class 25 and shows proper use of commas.

Semicolons should generally be used to separate distinct categories of goods or services within a single class. For example, "cleaners, namely, glass cleaners, oven cleaners, and carpet cleaners; deodorizers for pets" is an acceptable identification in Class 3. In this example, the word "cleaners" names the category covering "glass cleaners, oven cleaners, and carpet cleaners." The semicolon prior to "deodorizers for pets" indicates that the deodorizers are a separate category of goods from the cleaners.

Care should be taken to use commas and semicolons properly when identifying items that are part of a kit. In general, items that are to be sold together (e.g., as components of a system or kit) should be separated by commas. However, other goods within the same class that are to be sold independently of the kit or system should be separated by semicolons. This

is an exception to the general rule regarding using semicolons to separate categories of goods. Here the semicolons are used to separate items that in a non-kit identification would be separated by commas. For example, an identification that includes kits comprised of several items, as well as other goods sold independently from the kits, should be punctuated as follows: “beauty supplies, namely, makeup kits comprised of makeup, lipstick, eye shadow, and applicator brushes; skin lotions; moisturizing soaps; and facial scrubs.” The use of “and” before “applicator brushes” indicates that “skin lotions,” “moisturizing soaps,” and “facial scrubs,” are not included in the makeup kits. The use of semicolons indicates that each is a separate item in connection with which the mark will be used.

Colons and periods should not be used as punctuation within the identification of goods and services.

#### **1402.01(b) Identification of Goods and Services in a §44 Application**

The identification of goods and services in an application based on §44 of the Trademark Act, 15 U.S.C. §1126, must comply with the same standards that govern other applications. The applicant must identify the goods and services specifically, to enable the USPTO to classify the goods and services properly and to reach informed judgments concerning likelihood of confusion under 15 U.S.C. §1052(d).

Foreign registrations often include broad statements identifying the goods and services. In many cases, the identification is merely a repetition of the entire general class heading for a given class. These broad identifications are generally unacceptable in United States applications. The identification of goods and/or services in the United States application must be definite and specific even if the foreign registration includes an overly broad identification. *See In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (noting that the USPTO has discretion to require greater particularity than an entry in WIPO’s Alphabetical List of Goods and Services); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), *rev’d on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

Furthermore, in an application based on §44 of the Trademark Act, the identification of goods and services covered by the §44 basis in the United States application may not exceed the scope of the goods and services identified in the foreign registration. *Marmark Ltd. v. Nutrexpa, S.A.*, 12 USPQ2d 1843 (TTAB 1989); *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972). However, if the applicant also relies on use in commerce under §1(a) or intent-to-use in commerce under §1(b) as a filing basis, the identification may include goods or services not listed in the foreign registration, if the applicant specifically limits the §44 basis to the goods

and/or services covered by the foreign registration. 37 C.F.R. §2.32(a)(6). See TMEP §§806.02 *et seq.* regarding multiple-basis applications.

If a foreign registration in a single class includes a broad statement identifying the goods or services and the USPTO determines that the goods or services identified are in more than one class, the applicant may rely on the same foreign registration to cover the additional classes in the United States application, provided that the identification in the foreign registration encompasses all goods and/or services identified in the United States application and the applicant pays the fees to add the additional classes in the United States application. See TMEP §§1403 *et seq.* regarding multiple-class applications.

#### **1402.01(c) Identification and Classification of Goods and Services in a §66(a) Application**

The examining attorney will examine the identification of goods and/or services in a §66(a) application according to the same standards of specificity used in examining applications under §1 and §44 of the Trademark Act, 15 U.S.C. §§1051 and 1126. That is, the examining attorney must follow the procedures set forth in the TMEP and identify the goods and/or services in accordance with the USPTO ID Manual, whenever possible.

When the original identification of goods and/or services in a §66(a) application is definite, but misclassified under United States standards, the examining attorney must accept the identification.

The international classification of goods and/or services in a §66(a) application **cannot be changed** from the classification assigned by the IB. If the IB's classification of goods or services in the §66(a) application is different from the classification set forth in the USPTO ID Manual, the examining attorney will not request an amendment of the classification. In addition, the goods or services cannot be moved to another class identified in the application. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), and 1904.02(b). The examining attorney should notify the Office of the Administrator for Trademark Identification, Classification and Practice of each occurrence of definite, misclassified goods or services.

When an amended identification is definite, but describes goods and/or services in a class other than the original class assigned by the IB, the examining attorney will not accept it because the amended identification is outside the scope of the original wording. Because the international registration is limited to the class(es) assigned by the IB, any amendments to the identification of goods/services may only include goods or services that are properly within the scope of the class(es) set out in the original application. To propose an amendment outside of the scope of the IB-assigned class(es) would result in the lack of a basis for registration of such goods/services under U.S. law.

See also TMEP §§1904.02(c) *et seq.* regarding the examination of the identification of goods and services in a §66(a) application.

#### **1402.01(d) Location of “Identification of Goods and Services”**

*Paper Application.* If the applicant submits a separate drawing page in a paper application, this page is considered part of the written application and not a separate element. Any goods or services listed on the drawing in a paper application will be considered part of the “identification of goods and services,” even if they do not appear within the body of the application.

There is no requirement that goods or services be listed in any particular place within the body of a written paper application. See *In re Atlantic Scientific Corp.*, 47 USPQ2d 1959 (Comm'r Pats. 1998). However, goods or services referenced only on the specimen(s) are not considered part of the identification.

*TEAS or TEAS Plus Application.* In a TEAS or TEAS Plus application, only goods and/or services listed in the proper field will be considered part of the identification.

#### **1402.01(e) Responsibilities of Examining Attorney as to Identification**

It is the applicant's duty and prerogative to identify the goods and services. However, the examining attorney may require amendment of the identification of goods and/or services to ensure that it is clear and accurate and conforms to the requirements of the statute and rules. The examining attorney should explain clearly and concisely the reason for requiring an amendment.

Under 37 C.F.R. §2.61(b), the examining attorney may require information and evidence, if necessary, to ascertain the nature of the goods and/or services or otherwise permit proper examination of the application. See TMEP §814.

When requiring amendment to the identification, the examining attorney should advise the applicant that goods or services deleted by amendment may not be reinserted at a later point in prosecution. See TMEP §§1402.06(a) and 1402.07(e). Examining attorneys should take particular care to ensure that *pro se* applicants are aware of the restrictions on amendments to the identification of goods and services.

If an examining attorney is uncertain as to the acceptability of the language in an identification, he or she should consult with a senior or managing attorney. If, after consulting the senior or manager, the issue remains unresolved, questions about an identification of goods or services should be referred to the Office of the Administrator for Trademark Identification, Classification and Practice.

The examining attorney has the discretion to issue a final refusal based on a requirement to amend the identification of goods and/or services. Examining attorneys should make every effort to resolve these issues, and should suggest an acceptable identification, if possible. The appropriate senior or managing attorney must approve the final action if the examining attorney does not have full signatory authority. The Office of the Administrator for Trademark Identification, Classification and Practice should be consulted, whenever necessary, to resolve identification and classification issues that are the subjects of appeals, and copies of appeal briefs that involve those issues should be sent to the Office of the Administrator for monitoring purposes.

#### **1402.02                    Entitlement to Filing Date With Respect to Identification of Goods and Services**

An application under §1 or §44 must include an identification of goods or services to receive a filing date. 37 C.F.R. §2.21(a)(4).

Effective October 30, 1999, any goods or services listed on the drawing page of a paper application are considered part of the “identification of goods and services.” However, only goods and/or services listed in the proper field on a TEAS or TEAS Plus application will be considered for determining whether the application meets the requirements for receipt of a filing date.

If the application does not identify any recognizable goods or services, the USPTO will deny a filing date. For example, a filing date will be denied if the identification of goods or services is blank or recites only the following:

- (1) the mark itself;
- (2) a class number;
- (3) wording such as “company name,” “corporate name,” or “company logo;”
- (4) “Internet services” or “e-commerce services;”
- (5) “business” or “business services;”
- (6) “miscellaneous” or “miscellaneous services;” or
- (7) “personal services.”

These examples fail to meet the minimum requirements necessary to receive a filing date under 37 C.F.R. §2.21(a)(4), because they do not provide adequate notice to third parties as to the nature of the goods or services.

In an application under §1 or §44, if an examining attorney finds that the application fails to specify any recognizable goods or services, the examining

attorney should have the filing date cancelled for failure to specify recognizable goods or services, under 37 C.F.R. §2.21(a)(4).

If the identification language includes wording that would not be sufficient and other wording that, by itself, would be specific enough to entitle the application to a filing date, the USPTO will grant the application a filing date. However, any wording that would not otherwise be sufficient for a filing date will not be considered part of the application, and will be disregarded for the purpose of determining the scope of permissible amendments. For example, if the applicant uses “e-commerce services” along with definite language, such as “on-line retail store services featuring clothing,” the identification of services may only be amended to identify services within the scope of the definite language, e.g., “on-line retail store services featuring clothing,” and may not include services within the scope of “e-commerce services.” Or, if the applicant uses “advertising and business,” the USPTO will disregard “business,” and the identification may only be amended to services within the scope of the term “advertising.” See TMEP §§1402.07 et seq. regarding the scope of an identification for purposes of amendment.

The fact that goods or services are referenced on the specimen(s) does not satisfy the requirement for an “identification of goods or services.” In a paper application, the application documents themselves (i.e., the written application and/or separate drawing page) must contain a reference to the goods and/or services. In a TEAS or TEAS Plus application, the identification of goods and/or services must appear in the proper field. See TMEP §1402.01(d) regarding the location of the identification of goods and/or services.

The USPTO will not deny a filing date if the applicant uses the language of an international class heading or indicates that the mark is used on all goods or services in a certain class. However, the USPTO strongly discourages the use of the language of the international class headings or statements that the mark is used on all goods or services in a class to identify the goods or services for which registration of the mark is sought, and will require amendment of any such identification.

Note also that an applicant is required to submit a verified statement that the applicant is either using the mark in commerce or has a bona fide intention to use the mark in commerce on or in connection with all the goods and/or services set forth in the identification. It is unlikely that any applicant is using or intends to use a mark on all goods or services within a certain class. If an applicant claims use or asserts a bona fide intention to use the mark on all goods/services in a particular class but only uses or intends to use the mark on some of those goods/services, the registration that results could be void. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

### 1402.03                    **Specificity of Terms Used in Identifying Goods and Services**

Applicants frequently use broad terms to identify the goods or services in an application. In applications based solely on §1(a), 15 U.S.C. §1051(a), the applicant must have used the mark in commerce on all of the goods and/or services as of the application filing date. See *First Int'l Services Corp. v. Chuckles, Inc.*, 5 USPQ2d 1628 (TTAB 1987). In applications filed under §1(b), 15 U.S.C. §1051(b), and §44, 15 U.S.C. §1126, the applicant must assert a bona fide intent to use the mark in commerce on or in connection with the specified goods and/or services as of the application filing date. The requirement for use or a bona fide intent to use is not necessarily violated by broad identifying terms. When a mark is used on a number of items that make up a homogeneous group, a term that identifies the group as a whole would be understood as encompassing products of the same general type that are commercially related.

As long as a broad term identifies the goods or services that are intended to be covered with reasonable certainty, it will be reasonable, from a commercial viewpoint, to consider that the mark has been used for all the related goods or services that fall in the designated group. See *In re Dynamit Nobel AG*, 169 USPQ 499 (TTAB 1971) (“ammunition” permitted because its scope was assumed to be understood); *In re Port Huron Sulphite & Paper Co.*, 120 USPQ 343 (TTAB 1959) (“paper other than board papers” approved because of evidence of actual use on various types of paper).

Where an applicant has identified its goods or services very broadly but does not use the mark on a substantial number of related goods/services encompassed by the identification language, the USPTO may require further specificity.

The examining attorney must consider the following guidelines:

- (1) A term that clearly includes particular items that are classified in more than one class (e.g., “artists’ materials”) is not acceptable, even with such additional wording as “included in this class” at the end of the identification. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (“chronographs” held indefinite because it includes both time-recording devices in Class 9 and watches in Class 14 and because merely classifying the goods in only one of the classes does not preclude a requirement for further specificity in the identification). Other examples are “blankets,” which include such diverse and differently classified types as bed blankets in Class 24, fire blankets in Class 9, and horse blankets in Class 18; “boxes,” which include set top boxes and junction boxes in Class 9, music boxes in Class 15, and boxes for holding things, which are classified according to their material compositions; and “sports equipment,” because the nature of the equipment will determine the class, i.e., a football helmet would

be in 9; the football uniform would be in Class 25, and the football padding equipment in Class 28. However, the conclusion that a term would clearly include items classified in more than one class should not be drawn unless reasonable, in light of the evidence of record. See *In re Thor Tech, Inc.*, 85 USPQ2d 1474 (TTAB 2007) (“park trailer” held to be an acceptable identification, where the applicant’s evidence showed that it is a term of art generally understood by those in the industry and by consumers as a designation for a type of recreational vehicle, which unambiguously places it in Class 12; Board was not persuaded by the examining attorney’s argument that the identification was indefinite because it could also encompass mobile homes in Class 19).

See TMEP §1402.05(b) regarding goods that may be classified in more than one class depending on their material composition.

- (2) Some terminology is sufficient for purposes of according a filing date but too indefinite to enable proper examination (e.g., “metallic parts”). For example, in *In re Societe Des Parfums Schiaparelli, S.A.*, 122 USPQ 349, 350 n.4 (TTAB 1959), clarification of the term “beauty products” was held to be necessary because the term does not have a particular commercial meaning. In such a situation the examining attorney may seek further information under 37 C.F.R. §2.61(b). See TMEP §814.
- (3) In rare instances, an identification may include a term that has multiple, entirely different meanings. If the meaning of such a term can be understood when read in association with the title of the class in which it is placed, and if the term is otherwise satisfactory, the examining attorney need not require amendment to further qualify the term. For example, “mufflers” in the clothing class would not require further modification to indicate that articles of clothing are intended, rather than automotive mufflers. The limited number of items to which this applies, however, represents a narrow exception to the general rule that an identification must itself provide a clear indication of the nature of the goods or services, without reference to the class. See TMEP §§1402.01 and 1402.05(b). The title of a class cannot be used to define the nature of the goods when the same item could be classified in more than one class depending on its function, material composition, or field of use. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (“chronographs” held indefinite because it includes both chronographs that function as time recording devices in Class 9 and chronographs that function as watches in Class 14). For example, tools are classified in Class 7 if they are power driven or Class 8 if they are not power driven. The identification must indicate whether the tools should be classified in



Class 7 or 8 (powered or non-powered). In this situation, the class title cannot be used to justify the appropriate classification.

- (4) The common understanding of words or phrases used in an identification determines the scope and nature of the goods or services. A basic and widely available dictionary should be consulted to determine the definition or understanding of a commonly used word.
- (5) Many goods are commonly understood to move in a particular channel of trade or have particular attributes. When those goods are classified in the class that is appropriate for that common understanding, often no further specification as to the nature of those goods is necessary. However, when the goods have a special use or attributes that are not typically associated with those particular goods that would cause it to be classified in a different class, that use or attribute should be indicated in the identification in order to justify the classification. For example, “skin lotion” usually refers to a cosmetic product - one that is not medicated. For that reason, it can be classified in Class 3 without further specification. However, a skin lotion that is medicated should be classified in Class 5, and the identification should indicate that the product is medicated in order to justify its classification in Class 5 rather than in the more commonly understood and assigned Class 3.

With broad identifications, as with any identification that includes more than one item, the amount of proof (normally by way of specimens) necessary to assure the examining attorney that the mark has been used on “all” the items in the application will vary. See TMEP §904.01(a). The USPTO does not require specimens showing use of the mark for every item set forth in an application. However, if an identification is so broad that it encompasses a wide range of products or services, the applicant must submit evidence that it actually uses the mark on a wide range of products or services to obtain registration. See *In re Air Products & Chemicals, Inc.*, 192 USPQ 84, *recon. denied* 192 USPQ 157 (TTAB 1976). See TMEP §1402.05 regarding accuracy of the identification.

The examining attorney should consider: the degree of commercial relationship between the products; the fact that the applicant has claimed use of the mark, or an intention to use the mark, in regard to all goods specified in the application; and the fact that the applicant has stated that the facts set forth in the application are true. For a closely related group, a specimen showing use of the mark on one item of the group is sufficient. As the closeness of the relationship becomes less certain, specimens of use on more than one item might be necessary to show generalized use. The nature of the mark may also be considered. “House” marks are placed on all the goods that a company produces, whereas a “product” mark that is appropriate only for a specific commodity is used only on that commodity. See TMEP

§1402.03(b) regarding house marks, and TMEP §1402.03(c) regarding identifications that refer to “a full line of” a genre of products.

The appropriateness of any broad identification depends on the facts in the particular case. The examining attorney should permit applicants to adopt terms that are as broad as the circumstances justify.

#### **1402.03(a) Inclusive Terminology**

The identification should state common names for goods or services, be as complete and specific as possible, and avoid indefinite words and phrases. The terms “including,” “comprising,” “such as,” “and the like,” “and similar goods,” “products,” “concepts,” “like services” and other indefinite terms and phrases are almost always unacceptable.

The terms “namely,” “consisting of,” “particularly,” and “in particular” are definite and are preferred to set forth an identification that requires greater particularity. The examining attorney will require that vague terminology be replaced by these terms (e.g., power tools, namely, drills in Class 7; needle point kits consisting of needles, thread, and patterns in Class 26; or projectors, particularly projectors for the entertainment industry in Class 9).

In limited situations for closely related goods, certain indefinite terms may be used in explanatory phrases that follow a definite term -- for example, “fabric suitable for making coats, suits, and the like.” *See Ex parte The A.C. Gilbert Co.*, 99 USPQ 344 (Comm’r Pats. 1953).

“Parts therefor,” as related to machinery, is acceptable when it follows a definite identification. “Accessories therefor” is usually considered indefinite, but it has been allowed in some cases, particularly in the toy field. Identifications such as “dolls and accessories therefor” and “toy vehicles and accessories therefor” are acceptable because all goods that fall within that broad designation would be classified in Class 28 with the dolls or toy vehicles and could be the basis for a refusal of registration under 15 U.S.C. §1052(d). However, this phrase should only be used in a situation where it is clear that the goods encompassed by the phrase relate closely to the primary goods and would all be classified in the same class as the primary goods.

#### **1402.03(b) House Marks**

House marks are marks used by an entity on a wide range of goods. Marks of this type are often used in the chemical, pharmaceutical, and food fields. A house mark is different from a product mark that is used on a specific item or closely related items. A product may bear both a product mark and a house mark.

Under certain limited circumstances, an applicant may apply to register a mark as a house mark. In an application for registration of a house mark, the

identification of goods may include wording such as “a house mark for....” As with other applications, these applications must define the type of goods with sufficient particularity to permit proper classification and to enable the USPTO to make necessary determinations under §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

In an application to register a mark as a house mark based on use in commerce, the applicant must demonstrate that the mark is, in fact, used as a house mark. The examining attorney should require that the applicant provide catalogues showing broad use of the mark or similar evidence to substantiate this claim.

An intent-to-use applicant who wishes to register a mark as a house mark must clearly indicate its intention to register the mark as a house mark during initial examination, and the circumstances must establish that the applicant’s proposed use of the mark as a house mark is credible. The nature of the mark and the capacity of the applicant to use the mark as asserted should be considered in determining whether the claim that the mark is to be used as a house mark is credible. If the applicant indicates such an intention, the examining attorney should advise the applicant that, upon filing of the allegation of use, the applicant will be required to provide evidence to substantiate use as a house mark. If the applicant cannot do so, the applicant will be required to amend the identification of goods to conform to the usual standards for specificity.

The USPTO will register a mark as a house mark only in the limited circumstances where the mark is actually used as a house mark. Therefore, if an applicant seeks to register a house mark in an application under §44 or §66(a) of the Trademark Act, the examining attorney must require evidence that the mark is in fact used as a house mark. This is not a requirement for specimens, but rather a requirement that applicant provide evidence to substantiate the claim of use as a house mark. 37 C.F.R. §2.61(b). If the applicant cannot do so, the identification of goods must be amended to conform to the usual standards for specificity.

#### **1402.03(c) Marks for a “Full Line of ...”**

In rare circumstances, the USPTO may accept an identification of goods that refers to “a full line of” a genre of products. To qualify for the use of such terminology, the line of products must be in one class. The most commonly accepted situation is “a full line of clothing.” While there may be some rare exceptions, all clothing is classified in Class 25. Another example would be pharmaceuticals, which are almost all classified in Class 5. Therefore, so long as the specimens and/or other evidence show use of the mark on virtually all of these goods, the “full line of” language may be used. It may not be used in a situation such as “a full line of hand tools.” Even though Class 8 is the general class for hand tools, a number of items that might be

considered hand tools are classified in other classes (e.g., a non-electric egg beater is in Class 21 but could be considered to fall within the broad category of “hand tools”).

The “full line of” language may be used only in appropriate situations and the circumstances and specimens or other evidence of record should be analyzed carefully to ensure that an applicant who does not in fact use a particular mark on a sufficient number or variety of products in its line does not receive a trademark registration that could potentially bar the registration of another applicant who uses a similar mark on different products. If the goods are a “full line of pharmaceuticals,” the examining attorney must require the applicant to provide evidence that it uses the mark in connection with pharmaceuticals to treat diseases or health problems in all categories in the World Health Organization (“WHO”) International Statistical Classification of Diseases and Related Health Problems. See *In re Astra Merck Inc.*, 50 USPQ2d 1216 (TTAB 1999) (evidence of use on only three products does not justify registration of the mark for a full line of those products). See also TMEP §904.01(a).

Although the USPTO will accept “a full line of clothing” as a sufficient identification, because the applicant is committing to virtually all the goods described by the broad language and the validity of the registration depends on the applicant’s statement that it is using the mark on all the goods and the evidence of such use as a “full line,” the USPTO will not accept an identification of goods as merely “clothing.” In the latter situation, the applicant must identify the items of the clothing by their common commercial name since the applicant is not likely using the mark for all items of clothing and the registration should be limited to only those items of clothing on which the applicant is actually using the mark.

In some cases, it may be more appropriate to indicate that the applicant is providing a full line of a subset of a genre of products (e.g., “a full line of sports clothing” or “a full line of anti-viral and cardiovascular pharmaceuticals”). As with any identification that refers to a full line of a genre of products, all of the products must be classifiable in one class and the specimens and/or other evidence must show use of the mark on virtually all of the relevant goods.

An intent-to-use applicant who wishes to register a mark for a full line of a genre of products must clearly indicate an intention to register the mark for a full line during initial examination, and the circumstances must establish that the applicant’s proposed use of the mark for a full line of products is credible. The nature of the mark and the capacity of the applicant to use the mark as asserted should be considered in determining whether the claim that the mark is to be used for a full line of products is credible. If the applicant indicates such an intention, the examining attorney should advise the applicant that, upon filing of the allegation of use, the applicant will be required to provide evidence to substantiate use for a full line of products.

If the applicant cannot do so, the applicant will be required to amend the identification of goods to conform to the usual standards for specificity.

The USPTO will register a mark for a “full line of” a genre of products only in the limited circumstances where the mark is actually used as such. If an applicant seeks to register a mark for a “full line of” a genre of products in an application under §44 or §66(a) of the Trademark Act, the examining attorney must require evidence to substantiate use for a full line of products. This is not a requirement for specimens, but rather a requirement that applicant provide evidence to substantiate the claim of use as a mark for a “full line of” a genre of products. 37 C.F.R. §2.61(b). For example, in the pharmaceutical context, proof of use in connection with pharmaceuticals to treat diseases or health problems in all categories in the WHO International Statistical Classification of Diseases and Related Health Problems reflects appropriate use to qualify for a “full line.” If the applicant cannot establish sufficient use for a “full line of” a genre of products, the identification of goods must be amended to conform to the usual standards for specificity.

#### **1402.03(d) Identifying Computer Programs with Specificity**

Any identification of goods for computer programs must be sufficiently specific to permit determinations with respect to likelihood of confusion. The purpose of requiring specificity in identifying computer programs is to avoid the issuance of unnecessary refusals of registration under 15 U.S.C. §1052(d) where the actual goods of the parties are not related and there is no conflict in the marketplace. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Due to the proliferation and degree of specialization of computer programs, broad specifications such as “computer programs in the field of medicine” or “computer programs in the field of education” will not be accepted, unless the particular function or purpose of the program in that field is indicated. For example, “computer programs for use in cancer diagnosis” or “computer programs for use in teaching children to read” would be acceptable.

Typically, indicating only the intended users, field, or industry will not be deemed sufficiently definite to identify the nature of a computer program. However, this does not mean that user, field, or industry indications can never be sufficient to specify the nature of the computer program adequately. For example, “computer programs in the field of geographical information systems” would be acceptable. Geographical information systems, also known in the industry as GIS, are well-defined computer applications that do not need further definition. If the identification in the application does not adequately specify the nature of a computer program, further information may be requested. Any questions concerning the recognition of a term of art for a computer program should be discussed with senior attorneys, managing attorneys, or other examining attorneys who are knowledgeable in the computer field.

If an applicant asserts that the computer programs at issue serve a wide range of diverse purposes, the applicant must submit appropriate evidence to substantiate such a broad identification of goods. See 37 C.F.R. §2.61(b); TMEP §§1402.03(b) and (c).

Generally, an identification for “computer software” will be acceptable as long as *both* the function/purpose *and* the field are set forth. Some general wording is allowed. The following wording is acceptable:

- (1) *Computer game software.*
- (2) *Computer operating programs and computer operating systems:* Software under this category comprises master control programs that run the computer itself. They are the first programs loaded when the computer is turned on and set the standards for the application programs that run in the operating system or operating program.
- (3) *Computer utility programs:* These programs must be designed to perform maintenance work on a computer system or components thereof, such as file management (sorting, copying, comparing, listing, and searching files), as well as diagnostic and measurement routines that check the health and performance of the computer system. Beware of identifications that read “Computer utility programs, namely, business software.” - This is **NOT** a utility program.
- (4) *Computer software development tools:* These programs are designed to create other computer programs. This is one of the few exceptions in which use of the term “tools” is acceptable.
- (5) *Database management software [indicate for general use or specific field]:* Software that controls the organization, storage, retrieval, security, and integrity of data in a database (an electronically stored collection of data). For example:
  - General purpose database management software.
  - Database management software for use by financial advisors.
  - Database management software in the field of baseball cards.
- (6) *Spreadsheet software [indicate for general use or specific field]:* Software that simulates a paper spreadsheet, or worksheet, in which columns or individual cells of numbers are summed, subtracted, multiplied, or divided with the contents of other columns or cells for budgets and plans. For example:

- General purpose spreadsheet software.
  - Spreadsheet software for use by budget analysts.
- (7) *Word processing programs [indicate for general use or specific field]:* Software used to create text documents.
- (8) *Computer aided design (CAD) software [indicate for general use or specific field]:* Computer Aided Design software is generally used to design products. CAD software is available for generic design or specialized uses, such as architectural, electrical, and mechanical design. For example:
- Computer aided design (CAD) software for general use.
  - Computer aided design (CAD) software used for designing integrated circuits.
  - Computer aided design (CAD) software for architectural use.
- (9) *Computer aided manufacturing (CAM) software [indicate for general use or specific field]:* Computer Aided Manufacturing software automates manufacturing systems and techniques, including numerical control, process control, robotics, and materials requirements planning. For example:
- Computer aided manufacturing (CAM) software for general use.
  - Computer aided manufacturing (CAM) software used in the manufacture of airplane components.
  - Computer aided manufacturing (CAM) software for integrated circuits.
- (10) *CAD/CAM software [indicate for general use or specific field]:* Computer Aided Design/Computer Aided Manufacturing software integrates functions of CAD and CAM software in that products designed by the CAD systems are directly inputted into the CAM systems for manufacture.

Examples of indefinite and unacceptable wording include the following:

- (1) Computer programs featuring multimedia (unless the applicant specifies the content, e.g., motion pictures in the field of [specify], recorded on computer media).

- (2) Computer firmware (unless the applicant specifies the function/purpose of the program, and, if the program is content or field specific, the field of use).
- (3) Computer devices (must specify the common commercial name therefor).
- (4) Computer accessories (must specify the common commercial name therefor).

See TMEP §1402.11(a) regarding identification and classification of computer services.

### **1402.03(e) Identifying Publications with Specificity**

When the goods are publications, the identification must indicate both the specific physical nature and the literary subject matter of the publication.

*Example* - “Magazine devoted to medicine” is acceptable.

*Example* - “Television programming newsletter” is acceptable.

In the case of publications of a specialized nature, the identification should describe the goods by specific names or wording that explains their specialized nature.

*Example* - “Children’s storybooks” is acceptable.

Even if the mark itself indicates the subject of a publication, the identification must specify the subject matter.

As a general rule, “books” should be described by subject matter or class of purchasers (e.g., exercise books or children’s books). In the case of a mark used by a publishing house on books, a general identification, such as “a house mark for books” or “a full line of books” is sufficient if supported by the record. However, if the goods are restricted to certain types of literature, such as science fiction, engineering, romance, or poetry, the identification should so indicate. The applicant may also indicate the channels of trade or groups of purchasers for the goods.

When the subject matter is not a significant aspect of a publication, such as with in-house newsletters, the identification may merely give an indication of the general character or type of the publication.

*Example* - “Employee newspaper” may be accepted.

See TMEP §1402.11(a) regarding online publications.



#### **1402.04                    Acceptable Identification of Goods and Services Manual**

The USPTO maintains an ID Manual comprised of a listing of acceptable identifications of goods and services compiled by the Office of the Administrator for Trademark Identification, Classification and Practice. The USPTO ID Manual contains identifications of goods and services and their classifications that are acceptable in the USPTO without further inquiry by an examining attorney (provided such identification and classification is supported by the specimens of record). This Manual is updated periodically, and the entries in it are more extensive and specific than the Alphabetical List of Goods and Services that is published by WIPO. The listing is not exhaustive, but is intended to serve as a guide to examining attorneys in acting on applications and to the public in preparing applications.

Using identification language from the Manual enables trademark owners to avoid objections by examining attorneys concerning indefinite identifications of goods or services; however, applicants should note that they must assert actual use in commerce or a bona fide intent to use the mark in commerce for the goods or services specified. Therefore, even if the identification is definite, examining attorneys may inquire as to whether the identification chosen accurately describes the applicant's goods or services (see TMEP §1402.05 regarding accuracy of identifications).

No listing could include all possible identifications for the multitude of products and services for which marks may be registered. Therefore, a primary use of the Manual's listings, in addition to indicating precise identifications that will be accepted, is to indicate by analogy and example the kinds of identifications that will be acceptable for products and services not covered by the existing listings.

Any identification of goods and services in the Manual that has a letter "T" in the Trilateral column indicates that the identification is acceptable in the USPTO, the Japanese Patent Office ("JPO"), and the European Trademark Office ("OHIM," the Office of Harmonization in the Internal Market).

In a TEAS Plus application, the application must include correctly classified goods and/or services, with an identification of goods and/or services taken directly from the USPTO ID Manual. 37 C.F.R. §2.22(a)(8); TMEP §819.01(g).

The USPTO ID Manual can be downloaded free of charge from the USPTO website at <http://www.uspto.gov>, and it is accessible from within TEAS.

#### **1402.05                    Accuracy of Identification**

An identification is unacceptable if it is inconsistent with the goods or services indicated by the specimens, or if the ordinary meaning of the identification

language is at variance with the goods or services evidenced by the specimens or any other part of the record.

The examining attorney may require an amendment of the identification language to accurately describe the goods or services. Moreover, the examining attorney must require an amendment to the identification language when it includes broad wording that would normally be acceptable, but the specimen(s) shows that the actual goods or services are a specialized type or are used only in a specialized trade channel. In this situation, the broad identification would be overly broad and misleading. The amended identification should specify the specialized characteristic or specialized trade channel to accurately describe the goods or services. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1335 (TTAB 2009) (Board stating that “[t]he Office’s requirement that the examining attorney ensure the accuracy of the identification of goods is abundantly clear.”); *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980), *aff’d* 204 USPQ 261 (TTAB 1979) (examining attorney has discretion to require applicant to state whether goods are packaged in container to which mark refers); *Kiekhäfer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 USPQ 105 (C.C.P.A. 1956) (requirement to restrict identification to “outboard motors” considered proper); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505, 509 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974) (noting that, in view of specimens, greater specificity should have been required in identifying registrant’s detergent product); *In re Toro Mfg. Corp.*, 174 USPQ 241 (TTAB 1972) (noting that use on “grass-catcher bags for lawn-mowers” did not justify the broad identification “bags,” which would encompass goods diverse from and commercially unrelated to applicant’s specialized article); *Ex parte Consulting Engineer Publishing Co.*, 115 USPQ 240 (Comm’r Pats. 1957) (amendment of “periodical” to “monthly news bulletin” required).

In *Petroglyph Games*, 91 USPQ2d at 1336, the Board addressed the question of whether the identification “computer game software” was accurate for the mark BATTLECAM if the mark was being used only for a feature of a computer game. The Board found that the subsets of computer code identified by the mark, which the specimen indicated supported only particular aspects or features of the computer game, could also be accurately identified as “computer game software,” noting that although “there is a market for selling or distributing to computer game players all the software that allows a game to be played in its entirety, there may also be a market for computer game software related to only certain game features, perhaps among game developers or producers who might want to include a particular feature in a complete game, or perhaps among players seeking after-market add-ons or enhancements for existing games.” Therefore, it would not be inaccurate to identify such software simply as “computer game software.”

An identification cannot be amended to accurately describe the goods or services if the amendment would add to or expand the scope of the identification. See 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07 *et seq.*

#### **1402.05(a) Goods That Are Components or Ingredients**

When a mark is used to identify only a component or ingredient of a product, and not the entire product, the identification should precisely set forth the component or ingredient. In other words, when the specimen or other material in the record clearly indicates that the mark relates only to a distinguishable part, component, or ingredient of a composite or finished product, then the application should identify that component or ingredient as the goods. The identification should leave no doubt that the mark refers only to one part and not to the entire product. Also, the identification should indicate the types of finished products of which the identified components or ingredients form a part, e.g., “liposomes sold as an ingredient in face creams.” See *Ex parte The Joseph & Feiss Co.*, 114 USPQ 463 (Comm’r Pats. 1957); *Ex parte Palm Beach Co.*, 114 USPQ 463 (Comm’r Pats. 1957); *Mercantile Stores Co., Inc. v. The Joseph & Feiss Co.*, 112 USPQ 298 (Comm’r Pats. 1957); *In re Libbey-Owens-Ford Glass Co.*, 75 USPQ 202 (Comm’r Pats. 1947).

If the mark does not pertain solely to a component or ingredient rather than the finished or composite product, the identification should not specify the component or ingredient as the goods.

When classifying component or ingredient marks, a distinction should be made between (1) marks that identify products sold as separate ingredients or components and ingredients for use in the manufacture of the finished product, and (2) marks that identify components or ingredients sold as part of the finished product. In the first situation, the goods are classified in the class of the component or ingredient since it has not yet been transformed into the finished product. In the second, the goods are classified in the class of the finished product, since the component or ingredient has now been incorporated into other finished goods. In these situations, the examining attorney should examine the specimen to determine whether it shows use of the mark to identify the separate component or ingredient or the finished product in its entirety.

The same rules of language construction for purposes of amendment, as set forth in TMEP §§1402.01 *et seq.*, 1402.06 *et seq.*, and 1402.07 *et seq.*, apply to amendments of identifications to indicate components or ingredients. Thus, whether an identification may be amended will depend on the particular circumstances of each application.

*Example* - The indefinite term “fabric” may be amended to the definite identification “fabric for use in the manufacture of slacks”

but may not be amended to “slacks,” which is beyond the scope of the identification.

See TMEP §1402.05 regarding accuracy of the identification.

#### **1402.05(b) Material Composition**

If an identification of goods is specific, but the goods could be classified in more than one class depending on the material composition, then the material composition must be indicated in the identification of the goods.

*Example* - “Statues” refers to specific items; however, the classification depends on the material composition. “Statues of non-precious metal” are classified in Class 6; “statues of precious metal” are classified in Class 14; “statues of wax, wood, plaster, or plastic” are classified in Class 20; and “statues of glass or porcelain” are classified in Class 21.

However, in certain situations, because of the nature of the particular industry and the knowledge that the items are made out of different materials and are classified accordingly, an indication of the material composition in the identification may be unnecessary. See TMEP §§1401.06(a) and 1402.03 for further explanation.

#### **1402.06 Amendments Permitted to Clarify or Limit Identification**

Trademark Rule 2.71(a), 37 C.F.R. §2.71(a), restricts amendments to the identification of goods or services as follows, “The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.” This rule applies to all applications.

Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c), provides that filing an application for registration on the Principal Register establishes constructive use and nationwide priority, contingent on issuance of the registration (see TMEP §201.02). Therefore, the identification of goods and/or services in an application defines the scope of those rights established by the filing of an application for registration on the Principal Register.

#### **1402.06(a) Limiting the Identification of Goods and Services**

As noted above, the rules permit amendments to limit the identification of goods and services.

Deletions from the identification of goods and services are also permitted. “Deletion” means the elimination of an existing item in an identification of goods and services in its entirety. If the applicant wishes to amend the identification of goods and services to delete one or more items, the examining attorney should accept the amendment, if it is timely and otherwise

proper. However, once the applicant has expressly amended the identification of goods and services to delete an item, it may not be reinserted in a later amendment.

If the applicant wishes to amend the identification of goods and services to restrict one or more of the items by inserting qualifying language or substituting more specific language, the examining attorney should accept the amendment, if it is timely and otherwise proper. Qualifying language, however, may not be deleted from an identification.

*Example* - If the applicant initially identifies the goods as “publications,” the applicant may amend to substitute one or more terms that fall under the definition of publications. Likewise, if an applicant identifies its goods as “pamphlets,” the applicant may amend to include “brochures,” because these terms are generally equivalent and interchangeable. In either case, the applicant must specify the subject matter.

*Example* - If the applicant initially identifies the goods as “football uniforms,” the applicant may amend to indicate football uniforms in Class 25, football helmets in Class 9, and shoulder pads in Class 28. These goods are logically included within the initial identification. Footballs, however, could not be added, because this would add an item not logically included within the original identification.

*Example* - If the applicant initially identifies the services as “prepaid medical services” and wishes to amend to “underwriting prepaid medical plans and health care services in the nature of a health maintenance organization,” the amendment should be permitted. Both specific services are logically included under prepaid medical services.

*Example* - If the applicant initially identifies the goods as “cooking utensils sold to restaurants,” the applicant cannot delete the language “sold to restaurants,” because this would broaden the identification.

If an applicant wishes to amend the identification of goods and services to insert an item that is equivalent to or logically encompassed by an item already included in the identification of goods and services, the examining attorney should permit the amendment, if it is timely and otherwise proper.

On the other hand, an applicant may not amend an identification of goods/services to add or substitute a term that is not logically included within the scope of the terms originally identified or that is otherwise qualitatively different from the goods and services as originally identified.

*Example* - If the applicant identifies the goods as “computer programs,” the applicant may not add or substitute computers or other items of computer hardware to the listing.

*Example* - If the applicant initially identifies the goods as “hats,” the applicant may not add or substitute “scarves.” Likewise, the applicant may not add or substitute “shirts” for “slacks.”

*Example* - If the applicant identifies its services as “ophthalmologist’s services,” the applicant may not amend the identification to “medical services,” because the amendment would expand the identification to include services beyond the scope of those identified initially.

The scope of the goods and services, as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments. See TMEP §1402.07 *et seq.*

Under 37 C.F.R. §2.71(a), there is no general prohibition against specific types of limitations in identifications of goods and services, such as the use of negatives, exceptions, or similar language. Limitations on identifications phrased in the negative or as exceptions are acceptable, if they are otherwise proper.

Because 37 C.F.R. §2.71(a) precludes additions to the identification, examining attorneys should not require or suggest unduly restrictive identifications. See *In re Sentry Chemical Co.*, 230 USPQ 556 (TTAB 1986). Once the identification has been limited, it cannot be expanded later. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm’r Pats. 1991). Also, when requiring amendments to the identification, examining attorneys must advise applicants that additions to the identification are not permitted.

#### **1402.06(b) Clarifying the Identification of Goods and Services**

Under 37 C.F.R. §2.71(a), an applicant may amend “to clarify” the identification of goods and/or services. The applicant may clarify an identification that is indefinite or overly broad, to identify goods and/or services that are within the scope of the goods and services in the identification. As noted in TMEP §1402.06, filing an application for registration on the Principal Register establishes a constructive date of first use in commerce, contingent on issuance of the registration. 15 U.S.C. §1057(c). Accordingly, the applicant may not expand those rights through an amendment that broadens the identification of goods and/or services.

Thus, the applicant may amend from the more general to the specific, but the applicant may not amend from the specific to the more general. The scope of the goods/services identified initially, or as limited by an express amendment,

establishes the outer limit for permissible amendments. See TMEP §§1402.07 *et seq.*

In an application under §1 or §44 of the Trademark Act, classification may provide some guidance in determining whether an amendment exceeds the scope of the goods/services identified initially, but it is not controlling. In an application under §1 or §44, the examining attorney may suggest and accept amendments to the identification that result in a change of class, if the amended identification does not exceed the scope of the original identification.

*Example* - If an applicant has erroneously identified its goods and services as “menus” but, in fact, the applicant intends to register the mark for restaurant services, the applicant may not amend the identification of goods to “restaurant services.” In such a case, the original identification, which is specific and narrow in scope, may not be expanded to services beyond the scope of that identification.

*Example* - If an applicant has erroneously identified its goods and services as “bottles *for* salad dressing” but, in fact, the applicant intends to register the mark for salad dressing, the applicant may not amend the identification to “salad dressing.” However, if an applicant identifies its goods and services as “bottles *of* salad dressing,” the applicant may amend the identification to “salad dressing.” As above, where the original language is specific and narrow in scope, the identification may not be expanded to goods beyond that scope.

*Example* - If an applicant has erroneously identified its goods and services either as “packaging and labels” or as “packaging and labels for toys” but, in fact, the applicant intends to register the mark for toys, the applicant may not amend to correct the identification, because “toys” is not within the scope of the initial identification.

In a §66(a) application, classification is assigned by the IB and cannot be changed. 37 C.F.R. §2.85(d). See TMEP §§1401.03(d), 1402.01(c), and 1904.02(b) and (c) regarding §66(a) applications.

## **1402.07                    Scope of Identification of Goods and Services for Purposes of Amendment**

### **1402.07(a)            The “Ordinary-Meaning” Test**

In applications under §1 or §44, 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 number designation. The class number (see TMEP §§1401.03 *et seq.*), whether inserted by the applicant or

the USPTO, does not limit the scope of permissible amendments. 37 C.F.R. §2.85(f). If the applicant designates the class by number, this information may be weighed with other factors for the benefit of the applicant in determining the scope of permissible amendments.

However, if the applicant does not merely designate the class number, but expressly limits the goods or services recited to those that are within one or more classes, the applicant may not amend to specify items not in those classes.

In many cases, the identification is merely a repetition of the entire general class heading for a given class. In this situation, the USPTO will look to the ordinary meaning of the words for the purposes of determining the scope of the identification. The USPTO will not permit the applicant to amend to include any item that falls in the class, unless the item falls within the ordinary meaning of the words in the heading, or to amend to items in other classes. As noted in TMEP §1402.01(b), class headings are generally unacceptable to identify goods/services in United States applications, even if the class heading is used as the identification in the foreign registration.

In §66(a) applications, the classification assigned by the IB cannot be changed, so the scope of the identification for purposes of permissible amendments *is* limited by the class. 37 C.F.R. §2.85(f). See TMEP §§1401.03(d), 1402.01(c), and 1904.02(c).

#### **1402.07(b)      Ambiguous Identifications**

An applicant may amend an ambiguous identification of goods or services (i.e., an identification that fails to indicate a type of goods or services) in order to specify definite goods *or* services within the scope of the indefinite terminology.

*Example* - “Food” is indefinite, and may be amended to “fresh fruit” (Class 31), or “processed fruit” (Class 29), or “dog food” (Class 31). However, “food” may not be amended to “whiskey” (Class 33).

*Example* - “Metallic parts” is indefinite, and may be amended to “metal thread fasteners” (Class 6), or “metal drive gears for machines” (Class 7). However, “metallic parts” may not be amended to “metal automobile chassis” (Class 12).

Likewise, if the applicant includes wording in an indefinite identification of goods or services that, in context, is obviously superfluous, the applicant may amend the identification to specify goods *or* services within the scope of the indefinite terminology. In many cases, the superfluous wording will not restrict the range of permissible amendments.



*Example* - If the applicant begins an indefinite identification of goods with superfluous wording such as “sale of . . .,” “advertising of . . .,” “manufacture of . . .,” or similar wording, the applicant may amend to specify either goods or services within the scope of the existing identification. However, the specific terms used to preface the goods do establish some limitation as to scope. “Sale of” may justify an amendment to retail or mail order services for specific goods, or to the goods themselves, but not to custom manufacturing or advertising agency services related to those goods.

The policy permitting applicants to amend to specify *either* goods *or* services should be construed narrowly. The applicant should only be permitted to amend from goods to services, or vice versa, when the existing identification of goods and services fails to specify a definite type of goods or services *and* when the existing identification provides reasonable notice to third parties that the applicant may be providing *either* goods *or* services within the scope of the existing identification.

#### **1402.07(c) Unambiguous Identifications**

An applicant may amend an unambiguous identification of *goods* that indicates a specific type of goods to specify definite and acceptable identifications of *goods* within the scope of the existing terminology.

An applicant may amend an unambiguous identification of *services* that indicates a specific type of service to specify definite and acceptable identifications of *services* within the scope of the existing terminology.

*An applicant may not amend a definite identification of goods to specify services, or vice versa, except that if the goods are of a type that are available in more than one medium, and the applicant does not specify the medium in the identification of goods, the applicant will be allowed to amend to any medium, even if one of the mediums is classified as a service.*

*Example* - If the applicant specifies “newsletters in the field of accounting,” the applicant may amend to “printed newsletters in the field of accounting (Class 16),” “downloadable newsletters in the field of accounting (Class 9),” “providing online newsletters in the field of accounting (Class 41),” or “newsletters in the field of accounting, recorded on DVDs (Class 9).” See TMEP §1402.11(a) regarding online publications.

*Example* - If the applicant specifies “computer programs in the field of accounting,” the applicant may only amend to specify computer programs within the scope specified, i.e., those concerning accounting. The applicant may not amend to any service, other than “providing temporary use of non-downloadable computer

programs in the field of accounting.” The applicant may *not* amend from “providing temporary use of non-downloadable computer programs in the field of accounting” to “computer programs in the field of accounting,” because “computer programs” are broader in scope than “non-downloadable computer programs.” Neither may the applicant amend to any goods outside the scope of those already identified.

*Example* - If the applicant identifies the goods as “computer programs” without specifying the field, the applicant is limited to specific types of computer programs for the purposes of amendment. The applicant has identified a definite type of goods, but USPTO policy requires further specificity as to the purpose or function of the goods. An applicant who had identified its goods as “clothing” would likewise be limited to goods within the scope of the term “clothing.”

*Example* - If the applicant specified “retail store services,” the applicant would be limited to amendments within the scope of this service. Although USPTO policy requires further specificity as to field, the applicant has identified a definite type of service.

*Example* - If the applicant identifies its goods as “stationery,” “wine labels,” or “menus,” the applicant is restricted, in any amendments, to goods within the scope of the type indicated. The applicant could not amend to specify other types of goods or services, such as “wine” or “restaurant services.”

#### **1402.07(d) Permissible Scope of Identification Not Affected by Proposed Amendment That Is Unacceptable**

If the applicant proposes an amendment to the identification of goods and services, and the examining attorney determines that the amendment is unacceptable, the examining attorney should refer to the identification of goods before the proposed amendment to determine whether any later amendment is within the scope of the identification. In such a case, the applicant is not bound by the scope of the language in the proposed amendment but, rather, by the language of the identification before the proposed amendment.

If the applicant submits an amendment to the identification of goods and services, and the examining attorney determines that it is unacceptable, in whole or in part, the examining attorney must advise the applicant of the item or items that are unacceptable. For those items which are unacceptable, the examining attorney should also advise the applicant that the previous items listed in the existing identification (not the unacceptable substitute) remain operative for purposes of future amendment. If portions of an amended

identification are accepted, those items may not be further amended to exceed the scope of the accepted amendment. See TMEP §1402.07(e).

If the applicant submitted the amendment in response to a requirement, the examining attorney must issue a final requirement for amendment of the identification, if the proposed amendment raises no new issues and the application is otherwise in condition for a final action. See TMEP §714.05(a)(ii).

#### **1402.07(e) Permissible Scope of Identification Affected by Proposed Amendment That Is Acceptable**

Once an applicant files an amendment to the identification of goods and/or services in a manner that is deemed acceptable to the examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods/services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). The applicant may not amend the identification to reinsert goods or services that were omitted or deleted from the identification of goods or services, except in the following limited circumstances:

- (1) Where, before publication or within six months of the issuance of an examiner's amendment (see TMEP §§707 *et seq.*), whichever is earlier, the applicant objects to an amendment of the identification of goods or services in the examiner's amendment *on the ground that the examiner's amendment does not reflect the agreement between the applicant and the examining attorney*; or
- (2) Where the applicant inadvertently omits goods or services from a *paper* amendment to allege use and has not specifically indicated an intention to delete those goods or services (see TMEP §1104.09(c)).

In contrast to situation (2), set out above, if, in a statement of use or request for an extension of time to file a statement of use, the applicant inadvertently omits particular goods or services when specifying the goods and services on or in connection with which it has used or has a continued bona fide intention to use the mark in commerce, those items may not later be reinserted. 37 C.F.R. §§2.88(i)(2) and 2.89(f); TMEP §§1108.02(d) and 1109.13.

#### **1402.08 Moving Goods and Services Between Companion Applications**

If an applicant has filed separate applications to register the same mark, the applicant may, in a limited situation, amend to move items of goods or services from one application to another, if the application from which the item is to be moved was filed on or before the filing date of the application to which

it is to be moved. Such an amendment will be permitted only if some of the goods/services in one application should be classified in a different class and the companion application includes that class. If the companion application does not include that class, the proper recourse is for the applicant to file a request to divide. See TMEP §§1110-1110.11(a).

Moving goods/services between applications in this way may only be done when the applications involved have not yet been published in the *Official Gazette*. Moreover, items of goods/services can be moved between applications only in applications filed under §1 or §44 of the Trademark Act. The applicant cannot amend to move items of goods/services to or from a §66(a) application.

The applicant must file the amendment as a request to delete specified goods/services in the application from which they are to be moved and to add those goods/services into a specified companion application. The amendment must include the serial numbers of both applications. The examining attorney(s) must ensure that the USPTO automated records are updated to reflect the changes in both applications.

An applicant may file a request to move all the goods/services from one application to another, if the applicant meets the requirements set forth above. The USPTO will construe such a request as a request to expressly abandon the application from which the goods/services are moved. If the request to move all the goods/services is granted, and no goods or services remain in the application from which the goods/services are moved, the USPTO will abandon the application. The USPTO will not refund the application filing fee. See TMEP §718.01 regarding express abandonment.

#### **1402.09 Use of Marks Inappropriate in Identifications**

If a mark that is registered to an entity other than the applicant is used in the identification of goods or services, the examining attorney must require that it be deleted and that generic wording be substituted. It is inappropriate to use a registered mark to identify a kind of product or a service, because such a mark indicates origin in only one party and cannot be used to define goods that originate in a party other than the registrant. *Camloc Fastener Corp. v. Grant*, 119 USPQ 264, 265 n.1 (TTAB 1958). In place of the mark, a generic term must be used.

Generally, an applicant should not use its own registered or unregistered mark in an identification of goods or services in its own application. If the applicant chooses to do so, however, the applicant should be careful to use the mark as an adjective modifying the generic name of the goods or services. In addition, the words “applicant” or “registrant” must not appear in the identification of goods or services. Before registration, use of the term “registrant” is inaccurate, and, after registration, use of the term “applicant” is inaccurate.

If the examining attorney issues a *nonfinal* action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite but is unacceptable because it includes a registered mark, this is not considered a new issue, and the examining attorney must issue a final requirement for amendment of the identification. However, if the examining attorney issues a *final* action requiring amendment of the identification because it is indefinite, and the applicant responds with an amended identification that is definite but includes a registered mark, the examining attorney should treat the response as incomplete, and grant the applicant additional time to cure this deficiency, pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b) for further information about granting an applicant additional time to perfect an incomplete response. *Examining attorneys are encouraged to try to resolve this issue by examiner's amendment.*

#### **1402.10 Identification of Goods and Services in Documents Filed in Connection with §1(b) Applications**

See TMEP §1104.09(c) regarding examination of the identification of goods or services in an amendment to allege use; TMEP §1108.02(d) regarding the identification of goods or services in a request for an extension of time to file a statement of use; and TMEP §1109.13 regarding examination of the identification of goods or services in a statement of use.

#### **1402.11 Identification of Services**

This section addresses identifications of particular types of services.

The major requirements for an acceptable identification of services are: (1) the identification must be definite; (2) it must use the common name or terminology for the services, so as to be readily understandable; (3) it must accurately describe the services; and (4) it must specify the services, and not merely refer to “collateral or related activities associated with rendering the services.”

*Example* - Where a mark identifies checking account services, the identification “banking services in the nature of a checking account” is more accurate than the general identification “banking services,” which is inclusive of services that may not be associated with the mark. The former identification is more definite, and clearly stated. On the other hand, if a service mark identifies a bank’s many services, then the more general identification “banking services” would be appropriate. Thus, either of these identifications could be accepted depending on the particular circumstances, including the nature of the mark and its use or intended use. In both cases, the services would be classified in Class 36.

*Example* - “Radio broadcasting services” (Class 38) would be an appropriate identification when a radio station uses a mark, such as call letters, to indicate the source of its broadcasting services generally. On the other hand, if an applicant is using the name of a weekly comedy television show as a mark, “television broadcasting services” would not be appropriate because the mark does not serve to identify and distinguish the electrical transmission of the program. Instead, the applicant should identify the services as “television entertainment services in the nature of a series of comedy programs” (Class 41).

Generally, the identification of a service should not emphasize the method or manner by which the service is provided. However, in some circumstances, it may be helpful to include such information in a trailing phrase.

*Example* - “Accounting services” (Class 35) is an acceptable identification of services; thus, whether this type of service is rendered by use of computers or other means need not be mentioned.

*Example* - “Dinner theater services” (Class 41) emphasizes the entertainment aspect associated with theater generally. The fact that dinner is also served at the theater performance is ancillary to the primary service of presenting the theatrical production.

A mark identifying a beauty contest is classified either as a promotional service rendered by the organizer of the contest to the businesses or groups that sponsor the contest, or as an entertainment service. When the record shows that the primary purpose of conducting such a pageant is to promote the sale of goods or services of the sponsors, the service should be recited as “promoting the goods or services of others by means of a beauty contest,” in Class 35. Where the beauty contest is presented primarily as entertainment for the general public, the service should be identified as, “entertainment services in the nature of beauty contests,” in Class 41.

The activities recited in the identification must constitute services as contemplated by the Trademark Act. See TMEP §§1301.01 *et seq.* as to what constitutes a registrable service. For example, “sales” cannot be listed as the primary activity in an identification, because the sale of one’s own goods or services is not a registrable service.

See *also* TMEP §§1401.09 *et seq.* regarding the changes in the international classification of services effective January 1, 2002.

## **1402.11(a) Computer Services**

*Services Classified in Classes 35, 36, 37, 39, 40, 41, 44, and 45*

Any activity consisting of a service that ordinarily falls in these classes (e.g., real estate agency services, banking services, dating services), and that happens to be provided over the Internet, is classified in the class where the underlying service is classified. For example, banking services are in Class 36 whether provided in a bank or online.

The following are examples of some acceptable identifications:

- “Providing banking services via the Internet, in Class 36.”
- “Arranging travel tours via the Internet, in Class 39.”
- “Promoting the goods and services of others by preparing and placing advertisements on websites accessed through the Internet, in Class 35.”
- “Electronic payment, namely, electronic processing and transmission of bill payment data, in Class 36.”
- “Providing social introduction services by means of an Internet website, in Class 45.”

### *Content Providers*

The service of providing information via the Internet is classified in the class of the information subject. Entities that provide these services by computer are considered to be “content providers,” that is, they provide the informational or substantive content of a website and/or home page. If an entity provides information in a wide variety of fields, the applicant must select the subject matter to be protected and classify the services accordingly (e.g., banking information in Class 36, business information in Class 35, home repair information in Class 37). See TMEP §1402.11(b) regarding information services.

Some acceptable identifications:

- “Providing information in the field of banking via websites on the Internet, in Class 36.”
- “Providing a website *featuring information* in the field of banking, in Class 36.” This is purely an information provision service and should be treated accordingly.
- “Providing information in the field of travel destinations, in Class 39.”

### ***Class 38: Provision of Telecommunications Connections to the Internet***

These services primarily involve providing telecommunication connections such as those provided by AT&T® and Verizon®. Telecommunication connections are the technical means by which one computer can communicate with another. A telecommunications provider is NOT providing

the computer technology that transfers the data; rather, it provides the means by which that data or information is transferred. This service connects the user to the website itself.

Remember: Just because the applicant is conducting an activity that may *involve* transmission of data on the Internet does not mean the applicant's service is a Class 38 service. For example, an applicant who merely has a website is not conducting "electronic transmission of messages and data," in Class 38. The companies providing the Internet connections are conducting the actual transmissions; the applicant is merely making the information available.

"Online bulletin boards" and "chat rooms" are classified in Class 38 *regardless of the content or subject matter*. The rationale for this stems from the fact that these services allow individuals to communicate with each other, like other Class 38 services.

"Providing multiple-user access to the Internet," is classified in *Class 38*. *Note:* This identification covers those services provided by Internet Service Providers ("ISPs"), such as Cox®, AOL®, Comcast®, and AT&T®. They provide the computer connection (often using the Class 38 telecommunications services of other entities) that enables a computer user to access the databases and websites of others via the Internet. These entities are considered "access providers" in that they provide the computer connection needed for a computer user to access a content provider. The word "access" should be limited to these services and should not be used in describing the services of a content provider.

*Some acceptable identifications:*

- "Provision of telecommunications connections to the Internet, in Class 38."
- "Electronic mail services, in International Class 38."
- "Broadcasting television or radio programs via the Internet, in Class 38."
- "Webcasting audio/visual programming via the Internet, in Class 38."
- "Video and audio teleconferencing via the Internet, in Class 38."
- "Providing an online bulletin board in the field of medicine, in Class 38."
- "Providing online chat rooms for transmission of messages among computer users concerning teen topics, in Class 38."
- "Providing multiple-user access to the Internet, in Class 38." Many ISPs, such as AOL®, have expanded their services to encompass content-based services for their subscribers. The "providing multiple-user access" identification only covers the ISP services. If the applicant wishes to protect its "content-based" services, it must identify those services with specificity and pay the appropriate fees therefor, if applicable.



### *Office-Function-Type Computer Services*

These services are essentially office function services (e.g., filing and record keeping) that happen to be conducted with the use of a computer:

- “Data processing services, in Class 35.”
- “Computer data entry and data retrieval services, in Class 35.”

### *Computer Installation and Repair Services*

The applicant must distinguish between computer *hardware* and computer *software*. For example:

- “Installation, maintenance, and repair of computer *hardware* systems, in Class 37.”
- “Installation, maintenance, and updating of computer *software* systems, in Class 42.”

If the installation and maintenance services refer to networks or systems, the service should be classified in Class 37. For example:

“Installation, maintenance, and repair of computer systems, in Class 37.”

If the applicant applies for “*technical support services*,” the examining attorney should suggest the following identifications:

- “Installation and maintenance services in either Class 37 or 42 (depending on whether the subject matter is hardware or software);”
- “Technical support services, namely, repair of computer hardware, in Class 37;”
- “Technical support services, namely, troubleshooting of computer software problems, in Class 42;” and
- “Technical support services, namely, diagnosis of computer hardware and software problems in Class 42.”

### *Computer Retail Services*

Retail (and distributorship) services are classified in Class 35 no matter how the services are conducted. Either of the following identifications is acceptable:

- “Computerized online retail store services in the field of [specify], in Class 35.”
- “Providing a website used to place online orders in the field of [specify], in Class 35.”

### *Computer Entertainment Services*

Generally, entertainment services are classified in Class 41. The difficulty is trying to figure out what entertainment activity the applicant is conducting. Therefore, the identification “providing a website featuring entertainment” is not acceptable. Instead, one of the following may be more appropriate:

If the services comprise an “*online game*.”

- “Entertainment services, namely, providing a multiple-user online computer game, in Class 41.”
- “Providing a computer game that may be accessed network-wide by network users, in Class 41.”

If the services involve “*chat rooms*.” “Providing online chat rooms for transmission of messages among computer users concerning [indicate field or subject of chat room],, in Class 38.”

If the services involve providing *content*: “Providing a website featuring information in the field of computer gaming entertainment, in Class 41.” See TMEP §1402.11(b).

If the services involve *providing a website from which a user can receive “webcasted” transmissions* over the Internet: “Broadcasting (radio programs, television programs, multimedia programming, etc.) via the Internet, in Class 38.”

If the services consist of *providing a particular online show “webcasted”* over the Internet: “Entertainment, namely a continuing [indicate type, e.g., variety, news, comedy] show broadcasted over the Internet, in Class 41.”

### *Computer Design and Development Services*

Generally, these services are in Class 42. It is important to remember that these services must be performed for the benefit of *others*. If an applicant is developing its own software, it is not engaging in a recognized service. (See TMEP §§1301.01 *et seq.* regarding activities that do not constitute services.) If the services are identified as “computer design and development services,” the specimens must show that the applicant provides these services for other parties. Some acceptable identifications are:

- “Computer software design and development services for others, in Class 42.”
- “Computer services, namely, creating and maintaining websites for others, in Class 42.”
- “Duplication of computer programs, in Class 42.”

### *Database Services*

Prior to January 1, 2002, the service of providing an online database via the Internet was classified in Class 42 if the database included a wide variety of subject matter. However, effective January 1, 2002, the *subject matter or content of the online database* now governs the classification of the services. Applicants must now separate the subject matter or content of the databases into their appropriate individual international classes. Acceptable identifications include:

- “Providing an online electronic database on the Internet in the field of banking, in Class 36.”
- “Providing an online electronic database on the Internet in the field of business evaluations of automobile companies, in Class 35.”
- “Providing an online electronic database on the Internet in the field of computer programming, in Class 42.”
- “Providing an online electronic database on the Internet in the field of cosmetology, in Class 44.”

In determining whether the specimens support “database provision services,” look for the following clues:

- See if the specimens use words like “to access our database,” “our database includes...”, etc.
- Confirm that the information provided online is capable of being searched, sorted, re-arranged, and indexed like a traditional database.
- If the specimens consist of merely a series of web pages, this is NOT a database. A more appropriate identification would be “providing a website on the Internet featuring information in the fields of \_\_\_\_\_, in Class \_\_\_\_ (class dependent on the content).”

Other common database services include the following:

- “Database development services, in Class 42.”
- “Computerized database management services, in Class 35.”

See TMEP §1402.11(b) regarding information services.

### *Miscellaneous Computer Services*

Occasionally, an applicant applies for an identification such as “electronic storage and retrieval of information, in Class 35.” This identification is no longer acceptable. The examining attorney should suggest wording such as: “electronic storage (or archiving) for others of [indicate subject matter, e.g., messages, data], in Class 39.”

Do not use the term “data warehouse” to describe these services. A “data warehouse” is a very large database designed for fast processing of queries, projections, and data summaries, normally used by a large organization.

### *Online Publications*

All online publications are classified in Class 41 *no matter what the subject matter*. An acceptable identification would be:

“Computer services, namely providing online [indicate specific nature of publications, e.g., magazines or newsletters] in the field of [indicate subject matter of publication], in Class 41.”

A column or section of an online publication would be identified as “computer services, namely, providing a [column or section] in an online [indicate type of publication] in the field of [indicate subject matter of publication],” in Class 41.

The examining attorney should verify from the specimens that the information is presented in a “publication” format. An online magazine in Class 41 must really look and act like a magazine, i.e., contain monthly or periodic articles, sections, features, advertisements, credits, etc. If it does not, a more appropriate identification would be “providing a website on the Internet featuring information in the field of \_\_\_\_\_, in Class \_\_\_\_” (classification dependent on the content).

If an applicant identifies its goods as “publications, namely ...,” and it becomes apparent during examination that the goods are in fact online publications, the applicant may amend the identification to indicate that the goods are online publications in Class 41, since the term “publications” is broad enough to encompass both printed and online publications. On the other hand, if the applicant identifies its goods as “printed publications...,” the identification cannot be amended to indicate that the goods are “online publications,” because this would exceed the scope of the original identification. 37 C.F.R. §2.71(a).

### **1402.11(b) Information Services**

Prior to January 1, 2002, the identification “providing information in a wide variety of fields” was an acceptable identification of services, particularly in the context of Internet websites. The only caveat was to make sure that the website or information services *did* provide information in a wide variety of fields.

Effective January 1, 2002, the “miscellaneous” phrase has been eliminated from the heading of Class 42 (see TMEP §1401.09(a)). Therefore, the examining attorney must require that the applicant indicate the fields in which it is providing information so that the service can be accurately classified. The fields may be listed somewhat broadly, but with enough specificity to allow classification. “Bundling” of the fields of information (that is, listing all fields of information but allowing the dominant or most significant field to

control the classification with the other fields simply “along for the ride”) is no longer acceptable.

Since information services must now be classified according to the subject matter of the information, the nature or subject matter of the information provided must be specified to allow for proper classification. For example, “information in the field of automobiles” is not sufficiently definite to allow for proper classification. If the information pertains to purchasing an automobile, then the service is classified in Class 35. If the information pertains to the care and maintenance of automobiles, the service is classified in Class 37. If the service involves insurance or financing of automobiles, then Class 36 is the proper class. Perhaps the best way to ensure that the information is classified correctly is to identify the subject matter of the service. For example, “information in the field of automobile financing” is adequate to classify the service in Class 36. Another way to clarify the classification of information services is to characterize the information itself. Thus, “providing financing information in the field of automobiles” clearly puts the service in Class 36. As with many other service identifications that require an indication of the subject matter or field, the subject matter or field does not have to be as specific as would be required if that were the service itself. However, an indication of the nature of the information must be included, either by reference to the type of information or the subject matter of the information provided, to allow for proper classification of the activity.

An applicant is not required to register in all classes in which it provides information, but may instead choose to register only the classes of the fields that are most important to it. The examining attorney will ask the applicant to indicate the fields of information to assist in classification. The applicant must decide if it wishes to: (1) go forward and register the information services in all of the appropriate classes; or (2) choose the class(es) that are most important to its business, and amend the identification to delete reference to fields of information that fall into other classes. See TMEP §1401.04(b).

#### **1402.11(c) Association Services and “Promoting the Interest of” Services**

The classification of services rendered by associations was affected by the reorganization of Class 42 (see TMEP §§1401.09 *et seq.*). Prior to January 1, 2002, the Explanatory Notes regarding this topic for the old Class 42 included the language “services (not included in other classes) rendered by associations to their own members.” This language in the old Class 42 allowed identifications of services such as “association services, namely, promoting the interest of lawyers” to be accepted in Class 42. Effective January 1, 2002, there is no reference to “services rendered by an association” in the Class Heading or Explanatory Notes for any of the service classes.

Most activities rendered by associations are easily classified in other classes, e.g., insurance services (Class 36), business services (Class 35), travel arrangements (Class 39), training and entertainment (Class 41).

Effective January 1, 2002, lobbying services and activities related or similar to lobbying activities provided by an association are classified in Class 35, because they further the business interests of the group represented by the association. Even non-business interests such as those that promote reading skills or environmental protection have a “business interest” in promoting their concerns.

#### **1402.11(d) Charitable Services, Other than Monetary**

Prior to January 1, 2002, non-monetary charitable services were classified in Class 42, regardless of the type of service being provided by the charity. Effective January 1, 2002, services are classified by the nature of the service provided, e.g., “charitable services, namely, providing shelter for the homeless” are in Class 43, like other temporary accommodation services; “charitable services, namely, providing tutoring for underprivileged students” are classified in Class 41 like other educational services. See TMEP §§1401.09 *et seq.* regarding the changes in the international classification of services effective January 1, 2002.

#### **1402.11(e) Consulting Services**

Prior to January 1, 2002, all consulting services were classified in Class 42 except those relating to business (Class 35) and financial or insurance (Class 36). Effective January 1, 2002, consulting services are classified in the class of the subject matter of the service. This includes technical consulting services. Technical consulting is like any other consultation service; it just focuses more on how things work. Thus, the type of consultation or subject matter of the consultation must be set forth with adequate specificity to allow for accurate classification. It should be noted that “technology consulting” is in Class 42 because it encompasses consulting about the information technology related to the subject matter given.

*Some Acceptable Identifications:*

- “Consulting in the field of telecommunication services, namely, transmission of voice, data, and documents via telecommunications networks, in Class 38.”
- “Consulting in the field of telecommunications technology, in Class 42.”
- “Consulting in the field of maintenance and repair of telecommunications networks, apparatus, and instruments, in Class 37.”

- “Consulting in the field of environmental protection, namely, detection of contaminants in water, in Class 42.”
- “Technical consulting related to the installation of oil and gas equipment, control systems, and machinery, in Class 37.”
- “Technical consulting related to the manufacturing of oil and gas equipment, control systems, and machinery, in Class 40.”
- Technical consulting in the field of environmental science, in Class 42.”

See TMEP §§1401.09 *et seq.* regarding the changes in the international classification of services effective January 1, 2002.

#### **1402.11(f) Distribution of Videotapes, Audiotapes, Videodiscs, and Similar Items**

The services of production and distribution of motion pictures and television programs are classified in Class 41. This service involves the actual creation of the motion picture or television program and the accompanying activity of distributing it to movie theatres and television stations for display to the public. In this service, the ownership of the physical product does not leave the producer. The movie theatre or television stations “lease” (in a sense) the film or tape for a period of time and then return it to the producer. This is not the case when distribution relates to videotapes, audiotapes, or other hard goods that result from the production of visual or audio entertainment. When these goods are distributed, it is the same as the distribution of any other kind of hard goods by any other manufacturer. The ownership of the physical product is transferred to the purchaser just as it is with clothing, toys, food products, or computers. For this reason, the identification “distribution of videotapes, audiotapes, videodiscs, etc.” should not be accepted as a service even when the distribution is linked to the production of these goods. The production of the entertainment product is perfectly acceptable in Class 41; however, the distribution of the hard goods that result from that production is not a service in that class. It is possible that such distribution could be considered a distributorship service in Class 35, but that must be determined on a case-by-case basis. Distribution of one’s own goods is not a service; it is merely a necessary part of doing business. However, if the applicant distributes the videotapes, audiotapes, etc. of others as well as those it has produced, it may be identified as a distributorship service in Class 35.

See TMEP §§1301.01 *et seq.* regarding the criteria for determining whether an activity constitutes a service.

#### **1402.11(g) Recorded Entertainment Services**

For entertainment services such as those rendered by a musical group, the performance must be live. The recording of a live concert or studio performance is not considered a service of the performing group. Similarly, performances for the sole purpose of recording are not considered services. The production by another entity of a performance by a musical group for recordation would be a service, but an identification such as "live and recorded performances by a musical group" could not be accepted as a valid service identification unless the words "and recorded" were deleted.

Recorded entertainment usually takes the form of goods in Class 9, such as videotapes, audio cassettes, DVDs, CD-ROMs, etc. This is consistent with the treatment of "distribution" of these products as goods and not services as discussed in §1402.11(f).

See TMEP §§1301.01 *et seq.* regarding the criteria for determining whether an activity constitutes a service.

#### **1402.11(h) Identification of "Bonus Programs"**

Many businesses offer "bonus programs" or "frequent patron programs" to encourage patronage of that business. However, promotion of one's own goods or services is not considered a service under the Lanham Act since the beneficiary of such an activity is the business itself and not a third party. See TMEP §1301.01(b)(i). These special programs do confer some benefit to the customers who participate in the program, but this benefit flows directly from use of the trademark owner's goods or services. Thus, a frequent flyer program provided by an airline to encourage use of its own air transportation services would be identified as "air transportation services featuring a frequent flyer bonus program" and it would be classified in Class 39. Similarly, a retail store that has a program through which patrons earn points that result in discounts on future purchases at that store would be identified as "retail store services in the field of [indicate field] featuring a frequent patron program in which points are accumulated to be used for discounts on future purchases." This service would be in Class 35 because it is primarily a retail store service. It should be noted that organizing and conducting a program of this type for a third party is a promotion/advertising service and would be classified in Class 35 and identified with language such as "promoting the goods and services of others by means of a point accumulation program with points used for discounts on future purchases of those goods and services" (or whatever the details of the program may be.)

#### **1402.11(i) Recognition of Industry Terms**

Industry terminology should be recognized as sufficient to identify the services when supported by two or three references in dictionaries related to



that industry or other similar resource books. Examples of acceptable terminology are "telecommunications services, namely, personal communications services" and "telecommunications services, namely, ISDN services." If there is any question, a brief explanation of the activity may be included in the identification, but the accepted industry terminology may remain part of the identification as well.

#### **1402.11(j) Issuing Awards**

Services that involve the issuance of awards are usually classified in Classes 35 and 41. Classification depends upon the purpose of the award program. If the award program is an employee incentive rewarding excellence in job-related performance that actually furthers the business of an employer (e.g., safety, quality, productivity, customer service), then the service is classified in Class 35. If the award program is to recognize excellence or achievement that may or may not be related to the participants' business or professional endeavors (e.g., achievements in community service, excellence in country music performance), then the service should be classified in Class 41. The distinction is that Class 35 award programs do further the business interests of an employer by encouraging positive business-related performance, while Class 41 award programs reward excellence for endeavors that do not further the business interests of an employer.

#### **1402.12 Parentheses and Brackets Should Not be Used in Identifications of Goods and Services**

Generally, parentheses and brackets should not be used in identifications of goods and services. The Post Registration Section of the USPTO uses single brackets to indicate that goods/services have been deleted from a registration either by amendment under 15 U.S.C. §1057, filing of a partial affidavit of continued use under 15 U.S.C. §1058 or 15 U.S.C. §1141k, or filing of a partial renewal application under 15 U.S.C. §1059. The Post Registration Section also uses double parentheses to indicate that certain goods or services are not claimed in an affidavit of incontestability under 15 U.S.C. §1065. See TMEP Chapter 1600 regarding affidavits of continued use or excusable nonuse, renewal applications, affidavits of incontestability, and amendment of registrations.

Therefore, to avoid confusion, applicants should not use parentheses and brackets in the identification of goods or services in an application. The only time parentheses may be used in an identification is when the parentheses merely explain or translate the matter preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification.

For example, "bags (tote)" in Class 18 would not be an acceptable use of parentheses. If the identification were misinterpreted to mean that "tote" was no longer part of the identification of goods (due to an amendment of the

goods, or filing of a partial affidavit of continued use or renewal application, the item would merely read “bags.” That would create an ambiguity within Class 18, since it could refer to any type of bag – from an all-purpose sports bag to an evening bag – and it would make a determination of likelihood of confusion difficult. Also, some bags are in classes other than Class 18. Without an indication of the type of bag, classification of the goods is problematic.

However, an identification of goods such as “obi (Japanese sash)” in Class 25 would be acceptable because the parenthetical phrase merely provides further information about the goods.

#### **1402.13 Requirement for Amendment of Portion of Identification of Goods/Services**

If a requirement for an amendment of the identification of goods and/or services is expressly limited to only certain goods/services, and the applicant fails to file a response to the refusal or requirement, the application shall be abandoned only as to those particular goods/services, if it is otherwise in condition for approval for publication. 37 C.F.R. §2.65(a); TMEP §718.02(a). However, if the Office action includes an advisory stating that amendment would require the payment of additional fees because the fee paid is insufficient to cover all the classes, and the applicant fails to file a response, the entire application will be abandoned. TMEP §718.02(a).

Accordingly, when the identification of goods/services includes some terminology that is indefinite and some terminology that is acceptable, the examining attorney should specify which terminology is indefinite, suggest amended language if possible, and indicate that the rest of the identification is acceptable.

When an applicant fails to respond to a requirement to amend some terminology in an otherwise acceptable identification of goods/services, and the application is otherwise in condition for approval for publication, the examining attorney should issue an examiner’s amendment that clearly sets forth the changes that will be made to the identification of goods/services. No prior authorization from the applicant is needed to issue an examiner’s amendment in this situation. See TMEP §707.02 regarding examiner’s amendments without prior authorization by the applicant.

#### **1402.14 Identification of Goods/Services Must Conform to Rules and Policies in Effect at the Time Registration is Sought**

The question of whether an identification of goods/services is acceptable must be determined on the basis of the facts and evidence that exist at the time registration is sought, that is, at the time of filing. Cf. TMEP §1216.01. The international classification system and USPTO policy on acceptable

identifications change periodically (see, e.g., TMEP §§1401.09 *et seq.* regarding the restructuring of international class 42). Therefore, the fact that an identification of goods or services was accepted in an earlier-filed application or prior registration does not necessarily mean it is controlling in a later-filed application. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (examining attorney's requirement for amendment of the term "chronographs" in the identification of goods upheld, notwithstanding applicant's ownership of several registrations in which this term appears without further qualification in the identification).

#### **1402.15 Procedures for Processing Unacceptable Amendments to Identifications**

If an applicant submits an amendment to the identification of goods/services and the examining attorney determines that the amendment is unacceptable, the examining attorney must issue an action refusing to accept the amendment. If an unacceptable amendment was entered into the automated records of the USPTO, and an acceptable amendment was subsequently submitted, the examining attorney must ensure that the automated records are modified to reflect the acceptable identification prior to approving the mark for publication.

If the applicant later submits arguments in support of acceptance of the amendment and the examining attorney determines that the amendment is still unacceptable, the examining attorney must issue a final refusal of the amendment, if the application is otherwise in condition for final action.

#### **1403 Combined or Multiple-Class Application**

*37 C.F.R. §2.86. Application may include multiple classes.*

*(a) In a single application, an applicant may apply to register the same mark for goods and/or services in multiple classes. The applicant must:*

*(1) Specifically identify the goods or services in each class;*

*(2) Submit an application filing fee for each class, as set forth in §2.6(a)(1); and*

*(3) Include either dates of use (see §§2.34(a)(1)(ii) and (iii)) and one specimen for each class, or a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class. The applicant may not claim both use in commerce and a bona fide intention to use the mark in commerce for the identical goods or services in one application.*

*(b) An amendment to allege use under §2.76 or a statement of use under §2.88 must include, for each class, the required fee, dates of use, and one*

*specimen. The applicant may not file the amendment to allege use or statement of use until the applicant has used the mark on all the goods or services, unless the applicant files a request to divide. See §2.87 for information regarding requests to divide.*

*(c) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide. See §2.87 for information regarding requests to divide.*

### **1403.01 Requirements for Combined or Multiple-Class Application**

Goods and/or services that fall in more than one class may be included in one application, called a “combined” or “multiple-class” application.

A multiple-class application may be viewed as a group of applications for registration of a mark in connection with goods or services in each class, combined into one application. Each class of goods or services must be considered separately. See *G&W Laboratories, Inc. v. G W Pharma Ltd.*, 89 USPQ2d 1571 (TTAB 2009).

A multiple-class application may pertain to only one mark, and to only one register. A single certificate of registration will be issued, unless the application is divided. See TMEP §§1110 *et seq.* regarding division of an application.

A multiple-class application must contain the following:

- (1) The class numbers for which registration is sought, and the goods or services appropriately classified in each class. The classes must be set forth in consecutive numerical order beginning with the lowest number, and the goods or services must be listed in association with their class numbers. Setting the classes and the goods or services out in tabulated form rather than narrative form is desirable because it usually adds clarity. 37 C.F.R. §§2.32(a)(6) and (7).
- (2) A filing fee for each class. 37 C.F.R. §§2.6(a)(1), 2.32(d), and 2.86(a)(2). See TMEP §§810.01 and 1403.06.
- (3) The dates of first use and first use in commerce for each class, in an application under §1(a) of the Act. 37 C.F.R. §2.86(a)(3). If the dates are the same for all classes, the dates may be stated once, with the statement that the mark was first used on said dates on the goods or services in all the classes. If the dates of use differ for different classes, the appropriate dates for each class must be specified separately. The dates may be set forth in separate clauses, sentences, or paragraphs, or in tabular form, whichever will give complete information in the clearest way under the circumstances.

- (4) One specimen supporting use of the mark on goods or services in each class, in an application under §1(a) of the Act. 37 C.F.R. §2.86(a)(3). If a single specimen supports multiple classes, the applicant may so indicate, and the examining attorney need not require multiple copies of the specimen. The examining attorney should make a note, in the “Notes-to-the-File” section of the record, indicating which classes the specimen supports.
- (5) Only one drawing may be included, because there may be only one mark per application. See TMEP §807.01.

Prior to registration, an intent-to-use applicant must file an allegation of use under 15 U.S.C. §1051(c) or 15 U.S.C. §1051(d) which: states that the applicant is using the mark in commerce on or in connection with the goods or services; includes dates of use and a filing fee for each class; and includes one specimen evidencing use of the mark for each class. 37 C.F.R. §2.86(b). See 37 C.F.R. §2.76 and TMEP §§1104 *et seq.* regarding amendments to allege use, and 37 C.F.R. §2.88 and TMEP §§1109 *et seq.* regarding statements of use.

#### **1403.02            Amendment of Combined or Multiple-Class Application**

An application under §1 or §44 of the Trademark Act may be amended during prosecution to delete, correct, or add classes, when appropriate.

In a §66(a) application, classes may be deleted, but classes cannot be added, and goods/services cannot be moved to another class. 37 C.F.R. §2.85(d). See TMEP §§1401.03(d), 1402.01(c), and 1904.02(b) and (c).

##### **1403.02(a)            Deletion of Classes**

An applicant may delete a class or classes and prosecute the application only in the remaining class or classes. Normally, the filing fee is not refunded when a class is deleted. 37 C.F.R. §2.209; TMEP §§405.04 and 810.02.

If the applicant designates the classes incorrectly and there are actually no goods in one of the classes designated in a multiple class application, the fee for that class may be refunded.

##### **1403.02(b)            Correction of Classification**

In an application under §1 or §44 of the Trademark Act, improper classification can be corrected by switching goods/services by amendment from one to another of the classes originally set forth, or by changing the class designations, as long as the number of classes is not increased.

The examining attorney may correct classification through an examiner’s amendment, without prior authorization by the applicant. See TMEP §707.02.

When more than one item of goods or services are listed in a class, the specimen and dates of use given do not necessarily apply to all the items listed. If the item to which the specimen and/or dates pertain is removed from the identification by amendment, the applicant must submit a new specimen and/or dates of use for that class. If the new dates differ from the dates originally set forth, the additional dates must be supported by an affidavit or declaration by the applicant. 37 C.F.R. §2.71(c). See TMEP §903.04 regarding permissible amendment of dates of use.

In a §66(a) application, classes cannot be added, and goods/services cannot be moved to another class. 37 C.F.R. §2.85(d). See TMEP §§1401.03(d), 1402.01(c), and 1904.02(b) and (c).

### **1403.02(c) Addition of Classes**

In an application under §1 or §44 of the Trademark Act, class(es) may be added if any of the items originally recited are properly classified in class(es) not originally designated. The applicant must pay an additional fee for each new class.

The amount of the fee varies depending on the method used to file the original application and the amendment adding classes, as follows:

- If the original application was filed through TEAS Plus and the amendment is filed through TEAS (either as a preliminary amendment or a response to an examining attorney's Office action) or entered by examiner's amendment, then the fee for adding a class is the same as the TEAS Plus application filing fee per class (37 C.F.R. §2.6(a)(1)(iii)).
- If the original application was not filed through TEAS Plus, and the amendment is filed through TEAS or entered by examiner's amendment, then the fee for adding a class is the same as the TEAS application filing fee per class (37 C.F.R. §2.6(a)(1)(ii)).
- If the amendment is filed on paper, then the fee for adding a class is the same as the fee per class for filing an application on paper (37 C.F.R. §2.6(a)(1)(i)), regardless of how the original application was filed.

The current fee schedule is available on the USPTO website at <http://www.uspto.gov>.

If dates of use for a class that is added are different from dates previously set forth, the applicant must submit an affidavit or declaration under 37 C.F.R. §2.20 to support the dates. 37 C.F.R. §2.71(c). See TMEP §903.04 regarding permissible amendment of dates of use.

An additional specimen that is not identical to a specimen originally filed must be supported by an affidavit or declaration attesting to its use as of an appropriate date. 37 C.F.R. §2.59; TMEP §904.05.

If an intent-to-use application is amended to add class(es), the applicant must submit, for each added class, the basic application fee *and* fees for the allegation of use (i.e., either the amendment to allege use or the statement of use), and any extension request(s) granted in the interim. This applies even if the classes are added after the amendment to allege use or statement of use is filed, or the extension request(s) is granted.

In a §66(a) application, classes cannot be added, and goods/services cannot be moved to another class. 37 C.F.R. §2.85(d). See TMEP §§1401.03(d), 1402.01(c), and 1904.02(b) and (c).

### **1403.03 Dividing of Combined or Multiple-Class Application**

A delay in registration of one class in a multiple-class application will mean delay for the entire application. In such a situation, upon payment of the applicable fee, the applicant may file a request to physically divide the original application into separate applications. These new applications are assigned new serial numbers and cross-referenced with the original application. The additional separate applications are given the same filing date as the original application.

The following are examples of situations when an applicant may want to have class(es) divided out into one or more separate applications:

- (1) Registration is refused in less than all the classes;
- (2) A notice of opposition is filed against goods or services in less than all the classes; or
- (3) The applicant in a §1(b) application begins using the mark in commerce on goods or services in less than all the classes. .

When a multiple-class application is divided, the application is separated or divided into individual applications. See TMEP §§1110 *et seq.* for information about dividing an application.

### **1403.04 Combined or Multiple-Class Marks in *Official Gazette***

The marks in multiple-class applications appear in the *Official Gazette* in a separate section from the marks in single-class applications. Therefore, it is necessary to look in more than one place in the *Official Gazette* to make a complete review of published marks.

### **1403.05 Refusals and Oppositions as to Less Than All the Classes in a Multiple-Class Application**

A refusal to register or a requirement may be made for less than all the classes in an application. Whether it is appropriate to make a refusal or requirement with regard to less than all classes must be considered on a case-by-case basis.

When issuing a refusal or requirement pertaining to less than all the classes, the examining attorney must expressly state that the refusal or requirement that applies only to certain class(es), and indicate the class(es) to which the refusal or requirement pertains. If an applicant fails to file a complete response to a refusal or requirement that was expressly limited to certain class(es), the application shall be abandoned only as to those class(es) if it is otherwise in condition for approval for publication. However, if the Office action includes an advisory stating that amendment would require the payment of additional fees because the fee paid is insufficient to cover all the classes, and the applicant fails to file a response, the entire application will be abandoned. 37 C.F.R. §2.65(a). See TMEP §718.02(a).

When an opposition is sustained only as to some of the class(es) in a multiple-class application, the application is returned to the examining attorney. The examining attorney must perform the proper TRAM transaction to ensure issuance of registration for only the proper class(es).

### **1403.06 Fees for Action After Filing, Multiple Classes**

In a multiple-class application or registration, a fee for each class must be paid when filing an allegation of use or request for extension of time to file a statement of use for applications under §1(b) of the Trademark Act; ex parte appeal to the Trademark Trial and Appeal Board; affidavit or declaration under §8 or §71 of the Act; affidavit of incontestability under §15 of the Act; application for renewal of a registration under §9 of the Act, opposition, or petition for cancellation of a registration under §14 of the Act. 15 U.S.C. §§1051, 1058, 1059, 1063, 1064, 1065, and 1141k.

In these situations, when a party submits a fee that does not cover all the classes in the application or registration, the party should state that action is sought only for the number of classes equal to the number of fees submitted, and should specify the classes for which action is being sought. This may avoid an unnecessary inquiry by the USPTO.

See TMEP §1403.02(c) regarding the amount of the fee(s) for adding class(es) to an application.



**1403.07                      Surrender or Amendment in Multiple-Class Registrations**

In a multiple-class registration, deletion of less than all the goods or services in a single class constitutes an amendment, whereas deletion of an entire class constitutes a surrender of the registration for cancellation as to the class deleted. 37 C.F.R. §2.172; TMEP §1609.03.