

Chapter 1400 — Classification and Identification of Goods and Services

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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.

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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. Unless otherwise indicated, references in the 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.

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

1401.02(a) Headings of International Trademark Classes [R-2]

International trademark classification, and the headings of the international trademark classes, are established by the Committee of Experts of the Nice Union and are promulgated in the volume entitled *International Classification of Goods and Services for the Purposes of the Registration of Marks* (8th ed. 2002), published by the World Intellectual Property Organization (WIPO). For additional information relating to this publication, see TMEP §1401.02(c).

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 List of Classes are general indications relating to the field to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to make sure of the classification of each specific product or service.

Goods

- (1) If a product cannot be classified in accordance with the List of Classes or with the Alphabetical List, the following remarks indicate the criteria to be applied:

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- (a) Finished products are classified, in principle, according to their function or purpose; if that criterion is not provided for in the List of Classes, finished products are classified by analogy with other comparable finished products contained in the Alphabetical List. If none is found, other subsidiary criteria such as that of the material of which the goods are made or the mode of operation are applied.
- (b) Finished products which are multipurpose composite objects (e.g., clocks incorporating radios) may be classified in all the classes that correspond to each of their functions or intended purposes. If those criteria are not provided in the List of Classes, then other criteria indicated under (a) are to be applied.
- (c) Raw materials, unworked or semi-worked, are classified, in principle, 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, criterion (a) applies.
- (e) Where goods, whether finished or not, are classified according to the material of which they are made and where they are made of different materials, such goods are in principle classified according to the material which predominates.
- (f) Cases adapted to the product they are intended to contain are classified, in principle, in the same class as the product.

Services

- (1) If a service cannot be classified in accordance with the Alphabetical List, the following remarks indicate the criteria to be applied:
 - (a) Services are classified, in principle, according to the branches of activity specified in the headings of the service classes and their Explanatory Notes or, subsidiarily, by analogy with other comparable services contained in the Alphabetical List.
 - (b) Rental services are classified, in principle, in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, 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.

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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

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

Includes, in particular:

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

Does not include, in particular:

- raw natural resins (Cl. 02);
- chemical products for use in medical science (Cl. 05);
- fungicides, herbicides and preparations for destroying vermin (Cl. 05);
- 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; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Explanatory Note

This class includes mainly paints, colourants and preparations used for the protection against corrosion.

Includes, in particular:

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

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Does not include, in particular:

- unprocessed artificial resins (Cl. 01);
- laundry blueing (Cl. 03);
- cosmetic dyes (Cl. 03);
- 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

This class includes mainly cleaning preparations and toilet preparations.

Includes, in particular:

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

Does not include, in particular:

- chemical chimney cleaners (Cl. 01);
- degreasing preparations for use in manufacturing processes (Cl. 01);
- deodorants other than for personal use (Cl. 05);
- sharpening stones and grindstones (handtools) (Cl. 08).

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

This class includes mainly industrial oils and greases, fuels and illuminants.

Does not include, in particular:

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

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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

This class includes mainly pharmaceuticals and other preparations for medical purposes.

Includes, in particular:

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

Does not include, in particular:

- sanitary preparations being toiletries (Cl. 03);
- deodorants for personal use (Cl. 03);
- 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; nonelectric 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

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

Does not include, in particular:

- bauxite (Cl. 01);
- mercury, antimony, alkaline and alkaline-earth metals (Cl. 01);
- metals in foil and powder form for painters, decorators, printers and artists (Cl. 02).

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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

This class includes mainly machines, machine tools, motors and engines.

Includes, in particular:

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

Does not include, in particular:

- certain special machines and machine tools (consult the Alphabetical List of Goods);
- hand tools and implements, hand operated (Cl. 08);
- motors and engines for land vehicles (Cl. 12).

CLASS 8

(Hand tools)

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

Explanatory Note

This class includes mainly hand operated implements used as tools in the respective professions.

Includes, in particular:

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

Does not include, in particular:

- certain special instruments (consult the Alphabetical List of Goods);
- machine tools and implements driven by a motor (Cl. 07);
- surgical cutlery (Cl. 10);
- paperknives (Cl. 16);
- fencing weapons (Cl. 28).

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CLASS 9

(Electrical and scientific apparatus)

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), lifesaving 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

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 television receivers only;
- 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.

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. 08);
 - (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).

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CLASS 10

(Medical apparatus)

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

Explanatory Note

This class includes mainly medical apparatus, instruments and articles.

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

Includes, in particular:

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

Does not include, in particular:

- steam producing apparatus (parts of machines) (Cl. 07);
- electrically heated clothing (Cl. 09).

CLASS 12

(Vehicles)

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

Explanatory Note

Includes, in particular:

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

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Does not include, in particular:

- certain parts of vehicles (consult the Alphabetical List of Goods);
- railway material of metal (Cl. 06);
- motors, engines, couplings and transmission components other than for land vehicles (Cl. 07);
- parts of motors and engines (of all kinds) (Cl. 07).

CLASS 13

(Firearms)

Firearms; ammunition and projectiles; explosives; fireworks.

Explanatory Note

This class includes mainly firearms and pyrotechnical products.

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; jewelry, precious stones; horological and chronometric instruments.

Explanatory Note

This class includes mainly precious metals, goods in precious metals and, in general, jewelry, clocks and watches.

Includes, in particular:

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

Does not include, in particular:

- certain 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. 02);
 - amalgam of gold for dentists (Cl. 05);
 - cutlery (Cl. 08);
 - electric contacts (Cl. 09);
 - pen nibs of gold (Cl. 16);
- objects of art not in precious metals (classified according to the material of which they consist).

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CLASS 15

(Musical Instruments)

Musical instruments.

Explanatory Note

Includes, in particular:

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

Does not include, in particular:

- apparatus for the recording, transmission, amplification and reproduction of sound (Cl. 09).

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

This class includes mainly paper, goods made from that material and office requisites.

Includes, in particular:

- paper knives;
- duplicators;
- plastic sheets, sacks and bags for wrapping and packaging.

Does not include, in particular:

- certain goods made of paper and cardboard (consult the Alphabetical List of Goods);
- colours (Cl. 02);
- hand tools for artists (for example: spatulas, sculptors' chisels) (Cl. 08).

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.

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Explanatory Note

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

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

This class includes mainly leather, leather imitations, travel goods not included in other classes and saddlery.

Does not include, in particular:

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

CLASS 19

(Nonmetallic building materials)

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

Explanatory Note

This class includes mainly nonmetallic building materials.

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.

Does not include, in particular:

- cement preservatives and cement-waterproofing preparations (Cl. 01);
- fireproofing preparations (Cl. 01).

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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

This class includes mainly furniture and its parts and plastic goods, not included in other classes.

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.

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. 09);
- 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 (not of precious metal or coated therewith); 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

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

Includes, in particular:

- utensils and containers for household and kitchen use, for example: kitchen utensils, pails, and pans of iron, aluminum, plastics and other materials, small hand-operated apparatus for mincing, grinding, pressing, etc.;
- candle extinguishers, not of precious metal;

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- electric combs;
- electric toothbrushes;
- dish stands and decanter stands.

Does not include, in particular:

- certain goods made of glass, porcelain and earthenware (consult the Alphabetical List of Goods);
- cleaning preparations, soaps, etc. (Cl. 03);
- small apparatus for mincing, grinding, pressing, etc., driven by electricity (Cl. 07);
- razors and shaving apparatus, clippers (hand instruments), metal implements and utensils for manicure and pedicure (Cl. 08);
- 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

This class includes mainly rope and sail manufacture products, padding and stuffing materials and raw fibrous textile materials.

Includes, in particular:

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

Does not include, in particular:

- certain nets, sacs 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.

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Explanatory Note

This class includes mainly textiles (piece goods) and textile covers for household use.

Includes, in particular:

- bedding linen of paper.

Does not include, in particular:

- certain special textiles (consult the Alphabetical List of Goods);
- electrically heated blankets (Cl. 10);
- table linen of paper (Cl. 16);
- horse blankets (Cl. 18).

CLASS 25

(Clothing)

Clothing, footwear, headgear.

Explanatory Note

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

This class includes mainly dressmakers' articles.

Includes, in particular:

- slide fasteners.

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 (nontextile).

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Explanatory Note

This class includes mainly products intended to be added as furnishings to previously constructed floors and walls.

CLASS 28

(Toys and sporting goods)

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

Explanatory Note

Includes, in particular:

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

Does not include, in particular:

- Christmas tree candles (Cl. 04);
- diving equipment (Cl. 09);
- amusement apparatus adapted for use with television receivers only (Cl. 09);
- 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, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Explanatory Note

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

Includes, in particular:

- milk beverages (milk predominating).

Does not include, in particular:

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- baby food (Cl. 05);
- dietetic substances adapted for medical use (Cl. 05);
- salad dressings (Cl. 30);

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- fertilised eggs for hatching (Cl. 31);
- foodstuffs for animals (Cl. 31);
- living 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

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

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).

Does not include, in particular:

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- salt for preserving other than for foodstuffs (Cl. 01);
- medicinal teas and dietetic substances adapted for medical use (Cl. 05);
- baby food (Cl. 05);
- 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; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Explanatory Note

This class includes mainly land products not having been subjected to any form of preparation for consumption, living animals and plants as well as foodstuffs for animals.

Includes, in particular:

- raw woods;
- raw cereals;
- fertilized eggs for hatching;

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- mollusca and crustacea (live).

Does not include, in particular:

- cultures of micro-organisms and leeches for medical purposes (Cl. 05);
- 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 nonalcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Explanatory Note

This class includes mainly nonalcoholic beverages, as well as beer.

Includes, in particular:

- de-alcoholised drinks.

Does not include, in particular:

- beverages for medical purposes (Cl. 05);
- 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

Does not include, in particular:

- medicinal drinks (Cl. 05);
- de-alcoholised drinks (Cl. 32).

CLASS 34

(Smokers' articles)

Tobacco; smokers' articles; matches.

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Explanatory Note

Includes, in particular:

- tobacco substitutes (not for medical purposes).

Does not include, in particular:

- cigarettes without tobacco, for medical purposes (Cl. 05);
- certain smokers' articles in precious metal (Cl. 14) (consult the Alphabetical List of Goods).

SERVICES

CLASS 35

(Advertising and business)

Advertising; business management; business administration; office functions.

Explanatory Note

This class 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.

Includes, in particular:

- services consisting of the registration, transcription, composition, compilation, or systematization of written communications and registrations, and also the exploitation or 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;
- 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.

Does not include, in particular:

- activity of an enterprise the primary function of which is the sale of goods, *i.e.*, of a so-called commercial enterprise;

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- 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

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

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 cooperative 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

This class 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.

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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).

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

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

- (1) allow a 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).

Includes, in particular:

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

Does not include, in particular:

- radio advertising services (Cl. 35).

CLASS 39

(Transportation and storage)

Transport; packaging and storage of goods; travel arrangement.

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Explanatory Note

This class 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.

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.

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

This class 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.

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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.

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

This class contains 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.

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, scientific & legal)

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

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 specialists, lawyers, etc.

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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.

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).

CLASS 43

(Hotels and restaurants)

Services for providing food and drink; temporary accommodations.

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 accommodations.

Includes, in particular:

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

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).

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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.

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.

Does not include, in particular:

- vermin extermination (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)

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

Explanatory Note

Includes, in particular:

- investigation and surveillance services relating to the safety of persons and entities;

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- services provided to individuals in relation with social events, such as social escort services, matrimonial agencies, funeral services.

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);
- legal services (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 Remarks relating to the classification of services).

1401.02(b) Short Titles for International Trademark Classes

The United States Patent and Trademark Office 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

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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, scientific and legal
43. Hotels and restaurants
44. Medical, beauty and agricultural
45. Personal

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 international classes and Explanatory Notes in the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (8th ed. 2002), published by the World Intellectual Property Organization (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.

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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* (8th ed. 2002), published by the World Intellectual Property Organization (WIPO), 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 or services.

The *Acceptable Identification of Goods and Services 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 or the applicant’s attorney should designate the international class number(s) that are appropriate for the identified goods 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.

Incorrect classification will be corrected by amendment. *See* TMEP §1401.03(b).

1401.03(a) Designation of Class by Applicant Normally Accepted

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. For example, plastic statuettes are in Class 20 while glass statuettes are in Class 21. Generally, in these situations, the Office will presume that the class number designated by the applicant or the applicant’s attorney is correct in the absence of any contradictory information. The applicant may be asked for further clarification for classification of goods of this type during the examination of the application.

1401.03(b) Designation of Class by Office When Class Number Is Not Designated or Is Inaccurate [R-2]

If the applicant does not designate a class number(s), the Office 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 Pre-Examination Section Office will change the classification. The filing receipt for the application will indicate the class number(s) that have been designated.

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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 or services that would necessitate an amendment of the classification, the examining attorney should also require that the classification be amended.

If an incorrect class number was designated by the Pre-Examination Section, the examining attorney must inform the applicant of the correct class number for the identified goods or services and require amendment of the classification.

Amendment or correction of classification may be done through an examiner's amendment, without prior authorization by the applicant or the applicant's attorney. *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 should check to make sure that the properly assigned class is reflected in the electronic records of the Office.

1401.03(c) Failure to Classify May Delay Action

The applicant should make an initial effort at classification, using the Alphabetical List of Goods and Services. 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. TMEP §810.01.

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. A fee is required for each class.

If an application sets forth goods or services in more than one class and only one fee has been filed, the applicant must either amend the application to restrict the goods or services to a single class or submit a fee for each additional class to prosecute the application as a multiple-class application. The fees for multiple classes must be paid before an examining attorney does an extensive search in a large number of classes. 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 in due course.

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1401.04(a) Prior U.S. Classification System

Prior to the adoption of the International Classification in 1973, the U.S. Classification was the primary classification used in the Office. After adoption of the International Classification, the U.S. 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 U.S. classes that are most frequently associated with it. Neither examining attorneys nor any other Office personnel have the authority or capability of altering these automatically assigned secondary U.S. 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 involves 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. If, in the original identification or in an amendment to the identification, 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).

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:

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- Finished products are classified, in principle, according to their function or purpose or the industry that produces them or, secondarily, according to the material of which they are made or the trade in which they are sold.
- Finished products that are multipurpose composite objects (*e.g.*, clocks incorporating radios) may be classified in all the classes that correspond to each of their functions or intended purposes.
- 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, only classified in the same class as the end product if they cannot also be used for other purposes. When the goods can be used for other purposes in general manufacture, the same criterion as for finished products (above) applies.
- Goods, whether finished or not, are classified according to the material of which they are made and where they are made of different materials, such goods are classified, in principle, according to the material that predominates.
- Cases adapted to the product they are intended to contain are classified, in principle, in the same class as the product.
- Services are classified, in principle, according to the branches of activity specified in the headings of the service classes and their Explanatory Notes or, subsidiarily, by analogy with other comparable services contained in the Alphabetical List.
- Rental services are classified, in principle, in the same classes as the services provided by means of the rented objects (*e.g.*, rental of telephones, in Class 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, *e.g.*, transportation consultancy in Class 39, business management consultancy in Class 35, financial consultancy in Class 36, 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 General Remarks in the *International Classification* volume referred to above and 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 in the field of investment management and instructional manuals related thereto, sold as a unit” would be classified in Class 9. “Instructional manuals in the field of

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investment management and computer software relating thereto, sold as a unit” would be classified in Class 16.

1401.06 Specimens as Related to Classification

As a general rule, the specimen(s) in an application help to determine the correct classification. If the information in the record and the wording of the identification differ, or if some significant characteristic shown in the record is omitted from the identification, the assigned class number may be incorrect. The examining attorney should carefully review the specimen to ensure that the identification and classification are accurate. *See* TMEP §1402.05. However, the examining attorney must remember that, generally, the 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, and 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 or pellet 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 there is a classification 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 regardless of whether 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, there is no class specifically

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designated for ladders. Therefore, ladders 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.

The only exception to this general guideline is in the area of precious metal. Most items that are made of precious metal are classified in Class 14, even when there is another class in which those goods would be classified if they were made of any other material. For example, nut crackers are classified in Class 8 whether they are made of plastic, wood, nonprecious metal or any other material except precious metal. Nut crackers made of precious metal are in Class 14.

1401.07 Classification and Plurality of Uses

One 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 are indicated, multiple classification may be permissible. However, identical language cannot be used as the identification of goods in more than one class in these situations. The identification must clearly indicate the basis for multiple classification with language that is appropriate for the respective classes. Specimen(s) should reflect acceptable use of the mark for each of the specified classes or should be of a general utility nature. In the case of general utility specimens, there must be nothing in the record indicating only one use or aspect. *See 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 (or copy thereof) for each class with an application under §1(a) of the Act, or an amendment to allege use or statement of use in an application under §1(b). 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 that 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, that is always classified in Class 3 regardless of its ultimate use, cannot be transferred to Class 1 by adding Class 1 qualifying language.

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1401.08 Classification and the Identification of Goods and Services, In General

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 recited 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 8th Edition of the Nice Agreement

As of January 1, 2002, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks includes three new service 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 that 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).

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

1401.09(a) Elimination of “Miscellaneous Class Designation”

As previously noted, 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 “services that cannot be classified in other classes” 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. Most of the changes in practice due to the new service classes flow from the elimination of the miscellaneous class designation previously in Class 42.

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See TMEP §§1402.11(a) through (e) for further information about the changes in identification and classification of services.

1401.09(b) Implementation of the Changes

The United States will follow the implementation practice that will be used at WIPO by the International Registration Section (Madrid Agreement and Protocol). This will ensure that United States applicants will not be disadvantaged if the United States joins the Madrid Protocol. A Madrid application must comply with the edition of the Nice Agreement in effect at the time the application was filed in the home country, or it will be rejected with a class change requirement. Therefore, the United States will apply the new requirements of the 8th edition of the Nice Agreement to applications filed on and after January 1, 2002.

Applications filed before January 1, 2002 should follow the requirements of the 7th edition of the Nice Agreement. Upon examination, the examining attorney may give the applicant the option of remaining in compliance with the 7th edition of the Nice Agreement or amending the application to comply with the classification requirements of the 8th edition. After January 1, 2002, the applicant may, of its own accord, submit an amendment to its application that brings it into compliance with the 8th edition of the Nice Agreement.

1402 Identification of Goods and Services

1402.01 Specifying the Goods and/or Services - in General

A written application must specify the particular goods 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 of goods or services 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 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 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); *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.*

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of America, Inc., 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

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 and 1402.07 *et seq.*; *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991).

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:

- Is written in English;
- 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 *Acceptable Identification of Goods and Services Manual*;
- Is not a class heading; and
- Is in the correct class.

Deference should be given to the language and the classification set forth by the applicant in the original application. Obvious spelling errors in an identification of goods/services may be corrected by examiner's amendment without contacting the applicant. *See* TMEP §707.02.

1402.01(b) The 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 Office 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 will often include broad statements of the identification of 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 or services in the United States application must be definite and specific even if the foreign registration includes an overly broad identification. *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, if an application is based on §44 of the Trademark Act, 15 U.S.C. §1126, 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*,

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175 USPQ 178 (TTAB 1972). However, if the applicant also relies on use in commerce or intent-to-use in commerce, the identification of goods or services may include items or services not listed in the foreign registration if the applicant specifically limits the §44 basis to the goods and services covered by the foreign registration. 37 C.F.R. §2.32(a)(6). *See* TMEP §§806.02 *et seq.* regarding multi-basis applications.

If a foreign registration in a single class includes a broad statement of the identification of goods or services and the Office 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 the identification in the foreign registration encompasses all goods or services identified in the United States application. *See* TMEP §§1403 *et seq.* regarding multiple class applications.

1402.01(c) Location of “Identification of Goods and Services”

Before October 30, 1999, the applicant was required to set forth the identification of goods or services within the four corners of the written application.

Effective October 30, 1999, if the applicant submits a separate drawing page, this page is considered part of the written application and not a separate element. Any goods or services listed on the drawing will be considered part of the “identification of goods and services,” even if these goods or services do not appear within the four corners of the written application. The application will receive a filing date if the identification of goods or services appears only on the drawing page. If the written application includes an identification of goods or services, and additional goods or services are listed on the drawing page, the additional goods/services listed on the drawing page will be considered part of the identification of goods/services in the written application.

1402.01(d) 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 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 but concisely the reason for requiring an amendment.

Under 37 C.F.R. §2.61(b), the examining attorney may require information and exhibits if necessary to ascertain the nature of the goods or services or otherwise permit proper examination. When requiring amendment to the identification of goods and services, 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 still

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unresolved, questions about an identification of goods or services should be referred to the Administrator for Trademark Identifications, Classification and Practice.

The examining attorney has the discretion to issue a final refusal based on a requirement to amend the identification of goods 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 final action if the examining attorney has partial or no signatory authority. The Administrator for Trademark Identifications, Classification and Practice should be consulted whenever necessary and copies of appeal briefs that involve an issue of identification of goods or services should be sent to the Administrator for monitoring purposes.

1402.02 Entitlement to Filing Date With Respect to Specification of Goods and Services

An application must include an identification of goods and/or services to receive a filing date. 37 C.F.R. §2.21(a)(4). If an application does not include an identification of recognizable goods or services, it will be denied a filing date.

Effective October 30, 1999, any goods or services listed on the drawing are considered part of the “identification of goods and services,” and the application receives a filing date if the identification of goods or services appears only on the drawing page.

If the application does not identify any recognizable goods or services, the Office 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 or wording such as “all the goods in Class 16 [or any other class number];”
- (3) wording such as “company name,” “corporate name” or “company logo;”
- (4) “Internet services” or “e-commerce services;”
- (5) “advertising and business” (the short title of Class 35);
- (6) “miscellaneous” or “miscellaneous services;” or
- (7) “personal services” (the short title of Class 45).

These examples fail to meet even the minimum requirements necessary to receive a filing date under 37 C.F.R. §2.21(a)(4).

The Office will not deny a filing date if the applicant uses the language of an international class heading. However, the Office strongly discourages the use of the language of the

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international class headings to identify the goods or services for which registration of the mark is sought, and will require amendment of any such identification.

If an examining attorney finds that the application materials fail to specify recognizable goods or services, the examining attorney should return the materials to the Pre-Examination Section of the Office (or the supervisory legal instruments examiner in an e-commerce law office) with instructions to cancel the filing date for failure to specify 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 Office will grant the application a filing date. The Office will disregard wording that fails to include any scope limitations for the purpose of determining the scope of permissible amendments. For example, if the applicant uses “all goods in Class 16” along with definite language, the identification of services may only be amended to correct the identification within the scope of services indicated by the presence of the definite language. *See* TMEP §§1402.07 *et seq.* regarding the scope of an identification for purposes of amendment.

Reference to the goods or services only on the specimen(s) does not satisfy the requirement for an “identification of goods or services.”

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 or services as of the application filing date. *See First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988). 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 the goods 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 very broadly but does not use the mark on a substantial number of related goods encompassed by the identification language, the Office may require further specificity. For example, the Office generally requires that “paper” be identified with greater specificity, as many marks for paper are actually used on specific

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types of paper that may be classified in different classes and that have distinct channels of trade.

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. Another example is “tables,” which would include such diverse and differently classified types as operating tables, draftsmen’s tables and dining tables. 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 commercial relationships between all the goods or services identified in the application. *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 to be made (*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) An identification that can be understood when read in association with the title of the class in which it is placed, and that is otherwise satisfactory, should not be required to be further qualified by amendment. For example, “mufflers” in the clothing class would not require further modification to indicate that articles of clothing are intended; similarly, the term “house organ” in the class for printed publications would not need further qualification. 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. *See* TMEP §§1402.01 and 1402.05(b). However, 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 material composition or field of use. 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 determine 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, very often no further specification as to the nature of those goods is necessary. However, when the goods have a special use

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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, there is a question as to the amount of proof (normally by way of specimens) that is necessary to assure the examining attorney that the mark has been used on “all” the items in the application. *See* TMEP §904.01(a). The Office 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, the applicant must submit evidence that it actually uses the mark on a wide range of products 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.

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” and “consisting of” are definite and are preferred whenever setting forth an identification that requires greater particularity. Vague terminology should be replaced by “namely” and “consisting of” whenever possible.

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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 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 refer to marks that are 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 Office to make necessary determinations under Trademark Act §2(d), 15 U.S.C. §1052(d). The use of this phrase does not invite the use of broader terminology when identifying the goods on which the house mark is used.

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. *In re Astra Merck Inc.*, 50 USPQ2d 1216 (TTAB 1999). Evidence of use on only three products does not justify characterizing a mark as a house mark.

Likewise, 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 amendment to allege use or statement of use, the applicant will be required to provide evidence to substantiate use as a house mark. If

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

1402.03(c) Marks for a “Full Line of ...” [R-2]

In rare circumstances, the Office may accept an identification of goods that refers to “a full line of” a genre of products. In order to qualify for the use of such terminology, the line of products must be virtually all classifiable in one class. The most commonly accepted situation is “a full line of clothing” or “a full line of pharmaceuticals.” While there may be some rare exceptions, all clothing is classified in Class 25 and all pharmaceuticals are classified in Class 5. Therefore, so long as the specimens 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 and many hand tools are classified in Class 8, there are a number of items that would easily be considered hand tools that are not classified in that class (*e.g.*, a non-electric egg beater is in Class 21 but could be considered to fall within the broad category of “hand tools.”) This designation must only be used in appropriate situations and the circumstances and specimens or other evidence of record should be analyzed carefully to be sure that the applicant does not receive a trademark registration that would be applicable to goods that should not be considered within the scope of the identification of goods. In some cases it may be more appropriate to indicate that the applicant is providing a full line of a sub-set 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 an identification that refers to a full line of a genre of products, virtually all of the products must be classifiable in one class and the specimens 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 amendment to allege use or statement 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.

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

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1992). Due to the proliferation of computer programs over recent years and the degree of specialization that these programs have, broad specifications such as “computer programs in the field of medicine” or “computer programs in the field of education” should not be accepted unless the particular function 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 the senior 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 of “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 or 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) *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.

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- (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

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CAM software in that products designed by the CAD systems are directly inputted into the CAM systems for manufacture.

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 printed matter 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. 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 on-line publications.

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

The United States Patent and Trademark Office (USPTO) maintains a listing of acceptable identifications of goods and services compiled by the Administrator for Trademark Identifications, Classification and Practice in the Office of the Commissioner for Trademarks. The *Acceptable Identification of Goods and Services Manual* contains identifications of goods and services and their classifications that are acceptable in the Office without further inquiry by an examining attorney (provided such identification and classification is supported by the specimens of record). The 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.

The *Acceptable Identification of Goods and Services Manual* can be downloaded free of charge from the USPTO's website at www.uspto.gov, or purchased in a CD-ROM format from the Office of Electronic Information Products Development of the USPTO ((703) 306-2600).

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. For example, the term "posters" would be an unacceptable identification when specimens show use of the mark for "decalcomanias."

The examining attorney may require an amendment of the identification language to accurately describe the goods or services. *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980), *aff'g* 204 USPQ 261 (TTAB 1979) (examining attorney has discretion to require applicant to state whether goods are packaged in container to which mark refers); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 USPQ

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105 (C.C.P.A. 1956) (requirement to amend “internal combustion engines for industrial use” to “outboard motors” considered proper); *In re Opryland USA Inc.*, 1 USPQ2d 1409, 1410 (TTAB 1986) (noting that specimens showed use of the mark for “television broadcasting services” and/or “cable television transmission services” rather than “television production services”); *In re Air Products & Chemicals, Inc.*, 192 USPQ 84, *recon. denied* 192 USPQ 157 (TTAB 1976) (acceptance of identification of goods as “catalysts,” which could include large number of catalysts that applicant does not manufacture, would give applicant a scope of protection to which it was not entitled); *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); *Merchandising Promotions v. Hastings & Co., Inc.*, 110 USPQ 256 (Comm’r Pats. 1956) (amendment of “gold stamping foil” to “cellophane folders with pressure-sensitive gold foil strip attached for personalizing articles” required).

An identification cannot be amended to accurately describe the goods if the amendment would add to or expand the scope of the identification. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06 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 specimens or other material in the record clearly indicate 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 for use as an ingredient in face creams.” *See Ex parte 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. v. 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.

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

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identify a component or ingredient 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.

When classifying component or ingredient marks, a distinction should be made between marks that identify these products sold as separate ingredients or components and used to make the finished product, and 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 goods. In this situation, the examining attorney should make sure that the specimen shows use of the mark to identify the component or ingredient and not to identify the finished product in its entirety.

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.

Trademark Act §7(c), 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 services in an application defines the scope of those rights established by the filing of an application for the Principal Register.

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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 and football helmets 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.

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On the other hand, an applicant may not amend an identification of goods or 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” in the identification of goods. Likewise, the applicant may not add or substitute “shirts” for “slacks.”

Example - If the applicant identifies its services as “ophthalmologist’s services” and proposes to amend the identification to “medical services,” the amendment should not be permitted, 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.

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 of goods and/or services, examining attorneys should not require or suggest unduly restrictive identifications of goods and services. *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 of goods and/or services, examining attorneys should advise applicants that additions to the identification of goods and services 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 services. The applicant may clarify an identification of goods and services that is indefinite or overly broad, to identify goods 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 amendment of the identification of goods and services.

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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 and services identified initially, or as limited by an express amendment, establishes the outer limit for permissible amendments. Classification may provide some guidance in determining whether an amendment exceeds the scope of the goods and/or services identified initially, but it is not controlling. The examining attorney may suggest and accept amendments to the identification of goods and/or services 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. The initial identification failed to indicate the true nature of the applicant’s goods and services in any form. Therefore, the examining attorney must reject the amendment, because it is not within the scope of the initial identification.

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

1402.07(a) The “Ordinary-Meaning” Test

For the purpose of determining the scope of an identification, the examining attorney should consider the ordinary meaning of the wording apart from the class designation. The class designation (*see* TMEP §1401.03), whether inserted by the applicant or the Office, does not limit the scope of permissible amendments. If the applicant designates the class, this information may be weighed with other factors for the benefit of the applicant in determining the scope of permissible amendments.

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However, if the applicant does not merely designate the class 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.

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 - If the applicant specifies “computer systems,” the applicant may amend to specify either goods or services within the scope of that term, such as “custom design of computer programs,” “computers” or “computer programs for . . . (indicating specific purpose or function).”

Example - “Food” is indefinite, but 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, but 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 “automobile chassis” (Class 12).

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

Example - If the applicant begins an indefinite identification of goods with surplus wording such as “sale of . . .,” “publishing 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, 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.

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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.

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, those concerning accounting. The applicant may not amend to any service, or to any goods outside the scope of those already identified.

Example - Likewise, 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 Office policy requires further specificity as to purpose or function. 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 Office 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” or “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.

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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 should advise the applicant of the item or items that 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 the applicant submitted the amendment in response to a requirement, the examining attorney should 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 Accepted

Once an applicant amends the identification of goods or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods or 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 mailing 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*;
- (2) Where the applicant inadvertently omits goods or services from an amendment to allege use and has not specifically indicated an intention to delete those goods or services (*see* TMEP §1104.09(c)); or
- (3) Where the applicant inadvertently omits goods or services from a statement of use and has not specifically indicated an intention to delete those goods or services (*see* TMEP §1109.13).

In contrast to situations (2) and (3), set out above, if, in a 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 a continued bona fide intention to use the mark in commerce, those items may not later be reinserted. *See* 37 C.F.R. §2.89(f); TMEP §1108.02(d).

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1402.08 Moving Goods and Services Between Companion Applications

If an applicant has filed separate applications to register the same mark, the applicant may 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 at least as early as the application to which it is to be moved. Moving goods between files in this way may only be done when the applications involved have not yet been published in the *Official Gazette*.

1402.09 Use of Marks Inappropriate in Identifications

If a trademark or a service mark that is registered to an entity other than the applicant is used in the identification of goods or services, the examining attorney should 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 (TTAB 1958). In place of the mark, a generic term must be used.

However, an applicant may use its own registered mark in an identification of goods or services in its own application. The applicant should be careful to use the registered mark as an adjective and to follow it with the generic name of the goods or services offered under its mark. The words “applicant” or “registrant” should not appear in the identification of goods. Before registration, use of the term “registrant” is inaccurate, and, after registration, use of the term “applicant” is inaccurate.

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 collateral or related activities associated with rendering the services.

Examples - 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

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of services that may not be associated with the mark. The former recitation 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.

Examples - "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.

For franchise services (rendered by a franchisor as distinguished from a franchisee), the identification should include an indication of the type of franchise.

Example - "franchising services, namely, offering technical assistance in the establishment and/or operation of restaurants" (Class 35).

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 (such as beauty contests offered in theaters or amusement parks), the service should be identified as, "entertainment services in the nature of beauty contests," in Class 41.

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

1402.11(a) Computer Services [R-1]

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 by means of a global computer network, 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 on-line by means of a global computer network.

Some acceptable recitations:

- “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 web site, in Class 45.”

Content Providers

The service of providing information by means of a global computer network 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 recitations:

- “Providing information in the field of banking via websites on global computer networks, in Class 36.”
- “Providing a website on global computer networks *featuring information* in the field of banking, in Class 36.” This is purely an information provision service and should be treated accordingly. *Note:* The identification “providing a website in the field of _____” is *not* acceptable because there is no indication of what the services are, *e.g.*, providing information, on-line retail store services.
- “Providing information in the field of travel destinations, in Class 39.”

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Class 38: Provision of Telecommunications Connections to a Global Computer Network

These services primarily involve providing telecommunication connections such as those provided by AT&T® and MCI®. 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 “link provider” (see discussion below) or the website itself.

Remember: Just because the applicant is conducting an activity that may *involve* transmission of data on global computer networks 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.

“On-line 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 a global computer information network,” is classified in *Class 38*. *Note:* This identification covers those services provided by Internet Service Providers (ISPs), such as Erol’s®, Mindspring®, MCI®, 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 home pages of others via the Internet. These entities are considered “link 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 recitations:

- “Provision of telecommunications connections to a global computer network, in Class 38.”
- “Electronic mail services, in International Class 38.”
- “Broadcasting television or radio programs via a global computer network, in Class 38.”
- “Webcasting audio/visual programming via a global computer network, in Class 38.”
- “Video and audio teleconferencing via global computer networks, in Class 38.”
- “Providing an on-line bulletin board in the field of medicine, in Class 38.”
- “Providing on-line chat rooms for transmission of messages among computer users concerning teen topics, in Class 38.”
- “Providing multiple-user access to a global computer information network, in Class 38.” Many ISPs, such as AOL®, Prodigy® and CompuServe®, have also expanded their services to encompass content-based services for their subscribers. The “providing multiple-user access” identification only covers the ISP services. If the

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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 both of the following two recitations:

- “Installation and maintenance services in either Class 37 or 42 (depending on whether the subject matter is hardware or software);” and
- “Technical support services, namely, troubleshooting 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 recitations is acceptable:

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

Computer Entertainment Services

Generally, the 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 “*on-line game*.”

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- “Entertainment services, namely, providing a multi-user on-line 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 on-line 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 global computer networks: “Broadcasting (radio programs, television programs, multimedia programming, etc.) via the Internet, in Class 38.”

If the services consist of providing a particular *on-line show* “*webcasted*” over global computer networks: “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 recitations 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 on-line database via global computer networks 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 on-line 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 on-line electronic database on the Internet in the field of banking, in Class 36.”
- “Providing an on-line electronic database on the Internet in the field of business evaluations of automobile companies, in Class 35.”

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- “Providing an on-line electronic database on the Internet in the field of computer programming, in Class 42.”
- “Providing an on-line 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 on-line 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 global computer networks 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.

On-Line Publications

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

“Computer services, namely providing on-line [indicate specific nature of publication, *e.g.*, magazine] in the field of [indicate subject matter of publication], in Class 41.”

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

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The examining attorney should verify from the specimens that the information is presented in a “publication” format. An on-line 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 global computer networks 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 on-line publications, the applicant may amend the identification to indicate that the goods are on-line publications in Class 41, since the term “publications” is broad enough to encompass both printed and on-line publications. If such an amendment is entered after publication, the mark must be republished, due to the change in classification. On the other hand, if the applicant identifies its goods as “printed publications...,” the identification cannot be amended to indicate that the goods are “on-line 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

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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.

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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. The type of consultation or subject matter of the consultation must be set forth with adequate specificity to allow for accurate classification.

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

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 Office uses single brackets to indicate that goods/services have been deleted from a registration either by amendment of a registration under 15 U.S.C. §1057, filing of a partial affidavit of continued use under 15 U.S.C. §1058, 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 under 15 U.S.C. §1058, renewal applications under 15 U.S.C. §1059, affidavits of incontestability under 15 U.S.C. §1065, and amendment of registrations under 15 U.S.C. §1057.

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 under 15 U.S.C. §1057, or filing of a partial affidavit of continued use or renewal application under 15 U.S.C. §1058 or §1059), 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, there are bags that 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.

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1403 Combined or Multiple-Class Application

Extract from 37 C.F.R. §2.86.

(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; 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 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 dividing an application.

A multiple-class application must contain the following information or items:

- (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.
- (2) A filing fee for each class. *See* TMEP §§810.01 and 1403.05(a).
- (3) The dates of first use and first use in commerce for each class, in an application under §1(a) of the Act. 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

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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.
- (5) Only one drawing should be included, because there may be only one mark per application.

Prior to registration, an intent-to-use applicant must file an allegation of use (*i.e.*, either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)), that 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 for each class. *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 may be amended during prosecution to delete, correct, or add classes, when appropriate.

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. §1.26; 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

Improper classification can be corrected by switching goods or services by amendment from one to another of the classes originally set forth, or by changing the class numbers originally designated to other numbers without increasing the quantity of classes.

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. 37 C.F.R. §2.34(a)(1)(v). 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 vary from the original dates given, the additional dates must be supported by an affidavit or declaration by the applicant. 37 C.F.R. §2.71(c). *See* TMEP §903.05 regarding permissible amendment of dates of use.

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1403.02(c) Addition of Classes

Additional 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.

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 §903.05 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 a declaration attesting to use as of an appropriate date. 37 C.F.R. §2.59; TMEP §904.09.

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 either the amendment to allege use or the statement of use, and any extension requests 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 requests are granted.

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 request the Office to physically divide the 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 a class or classes 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 in one class but not against the goods in the other class(es); and
- (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 file wrappers. *See* TMEP §§1110 *et seq.* for information about dividing an application.

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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 Action After Filing, Multiple Classes

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. If appropriate, the examining attorney should indicate the class to which the refusal or requirement pertains and that the refusal or requirement does not pertain to the remaining class(es). Failure to respond to a refusal that pertains to fewer than all classes in an application will result in abandonment of the entire application. It is emphasized that examining attorneys cannot issue a final action for one class if prosecution is continuing with regard to another class.

When an opposition is sustained only as to some of the class(es) in a multiple-class application, the file is returned to the examining attorney. The examining attorney should verify that the file is marked appropriately and the proper TRAM transaction performed to ensure issuance of registration for only the proper class(es).

1403.05(a) 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 amendment to allege use, statement of use, or request for extension of time to file a statement of use for applications under §1(b) of the Act; *ex parte* appeal to the Trademark Trial and Appeal Board; affidavit or declaration under §8 of the Act; affidavit of incontestability under §15 of the Act; application for renewal of a registration, opposition and petition for cancellation of a registration. 15 U.S.C. §§1051, 1058, 1059, 1063, 1064 and 1065.

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 Office.

1403.05(b) 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.