

The Role of Prefatory Language in the Identification of Goods and Services in U.S. Trademark Applications and Registrations



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My article in the October 2010 edition of *Intellectual Property Today*, titled “Defining the Claims of U.S. Trademark Protection: The Metes and Bounds of Trademark Registration,” discussed the notice function that the identification of goods and services plays in U.S. trademark applications and registrations. The article posited that applicants should consider the role that the specification plays in alerting others, who come across the mark in trademark searching, about the true intended use of the mark, so as to increase the likelihood that those third parties will steer clear and avoid adopting a confusingly similar mark. But what is the role of prefatory language (that is, the wording preceding “namely”) in the identification of goods and services? While it, too, can serve such a notice function, it arguably does not have any legally cognizable function in defining the trademark claims.¹

Consider, for example, a trademark registration covering “toys, namely, dolls” in International Class 28. One might argue that the registration covers “toys” in general. However, as discussed below, the better argument seems to be that the prefatory language is not part of the claim.

To begin, the international classification of goods and services is the primary clas-

sification used by the United States.² The short title for International Class 28 is “toys and sporting goods.”³ This is presumably one reason why an applicant may choose to preface its identification of goods with the general word “toys.”⁴ However, the classification system is merely a search tool and does not determine the trademark owner’s rights, which are based on use of the mark and the identification of the goods, not on the class in which the mark is registered.⁵

The U.S. Trademark Act requires an applicant to specify with particularity the goods on which it either uses or intends to use the proposed mark in commerce.⁶ In turn, the T.M.E.P. states that “the identification of goods and/or services in an application defines the scope of those rights established by the filing of an application for registration on the Principal Register.”⁷ The T.M.E.P. further states that “[t]he identification of goods and/or services must be specific, definite, clear, accurate, and concise.”⁸ Terms such as “namely” are considered “definite and are preferred whenever setting forth an identification that requires greater particularity. The examining attorney will require that vague terminology be replaced by these terms.”⁹

The U.S.P.T.O. maintains a listing of acceptable identifications of goods and services.¹⁰ The U.S.P.T.O. manual of acceptable identifications (the “ID Manual”) can be downloaded from its website at www.uspto.gov. Using identification language from the ID Manual enables trademark owners to avoid objections by Examining Attorneys concerning indefinite specifications.¹¹

Using our hypothetical, a simple search of the ID Manual reveals that “toys” alone is not an acceptable identification of goods. Indeed, the U.S.P.T.O. considers “toys” unacceptably vague. An identification of goods should identify the specialized characteristic or trade channel to accurately describe the goods.¹²

Consequently, an applicant should not be heard to claim that its filing covers the broader and unacceptably vague term

“toys” when it really covers just the specific and definite term “dolls.” Had the applicant initially applied to register its mark for “toys” only, the Examining Attorney would have issued an Office Action requiring it to amend the identification of goods to provide greater specificity by identifying the common commercial name for the goods. Indeed, “dolls” is a preapproved term in the Official ID Guide.¹³

Nor can an applicant amend its application to enlarge the identification of goods after filing. The T.M.E.P. states that “[o]nce the identification has been limited, it cannot be expanded later.”¹⁴ Indeed, qualifying language (*i.e.*, “namely”) may not be deleted from an identification once inserted to clarify an otherwise ambiguous, overly broad, or indefinite identification.¹⁵

Even if the prefatory language is not considered as part of the trademark claim, the scope of protection afforded the mark may not unduly suffer. The “related goods” doctrine in U.S. trademark law affords protection of the mark for goods which are closely related to those included in an application or registration.¹⁶ Thus, a registration covering “toys, namely, dolls and doll accessories” may prevent a third party from using or registering a confusingly similar mark for toys because dolls are arguably closely related to toys.¹⁷

A situation where the prefatory language may come into play, however, is in a non-use cancellation action. In filing a Declaration of Use, it is necessary to specify the goods recited in the registration on or in connection with which the mark is in use in commerce.¹⁸ If a registration covers “toys, namely, dolls,” and the mark is in use for a non-doll toy, such as an electronic toy game, the registrant should not be permitted to claim use of a mark for the goods in the registration. The prefatory language should not save such a registration from cancellation for non-use.

In conclusion, a review of the relevant statutory language, administrative rules, common prosecution practice, and legal precedent suggests that the scope of a trademark registration is limited to the specific goods following any qualifying language. To conclude otherwise would allow a registrant to acquire a greater scope of Lanham Act protection against the public-at-large, without public notice, than it originally agreed to accept when procuring the registration in the first place.

ENDNOTES

1. Some parallels can be drawn between the identification of goods in a trademark registration and a claim in a patent. A patent must include at least one claim, which is a single sentence that particularly points out and distinctly claims the subject matter regarded as the invention or discovery. 37 C.F.R. § 1.75. A patent claim consists of three parts: a preamble, a transition phrase (e.g., “comprising”), and a body that includes the limitations defining the scope of the claimed invention.
2. Trademark Manual of Examining Procedure (“T.M.E.P.”) at § 1401.02 (7th Ed.). The T.M.E.P. is the guideline that Examining Attorneys in the U.S. Patent and Trademark Office (“U.S.P.T.O.”) are obligated to follow during the application process. See T.M.E.P. at Introduction.
3. *Id.*
4. Some applicants may include indefinite prefatory language as a means to delay examination of their applications in order to buy time to prove use of the mark down the road. An application to register a mark for “toys” should encounter an Office Action in which the Examining Attorney requires clarification of the goods.
5. See *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975 (Fed. Cir. 1993) (“The benefits of a Principal Register registration apply with respect to the goods named in the registration without regard to the class or classes named in the registration. The statute authorizing the establishment of a classification is 15 U.S.C. § 1112 which provides [that] “[t]he Commissioner may establish a classification of goods and services, for the convenience of the Patent and Trademark Office administration, but not to limit or extend the applicant’s or registrant’s rights.”).
6. See 15 U.S.C. §§ 1051(a)(2) and 1051(b)(2).
7. T.M.E.P. at § 1402.06
8. *Id.* at §1402.01.
9. *Id.* at § 1402.03(a).
10. *Id.* at § 1402.04.
11. *Id.*
12. *Id.* at § 1402.05; *In re Petroglyph Games, Inc.*, 91 U.S.P.Q.2d 1332, 1335 (T.T.A.B. 2009) (stating that “[t]he Office’s requirement that the examining attorney ensure the accuracy of the identification of goods is abundantly clear.”); *In re Toro Mfg. Corp.*, 174 U.S.P.Q. 241 (T.T.A.B. 1972) (noting that use on “grass-catcher bags for lawnmowers” 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 U.S.P.Q. 240 (Comm’r Pats. 1957) (amendment of “periodical” to “monthly news bulletin” required).
13. Identifications of goods and services in the USPTO ID Manual are acceptable in the USPTO without further inquiry by an Examining Attorney. T.M.E.P. at § 1402.04.
14. T.M.E.P. at § 1402.06(a). See also *In re X-Fight LLC*, 2010 WL 985324, *2 (T.T.A.B. Feb. 26, 2010) (“Once an applicant amends the identification of goods and/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/services to that of the amended language”); *In re Orange Commc’ns Inc.*, 41 U.S.P.Q.2d 1036, 1996 WL 754044, *7 n. 1 (T.T.A.B. Oct. 30, 1996) (affirming the examining attorney’s position that “as a result of applicant’s previously submitted amendments, the public had been placed on notice as to what applicant was claiming and that applicant should not now be permitted to change this claim”); *In re Sven Sonic Corp.*, 21 U.S.P.Q.2d 1794, 1795 (T.T.A.B. Dec. 4, 1991).
15. T.M.E.P. at § 1402.06(a). Indeed, if anything, the prefatory language should be viewed as a limit on the claim. An application or registration covering “toys, namely, dolls” in Class 28 would not seem to cover non-toy dolls such as medical teaching dolls. See, e.g., the deluxe hospital training doll offered at www.cpr-savers.com/Industrials/Cpr%20prod/cpr%20manikins/lifeform-nursing-hospital-training-manikins.html. As such, the prefatory language may be akin to the preamble of a patent claim. A preamble either has no effect on the scope of the claim or serves to limit the claim, but generally cannot be relied upon to broaden the limitations in the body of a claim. A preamble may limit the scope of a claim if “it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim. *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 298 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed.Cir. 1999).
16. “The modern rule of law gives the trademark owner protection against use of its mark on any product or service which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connection with, or sponsored by the trademark owner.” 4 McCarthy on Trademarks and Unfair Competition (4th ed) at § 24:6.
17. The trademark owner is entitled to protection against use of its mark on any product which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 958, 24 U.S.P.Q.2d 1001 (7th Cir. 1992).
18. 15 U.S.C. §1058(b) and 37 C.F.R. §2.161(e)(1),