

Defining the Claims of U.S. Trademark Protection: The Metes and Bounds of Trademark Registration



BY PETER S. SLOANE OF
LEASON ELLIS LLP

Peter Sloane is a Partner at Leason Ellis LLP in White Plains, New York. Mr. Sloane is a trademark and copyright attorney practicing domestic and international prosecution and litigation. He may be reached at sloane@leasonellis.com.

INTRODUCTION

Have you ever come across a mark in a search report with an egregiously long identification of goods? You know the one. It makes your eyes glaze over and move quickly to the next mark lest you fall asleep. Such marks ignore one of the primary benefits in obtaining trademark registration: to put others on notice of your trademark rights. Registrations appear in search reports relied upon by others in choosing new marks. Consequently, registration should serve as a stake in the ground to put others on clear notice of the metes and bounds¹ of your trademark claims. However, many trademark owners seem to give little thought to this notice function in filing trademark applications. Rather, they seem to view trademarks as akin to patents, meaning that they think that the broader the claim, the stronger the registration.² This article will provide several reasons why trademark owner should think twice before filing overbroad applications (apart from the usual and well-documented reasons in avoiding fraud problems and specificity requirements).³

Overbroad Specifications Fail to Provide Adequate Notice

We begin our survey of overbroad specifications with an extreme example. A company name Pecunia AS in Oslo, Norway has registered its name as a mark in all 45 international classes. U.S. registration number 3,793,195 covers the mark PECUNIA for goods in Class 1, including things such as chemicals used in science and industry to services, all the way up to Class 45 including, among other things, legal services. Apart from the fact that there is no conceivable way that a company can provide all goods and services under the sun, such a registration completely fails to provide third parties with any notice about the business of Pecunia AS such that they may avoid adopting a confusingly similar mark.

A lengthy specification also runs the risk of burying the true goods of interest. For example, U.S. Registration No. 3,715,871 of the mark VIKO and Design covers a lengthy list of disparate goods ranging from “life saving rafts” to “automatic vending machines” to “fire-extinguishing apparatus.” Entirely lost within the specification are the goods apparently sold by the registrant Viko Elektrik. According to the website at www.viko.com.tr, the company makes switches and sockets used for energy transfer and use. The fact that the registration, in fact, covers items like “electrical plugs and sockets” can easily be overlooked within the broader specification of goods.

This issue was acknowledged in a different context by Lord Justice Jacob of the Court of Appeal of England and Wales, who stated the following in connection with CTM applications:

It is apparent from the specifications of goods being allowed by OHIM that owners are being allowed to register for ranges of goods or ser-

vices far wider than their use, actual or intended. This causes the Office massive unnecessary work-hours spent ploughing through long specifications to find out whether, buried in there, are goods or services of which the mark is descriptive.⁴

OHIM does not even examine marks on relative grounds (i.e., for confusingly similar marks) so one may imagine that Examining Attorneys in the U.S.P.T.O., not to mention those in private practice searching the availability of a mark, face an even more daunting task.

Although one searching a trademark can look to the web to try to learn information about the mark, this overlooks the intense time pressures faced by those doing the searching. Full search reports often run hundreds of pages long these days. Cost restraints including flat fees limit the time one can devote to reviewing reports and preparing opinions. It is simply unrealistic to expect one to search the internet each time they encounter an overbroad list of goods. Plus, information may not be found when the mark is not yet in use as with an intent-to-use application or an application filed on the basis of a home country filing. Furthermore, even today, not all companies have internet websites. Thus, it behooves the trademark owner to avoid including superfluous goods or services in the specification that may obscure the relevant ones third parties should avoid in adopting their marks.

Foreign Applicants are Often Overinclusive

The tendency to overclaim is especially pronounced among foreign applicants. Some countries like Norway allow identification of class headings.⁵ Other countries such as Argentina even allow for the identification of the entire class.⁶ Such practices do not exactly encourage restraint in specifying goods and services when filing in the U.S.

The Trademark Manual of Examining Procedures of the U.S.P.T.O. (T.M.E.P.) expressly recognizes that, in many cases, the identification in foreign registrations “is merely a repetition of the entire general class heading for a given class.” T.M.E.P. § 1402.01(b). The T.M.E.P. further states that “[t]hese broad identifications are gen-

erally unacceptable” in the U.S. and that the specifications here “must be definite and specific even if the foreign registration includes an overly broad identification.” *Id.*

The propensity to claim broadly is aggravated by the ease of extending requests for protection into the U.S. from International Registrations. When it requires only checking a box extending protection to the U.S.,⁷ it is easy to overlook the notice function in filing. Foreign applicants should consider filing directly in the U.S. to obtain the advice of American trademark professionals who may advise about such risks in overbroad filing, not to mention the usual caveats about avoiding fraud and the need for specificity here.

The Problem with Overbroad Pharmaceutical and Chemical Marks

The problem with overinclusiveness is particularly acute with pharmaceutical marks. This is because Class 5 is one of the most crowded classes⁸ and drug companies routinely file applications for pharmaceuticals covering a wide variety of diseases and disorders. A typical example may include “pharmaceutical preparations and substances for the treatment of infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, obesity and cognitive disorders, viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders.” Such a specification provides little real notice to third parties about the intended use of the mark. It also arguably runs afoul of the prohibition in the Lanham Act against the “warehousing” of trademarks.⁹

Similarly, many marks covering chemicals include highly technical specifications without any reference to the function of the goods. For example, U.S. Registration No. 2,204,894 of the mark SILIPHOS covers “flavolignan complexes with phospholipids for use in pharmaceutical, cosmetic and food industry” in Class 1. Siliphos appears to be a pharmaceutical product intended to support liver health.¹⁰ The absence of the term “liver” from the identification of goods renders the registration in some respects invisible to others and represents a lost

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opportunity for the registrant to put third parties on notice of its trademark rights.¹¹

Applicants Unnecessarily Include Ancillary Services

Many trademark applicants overreach by identifying ancillary services they may provide internally but not render to third parties at arms length in the ordinary course of business. The T.M.E.P. specifically states that the identification of services must not merely refer to “collateral or related activities associated with the rendering the services.” T.M.E.P. § 1402.11. The T.M.E.P. provides an example in that “sales cannot be listed as the primary activity in an identification, because the sale of one’s own goods is not a registerable service.” *Id.*

Advertising services are another example of an ancillary activity regularly included in applications. For example, U.S. Registration No. 3,732,639 of the mark SPEEDY MUERTITO covers clothing in Class 25 and various services in Class 35 including computerized on-line ordering services in the field of clothing and accessories as well as advertising and marketing services. Indeed, the registrant has a website at www.speedymuertito.com where it sells its own clothing. However, the website does not advertise or market the goods or services of third parties. As a result, those services were arguably included in the registration unnecessarily.

Some Pros and Cons in Limiting the Specification

By unnecessarily including terminology in the identification of goods, the applicant

may be needlessly inviting trademark conflict. An overbroad specification may result in a Section 2(d) refusal¹² or an opposition proceeding. Narrowly tailoring the identification of goods and services reduces the chances of conflict with others.

On the other hand, there are legitimate reasons to cover broadly. Of course, the broader the specification, the wider the scope of protection afforded to the mark. A generalized specification may also help to avoid descriptiveness objections.¹³

Apart from such reasons, trademark owners need not fear underinclusiveness in their filings. The “related goods” doctrine in U.S. trademark law should protect the mark for goods and services which are closely related to those included in the application or registration.¹⁴ Thus, cheese and wine may be said to be “related” goods because they are complementary to each other.¹⁵

Even though certain broad terms are acceptable in U.S. trademark practice, applicants may wish to consider providing more specificity in their identification in order to increase the chances of the mark turning up in search reports. For example, “medical services” in Class 44 is pre-approved in the Acceptable Identification of Goods and Services Manual (the “ID Manual”) of the U.S.P.T.O. However, a plastic surgeon may be better off identifying “cosmetic and plastic surgery” in Class 44. Indeed, to get the best of both worlds, broad coverage and key terminology, the surgeon can even identify “medical services; cosmetic and plastic surgery.”

Drafting Applications

Defining the metes and bounds of trademark registration all begins with drafting the underlying application. Looking at the client and its true intent in using a mark offers a more natural way of drafting the identification of goods and services than, for example, working backwards from the class heading. It is simple to use the ID Manual of the U.S.P.T.O. available online at <http://tess2.uspto.gov/netahtml/tidm.html> to craft the specification. Not only does this approach ensure avoidance of objection based upon lack of specificity,¹⁶ but it also provides the applicant with a plethora of relevant terms to include in the specification. For example, searching the term “banking” reveals that “mortgage banking” in Class 36 is a pre-approved term. However, it also shows that the more descriptive and possibly relevant phrase “mortgage banking services, namely, origination, acquisition, servicing, securitization and brokerage of mortgage loans” is acceptable as well. Thus, someone who searches for marks including the term “loans” will come across the more descriptive phrase and, hopefully, avoid adopting a confusingly similar mark.

The T.M.E.P. also has many helpful sections addressing identification of particular goods and services. Those sections range from common products like computer programs (1402.03(d)) and publications (1402.03(e)) to less common activities like recorded entertainment services (1402.11(g)) and even “bonus programs” (1402.11(h)). The trademark practitioner is well advised to become familiar with such sections and consult with them where warranted to craft a suitable specification.


Movement for Change

There is growing concern among the trademark bar about lengthy identification of goods and services. In the European Union, there is discussion about moving to a use based register or at least requiring applicants to declare a bona fide intent to use the mark for all items covered. The fact that an applicant can register a mark without declaring a bona fide intent to use “leads to numerous applications having unreasonably broad specifications of goods and services and to ‘deadwood’ trademark registrations.” Daniel R. Bereskin, Q.C.,

Miles J. Alexander, and Nadine Jacobson, *Bona Fide Intent to Use in the United States and Canada*, The Trademark Reporter, Vol. 100 at 709-10.

In the United States, the U.S.P.T.O. has called for requests for comments on suggestions to improve the accuracy of identifications of goods and services due to their growing length. See www.uspto.gov/trademarks/notices/Bose_feedback.jsp. Some of the comments supplied thus far call for applicants to provide a specimen of use for each identified item. However, this would put a financial and logistical burden on many applicants. One would hope that self-interest would persuade applicants to identify only items that they truly intend to offer under the mark in the U.S. rather than extraneous items which may cause others to take the claim of rights less seriously.

CONCLUSION

In sum, trademark applicants should think about more than just the scope of coverage when filing in the U.S. They should put themselves in the position of a third party who may come across their mark in trademark searching. In most cases, it is desirable to let others know about how you actually intend to use the mark so that they can stay clear and avoid adopting a confusingly similar mark. 

ENDNOTES

1. Wikipedia states that “metes and bounds” is a system or method of describing property to define and describe its boundaries.
2. Generally speaking, broad patent claims are economically more valuable, because they subject a wider range of activities to control. 1 Moy’s Walker on Patents § 4:63 (4th ed.).
3. See *In re Bose Corporation*, 580 F.3d 1240, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009) and Trademark Manual of Examining Procedure (“T.M.E.P.”) of the U.S. Patent and Trademark Office (“U.S.P.T.O.”) at § 1402.01, respectively.
4. D. Kitchin & D. Llewelyn, *Kerly’s Law of Trade Marks and Trade Names*, preface, at viii-ix (13th ed. 2000).
5. Norwegian Trademarks Act entered into force on July 1, 2010, and the regulation regarding the list of products is at Section 10 of the Trademarks Regulations. Although it does not specifically mention use of class headings and states that “the products must be mentioned clearly and unambiguously,” in practice, the use of the class

headings unconditionally fulfills the requirement for specificity.

6. Argentina Regulation N° 3/1961, dated June 13, 1961, states “[w]hen a trademark is applied for claiming all the good in a class, it will not be necessary to specifically indicate each of the goods claimed and it shall only be indicated that the trademark is being filed for all the goods in the class.” §1(a).
7. See www.wipo.int/edocs/formdocs/form-madrid/en/form_mm2.pdf. The United States also requires submission of a separate form containing the declaration of intention to use the mark in the U.S. See www.wipo.int/edocs/formdocs/form-madrid/en/form_mm18.pdf. While the language of having a bona fide intention to use the mark in commerce is familiar to American practitioners, it would not necessarily lead foreign applicants to conclude that it is in their interest to narrow the specification in order provide third parties with clearer notice of the claimed trademark rights.
8. See *Brand Matters: The lingua franca of pharmaceutical brands names*, Rebecca Robins, www.brandchannel.com/papers_review.asp?sp_id=1233.
9. Warehousing, which occurs when one hoards a mark for future use without concrete intent to use it in the future, is impermissible. *Emmpresa Cubana Del Tabaco v. Culbro Corp.*, 213 F. Supp. 2d 247 (S.D.N.Y. 2002), citing, *Exxon Corp. v. Humble Exploration Co.*, 592 F.Supp. 1226 D.C.Tex. 1984).
10. See www.purecaps.com/itemdy00.asp?T1=SLP1.
11. An overly technical specification may also run afoul of T.M.E.P. § 1402.1, which states that the “language used to describe goods and/or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field.”
12. 15 U.S.C. §1052.
13. It is well-settled that “[t]he determination of whether or not a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods or services for which registration is sought.” *In re Venture Lending Associates*, 226 U.S.P.Q. 285 (T.T.A.B. 1985).
14. “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, connected with, or sponsored by the trademark owner.” 4 McCarthy on Trademarks and Unfair Competition (4th ed.) at § 24:6.
15. *Bongrain International (American) Corp. v. Moquet, Ltd.*, 230 U.S.P.Q. 626 (T.T.A.B. 1986).
16. 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. § 1402.04.