Mailed:
March 14, 2012
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Jakks Pacific, Inc.

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Serial No. 77404047

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Larry Miller of Feder Kaszovitz LLP for Jakks Pacific, Inc.

Brian Pino, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

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Before Bucher, Zervas and Mermelstein, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Jakks Pacific, Inc. seeks registration on the Principal Register of the mark **BIONICAM** *(in standard character format)* for goods identified in the application, as amended, as follows:

> magnifying glasses, cameras, video cameras and microscopes; video output machines for use with microscopes; video output machines for use with cameras; video output machines for use with video cameras; batteries in International Class 9; and

> toy magnifying glasses, toy microscopes, toy cameras, toy video cameras; electronic learning toys in International Class 28.[1]

The Trademark Examining Attorney refused registration *for the goods in International Class 9 only* on the ground that applicant failed to provide a specimen that shows use of the mark in commerce as a trademark for the goods identified in this class under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board.

In a combined (or multiple-class) application, there must be one specimen of the mark for each class. 15 U.S.C. § 1051(a)(1); 37 C.F.R. §§ 2.56(a) and 2.86(b). While in some cases a single specimen might well support registration in multiple classes, the Trademark Examining Attorney argues that is not the case herein. We agree and, hence, the majority of this panel affirms the refusal to register.

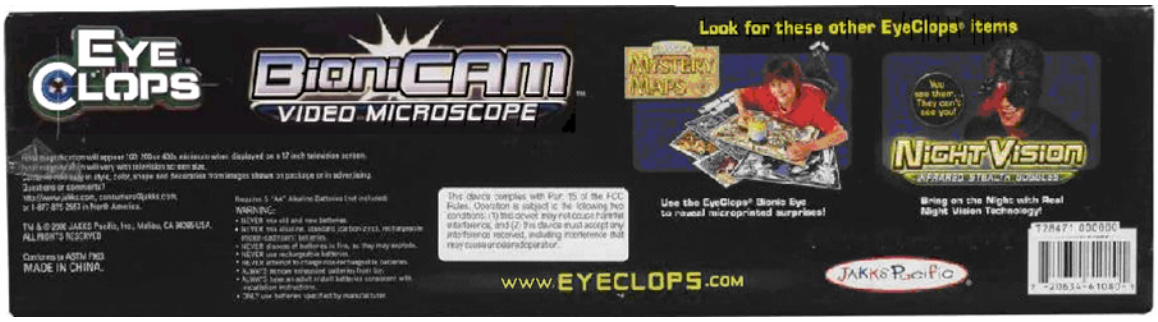
Prosecution History:

In the initial Office action of May 27, 2008, the Trademark Examining Attorney asked applicant whether the term **BIONICAM** has any significance in the trade. Applicant,

[1] Application Serial No. 77404047 was filed on February 22, 2008, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. On November 24, 2009, applicant filed a Statement of Use (SOU) alleging use anywhere and use in commerce since at least as early as July 31, 2008.

in its response of November 25, 2008, replied that "The word **BIONICAM** is a made-up word; the good itself is a camera that is used in conjunction with the **EYECLOPS** brand toy which applicant has referred to as a 'bionic eye,' but which functions as a kind of microscope."

The single specimen of record accompanying the Statement of Use (SOU), submitted on November 24, 2009, included the following piece of product packaging:



In the Office action of February 2, 2010, the Trademark Examining Attorney took the position that this specimen shows use of the mark for applicant's Class 28 goods, but fails to support registration of the mark in connection with the goods identified in International Class 9. He cited, *inter alia*, to information from *www.amazon.com*:

> **Product Features**
>
> - The Bionic Cam … is the next generation of the award winning Bionic Eye, with a full color LCD screen, Multiple lenses and battery pack. Everyone can take EyeClops on the go [to] explore the wor[l]d around you indoor[s] and outdoors
> - Use the LCD screen as a viewfinder for specimens, zoom in with one of three powerful new magnifications (100x, 200x and an

eye-popping 400x) and take digital pictures and video of your amazing discoveries, and send around the world via the internet.
- Save and share your findings with the built-in flash drive and removable USB key – view on any standard television and upload your files to your PC to email and send to friends [-] USB key included
- Portable and recordable, the EyeClops BioniCam is the ultimate Bionic Eye
- Winner of Many of this year[']s Toy Awards

Product Description

Amazon.com Review

The EyeClops BioniCam Video Microscope from JAKKS Pacific opens up a world of microscopic fun for kids to explore. This bionic eye makes it easy to take digital pictures and capture video that documents new discoveries. Designed to keep inquisitive children aged eight and up entertained and interested in the world around them, the BioniCam is also engaging enough to capture [sic] adults.

An adult user of this product wrote the following review further down on this same website:

> If they would have had this thing when I was a kid (a few decades back), I would have gone crazy with it. It is a TOY, not a real scientific instrument, but it's the kind of toy that can good and truly make a kid fall in love with science. …

In its reply of August 2, 2010, applicant took issue with the refusal, arguing as follows:

> The submitted specimen of use does show the use of the mark with respect to the goods in class 9. … Applicant avers that the goods in question function as magnifying glasses, cameras, video cameras, etc., and that all function with video output devices of the sort falling under class 9 … (class heading of class 9 includes "amusement apparatus adapted for use with an external display screen or monitor"); See attachments hereto. Furthermore, the BIONICAM is a multipurpose composite object so that it may be classified in both classes 9 and 28. Applicant also avers that the PTO has allowed its EYECLOPS mark to register in class 9 and 28 for similar goods in class 9 (Magnifying glasses

and microscopes; video output machines for use with microscopes); the refusal of the instant specimen of use is inconsistent with the prior PTO allowance.

Attachments included article excerpts such as follows:

> Kids can zoom in on scientific fun with the EyeClops BioniCam, an updated take on last year's best-selling EyeClops BionicEye "microscope." The BioniCam features an adjustable multizoom lens with 100x, 200x and 400 x magnification, a color display screen, a built-in camera and a USB key that lets kids transfer pictures and videos of specimens to a computer. Like the original model from Jakks Pacific, it also connects to a TV. For kids 6 and up, it will go on sale in the fall for $80. [2]

> **EyeClops BioniCam** (Jakks Pacific, $79.99, ages 6 up)
> You have to love a toy that sneaks in a science lesson. We loved the BioniCam that allows you to move around and capture images at 100x, 200x or 400x magnification. You can record the images and view them on the color LCD screen, so no fussy slides, eyedroppers or one-eye focusing problems we've encountered with traditional microscopes. Then you can take images on the enclosed [flash drive] to your television or computer and look at them on a larger screen and print or e-mail your findings. Holding the focus steady was a bit tricky for the two 6-year-olds who tried it out, but they mastered it eventually. The three 10-year-olds had no problem coming up with nifty images of their hair, pencil erasers, leaves and the god's ear. The gross-out factor of a dirty toenail magnified 100 times was high (and we mean that as a compliment). Your young scientist will enjoy this one. [3]

> **EyeClops BioniCam** (Jakks Pacific Inc.), $79.99, ages 8 and up. This "BioniCam" is much more than a microscope – Parents' Choice calls it an "eyeball on a stick." It lets kids zoom in on their own sweat, an ant, a penny, and other images. Photos taken with the camera can also be uploaded to a computer for even closer inspection.
>
> PhotoGallery – Top Ten Science Toys for Kids:
> Perfume Science
> EyeClops BioniCam ... [4]

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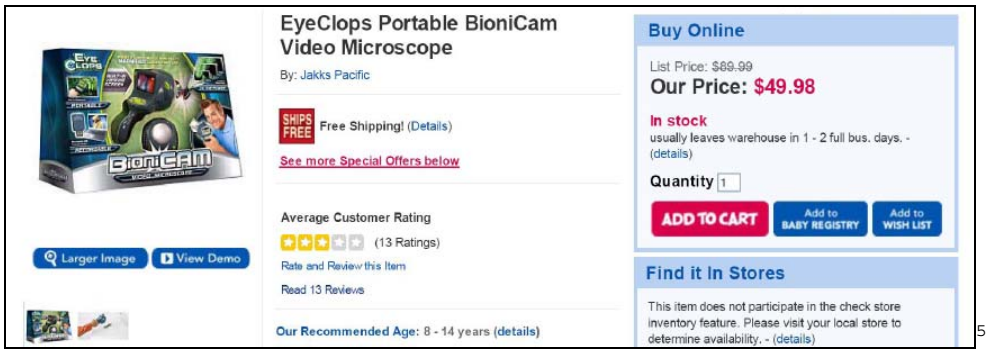
[2] Having a citation to www.jakks.com, but drawn from a Gannett News Service release of February 29, 2008, written by Deborah Porterfield.

[3] *The Monterey County Herald* (California), December 12, 2008, by Sherry Robinson of the St. Petersburg Times (Florida).

[4] U.S. News & World Report, December 9, 2008.



[5]

> SCIENTIFIC VISION
> * EyeClops BioniCam (Jakks Pacific, $79.99): The EyeClops BionicEye, a microscope that plugs into most TVs, was one of last year's hottest holiday toys. It's trying to top itself with the EyeClops BioniCam, a portable version with three levels of magnification, an LCD screen on the toy itself, and a built-in digital camera and flash drive allowing children to snap pictures and video of magnifications. Arriving in August; recommended for ages 8 and older. [6]

Despite this showing, in his Final Office action of August 24, 2010, the Trademark Examining Attorney maintained the refusal:

> In this case, the specimen shows use of the mark for a toy, not the non-toy items listed in the identification. The previously attached internet evidence from the website address listed on the specimen shows that the goods are toys. The previously attached additional internet evidence from amazon.com shows that the goods are intended to be a toy for use by children and that the product is the winner of toy awards. Therefore, the specimen is not acceptable for the non-toy goods in International Class 9.

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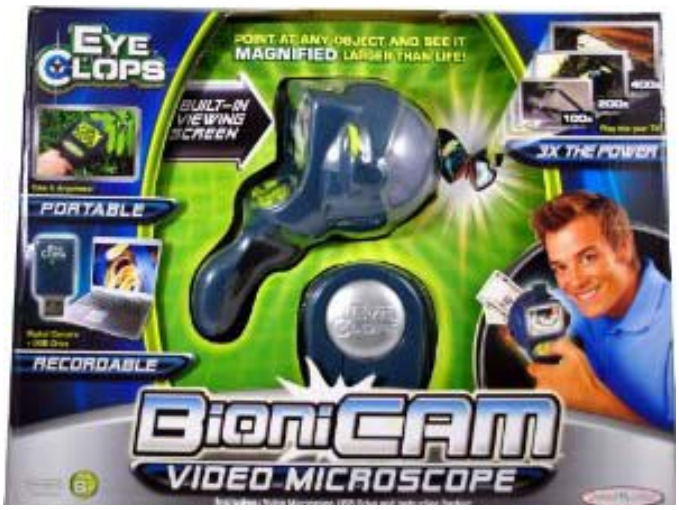
[5] http://www.toysrus.com. The continuing page from the Toys R Us website highlights features such as the fact that it captures detailed scenery, has it own digital video screen and has "incredible connectivity" to a TV or PC.

[6] *The Atlanta Journal-Constitution*, July 15, 2008, article by Jon Waterhouse.

In applicant's request for reconsideration of February 24, 2011, applicant attached additional copies of screen prints from Amazon.com, showing more recent promotional materials for applicant's "***EyeClops Portable Recordable BioniCam Video Microscope that Plugs to Your TV with Removable USB Drive, LCD Video Screen, Digital Control Panel, EZ Grip Texture and Multi-Zoom Adjustment Magnification (100x, 200x and 400x)***":



Product Features

- With a built in video screen and battery pack, you can take the BioniCam video microscope on the go. Explore you[r] world like never before!
- Capture images and video of your amazing discoveries with the built-in digital camera. Then save to your PC with the BioniCam USB Drive. Email friends and post on your own blog or website!
- The powerful, new Multi-Zoom feature provides a bigger, eye popping peek at the world around you! Now examine objects in 100x, 200x and 400x eye-popping magnifications!
- Require[s] 5 "AA" batteries (Not included)
- For age 8 and up

Product Description

The all new EyeClops BioniCamTM Video Microscope is the next generation of EyeClops® and boasts three exciting new features. First, with a simple flip of a switch, kids can adjust the new multi-

> zoom lens for an eye-popping peek at the world in 100x, 200x or 400x magnification. With BioniCam's new portability feature, kids can now take EyeClops on-the-go. A color LCD screen and clip-on battery pack allows kids to view amazing discoveries right on the hand-held EyeClops unit! And finally, the built-in digital camera and flash drive empowers kids to capture images and video of specimens and, with the included USB key, upload them to a computer to be printed, emailed, posted and shared. The EyeClops BioniCam plugs into the A/V jacks of any standard television, allowing young explorers to see their discoveries right on their TV. Portable and recordable, the EyeClops BioniCam has it all!

In his denial of applicant's request for reconsideration of March 15, 2011, the Trademark Examining Attorney again contended that:

> The specimen [accompanied by declaration] submitted with the request for reconsideration shows use of the mark for a toy microscope that is specifically used as a toy and is marketed to children; the specimen itself is from the toy section of AMAZON.COM and the goods description shows that the goods are toys for children " … age 8 and up."

Analysis:

This appeal involves the intersection of two related concerns – the practices of the United States Patent and Trademark Office's Trademark Examining Operation designed to ensure accurate identifications of goods as well as the process of correctly classifying goods in the International Classification system. We have very little precedent in the area of intersection presented by this case, inasmuch as these types of concerns are most often resolved during *ex parte* examination.

Identification of Goods

Prior to a substantive examination, and certainly before being able to determine the proper classification for goods, one needs to settle on the correct identification of the involved goods.[7] When terms are used in the identification of goods within a trademark application, the common meaning of the words, phrases, names and other terminology (as generally understood by the average English-speaking consumer) determines the nature and scope of the goods. See TMEP § 1402.01(a).

Over the past two dozen years since the passage of the Trademark Law Revision Act of 1988, we have entertained *ex parte* appeals on identifications of goods where the issue is whether an applicant's proposed amendment to an identification of goods exceeds the limits of the earlier established identification of goods. *E.g., In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991). However, for much longer than that, the prototypical identification of goods issue coming before his Board has involved the case where the Trademark Examining Attorney alleges that the proffered

[7] Because this case involves goods, we will restrict our focus to goods generally rather than using the phraseology "goods and services" throughout. In addition to simplifying the verbiage, this tack also makes sense inasmuch as the specimen issues that come to this Board in service mark appeals often have significantly different nuances unique to demonstrating the promotion or advertising of a service.

language is unacceptable because of indefiniteness or ambiguity in the wording, requiring a more specific identification of goods. For example, is the term "slot machines" definite? Does an applicant need to clarify all the possible uses of a "gear bag" it has placed in International Class 18? Is the term "chronographs" ambiguous for registration purposes inasmuch as it would include both watches (International Class 14) and time recording devices (International Class 9)? *See, e.g., In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007). However, ambiguity of the wording in applicant's identification of goods contained in International Class 9 is not the nature of the issue before us. Rather, there are times when a definite identification of goods is unacceptable if it results in an improper classification of goods. *In re Omega*, 83 USPQ2d at 1544. For example, an identification of goods is unacceptable if it is inconsistent with the goods as indicated by the specimens or any other part of the record. TMEP § 1402.05.

The words crafted by applicant in International Class 9 represent a definite identification of goods in that class. However, the question raised by the Trademark Examining Attorney is whether this otherwise *definite* identification is *acceptable*. Specifically, based on the specimens and

other parts of this record, is applicant marketing goods that are appropriate for International Class 9 under the Nice Classification system?[8]

Determining International Classification

Once the identification of goods is definite, the next logical challenge is classification. In some cases, such as *In re Omega*, 83 USPQ2d at 1544, and in the case at bar, these concerns are inextricably tied together.

The Office classification is based upon the Nice Agreement Concerning the International Classification of Goods and Services, to which the United States is a party. Each of the countries party to the Nice Agreement is obliged to apply the Nice Classification in connection with the registration of marks.[9] Consistent with this system, the United States Patent and Trademark Office has the discretion to require the degree of particularity deemed necessary to clearly identify the goods covered by the mark. *Id.;* TMEP

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[8] A related question that the Trademark Examining Attorney does not explore at length is whether applicant's mark identifies numerous products or a single, unitary product having numerous features. Query, for example, does applicant, under the applied-for mark, actually sell a "camera" as a separate item, or is this simply a reference to the image recordation function of the toy microscope?

[9] The most recent guidance is contained in "International Classification of Goods and Services for the Purposes of the Registration of Marks" (10th ed. 2011), published by the World Intellectual Property Organization ("WIPO"). http://www.wipo.int/classifications/en/index.html

§ 1402.01. Consistent with this structure, matters relating to identification/classification are governed by the U.S. Acceptable Identification of Goods and Services Manual (I.D. Manual), available on the United States Patent and Trademark Office website.[10] The classification system has been set up for the convenience of trademark offices worldwide, and hopefully serves well the interest of merchants and manufacturers who own marks in the United States, as well as their trademark counsel.[11]

However arbitrary the classification system may seem at times to some, the U.S. Patent and Trademark Office Acceptable Identification of Goods and Services Manual controls in all U.S. applications. For the Office, for applicants and for panels of this Board, the most vexing classification issues often involve defining the boundaries between two or more classes when faced with goods that seem perfectly to straddle the lines.

The magnitude of the challenge here is apparent: the classification system forces trademark owners to place each

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[10] http://tess2.uspto.gov/netahtml/tidm.html

[11] In the United States, a registrant's rights are determined by the wording contained in the identification of goods. By contrast, in countries that permit an applicant to include "all the goods" within a particular class, the classification system is more critical in determining the trademark owner's rights. *See Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771 (Fed. Cir. 1993).

commercialized product or service for which registration of a mark is sought into one of forty-five distinct classes. The classification of items is determined first and foremost by the Nice Classification System, through its panel of experts who are delegates from the member countries. Nonetheless, within the United States Patent and Trademark Office, the Trademark Examining Operations rely upon the continuing guidance provided by the professionals from the Office of the Administrator for Trademark Identification, Classification and Practice.[12]

As noted above, in cases such as *In re Omega*, 83 USPQ2d at 1544, and in the case at bar, these concerns are inextricably tied together. Turning then to the specific international classes involved in this case, Office manuals and guidance from the Nice Classification system reveal that products identified as "toys" are placed in International Class 28. This class, covering thousands of specific playthings, includes for our purposes, *inter alia*, apparatus for games and amusement, including, for example, hand held game apparatus with liquid crystal displays.

[12] We presume that the Trademark Examining Attorney followed the guidance of TMEP § 1402.01(e) to consult with the Office of the Administrator in connection with this final refusal and appeal.

By contrast, International Class 9 includes, *inter alia*, microscopes and their parts, computer monitors and other peripheral devices, scientific apparatus and instruments, digital recording media, and apparatus for recording, transmitting or reproducing images. Although historically, this class included all types of apparatus for video game consoles adapted for use with an external display screen or monitor, we note that in the "Tenth Edition" of the Nice Agreement Concerning the International Classification of Goods and Services, the "Explanatory Notes" on International Class 9 specifically excludes from class 9 "amusement and game apparatus adapted for use with an external display screen or monitor" – instead placing them in International Class 28. Class 9 continues to include game controllers and game accessories therefor sold separately.[13] Thus, to answer one of applicant's contentions, these accessories (sold with the amusement

[13] As a general rule, under the Nice Classification system, a finished product is classified according to its primary function or purpose. By contrast, the same finished product, if intended to form part of another product (including when "sold as a unit") will be classified in the same class as that primary product. This means that batteries, battery chargers, power supplies, transformers, cables, or even pre-made wraps and skins for hand held units for playing video games, if sold individually, will be in International Class 9. On the other hand, if sold as a unit with a Class 28 apparatus, these same accessories will be included in International Class 28.

device, or separately) would appear to be goods that straddle the boundaries of these two classes.

In support of classification of its goods in International Class 9, applicant also points to the Office's placement in class 9 of "video output machine for use with cameras (and a separate monitor)" as well as "batteries." Applicant's Brief at 3.

However, we agree with the Trademark Examining Attorney that in arguing against the position the Office has taken on this classification issue, applicant has conflated several terms used in its identification of goods that individually may point toward International Class 9 goods, but on balance, the words do not accurately describe applicant's goods. All the evidence of record, whether submitted by applicant or by the Trademark Examining Attorney, describes the involved goods as a toy video microscope. Yet, in its response to the final refusal and in its appeal brief:

> [a]pplicant avers that the goods in question … function with video output devices of the sort falling under class 9.

Apparently this toy video microscope does contain a camera (i.e., has a recording function) and can be connected by a cable to a television monitor to display the images in real time. However, from this fact, it does not follow logically that applicant's toy video microscope (International Class

28) must be classified along with these larger video output machines (International Class 9). Classification of new types of products are generally grouped using analogies to items in the I.D. Manual. For a long time, International Class 28 has been the home for video input devices whether the input is described as originating with a "video game consoles, controllers and software," "video game player machines for use with television or computer," "digital video cameras," etc. In fact, as noted above, under the "Tenth Edition" of the Nice Agreement, it is absolutely clear that whether one analogizes applicant's product to "amusement and game apparatus adapted for use with an external display screen or monitor" (such as **X-BOX**, **Wii**, or **PlayStation**) or "hand held units for playing video games other than those adapted for use with an external display screen or monitor" (such as **Nintendo Game Boy** or **Sega Game Gear**), those ubiquitous hand-held game apparatus having small built-in displays -- all such electronic gaming devices and their accessories *sold as a unit* are classified in International Class 28.[14] Finally, while this toy requires batteries for

[14] While our dissenting colleague (in footnote 34) appears to take issue with this clarification of where the lines should be drawn between two particular International Classes, we should hasten to add that we do not view applicant's strenuous arguments for reversal based upon this rather *tangential* point to be at the heart of our disagreement with our dissenting colleague.

its operations, applicant does not argue that it markets batteries separately under the **BIONICAM** mark.[15]

Accordingly, in reviewing the prosecution of this application, we find no fault with the position of the Office in carrying out what is largely a ministerial function involving the correct classification of goods.

Analysis

We begin our analysis by acknowledging that, the same item may be identified in more than one way, such that it could be registered in two or more classes. Perhaps the closest Board precedent actually involves the *reversal* of an examiner's refusal to register more than forty years ago in a case captioned *In re International Salt Company*, 166 USPQ 215 (TTAB 1970). Registration was refused, according to the Office, because the specimen showed use of the mark for salt for food purposes rather than for salt to be used in chemical industries. The packages submitted as specimens were 100-pound bags stamped with the mark **TX-10** and the word "Salt." In short, this appears to be a case where factually, 100-pound bags of salt are substantially the same product without regard to later uses and/or channels of

[15] Moreover, according to the specimens, batteries are not included with the sale of this item.

trade, and a product such as salt may fall into a number of different classes, depending upon its further uses.

The Office also permits applicants a certain amount of latitude in identifying and classifying their goods (and services), provided, of course that the "specimens filed in any particular class should reflect use of the mark in connection with the product for the use set forth in the application." *Id.* at 216.

The rule of the *International Salt* case also contemplates situations where the specimens may be "of a nature or contain language which would, on their face, restrict the product to but a single purpose or use." *Id.* at 216. For example, if the hangtag says ***XYZ Earmuffs***, and the involved goods are identified as "earrings," it is appropriate for the Trademark Examining Attorney to inquire about the seeming contradiction before approving the application in International Class 14.[16] A basic principle lies at the very heart of the trademark registration system in the United States: the involved applicant must be manufacturing or marketing goods, or own a foreign or international registration covering goods, that are accurately identified and properly classified for each class in which registration is sought.

[16] TMEP § 1401.03(a).

In a combined (or multiple-class) application, the rule says that there must be one specimen of the mark for each class. 15 U.S.C. § 1051(a)(1); 37 C.F.R. §§ 2.56(a) and 2.86(b). However, applicant is also correct in noting that in some combined-class applications, Office practice anticipates that a single type of specimen might well support use in connection with goods placed in more than one international class. Agreeing that a single type of specimen can support multiple classes, the Trademark Examining Attorney contends that this is not such a case, and we agree.

In the case of a finished product that functions as a multipurpose object (e.g., a clock-radio combination), how the applicant describes it determines the class. For example, the same specimen could support "radios incorporating clocks" in Class 9 or "clocks incorporating radios" in Class 14.[17] Or it may be a case where industry practice involves "specimens of general utility" like identical hangtags, where a house mark may be used on

[17] Committee of Experts of the Nice Union and set forth in the *International Classification of Goods and Services for the Purposes of the Registration of Marks,* (10th ed. 2011), "General Remarks," Goods, remark (b); also see TMEP §§ 1401.02(a), 1401.05 and 1401.07.

clothing, as well as on related accessories placed in various non-clothing classes.[18]

In the present case, we appreciate the fact that particularly for youngsters, a learning tool like this toy microscope could represent a wonderful introduction to an exciting world of scientific inquiry, and that a youngster might well view applicant's product as a "real" microscope. However, it is also clear that microscopes as scientific instruments are classified in Class 9, while toy microscopes are classified in International Class 28.

We agree with applicant that deference should be given to the language set forth by the applicant in its original application.[19] On the other hand, in an application under § 1(b), for example, the applicant must file an acceptable specimen for each class with its SOU under 15 U.S.C. § 1051(d). In the event that the Trademark Examining Attorney raises questions about whether the file contains appropriate specimens for each class, applicant's successful explanation will be critical to overcoming such a refusal in any application containing allegations of use in commerce.

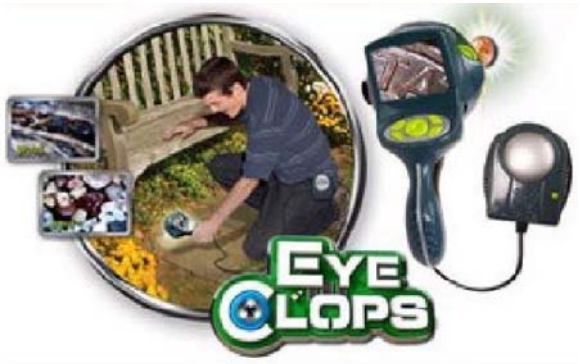
In this case, we agree with the Trademark Examining Attorney that the evidence in this record, including several

[18] TMEP § 1401.07.
[19] TMEP § 1401.02(a).

images submitted by applicant that serve as valid specimens, fails to show the applied-for mark used by applicant in connection with "microscopes" *qua* scientific instruments in Class 9. Rather, the specimens of record demonstrate use of the **BIONICAM** mark in connection with a mere toy. That is, the specimens of record do not show applicant's use of its mark in association with the sale of any of the goods specified in International Class 9 in the application. Trademark Examining Attorney Pino is not arbitrarily shoehorning this video microscope into only one class – he is following guidance from the United States Patent and Trademark Office and an international classification treaty to which the United States is a signatory.

Applicant takes the position that because the toy video microscope is capable of four hundred power magnification (400x zoom), the microscope is arguably not a toy. In response, the Trademark Examining Attorney notes that the involved product is a testament to "how far toy manufacturers have come in the use of cheap and efficient modern technology," but that this "single feature does not transform the toy video microscope" into a scientific apparatus or instrument. Nowhere in this record does applicant argue that it is involved in the field of scientific apparatus and instruments (i.e., marketing

primarily to universities, hospitals, laboratories, etc.). In fact, everything in this record supports the conclusion that no scientist would ever use applicant's toy video microscope for scientific research. Among other testimonials from users of the device, one review notes that despite the exciting possibilities for scientific exploration by youngsters, "It is a TOY, not a real scientific instrument." (EMPHASIS in original). In another review, six-year-olds reportedly used the device out of the box with minimal supervision.



Other reviews in the record point out severe limitations of the device as to focusing, dim lighting, difficulties in using the 400x magnification, etc. Of course, even if current challenges related to lighting, focusing and extreme magnification were to be resolved, as long as the trade dress on the specimens of record demonstrates that this item is being marketed to young children, it remains a toy microscope. If the Office were

to water down the essential concept of a Class 9 "microscope" as a scientific instrument, as urged by our dissenting colleague, by ignoring the context of the class and referring only to the basic dictionary definition of an item having remarkable powers of magnification, then the word "microscope" retains no meaning whatsoever when used in an identification of goods in International Class 9. The broad, common definitions drawn from several dictionary entries certainly do not trump the realities of the actual marketplace combined with decades of experience in deciphering the tricky boundaries between two International Classes under the Nice Agreement. Rather, we find that merely because certain toys may contain technological capabilities unheard of a decade earlier, a merchant or manufacturer whose market involves high-tech learning toys for young children is still not marketing scientific apparatus or instruments.

Another useful analogy (i.e., in addition to handheld gaming devices, *supra*) comes to mind. Under this analogue, the manufacturer of the **Easy-Bake** toy oven would not be entitled to a registration for "ovens" in International Class 11 for this product – a *toy oven* is not an *oven* for International Class 11 purposes, even if it may be capable of baking a cupcake. In this hypothetical, should the

specimen being challenged reveal a toy oven, prior to securing a registration for ovens in Class 11, it would not be unreasonable for the Trademark Examining Attorney to ask that applicant (e.g., the manufacturer of the toy oven) to demonstrate with a specimen and/or other evidence that it also sells full-sized appliances.

In thousands of *ex parte* examinations every week, Trademark Examining Attorneys assist applicants in correctly classifying their goods (and services). This system has proven to be fairly efficient in protecting the interests of new registrants as well as the interests of applicants who file later. A much less efficient method would be to force unnecessary *ex parte* appeals or *inter partes* litigation (e.g., under Section 18) later to correct a classification that is misleading as to the applicant's actual goods.

Contrary to applicant's contention, the distinctions we are drawing herein are not based on "the subjective view of the examiner" but rather reflect a factual determination based on "the nature of the goods themselves," as shown by the specimens and other evidence of record. Specifically, we find that Trademark Examining Attorney Pino factually and correctly determined the true nature of applicant's goods.

Applicant points out that in its earlier application to register its **EyeClops** mark, applicant relied on the same

specimen that accompanied applicant's initial SOU in this application.[20] That Trademark Examining Attorney found nothing in the specimen or elsewhere in the record to suggest that the mark may not be used in connection with scientific instruments in International Class 9, and so made no further inquiries or requirements. In the prosecution of this application, the issue was raised when applicant correctly characterized the involved product as a "toy," by seeking registration in Class 28, in addition to Class 9, but relying on the same specimen for each class. We find no fault with the resulting inquiry by the Trademark Examining Attorney herein. While the Trademark Examining Operation attempts to achieve maximum consistency, we are certainly not persuaded to reverse this Trademark Examining Attorney on this record merely because another Trademark Examining Attorney, reviewing another record, did not make the same inquiry. In the event that applicant, in another application, was awarded protection in International Class 9 to which it may not have been entitled, this is a situation that need not be repeated here. TMEP §§ 1401.02 and 1401.10.

[20] The **EYECLOPS** application matured into Registration No. 3415269.

In the abstract, as discussed above, it is true that the same mark can be used in connection with a variety of different goods. However, in the specific facts of the case at bar, viewing the matter within the four corners of these specimens and other information contained elsewhere in the record, we agree with the Trademark Examining Attorney that this particular mark is not associated with any goods applicant has listed in International Class 9.

The "customer focus" of the Trademark Examining Operation means that the organization defers where appropriate to applicants' identifications of goods (and recitations of services) when trademark owners are seeking federal statutory protection for their intellectual property interests. However, under the facts of the case at bar, the majority herein supports the ministerial function of the Office of the Administrator for Trademark Identification, Classification and Practice by refusing to adopt the position of applicant and of our dissenting colleague: namely, encouraging an "eyeball on a stick" to masquerade as an actual scientific instrument in International Class 9.

Decision: The refusal to register is affirmed on the ground that the specimens do not show use of the mark in connection with the goods listed in International Class 9.

The application will proceed to registration with the goods listed in International Class 28 only.

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Mermelstein, Administrative Trademark Judge, dissenting:

Because I disagree with the majority that the refusal to register in this case is appropriate, I respectfully dissent.

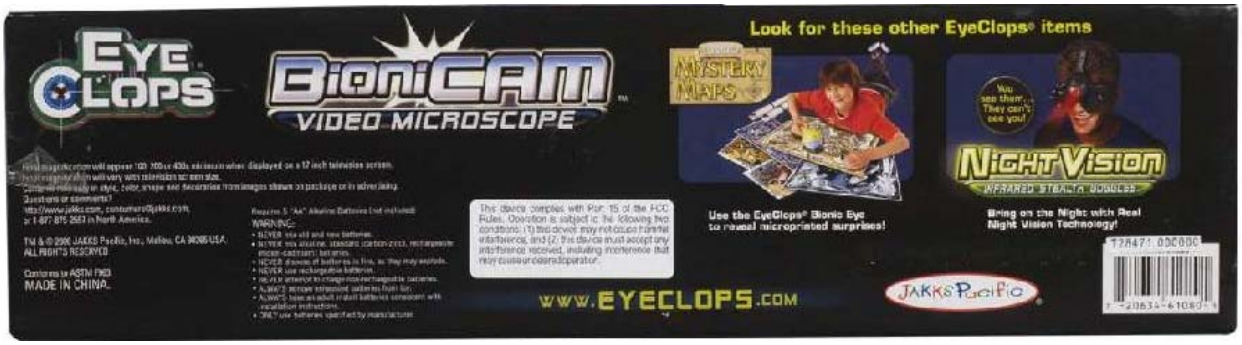
I. Relevant Facts

Applicant's identified goods include "microscopes" in International Class 9, and "toy microscopes" in International Class 28.[21] I note that applicant's identification of goods in both classes has been accepted by the examining attorney, and no issue has been raised as to the adequacy of applicant's specimen for its International Class 28 goods. The only issue before us is the adequacy of either of applicant's specimens in support of applicant's International Class 9 goods.

At the heart of this case is the fact that the goods upon which applicant relies to support its application in

[21] Applicant identifies other goods in Class 9. However, because I would find that applicant's specimen is adequate to demonstrate use of the mark on microscopes, it is unnecessary to determine whether it would be acceptable evidence of use with respect to any of applicant's other Class 9 goods. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 904.01 (8th ed. 2011) (only one specimen per class required).

both Class 9 (microscopes) and in Class 28 (toy microscopes) are apparently the same product. Upon filing its statement of use, applicant initially submitted the same specimen as evidence of its use of the mark in both classes:



This specimen appears to be the image of a panel from a box (*i.e.*, packaging) for applicant's goods. The mark – BIONICAM – appears on the specimen, below which are the words "video microscope." Notwithstanding that the specimen itself actually describes applicant's product as a "video microscope," the examining attorney rejected it, relying on extrinsic evidence to argue that "the specimen shows use of the mark for a toy, not the non-toy items listed in the identification." Office Action, Feb. 2, 2010. Following the refusal, applicant submitted a substitute specimen for Class 9 – an online advertisement depicting the mark and the goods – although it was rejected for the same reason.[22]

[22] Because I would find the original specimen acceptable, I do not discuss applicant's substitute specimen, although I believe that it would also be acceptable.

The examining attorney's position is that applicant's specimens[23] are inadequate to show use of the mark on the identified Class 9 goods, *see* Ex. Att. Br. at 2, and I agree that is the only issue properly before us. In my opinion, applicant's specimens are adequate evidence of its use and none of the other evidence of record is sufficient to reach a different conclusion.

II. Applicable Law

In some cases an applicant may seek registration in more than one International Class on the basis of its use of the mark on a single product. Of course, the identification of goods in each class must be appropriate, and the specimen or specimens must be acceptable as evidence of use of the mark on the goods as identified in each class. For example, in *In re Int'l Salt Co.*, 166 USPQ 215 (TTAB 1970), applicant filed two applications, one for "salt for food purposes" and one for "salt for use in chemical industries," using

[23] The astute observer will note that there is little or nothing in the file explaining why applicant's original or substitute specimen is itself lacking. Rather, the examining attorney's case is built largely on the basis of other evidence (extrinsic to the specimens) about applicant's BIONICAM product and the fact that applicant also applied for registration in Class 28 based on its sale of the same product. In other words, applicant's statement of use has been rejected not because of its specimens, but in spite of them. Nonetheless, because I believe that the examining attorney's evidence does not demonstrate that applicant's Class 9 specimens are inadequate, I assume the propriety of this evidence and discuss it below.

identical specimens. The examiner in the second (chemical) application refused registration, arguing that the specimen only showed use of the mark on salt for food purposes. We explained:

> There can be no question but that a product such as salt may be used both for food purposes and for use in chemical industries. It is settled, moreover, that the owner of a trademark has a right to register the trademark for a particular product in a plurality of classes covering the different purposes or uses of the article that happen to fall within two or more classification classes instead of the usual single class. *See Mead Johnson Co. v. Watson*, 112 USPQ 284 (D.D.C. 1957); *aff'd* 117 USPQ 13 (D.C. Cir. 1958). The only possible restriction on this right is that the specimens filed in any particular class should reflect use of the mark in connection with the product for the use set forth in the application or, conversely, the specimens should not be of a nature or contain language which would, on their face, restrict the product to but a single purpose or use. In those instances where the specimens are of a general utility, and there is nothing on their surface or in the record to suggest that they cannot possibly be used in connection with a product when employed for the purpose enumerated, the examiner is obligated to accept the statement under oath in the application that the specimens are so being used.
>
> In the instant case, the specimens filed are photographs of the packages in which the salt is shipped; the packages are 100-pound bags; the only product identification thereon is simply the word "Salt" without any indication thereon as to any or all intended uses of the product; and applicant, under oath, has alleged that "The mark is used by imprinting it on packages containing the goods...."

Id. at 215-16 (citations revised). We reversed, finding "that the examiner erred in refusing to accept the specimens filed as evidence of use of the mark." *Id.* at 216.

The TMEP likewise recognizes this principle:

> **1401.07 Classification and Plurality of Uses**
>
> A product or service that has a plurality of uses or aspects is ordinarily classified in a single class. *Ex parte Schatz*, 87 USPQ 374 (Comm'r Pats. 1950). However, if it can be shown that a product or service has a plurality of uses or aspects so that two or more classes apply, multiple classification may be permissible. However, identical language cannot be used as the identification of goods in more than one class. The identification must clearly indicate the basis for multiple classification with language that is appropriate for the respective classes. For example, the USPTO will not accept the identification "clock radios," because it is unclear what the goods are and in which class the goods fall – Class 9 for radios or Class 14 for clocks. However, the applicant may adopt either or both of the following identifications – "radios incorporating clocks" in Class 9 or "clocks incorporating radios" in Class 14.
>
> In an application under § 1 of the Trademark Act, the specimen(s) should reflect acceptable use of the mark for each of the specified classes or should be of a general utility nature (e.g., labels for goods). In the case of general-utility specimens, there must be nothing in the record indicating only one use or aspect. *See The Procter & Gamble Co. v. Econ. Lab., Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (CCPA 1974); *In re Int'l Salt Co.*, 166 USPQ 215 (TTAB 1970); *Mead Johnson Co. v. Watson*, 112 USPQ 284 (D.D.C. 1957), *aff'd* 253 F.2d 862, 117 USPQ 13 (D.C. Cir. 1958).
>
> Where a single product or service is classified in more than one class, the applicant must file an acceptable specimen for each class with an

> application under §1(a) of the Act, or an allegation of use (*i.e.*, either an amendment to allege use under 15 U.S.C. § 1051(c) or statement of use under 15 U.S.C. § 1051(d)) in an application under § 1(b). However, where a single specimen supports multiple classes, the examining attorney need not require multiple copies of the specimen. *See* TMEP § 904.01.
> ...
>
> **904.01 Number of Specimens**
>
> One specimen for each class is required in an application for registration under § 1(a) of the Trademark Act, or in an allegation of use in an application under § 1(b). If a single specimen supports multiple classes, the applicant should indicate which classes are supported by the specimen. The examining attorney need not require multiple copies of the specimen. ....

TMEP §§ 1401.07, 904.01 (citations revised).

III. Discussion

As noted, applicant's identified Class 9 goods comprise "microscopes." But what is a microscope? There is nothing in applicant's identification of goods or in the record which would indicate that its use of this term in its Class 9 identification has any meaning other than its ordinary one. *See* TMEP § 1401.02 ("The identification should set forth common names, using terminology that is generally understood."). Although more specific identifications are also listed, the Office's online U.S. Acceptable Identification of Goods and Services Manual lists

"microscopes" without further qualification as an acceptable identification of goods in International Class 9.[24]

As is relevant to the facts of this case, "microscope" has been defined variously as follows:[25]

- "[A]n optical instrument having a magnifying lens or a combination of lenses for inspecting objects too small to be seen or too small to be seen distinctly and in detail by the unaided eye." DICTIONARY.COM UNABRIDGED (Based on the RANDOM HOUSE DICTIONARY (2012)).

- "Any of various instruments used to magnify small objects that are difficult or impossible to observe [by] the naked eye." AMERICAN HERITAGE SCIENCE DICTIONARY (2002) (online).

- "[A]n optical instrument consisting of a lens or combination of lenses for making enlarged images of minute objects." MERRIAM-WEBSTER DICTIONARY (2012) (online).

From applicant's specimens and the other evidence of record, we learn that applicant's actual BIONICAM brand device has optical lenses and can capture images of small objects at 100x, 200x, and 400x power magnification for

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[24] For instance, the Manual lists biological microscopes, electron microscopes, metallurgical microscopes, polarizing microscopes and microscopes for operations.

[25] The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

While I am cognizant of the danger of slavish reliance on the minutiae of dictionary definitions, I note that the referenced definitions are both general and consistent, and they comport with the general understanding of the term "microscope." While other types of microscopes exist (*e.g.*, x-ray microscopes, electron microscopes), I have not included such definitions, as they have no relevance to these facts.

display on a built-in LED screen, on a television screen or on a computer. In other words, it is an optical microscope with a video display, and as such clearly meets the definition of a "microscope."[26] This is supported by an excerpt from the Amazon.com website advertising applicant's product and offering it for sale:

> **Amazon.com Review**
> The EyeClops BioniCam Video Microscope from JAKKS Pacific opens up a world of microscopic fun for kids to explore. This bionic eye makes it easy to take digital pictures and capture video that documents new discoveries. Designed to keep inquisitive children aged eight and up entertained and interested in the world around them, the BioniCam is also engaging enough to captive [*sic*] adults.[27]
>
> ...
>
> **What We Think**
> **Fun Factor:** ★★★★★
> **Durability:** ★★★★☆
> ...
>
> **The Good:** Look at familiar objects in a whole new way; review images on a TV or computer
>
> **The Bad:** Learning to focus the eye takes practice
>
> **In a Nutshell:** Unique video microscope provides creepy close-ups and informal science lessons
>
> **At a Glance**
> **Ages: 8 and older**

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[26] My colleagues suggest that I am "urg[ing]" the USPTO to "water down the essential concept of a Class 9 'microscope.'" *Supra* at 22-23. To the contrary, I urge only that the ordinary meaning of that term be applied.

[27] I assume the author meant that applicant's product is engaging enough to *captivate* adults. (There is no indication in the record that applicant's goods are particularly suited for use by those confined to correctional facilities.)

> **Requires:** 5 AA batteries; TV and/or computer for full effect

Amazon.com, www.amazon.com (Jan. 26, 2010) (submitted by examining attorney). Applicant submitted a similar entry from the Toys-R-Us web page:

> **Product Description**
> The EyeClops BioniCam Video Microscope helps you see the world around you like you've never seen it before. Table salt looks like blocks of ice and fine hair looks like twisted rope. Even your own skin looks alien. Now imagine seeing all these cool things and more with three times the magnification. With magnification of 100x, 200x and 400x, the powerful multi-zoom lens provides a bigger, eye-popping look at the world around you. A built-in digital video screen and battery pack lets you take the BioniCam on the go to explore your world like never before. Like the Bionic Eye, the BioniCam plugs into any standard television for cool magnifications on the big screen. Capture images and videos of your amazing discoveries with the built-in digital camera. You can then save the video to your PC using the included USB drive.

www.toysrus.com.

The examining attorney notes in his brief that "[t]he specimens submitted by the applicant all describe the goods as a video microscope." Ex. Att. Br. at 3. Nonetheless, the examining attorney contends that this is not sufficient, as he alleges that applicant's goods are in fact toy microscopes. "Calling the toy video microscope by another name does not transform the toy video microscope into another good. In other words, the specimens and evidence plainly show that the goods are toy video microscopes that

can only be classified in International Class 28." *Id.* at 3-4.

I think the examining attorney is correct, up to a point. For these purposes at least, I will presume (without deciding) that applicant's BIONICAM product is indeed a "toy microscope," at least in part. Applicant submitted an acceptable identification of its goods as such in International Class 28, and the examining attorney accepted applicant's specimen as evidence of use of the mark on "toy microscopes" in that class.[28] But I do not believe that applicant's identification of its goods in Class 28 as "toy microscopes" necessarily limits our consideration of the same goods (albeit described differently) in Class 9. In order to determine whether applicant's Class 9 specimen is acceptable, I would consider whether the specimen evidences use of the mark on at least one of the identified Class 9 goods. Whether the specimen is also acceptable evidence of use with respect to applicant's identified Class 28 goods is not relevant.

Applicant's identified Class 9 goods comprise "microscopes," and as already discussed, applicant's actual BIONICAM product clearly meets the definition of a

[28] Thus the acceptability of applicant's specimen as evidence of its use of the mark on its identified International Class 28 goods is not before us.

"microscope." Applicant's original specimen clearly and prominently describes the device as a "video microscope." While much of the remaining print on the specimen is very small, under careful inspection (and magnification), I can discern nothing that would indicate that the BIONICAM product is *not* a microscope.[29] Indeed, although the examining attorney accepted the same specimen as to Class 28, there is nothing on the specimen which would indicate that the BIONICAM is – as the examining attorney contends – a toy microscope at all, let alone exclusively a toy microscope.

Perhaps the examining attorney reasons that if goods can be described as toy microscopes, then by necessity they cannot also be described as (non-toy) microscopes. ("Do any of the specimens show use of the mark for the goods in International Class 9 when the specimens and evidence show that the goods are award winning toys properly classified in International Class 28...?" Ex. Att. Br. at 2; "Calling the toy ... video microscope by another name does not transform [it] into another good." *Id.* at 3.) This position has a

[29] The specimen does urge one to "Look for these other EyeClops items," above two pictures of boys using what appear to be other products sold by applicant under different marks. There is no question that applicant's goods are primarily directed to young people, although I can see no reason why that would banish such goods from International Class 9.

certain logical attraction. But I am not at all sure that for purposes of a trademark application, the BIONICAM video microscope cannot accurately be described as both a "microscope" and a "toy microscope," much the same way as the same substance can comprise salt for food use on the one hand, and salt for non-food use on the other, *see Int'l Salt Co.*, 166 USPQ at 215, or the very same clock radio can be identified and registered as either a radio incorporating a clock or a clock incorporating a radio, *or both*. TMEP § 1401.07. USPTO practice clearly permits such a result in some circumstances. The fact that some may use applicant's goods for sheer amusement (*i.e.*, as a plaything) does not necessarily preclude others from employing the same item as a microscope. Thus, I do not consider International Class 9 and International Class 28 to be mutually exclusive in this regard. Again, the issue before us is not whether applicant's goods can be identified as "toy microscopes" in International Class 28, or whether applicant's specimen supports such use; the issue here is only whether applicant's specimen is acceptable as evidence of applicant's use of the mark on "microscopes" in Class 9.

In any event, the examining attorney, supported by extrinsic evidence, argues that the only use to which applicant actually puts its goods is as a toy. This

evidence, attached to the examining attorney's February 2, 2010, Office action consists of one page from what seems to be applicant's own website and several pages (including the evidence discussed earlier) from Amazon.com.

As noted by the majority, the word "toy" is used several times in customer[30] posts on Amazon.com reviewing or commenting on applicant's BIONICAM video microscope. But I think it would be a mistake to make too much of such references to applicant's goods. When considered in context, these posts do not suggest that applicant's BIONICAM video microscope is a toy – and *only* a toy. For example:

- "If they would have had this thing when I was a kid (a few decades back), I would have gone crazy with it. It is a TOY, not a real scientific instrument, but it's the kind of toy that can good and truly make a kid fall in love with science. It turns the world into a puzzle – What would that thing look like if I were the size of an ant? It offers the ability to capture and share images,

[30] I assume for the sake of argument that the posters are customers. But the truth is that we know little about them or their familiarity with the goods from their very brief posts. Further, I would not readily assume that they are knowledgeable about the identification and classification of goods in trademark applications.

To the extent the posters express their own characterization or perception of applicant's goods, it is unclear whether such statements are either relevant or representative. While the perception of a mark by potential or actual consumers is highly relevant when considering likelihood of confusion, it is not clear to me that consumer opinion about the goods necessarily carries the same weight when the issue is the acceptability of specimens of use or the identification and classification of goods.

and compare them with each other. ... [F]or an 8 – to 14-year-old child, this is a portal into interesting worlds, and a possible introduction to science and nature that could result in a lifelong appreciation of discovery. ..." Greg Peterson (Minneapolis, MN).

- "This is a pretty cool toy. I'm 31 years old and I purchased it for my gardening needs to diagnose different mites and pests on them and it's a pretty handy and fun device." Andrew J. Hermann (emphasis added).

- "This is a great toy AND a useful tool for recording close-up images of a variety of objects." "AUgie the Prospector" (emphasis added).

- "This toy seems like a great idea, basically an electronic microscope. However, it is difficult to focus and the illuminating light is so dim that it is unusable." "crtee" (emphasis added).

- "This is a great toy for the whole family. Once you get the focusing part down and taking a picture at the same time, it is great. We also bought some pre-made slides that are great to look at as well. I have not used the video function yet, but that should be pretty cool once we get there. Great toy for Christmas." Jason Berchek (San Diego, CA).

- "Fun but can be hard to focus for kids. I need my dad to help. The pictures look great on our big tv. The weirdest thing to look at was arm hair." I am 8 years old. Unsigned.

- "We bought the bionicam for our son's 5th birthday, thought he would absolutely LOVE it! He does enjoy it and finds it fascinating to see what some things look like magnified. "Sharra."

Although some of these posters indeed call applicant's product a "toy,"[31] it is clear from the context that their use of that word does not exclude use of applicant's goods as a scientific, technical, or educational tool, and that applicant's goods do in fact meet the definition of a "microscope." While some adult posters noted that they or their children found the product to be entertaining, those comments were balanced by others (sometimes by the same poster) noting that the product was useful (*e.g.*, for identifying garden pests) or that it provided a means for younger children to begin their exploration of science and nature.

Notably, it is not clear that any of the material on the Amazon.com or Toys-R-Us web pages constitutes applicant's own characterization or advertising of the goods.[32] Although the examining attorney submitted one page from what appears to be applicant's website, the only

[31] One of the Amazon.com pages notes briefly that applicant's product is the "Winner of Many of this years [*sic*] Toy Awards." While this indicates that applicant's product is considered a toy (at least by some people or for some purposes), that comes as no surprise. The issue here is not whether the product associated with the specimen is a toy, but whether it is (or is also) a microscope. The fact that applicant won toy awards sheds no light on this question.

[32] It is possible that applicant supplied the product descriptions on both websites quoted earlier in this opinion, although there is no evidence of this.

information on that page is supportive of applicant's position that the goods are, in fact, a "microscope":

> 3 x THE POWER
> With magnifications of 100x, 200x and 400x, the powerful, new multi-zoom lens provides a bigger, eye popping look at the world around you!
>
> PORTABLE:
> With a built-in digital video screen and battery pack, you can take BioniCam video microscope on-the-go – explore your world like never before! And like the Bionic Eye, the [text does not continue]

http://eyeclops.com/ (Jan. 26, 2010).

As noted by the majority, in his first Office action (*i.e.*, prior to submission of applicant's Statement of Use and specimens), the examining attorney required that applicant provide information about whether the mark has any significance as applied to the goods or in the relevant trade or industry. Applicant responded as follows:

> Answer: Not really. The word BIONICAM is a made-up word; the good itself is a camera that is used in conjunction with the EYECLOPS brand toy which applicant has referred to as a "bionic eye", but which functions as a kind of microscope. It does not have any other significance in the industry.

Response (Nov. 25, 2008).

Similar to the online customer posts, applicant's brief response to the examining attorney's query points in two directions. On the one hand, applicant says that the BIONICAM product "is used in conjunction with the EYECLOPS brand toy...." On the other, applicant describes the same

item as "a camera ... which functions as a kind of microscope." Again, applicant describes its product in words suggesting that it is *both* a toy and a microscope. Applicant's response clearly does not indicate that the BIONICAM product is exclusively a toy.[33]

Considering all of the evidence of record, it is clear that applicant's goods are primarily marketed for the use of children, although some adults find them both entertaining and useful. Further, while there is no evidence that the goods are (or are likely to be) used for advanced education, research, or diagnostic purposes, the goods are seen by some as educational tools (albeit at a level appropriate for 8-year-olds). As noted, customers in online posts reported that both children and adults use the BIONICAM video microscope to explore the realm of microscopy, including adults who indicated use of it for the identification of plant pests and for viewing and recording other small objects.

[33] While applicant's response seems vague and ambiguous when regarded in light of the question at hand, it should be noted that the examining attorney asked only whether applicant's mark had any significance as applied to the goods or in the relevant trade or industry. Applicant was not requested to provide information about the nature of the goods. (The response was apparently adequate as to the significance of the mark, as no further mention of that issue appears in the file, and the mark was approved for publication.)

In fairness, it should be added that a number of posters commented on what they perceived to be shortcomings of applicant's microscope, including difficulty in focusing, limited display, and poor built-in illumination. But the disappointment of some with the aspects of applicant's video microscope highlights the fact that the posters considered the device as a microscope, and not simply as a toy. Even if it could be said that applicant's BIONICAM video microscope is not a high-quality microscope, that does not mean that it is not a microscope at all.[34]

As far as I am aware, International Class 9 is not an exclusive club that may only be joined by microscopes used by post-doctoral researchers in white lab coats, or ones that cost a certain amount of money, are of a certain quality, or are even used by anyone over eight years old.

[34] The majority notes that "those ubiquitous hand-held game apparatus having small built-in displays" are properly classified in International Class 28, and that by "analog[y]," so are applicant's video microscopes. *See supra* at 16. With respect to my colleagues, the analogy is inapt. As the majority points out, applicant said that its goods "function with video output devices of the sort falling under class 9." While the majority is correct that not all video output devices fall in Class 9, the point is not relevant here. Applicant did not say that all video output devices fall in Class 9, only that its goods are similar to such devices which *do* "fall[] under class 9." In any event, applicant does not identify or describe its goods as a "game apparatus," nor is there any evidence of record to support such a conclusion. The fact that applicant's video microscope is hand-held and has a small built-in display does not make it a game, nor is there anything about a small hand-held display which requires that a product be identified exclusively as a toy or placed in Class 28.

(Every student of science has to begin at some point.) As can be seen from the definitions quoted above, the term "microscope" is ordinarily understood as focusing on the nature of the instrument, not the age or occupation of its intended user. And while some trademark applicants may choose to more narrowly identify their microscopes by a specific function, use, or user, the Office has apparently determined that they need not do so. In this case, applicant acceptably identified its goods as "microscopes," and its specimen shows use of the mark on packaging for a good which meets that definition.

IV. Conclusion

To sum up, in my view, applicant's first specimen (packaging for the goods) demonstrated use of the mark on "microscopes." Applicant's packaging describes the goods as a "video microscope," and nothing on that specimen limits its use to that of a toy. Further, while the examining attorney's extrinsic evidence does show that some customers are entertained by applicant's goods or describe it as a "toy," this evidence also shows use of it as a "microscope." All of that is entirely consistent with the application claiming use in both International Classes 9 and 28.

In order to reject applicant's Class 9 specimen, I think it is insufficient to ask merely whether some

customers consider or use applicant's goods as a toy, or even whether a majority of them do. Here, applicant's specimen did in fact "reflect use of the mark in connection with the product for the use set forth in the [Class 9] application," and the specimen was "not ... of a nature [n]or [did it] contain language which would ... restrict the product to *but a single purpose or use*." *Int'l Salt*, 166 USPQ at 215 (emphasis added). Finally, the extrinsic evidence does not show that applicant's microscope is only and exclusively sold or used as a mere toy. In the language of the TMEP, "there [is] nothing in the record indicating *only one* use or aspect" of applicant's goods. TMEP § 1401.07 (emphasis added).

I would therefore find that the original specimen adequately evidences applicant's use of the applied-for mark on microscopes, and I respectfully dissent from my colleagues' contrary holding.

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