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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86230383

MARK: U



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Unistrut International Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant Unistrut International Corporation appeals the examining attorney's final requirement for an acceptable identification and proper classification of certain goods for which registration of a mark consisting of the letter "U" on a shield is sought.

FACTS

Applicant filed this application on March 24, 2014 seeking registration of a mark consisting of the letter “U” on a shield for use on various goods classified by the applicant in International Classes 6, 9 and 19, and generally encompassing building and framing components, electrical and electronic installation products, electrical substation assemblies, and printed circuit card guide assemblies. On June 18, 2014, the examining attorney issued an Office action requiring applicant to clarify the identification and classification of numerous items in the application. Applicant’s December 15, 2014 response proposed amendments to the identification and reclassified certain goods to International Classes 11 and 17. Several of the amendments were rejected in the January 10, 2015 final action.

Applicant subsequently filed the current appeal to the Trademark Trial and Appeal Board¹ in conjunction with a request for reconsideration. The request contained only a single proposed amendment, the deletion of "and supports" from "electrical and electronic installation products and accessory components, namely, fittings and supports for fluorescent lighting fixtures" in International Class 11, and also included arguments that the remaining wording was acceptable as proposed in the December 15, 2014 response. The request for reconsideration was denied on August 7, 2015.

PRELIMINARY MATTER

Upon further consideration, the requirements for amendment of the following wording are *withdrawn*.

- sectional metallic building units and couplings, fittings, and connections therefor, adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures in International Class 6;

¹ Applicant also appealed the same identification requirements in its co-pending Application Serial No. 86220011, and the examining attorney's brief therein is filed concurrently with the brief in the present appeal. If the Board finds consolidation or issuance of a single decision for these two appeals appropriate under TBMP 1214, the examining attorney is amenable to such action.

- metal electrical and electronic installation products and accessory components, namely, cable trays and supports, conduits, bus duct and bus bar supports, cable saddles and supports, bus bar clamps, bus duct connectors, and wiring stud nuts in International Class 6;
- electrical and electronic installation products and accessory components, namely, raceways, switch plates, outlets and outlet plates, conduit connection fittings and connectors, outlet box connection fittings, fibre wire retainers in the nature of reels for electrical wire, relay racks for mounting electrical equipment in International Class 9;
- electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures in International Class 11;
- building and framing accessory and installation components, namely, rubber washers, in Class 17;
- non-metal structural building and framing products, and accessory components therefor, namely, ducts and door jambs in International Class 19;
- non-metal building and framing accessory and installation components, namely, pipe couplings, pipe clamps, [and] pipe hangers in International Class 19.

ISSUE

The issue on appeal is whether the following wording in applicant's proposed identification of goods is acceptable for purposes of registration under the Trademark Act, 15 U.S.C. §1051 *et seq.*, and the Rules of Practice in Trademark Cases, 37 C.F.R. Part 2:

- structural building and framing products, namely, rolled and extruded metal sections in International Class 6;
- printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements in International Class 9;
- electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members; electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators in International Class 9;
- building and framing accessory and installation components, namely plastic conduits in International Class 17;
- non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings in International Class 19; and

- non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe rollers for use as hardware, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers in International Class 19.

ARGUMENT

The Trademark Act requires that an application include a "specification of the goods [or services]" in connection with which the mark is being used or will be used. 15 U.S.C. §1051(a)(2), (b)(2); 15 U.S.C. §1053. The USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1597 (TTAB 2014) (citing *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). The identification must be specific, definite, clear, accurate, and concise. *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d at 1597-98; TMEP §1402.01. The application must also specify the appropriate International Class for the goods and/or services identified in the application. 37 C.F.R. §2.85(a); TMEP § 1401.02. Proper classification of goods and services is an administrative matter and is solely within discretion of the USPTO. *In re Faucher Indus. Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013) (quoting *In re Tee-Pak, Inc.*, 164 USPQ 88, 89 (TTAB 1969)).

The proposed amended wording at issue is not acceptable because it fails to identify goods that are definite and properly classified. TMEP §§1402.01, 1402.03. An identification of goods and/or services must be in the correct class and also must not include language that "makes classification difficult or ambiguous." TMEP §1402.01(a). Wording that includes items in more than one class is not acceptable. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) ("chronographs" held indefinite because it includes both time-recording devices in Class 9 and watches in Class 14 and because merely classifying the goods in only one of the classes does not preclude a requirement for further specificity in the identification).

Applicant was advised in the June 18, 2014 Office action, and the January 10, 2015 final action that its proposed wording was unacceptable and the specific reasons for each listed item. Applicant was also provided with a sample amended identification which featured examples of acceptable clarifications and proper classification highlighted in bold and italic text. In each instance applicant failed to respond with an acceptable amendment.

Following is a listing of the wording at issue and the reasons why it fails to meet the standard for an acceptable identification:

1. Structural building and framing products, namely, rolled and extruded metal sections in International Class 6

This wording is indefinite because sections for building and framing could include a wide variety of products, and thus does not clearly specify the particular goods. The January 10, 2015 final Office action advised applicant that it must specify the type of section and provided the example of "wall panels" as an acceptable clarification.

Applicant's examples of entries from the U.S. Acceptable Identification of Goods and Services Manual ("ID Manual"), namely, "frames of metal for building," "frameworks of metal," and "building wall framing made primarily of metal," are not analogous to its proposed amendment. Each of these items is specified as a particular frame, while applicant's proposed amendment is much broader, as it identifies namely "rolled and extruded metal sections" that may include semi-finished products for use in further manufacture of finished building frames. Due to the ambiguous nature of this wording as possibly identifying finished versus semi-finished goods, the wording is unacceptable for purposes of registration.

2. Printed circuit card guide assemblies including framing members, brackets, rubber-phinolic guide elements, or resin or plastic guide elements and insert elements in International Class 9

The wording "including" constitutes an open-ended word and is not acceptable; identifications must specify the goods using inclusive and specific terms. TMEP §1402.03(a) ("The terms "including," "comprising," "such as," "and the like," "and similar goods," "products," "concepts," "like services" and other indefinite terms and phrases are almost always unacceptable"). As explained in the TMEP, "including" is only acceptable when it follows a definite term. Thus applicant's hypothetical of "furniture including chairs" is not relevant as "furniture" itself is acceptable and the wording "including chairs" is merely a further clarification of an already definite term. In contrast, applicant has not provided any evidence that its wording "printed circuit card guide assemblies" is an acceptably definite term.

Additionally, this wording is unclear and must be clarified to indicate whether the items are for assembling circuit cards or component parts of circuit cards. Applicant was provided with a sample clarification of "printed circuit card guide assemblies in the nature of component parts of circuit cards, namely, framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements" in the January 10, 2015 final action.

3. *Electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members; electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators in International Class 9*

This wording is too broad and could include goods in other international classes. TMEP §§1402.01, 1402.03. Metal hardware frames, brackets and fittings that are not electric in nature are in International Class 6, electrical items that are parts of assemblies are in International Class 9, non-metal framing such poles for electric power lines and building are in International Class 19.

Applicant's argument that this wording should be accepted because some goods could be in International Class 9 does not address the issue that the wording could also include items that are not in

International Class 9. To be acceptable, the identification must be worded such that the goods are clearly in the relevant class and only goods that are in the specified class. TMEP §1402.01(a).

4. *Building and framing accessory and installation components, namely, plastic conduits in International Class 17*

This wording must be clarified because it is too broad and could include goods in other international classes. TMEP §§1402.01, 1402.03. Per entries found in the USPTO's ID Manual², "plastic conduits for electrical use" are in International Class 9, "plastic conduits for plumbing" are in International Class 17, and "plastic conduits for drainage" are in International Class 19. Applicant elected not to provide clarification as to the type or purpose of the conduits, and thus this wording is unacceptable as overly broad as proper classification cannot be determined.

Applicant's reference to a notation from the ID Manual does not render its proposed amendment acceptable. The entry to which applicant refers, "Plastic tubes for {indicate use, e.g. protecting electrical wires, milking machines, etc.} [conduits; not packaging]" in International Class 17, is actually an identification for "tubes" while the wording in brackets, "conduits; not packaging" serves to further clarify the nature of the tubes. Further, applicant's wording is not limited to plastic tubes used as building material, as the prefatory wording specifies the much broader "building and framing accessory and installation components," which could include components for installing building and framing, and not merely building materials themselves.

5. *Non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings in International Class 19*

² Available at <https://tmidm.uspto.gov/id-master-list-public.html>.

This wording is too broad because it could include goods in multiple international classes. TMEP §§1402.01, 1402.03. For example, per entries found in the ID Manual, "non-metal shelf brackets" are in International Class 20. Furthermore, such items as "concrete inserts, partition and display fittings and moldings" are indefinite because the use for which they are intended and their appropriate classification cannot be determined from the current identification. The January 10, 2015 final Office action included examples of clarifications in each possible international class properly classified pursuant to guidance of the ID Manual entries relating to such goods.

Applicant's argument that its identification is only for non-metallic building materials is not reflected in the actual proposed wording of the identification, which also includes structural products and components therefor that do not meet the definition of "building materials."³ For example, the "non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts" could identify machine and vehicle parts rather than structural building materials.⁴ Characterizing such goods as "structural building or framing products" creates an ambiguity as to the nature of the goods on which the mark is intended to be used.

6. *Non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, ... pipe rollers for use as hardware, ... fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers in International Class 19*

This wording is too broad because it could include goods in multiple international classes. TMEP §§1402.01, 1402.03. Non-metal nuts, bolts, screws, studs, hinges, springs for use as hardware, spring

³ "Building materials" are "material used for constructing buildings" (<http://www.vocabulary.com/dictionary/building%20material>) or "materials such as bricks, cement, timber, etc." (<http://www.collinsdictionary.com/dictionary/english/building-materials>).

⁴ A "conveyor" is "a moving belt that transports objects (as in a factory)" (<http://www.vocabulary.com/dictionary/conveyor>) while a "trolley" is "a wheeled vehicle that runs on rails and is propelled by electricity" (<http://www.vocabulary.com/dictionary/trolley>).

clips for use as hardware, pipe rollers for use as hardware, pipe hangers, fender hooks for hardware use, clamps, brackets for use as hardware, and tubing clips are all in International Class 20, not International Class 19. Thus, this wording is misclassified, as set forth in the January 10, 2015 final Office action which also included examples of clarifications in each possible international class.

Applicant's argument that its identification is only for non-metallic building materials is not reflected in the actual proposed wording of the identification, which includes also structural products and components therefor that do not meet the definition of "building materials." For example, "non-metal building and framing accessory and installation components, namely, conveyor and trolley rollers for use as hardware" is ambiguous as the goods specified after "namely" could include goods such as machine and vehicle parts rather than building and framing accessories or installation components. As worded, the identification includes goods in International Class 20 as well as goods that are too ambiguous as described to determine the proper international class.

CONCLUSION

The examining attorney respectfully submits that for the reasons set forth above, the applicant's proposed amendments to the identification of goods are not acceptable and that the refusal to register as to the following goods be *affirmed*:

International Class 6: structural building and framing products, namely, rolled and extruded metal sections

International Class 9: printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements; electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members; electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators

International Class 17: Building and framing accessory and installation components, namely, plastic conduits

International Class 19: Non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings; non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe rollers for use as hardware, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers

Respectfully submitted,

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