

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: March 2, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Northeastern University*  
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Serial No. 87487674  
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Michael E. Hall of Kacvinsky Daisak Bluni PLLC,  
for Northeastern University

Steven M. Perez, Trademark Examining Attorney, Law Office 101,  
Ronald R. Sussman, Managing Attorney.

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Before Wellington, Shaw and Greenbaum,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Northeastern University (“Applicant”) seeks registration on the Principal Register  
of the mark NORTHEASTERN (in standard characters) for

Cases for mobile phones; refrigerator magnets; clips for  
electric charging cables; battery packs; mouse pads;  
computer mouse; blank USB flash drives; sleeves for  
laptops in International Class 9.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87487974 was filed on June 13, 2017, based upon Applicant’s claim  
of first use anywhere and use in commerce since at least as early as June 13, 2017.

The Examining Attorney has refused registration of Applicant's mark on the ground that Applicant has failed to amend its identification of goods, as the Examining Attorney has required. The requirement, and therefore the refusal, is limited to the wording "clips for electric charging cables."

After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm.

### I. Applicable Law

Trademark Act Section 1(a)(2), 15 U.S.C. § 1051(a)(2), requires that "[t]he application shall include specification of ... the goods in connection with which the mark is used...." *See also* Trademark Rule 2.32(a)(6), 37 C.F.R. § 2.32(a)(6) (requiring an applicant to include "[a] list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark."). An applicant must identify the goods with sufficient particularity to provide public notice, to enable the USPTO to classify the goods properly, and to allow the USPTO to reach informed judgments concerning likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). TMEP § 1402 (October 2017). The examining attorney has discretion to require a more particularized statement of the goods in the identification of goods and to classify them under the Nice Agreement Concerning the International Classification of Goods and Services ("Nice Agreement"), the international system of classification to which the United States is a party and the USPTO has adopted. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007) ("It is within the discretion of the PTO to require that one's goods be identified with

particularity.”); *In re Walter Gremlin Co.*, 635 F.2d 841, 208 USPQ 89, 91 (CCPA 1980). Terminology that includes items in more than one class is considered indefinite. *Omega*, 83 USPQ2d at 1544. Proper classification of goods and services is a purely administrative matter within the Office’s sole discretion. *In re Faucher Indus. Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013) (quoting *In re Tee-Pak, Inc.*, 164 USPQ 88, 89 (TTAB 1969)).

## II. Analysis

The only issue is whether “clips for electric charging cables” is sufficiently definite. The Examining Attorney maintains that this wording is indefinite and could include goods classified in more than one International Class depending on their material composition. It is the Examining Attorney’s position that “clips for electric charging cables” are essentially small items of hardware that generally fall in International Class 6 if they are metal, and International Class 20 if they are non-metal, regardless of the type of cable with which they will be used. He therefore has required Applicant to specify the material composition of the goods.

Applicant contends, however, that the clips properly are classified in International Class 9, with no need to specify their material composition, because they are for “electric charging cables” that fall in International Class 9 rather than clips for general use. Applicant points to several examples of clips that are classified by function where a single use is stated, such as “pacifier clips” and “surgical clips,” which are classified in International Class 10 with medical goods, and “binder clips” and “pen clips,” which are classified in International Class 16 with stationery

products. According to Applicant, the purpose of the clips controls their classification, and the material composition is a secondary consideration to be used if the goods cannot be classified by function or purpose. Applicant also argues that the singular purpose of its clips constitutes a special use or attribute justifying classification in International Class 9.

TMEP § 1401.02(a) sets forth the general remarks, class numbers, class headings, and explanatory notes for each international class under the International Classification of Goods and Services for the Purposes of the Registration of Marks (“Nice Classification”). The relevant language follows:

#### GENERAL REMARKS

The indications of goods or services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to ascertain the exact classification of each individual products or service.

#### *Goods*

If a product cannot be classified with the aid of the List of Classes, the Explanatory Notes and the Alphabetical List, the following remarks set forth the criteria to be applied:

- (a) A finished product is in principle classified according to its function or purpose. If the function or purpose of a finished products is not mentioned in any class heading, the finished product is classified by analogy with other comparable finished products, indicated in the Alphabetical List. If none is found, other subsidiary criteria, such as that of the material of which the product is made or its mode of operation, are applied.

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As the Examining Attorney points out, Applicant relies on TMEP § 1401.02(a) to support its position, but it has ignored the introductory language limiting such criteria to situations where a product cannot be classified “with the aid of the List of

Classes, the Explanatory Notes and the Alphabetical List.” In this case, Applicant’s cable clips can be classified “with the aid” of the foregoing primary classification resources, rendering unnecessary reliance on criterion (a) above.

The Nice Classification’s List of Classes and Explanatory Notes for International Classes 6 and 20 cover small items of hardware similar to Applicant’s cable clips. International Class 6 covers “Metal goods” including “non-electric cables and wires of common metal” and “small items of metal hardware.” According to the “Explanatory Note,” International Class 6 “includes, in particular: small items of metal hardware, for example, bolts, screws, nails, furniture casters window fasteners.” International Class 20 covers “Furniture and articles not otherwise classified.” According to the “Explanatory Note,” International Class 20 “includes, in particular: small items of non-metallic hardware, for example, bolts, screws, dowels, furniture casters, collars for fastening pipes.” Likewise, the Alphabetical List includes “clips of metal for cables” in International Class 6, and “clips, not of metal, for cables” in International Class 20.<sup>2</sup>

We agree with the Examining Attorney that his

requirement that Applicant specify the material composition of its cable clips does not constitute a resort to

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<sup>2</sup> We grant the Examining Attorney’s request to take judicial notice of an excerpt from the Alphabetical List of the Nice Classification Eleventh Edition, attached to the Examining Attorney’s Brief. *See, e.g., B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTA 2001) (dictionary entries and other standard reference works).

In addition to these primary classification resources, the ID Manual classifies “cable clips” by their material composition, with “metal cable clips” in International Class 6, and “non-metal cable clips” in International Class 20. September 7, 2017 Final Office Action, TSDR 4.

the subsidiary criterion of material composition as contemplated by TMEP § 1401.02(a). Instead, it represents the application of primary criteria of the Nice Classification as directly reflected in the Trademark Office ID Manual. Applicant has identified clips for cables that are necessarily either primarily metal or non-metal. In each instance, their proper classification may be readily determined without consideration of their function or purpose beyond their status as clips for cables. The fact that Applicant has omitted from the identification information enabling accurate classification in Class 6 or 20 does not trigger secondary criteria rendering the wording acceptable in Class 9. Instead, the wording is simply indefinite and requires clarification.<sup>3</sup>

We acknowledge that there is no rule mandating that all clips must be classified in International Classes 6 or 20 according to their material composition, and that, for example, pen clips and binder clips are classified according to their function rather than material composition. However, the primary classification resources discussed above make it clear that cable clips are classified by their material composition.

Furthermore, we agree with the Examining Attorney that “[e]ven if consideration of function or purpose were relevant in this case, applicant’s reference to a type of cable does not alter the classification of its clip goods” because “as with other cable clips, the presumed function or purpose of the identified cable clip is to enable the fastening of a cable to itself or something else. Applicant provides no arguments or evidence that this essential function or purpose changes based on the type or class of cable fastened by a clip.”<sup>4</sup> In other words, contrary to Applicant’s contention,

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<sup>3</sup> Examining Attorney’s Brief, 10 TTABVUE 9-10.

<sup>4</sup> *Id.* at 10-11.

Applicant's cable clips are not properly classified in International Class 9, with electrical goods, simply because they are used "for electrical charging cables."

Finally, unlike "toilets adapted for medical patients or for use by disabled persons," which are classified as medical apparatus in Class 10 based on the particular use of the goods, rather than in Class 11 with general "toilets," Applicant's "clips for electrical charging cables" do not have a special use or attribute that would justify classification in International Class 9 rather than by material composition in International Classes 6 or 20. *See* TMEP § 1402.03(5). As the Examining Attorney explains, "[t]he description of cable clips as for use with electric charging cables does not reflect any special adaptation, but is instead simply a voluntary narrowing of readily classifiable goods."<sup>5</sup> We agree with the Examining Attorney that "[n]othing in the identification of goods indicates that Applicant's cable clips function differently than other cable clips, or that they are specially adapted for "for electric charging cables."<sup>6</sup>

### III. Conclusion

After careful consideration of all of the evidence made of record and the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion, we conclude that Applicant's identification of "clips for electric charging

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<sup>5</sup> Examining Attorney's Brief, 10 TTABVUE 11.

<sup>6</sup> After Applicant filed its brief, the Examining Attorney and Applicant exchanged emails in which the Examining Attorney suggested that an amendment indicating that the goods were "specially adapted" for electric charging cables would be acceptable in Class 9. Applicant, however, rejected the proposed amendment as unwarranted. September 12, 2017 Note to the File, TSDR 1.

cables” is unacceptably indefinite. *Omega*, 83 USPQ2d at 1544 (examining attorney has discretion to determine to require an applicant to identify its goods “with particularity.”).

**Decision:** The refusal to register based on Applicant’s failure to comply with the requirement for an amendment to the identification of goods is affirmed solely as to “clips for electric charging cables.” The application will register with the following amended identification of goods: “Cases for mobile phones; refrigerator magnets; battery packs; mouse pads’ computer mouse’ blank USB flash drives; sleeves for laptops” in International Class 9.