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Paper No. 9
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Laura M. Congemi

Serial No. 76/106,045

Edwin D. Schindler for Laura M. Congemi.

Leigh Caroline Case, Trademark Examining Attorney, Law
Office 105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Hanak and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 9, 2000, applicant filed the above-
referenced application to register the mark "AUNT SAMANTHA-
AMERICA FIRST" on the Principal Register for
"goods/services" recited as "female version of Uncle Sam to
help promote America's greatness," in Class 42. The basis
for filing the application was applicant's assertion that
she possessed a bona fide intention to use the mark in
connection with these goods or services in commerce.

The Examining Attorney refused registration under Sections 1, 2 and 45 of the Lanham Act on the ground that the "goods/services" set forth in the application do not constitute either goods or services within the meaning of the Act. Further, applicant was advised that it could not amend the application to identify any goods or services because although an application may be amended to clarify or limit the identification of goods and services, additions are not permitted.

Applicant responded to the first Office Action by amending the application to delete the language in the identification of "goods/services" in the original application and to substitute therefore the following: "printed matter containing a female version of 'Uncle Sam' with the expression 'Aunt Samantha-America First,' in International Class 16."

The Examining Attorney refused to accept applicant's amendment, contending that applicant's amended identification of goods identifies goods not within the scope of the application as filed. Additionally, she advised applicant that she could not include the wording "Aunt Samantha-America First" in the identification-of-goods clause because an applicant may not use a trademark in identifying its goods or services. The Examining

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Attorney maintained and made final the refusal to register based on applicant's alleged "failure to properly identify goods or services."

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs on appeal. Applicant did not request an oral hearing before the Board.

Based on careful consideration of the record in this application, the written arguments of applicant and the Examining Attorney and the relevant legal precedents, we conclude that the Examining Attorney's refusal to accept applicant's amendment to the identification-of-goods clause is not well taken.

The rule with regard to amending the identification of goods or services is set forth in Trademark Rule 2.71(a). This section states that an application may be amended to clarify or limit the identification of goods or services, but it may not be amended to broaden the goods or services as claimed in the original application as filed. The scope of goods or services, as designated in the original application or in any subsequent amendment, establishes the outside limit for any later amendments.

TMEP Section 1402.07(b), in discussing this issue, specifically addresses the situation with which we are

presented in this appeal. It states as follows: "An applicant may amend an identification of goods or services (i.e., an identification that fails to indicate a type of goods or services) in order to specify definite goods or services within the scope of the indefinite terminology."

This is precisely the situation in the case at hand. As filed, the application failed to indicate a type of goods or services, at least with any clarity or specificity. Applicant amended to specify definite goods.

The issue thus became whether or not the goods identified in the amendment are within the scope of the indefinite terminology which was used in the application as filed. We hold that they are. As applicant points out, the "version" of the Uncle Sam character referred to in the original application would have to be manifested in some form or another, whether as a doll, a live character or by appearing in graphic form on objects such as posters and items of apparel. The printed matter specified in the amended identification-of-goods clause is plainly within the scope of the original language used in the application as filed. The proposed amendment is therefore acceptable.

The Examining Attorney's statement in the first Office Action advising applicant that no amendment would be allowed because the application as filed did not clearly

identify either goods or services and only limitations or clarifications are permitted requires additional comment. This statement was neither clear nor helpful to the applicant. On its face, it appears to be inconsistent. If amendments to limit or clarify are permitted, then why could applicant not file such an amendment? As discussed above, when an original identification is unacceptably broad or unclear, it must be clarified. Section 1402.07(b) of the examination manual explains this necessary process. To advise an applicant that once the application had been filed with an unclear identification, no amendment would be permitted because the original identification could only be clarified or limited was simply wrongheaded.

The Examining Attorney's problem with applicant's inclusion of the words in her mark in the identification-of-goods clause is equally unfounded. Section 1402.09 of the TMEP states that if a mark that is registered to another entity is used in the identification of goods, the Examining Attorney should require that it be replaced with the generic term, rather than the other entity's mark. Obviously, by its very terms, this section is limited to an applicant's use of a mark owned by another. It does not govern the instant situation, where applicant refers to her own mark in the identification clause.

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DECISION: The refusal to accept the amended
identification-of-goods clause is reversed.