Mailing:
January 7, 2005

This Opinion is Not Citable as Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BrainLAB AG

Serial Nos. 78102333 and 78102336

Don W. Bulson of Renner, Otto, Boisselle & Sklar, LLP for BrainLAB AG.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

In separate applications, BrainLAB AG has applied to register the marks "CardioSUITE" and "BrainSUITE," respectively. Each application was based on applicant's stated intention to use the specified mark in commerce, see Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), and claimed a priority filing date because of applicant's having previously filed a corresponding application to register the specified mark for the identified goods and

services in the Federal Republic of Germany, see Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d).[1]

The involved applications each list a broad range of products in Classes 9 and 10, as well as numerous services in Class 42. During the course of examination of the applications, applicant and the examining attorney agreed on certain amendments to the identifications, to obviate concerns of the examining attorney. Eventually, however, the examining attorney issued a final action in each application, requiring further amendments of the identifications in classes 10 and 42 as a prerequisite to approval of each mark for publication. Applicant further amended the Class 42 identification in each application, as required, but refused to adhere to all the examining attorney's requirements for amendment of the Class 10 identifications. Accordingly, the examining attorney made final a requirement for an acceptable identification in Class 10, and applicant appealed.

[1] The USPTO inferred a secondary basis for registration in the United States, distinct from applicant's stated intention to use, based on applicant's anticipated receipt of German registrations for its marks. See Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). Currently, each application is based on applicant having obtained a registration for the specified mark in Germany; applicant no longer asserts Section 1(b) as a separate basis. Applicant has maintained its claim to a priority filing date in each application.

After considering applicant's appeal briefs, the examining attorney further narrowed the Class 10 identification issues to be considered on appeal by withdrawing certain requirements. At this point, only four specific identification issues remained unresolved. Next, applicant and the examining attorney negotiated satisfactory amendments obviating three of the remaining four issues. Thus, the only issue to be considered on appeal, in regard to each application, is the propriety of the examining attorney's requirement that applicant amend, to make more definite, the phrase "electronic apparatus and image presentation apparatus for medical purposes."

The issue is fully briefed. Applicant did not request a hearing at which to present oral arguments.

Apart from explaining the policies behind the USPTO's requirement for a certain degree of specificity in identifications of goods, the examining attorney essentially argues that the disputed language encompasses both "electronic apparatus … for medical purposes" and "…image presentation apparatus for medical purposes"; that the former is so broad as to encompass goods as diverse as, for example, heating pads, electronic heart rate monitors, hearing aids, medical electrodes, massage apparatus, and electrocardiographs; that the latter is so broad as to

encompass, for example, x-ray apparatus, urological imaging systems, electromagnetic medical diagnostic imaging apparatus, and microscopes for operations; that the breadth of these phrases and, in their combined form, the breadth of the disputed phrase in the identification, encompasses very expensive items and relatively inexpensive items; that other examining attorneys searching the register for appropriate citations under Section 2(d) of the Trademark Act would have difficulty assessing the import of a registration including the disputed language; and that a registration including the disputed language would provide little practical notice as to the nature of applicant's goods.

Applicant argues that it has utilized virtually identical language in three other registrations that it has obtained from the USPTO; that the office has, therefore, determined that this language is acceptable; that Trademark Examination Note 98/1 requires only that an identification be clear enough that a non-expert in trademarks or in applicant's field understand "what the item… is," that it allow for proper classification, and that it adequately define the parameters of the goods; that the disputed language meets these requirements; and that Trademark Examination Guide No. 1-01 states that an examining

attorney should, in assessing a proposed identification, act consistently with treatment accorded companion applications that have matured into registrations.

Trademark Rule 2.32(a)(6), 37 C.F.R. § 2.32(a)(6), provides that an application must include a "list of the particular goods." Section 1402.03 of the Trademark Manual of Examining Procedure (TMEP) explains that when broad terms are used, they generally must be readily understood as to the scope of products identified by the terms, or such terms must identify a "homogeneous group" of products, and that circumstances presented by a particular application should justify the use of broad terms. In addition, when an application is based on Section 44 of the Trademark Act, as are the involved applications, the scope of the identification may not exceed the scope of the foreign registration on which the corresponding United States application is based. Trademark Rule 2.32(a)(6); see also, TMEP Section 1402.01(b) and Board decisions cited therein.

We agree with the examining attorney that the phrase "electronic apparatus and image presentation apparatus for medical purposes" is too broad and indefinite. It does not meet the requirement of Trademark Rule 2.32(a)(6) that "particular" goods be specified in an application.

Further, we do not find the phrase to readily identify a cognizable "homogenous group" of products or to be such that its scope would be readily understood. Finally, we do not find the circumstances presented by the involved applications to warrant use of such a broad phrase and, instead, find the phrase to exceed the scope of the foreign registrations on which the involved applications are based.

In regard to the last point, we note that applicant's corresponding German registrations, as shown by the translations provided by applicant, employ the language "electrical and electronic apparatus and image-presenting apparatus for medical purposes, in particular medical and/or surgical robots, also for application with image-guided localization systems for surgical purposes." We find this language to limit applicant's "electronic apparatus and image presentation apparatus" not just by the phrase "for medical purposes" but rather, to limit such goods to "medical and/or surgical robots" for use on their own or "for application with image-guided localization systems for surgical purposes."

Accordingly, we affirm the examining attorney's refusal to approve applicant's marks for publication so long as the application identifications include the phrase "electronic apparatus and image presentation apparatus for

medical purposes" in the Class 10 identifications. That applicant may have obtained approval of other applications including the same or virtually identical language is no justification for allowing its use in the applications now before us. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (Though uniformity of standards used to assess applications is encouraged, each application must be assessed on its own merits).

Following expiration of the time for applicant to file an appeal from this decision, if no appeal is filed, then the referenced phrase shall be deleted from the Class 10 identification and the mark will be forwarded for publication.

Decision: The requirement of the examining attorney for a revised identification of goods is affirmed.