

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 23, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gina Marie Slattery and Kris Johnson

Serial Nos. 78887793 and 78887799

Laura J. Zeman of Snell & Wilmer for Gina Marie Slattery
and Kris Johnson.

Ingrid C. Eulin, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Walters, Drost and Bergsman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Gina Marie Slattery and Kris Johnson ("applicants")
seek registration on the Principal Register of the marks
COMPACT WITH AN EDGE¹ and COMPACT WITH AN ATTITUDE,² both in

¹ Serial No. 78887793, filed May 19, 2006. The application was filed on the basis of and allegation of a bona fide intention to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b). The application includes a disclaimer of EDGE apart from the mark as a whole.

² Serial No. 78887799, filed May 19, 2006. The application was filed on the basis of and allegation of a bona fide intention to

standard character form, for, as amended, "multi-function pocket/pocketbook tool, namely, a small multi-function tool having a combination of tools including two or more of a pocket knife, scissors, shears, razor, bottle opener, corkscrew, nail file, nail clippers, flashlight, whistle, mirror, defensive spray, tweezers, screwdriver, mirror, and needle and thread," in International Class 8.

Because the issue on appeal is the same in both applications, we are deciding these appeals together and issuing this single opinion.

At issue in these appeals is the Trademark Examining Attorney's final refusal to register applicants' marks on the ground that the identification of goods is indefinite in each application. See Trademark Act Section 1(b)(2), 15 U.S.C. §1051(b)(2), and Trademark Rule 2.32(a)(6), 37 C.F.R. §2.32(a)(6). The appeal is fully briefed.

As a preliminary matter, in each case, applicants submitted copies of third-party registrations with their briefs and the examining attorney has objected thereto. We agree that this evidence is untimely, as all evidence must be submitted prior to appeal, and, therefore, we have not considered this evidence. See, 37 CFR 2.142(d); and *In re*

use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

Moreover, even if we were to consider this evidence, it would not affect our decision in these cases as the fact that an identification of goods or services was accepted in an earlier-filed application or prior registration does not necessarily mean it is controlling in a later-filed application. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007).

Also preliminarily, we note that, in each application, applicants filed a request for reconsideration which included an amendment to the identification of goods. This amendment was entered into the record in each application and is the operative identification of goods on appeal.³

While the examining attorney sets out in her brief essentially four reasons for her conclusion that the identification of goods is indefinite, we find that her argument principally relies on her contention that the use of the word "including" is not "sufficiently specific and all-inclusive" because it "permits a multitude of combinations that have not been identified." (Brief, unnumbered p. 3.) Her other contentions about classification depend, first and

³ We note that the examining attorney issued a general denial of the request for reconsideration. She neither informed applicant that their amendment had been entered nor offered applicants any further explanation as to why the amended identification of goods is unacceptable.

foremost, on her position that the identification of goods is not all-inclusive.

On the other hand, applicants do not specifically address what we have construed as the primary reason for the examining attorney's refusal. Instead, applicants focus on the argument that the fact that goods may fall in multiple classes does not make the description of goods indefinite. Applicants contend that their identification of goods is acceptable, stating that "the conclusion that a term would clearly include terms classified in more than one class should not be drawn unless reasonable, in light of the commercial relationships between all the goods or services identified in the application," citing TMEP §1402.03, guideline one. (Brief, p. 2.) Applicants refer to their improperly submitted evidence to argue that the USPTO has "allowed registration in International Class 8 of a number of similar multi-function tools" and "allowed registration of a number of marks for a multi-function pocket tool containing multiple instruments without requiring the registrant to identify and list the multiple functions and/or instruments." (Id.)

"It is within the discretion of the PTO to require that one's goods be identified with particularity." *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89, 91 (CCPA

1980), *aff'g In re Water Gremlin Company*, 204 USPQ 261 (TTAB 1979). See also, *In re Societe General des Eaux Minerales de Vittel*, 1 USPQ2d 1296, 1298 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 457, 3 USPQ2d 1450 (Fed. Cir. 1987) and cases cited therein. The question before us is whether the examining attorney abused this discretion.

The USPTO has consistently taken the position that the identification of goods must be all-inclusive; and, thus, that open-ended language suggesting additional items may be part of the goods covered by the application/registration is unacceptable. This prohibition almost always includes use of the word "including" because, in the context of an identification of goods, it usually means "such as" or "for example." See TMEP §1402.03(a). We take judicial notice of the definition in *Merriam-Webster's Collegiate Dictionary* (11th ed. 2003) of "include" as, in relevant part, "to take in or comprise as a part of a whole or group" and "INCLUDE suggests the containment of something as a constituent, component, or subordinate part of a larger whole."

The determination of whether the term "including" renders the identification of goods indefinite must be decided on a case-by-case basis in the context of the goods so identified. We must determine what is a reasonable

understanding of this identification of goods. In this case, the product is a pocket tool consisting of a combination of at least two items. The identification of goods states: "a small multi-function tool having a combination of tools including two or more of ...". This statement is followed by a definite list of seventeen items. However, the term "including" refers to the "combination of tools" on any particular pocket tool and, in this context, the term "including" is not all-inclusive. Rather, as in many unacceptable identifications of goods, it means "for example" or "such as," suggesting that the list of seventeen items are illustrative examples of the items that can be combined on the pocket tool. In other words, the pocket tool may include, but is not limited to, the illustrative list of seventeen different items.

Therefore, the identification of goods is indefinite because of the use of the word "including," and the examining attorney properly required applicants to amend their identification of goods to replace the indefinite word "including" in each application.⁴

Decision: The refusal to register is affirmed.

⁴ An example of a proper identification of goods in International Class 8 would be "a multi-function pocket tool consisting of a pocket knife and screwdriver and which may also include ..."