

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Degussa GmbH

Serial No. 79022373

Scott D. Woldow of Smith Gambrell & Russell, LLP for
Degussa GmbH.

Khanh M. Le, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Bucher, Drost and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark **PERACLEAN** (*in standard character format*) for
goods identified in the original application as follows:

"chemical products for industrial use, *in particular* raw materials for chemical syntheses" in International Class 1;

"bleaching agents" in International Class 3;

and

"disinfectants" in International Class 5.¹

¹ Application Serial No. 79022373 was filed on March 17, 2006 based upon an International Registration under Section 66(a) of the Trademark Act, 15 U.S.C. §1141f(a), and includes an allegation of a *bona fide* intention to use the mark in commerce.

Applicant is also the owner of Registration No. 2424321 for the mark **PERACLEAN** for "chemicals used in industry, namely,

In her initial Office action, the Trademark Examining Attorney required clarifying amendments to the identification of goods in International Classes 3 and 5 in order to specify the intended purpose of the bleaching agents and disinfectants. Eventually, applicant provided acceptable identifications for these two classes of goods.²

The sole issue on appeal herein is the Trademark Examining Attorney's refusal to register the mark as to International Class 1 based upon applicant's failure to

compounds with active oxygen content for chemical synthesis, particularly for oxidation and epoxidation reactions; chemicals used in industry, namely, raw materials used in the manufacture of disinfection and bleaching preparations namely, peracetic acid, except for use in dishwashing and in kitchens" in International Class 1, issued on January 30, 2001; Section 8 affidavit (six-year) accepted.

² The two acceptable classes of goods, as amended, are as follows:

"bleaching agents for industrial cleaning purposes, bleaching agents for use in laundry, bleaching agents for use on hair, bleaching agents for use on fibres, bleaching agents for use in the textile industry, bleaching agents for use in the paper industry, but not including bleaching agents for use in dish washing or in kitchens and not including bleaching agents for use in the printing, packaging and converting industries" in International Class 3; and

"all purpose disinfectants, disinfectants for industrial use, disinfectants for household use, disinfectants for medical instruments, disinfectants for the food and beverage industry, disinfectants for the laundry industry, disinfectants for the paper industry, disinfectants for cooling water, disinfectants for waste water, disinfectants for ballast water, disinfectants for vegetable washing

comply with the requirement of the Trademark Examining Attorney to submit an amended identification of goods in compliance with Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a).³

Applicant and the Trademark Examining Attorney have submitted briefs. We affirm the refusal to register the goods only in International Class 1, sending the mark on to publication as to the remaining classes of goods.

The relevant prosecution history of this case reflects much wrangling back and forth over various proposed formulations of the amended identification of goods in International Class 1. The several interim formulations need not clutter this opinion. The following identification of goods is applicant's latest proposed amendment, with highlighting added for that portion still rejected by the Trademark Examining Attorney:

"chemicals used in industry, namely, compounds with active oxygen content for chemical synthesis, for oxidation and for epoxidation reactions; chemicals used in industry, namely, raw materials used in the

water, disinfectants for animal hygiene, disinfectants for carcass washing" in International Class 5.

³ **§ 2.71 Amendments to correct informalities.**

The applicant may amend the application during the course of examination, when required by the Office or for other reasons.

(a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.

manufacture of disinfection and bleaching preparations; **chemicals for use in industry, namely, peracetic acid; chemicals for use in industry; chemicals for use in industry and science;** chemical additives for use in the manufacture of a wide variety of goods; specialty chemicals, namely, chemical additives for general industrial use in the manufacture of a wide variety of goods; catalysts for use in the manufacture of industrial chemicals; catalysts for chemical and biochemical processes; chemical additives for fuel treatment; chemical agents for chelating and sequestering" in International Class 1.

This appeal turns on the correctness of the Trademark Examining Attorney's interpretation of the conjunctive adverb, " ... , in particular ... " within applicant's original identification of goods, as filed. Specifically, as noted above, the goods in International Class 1 were filed as follows: "chemical products for industrial use, *in particular* raw materials for chemical syntheses." [emphasis supplied]. Despite agreement on the non-highlighted balance of the verbiage in applicant proposed amendment to the goods (immediately above), the current stalemate is over the issue of whether or not the following three phrases in applicant's latest proposal exceed the scope of the goods as filed:

- "chemicals for use in industry, namely, peracetic acid,"

- "chemicals for use in industry," and
- "chemicals for use in industry and science"

without the addition of the limiting language required by the Trademark Examining Attorney, of "for chemical syntheses" after this three-part listing of industrial chemicals.

In order to place our resolution of this semantical difference in the proper context, we note that applicant's original identification of goods in International Class 1 was *not* found to be *indefinite*. In fact, this was the only class of goods that the Trademark Examining Attorney deemed to be acceptable upon first reviewing the application for informalities. The problem occurred when, in responding to the Trademark Examining Attorney's initial refusal of indefiniteness as to classes 3 and 5, applicant proposed an amendment of more than a hundred words to replace the dozen-word listing contained in International Class 1 that the Trademark Examining Attorney had deemed to be definite and acceptable.

As the time this appeal was taken, applicant and the Trademark Examining Attorney had reached agreement upon appropriate wording for 85% of the class of goods. However, inasmuch as no acceptable amendment to the

identification of goods in International Class 1 has been accepted by the Office prior to this appeal, should we determine that the Trademark Examining Attorney is correct, applicant is left with a listing of goods that is still indefinite, and hence the entire class would have to be deemed unacceptable.

The concern of the Trademark Examining Attorney is that the broad phrase common to all three of the rejected goods ("chemicals for use in industry...") exceeds the scope of the original identification of goods, limited to "raw materials for chemical syntheses." She has taken the position that this amendment, if permitted, could well modify applicant's channels of trade, and affect other du Pont factors.⁴ Were the Office to permit applicant undue latitude in changing the identification of goods or recitation of services during the course of prosecuting an application, it could well jeopardize the rights of a third party (e.g., someone prepared to adopt a similar mark sometime after March 2006 who had searched the records of the United States Patent & Trademark Office and then made a

⁴ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973) sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

decision on potential instances of likelihood of confusion). Such a party might well rely to its detriment upon the scope of the original identification of goods - that is, if reading this applicant's initial identification of goods with the perspective argued by the Trademark Examining Attorney.

Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), provides that filing an application for registration on the Principal Register establishes constructive use and nationwide priority, contingent upon issuance of the registration. Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for the Principal Register.

The structure of the original intent-to-use rules promulgated in 1989 as reflected in almost twenty years of Office practice was calibrated to establish a reasonable and pragmatic system for applicants, while taking into consideration the important interests of third parties operating in the marketplace.⁵

⁵ The Trademark Examining Operation is correct in interpreting this rule with care. A primary objective of the constructive use provisions of the intent-to-use system (§7(c) of the Lanham Act as amended) was ensuring clear notice to third parties, thereby providing greater certainty in the acquisition of trademark rights. This principle that has been followed

In practical terms, the fundamental disagreement between applicant and the Trademark Examining Attorney is how to interpret the meaning of the transitional term beginning with " ... , in particular" We turn then to the language of the Trademark Manual of Examination Procedure:

1402.03(a) Inclusive Terminology

The identification should state common names for goods or services, be as complete and specific as possible and avoid indefinite words and phrases. 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.

The terms "namely" and "consisting of" are definite and are preferred whenever setting forth an identification that requires greater particularity. Vague terminology should be replaced by "namely" and "consisting of" whenever possible.

consistently - from the time the Trademark Review Commission released its report, during the Congressional proceedings leading to passage of the Trademark Law Revision Act of 1988, through development of the Trademark Rules and the instructions contained in the first intent-to-use examination guidelines that were later reflected in the Trademark Manual of Examining Procedure (TMPEP), during all the Patent and Trademark Office lectures for trademark practitioners and Trademark Examining Attorneys, as well as in specific cases decided over the past fifteen-plus years by the Commissioner [e.g., *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991) involving the mere addition of new items of clothing beyond an interim amendment during prosecution], and by the Trademark Trial and Appeal Board [e.g., *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991)]. By contrast, a looser interpretation of these provisions would have the perverse effect of creating much uncertainty.

This brief discussion of "inclusive terminology" in TMEP § 1402.03(a) has as its conceptual underpinning the contrast between transitional terms that are "definite" or "close-ended" and those considered to be "indefinite" or "open-ended." The position of the Trademark Examining Attorney is that applicant's "in particular" should be treated as a close-ended transitional term (e.g., "namely"). For example, if the identification of goods had been filed as "chemical products for industrial use, *namely* raw materials for chemical syntheses," the entire scope of the goods in applicant's International Class 1 would have been restricted to a clearly-defined subset of chemical products that could not be broadened on the way to issuance of a registration.

The word "namely" like the term "in particular" fits into an awkward category known as "conjunctive adverbs." However, while "namely" is clearly a conjunctive adverb of *apposition*, "in particular" is more of a conjunctive adverb of reinforcement.

Specifically, there is no question but that what follows "namely" in an identification of goods is a definite, explanatory equivalent of what preceded it. Any proposed amendment later to clarify the instant goods that

would have the effect of broadening the identification of goods beyond the bounds of "raw materials for chemical syntheses" would be impermissible under Rule 2.71(a).

The contrary argument presented by applicant is that its original identifying language should be treated as a vague or indefinite modifier (e.g., "including," "such as," "and the like"). Furthermore, if this were the case, then under long-standing Office practice, applicant argues that its broad, indefinite identification of goods can be replaced with a determinate listing of goods using definite and specific terminology and with the transitional phrase in the amendment consisting of a close-ended conjunctive adverb like "namely."⁶

⁶ We note in passing a different argument put forward by applicant that seems to turn on an alternative attempt at deconstruction of the syntactic relationship of the two involved phrases. Specifically, applicant argues that given the significance of the *comma* in the original identification of goods, the two portions should be seen as presenting a disjunctive. Under this interpretation, the lead-in phrase, "chemical products for industrial use ... " is in no way limited by the arguably disjointed phrase " ... raw materials for chemical syntheses."

Apart from the disputed meaning of the transitional term, "in particular," we disagree with applicant's position that the comma itself creates two separate and distinct subsets of goods in International Class 1. The Office's fine-honed identification of goods practice, and especially the limitations of Rule 2.71(a), would come completely undone if a comma before a close-ended transition like "namely," for example, were to be interpreted as a disjunctive.

In short, we are faced with the question of whether applicant's choice of "in particular" is to be treated like "including" or like "namely."

"In particular"

Applicant argues from an assortment of dictionary entries - and primarily from definitions that the Trademark Examining Attorney placed into the record - that the weight of the evidence supports applicant's position. The following is generally the order in which applicant discussed these entries in its brief.

12. *Logic. Particular* an individual or a specific group within a general class. ⁷
10. *Particular* an individual or distinct part, as an item of a list or enumeration. ⁸
3. *Particular* distinguished or different from others or from the ordinary; *noteworthy*, marked; unusual: *She sang with particular warmth at last evening's concert.* ⁹
4. *Particular* *exceptional or especial. Take particular pains with this job.* ¹⁰

⁷ Dictionary.com Unabridged (v 1.1) Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006.

⁸ Id.

⁹ Id.

¹⁰ Id.

8. Logic. Particular

a. *not general; referring to an indefinite part of a whole class.*¹¹

par·tic·u·lar (pər-tīk'yə-lər, pə-tīk'-) adj. *Logic*

Encompassing *some but not all of the members of a class or group*. Used of a proposition.¹²

3. Particular *Worthy of note; exceptional: a piano performance of particular depth and fluidity.*¹³

2. Particular Separate and distinct from others of the same group, category, or nature: *made an exception in this particular case.*¹⁴

—*Idiom* **13. in particular**, particularly; specifically; especially: *There is one book in particular that may help you.*¹⁵

in particular *adverb* specifically or especially distinguished from others; "loves Bach, particularly his partitas"; "recommended one book in particular"; "trace major population movements for the Pueblo groups in particular" [syn: particularly]¹⁶

in particular especially; ...¹⁷

¹¹ Id.

¹² *THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, Fourth Edition*

¹³ Id.

¹⁴ Id.

¹⁵ Dictionary.com Unabridged (v 1.1) Based on the *RANDOM HOUSE UNABRIDGED DICTIONARY*, © Random House, Inc. 2006.

¹⁶ *WordNet® 3.0, © 2006 by Princeton University.*

¹⁷ *The American Heritage Dictionary of Idioms*, Christine Ammer.

in particular more than others¹⁸

— **in particular** : in distinction from others : SPECIFICALLY¹⁹

In its brief at 7 - 11, in support of its position herein, applicant highlighted the following amalgam of related concepts drawn from these entries: "*especially, or 'to a great extent'*"; one item, out of many, that has added importance but is *not exclusive of all others*; "raw materials for chemical syntheses" are but one item in a list; "raw materials for chemical syntheses" are a specific and significant part of the group, however, the identification of goods should not be limited to only these goods; there are *other* "chemical products for industrial use" *in this class that can and should be specifically identified*; the goods are "chemical products for industrial use" and the *other unnamed items should be allowed to be identified* as well; "in particular" is *not limiting in nature*; the "raw materials for chemical syntheses" are *notable* and important but are *not the only goods encompassed* by the preceding language "chemical products for industrial use"; applicant seeks to remedy an indefinite part of International Class 1 by designating the

¹⁸ Kernerman English Multilingual Dictionary, K.Dictionaryes Ltd.

other specific "chemical products for industrial use"; the "raw materials for chemical syntheses" are an important part of a group of chemical products for industrial use *but are not the only items* and thus, applicant should be allowed to specify the other items in the group; "raw materials for chemical syntheses" are *worthy of particular attention* and are *exceptional* but are *by no means the only items of the large group*; "raw materials for chemical syntheses" are "*separate and distinct* from others of the same group"; definition emphasizes one thing and how it is distinguished from others; definitions indicate that one item stands out among many and so *applicant should not be limited to one item* but should be allowed to add other items as long as the additional items are types of "chemical products for industrial use"; note that part of the definition is "*distinction from others.*"

Of course, it was the Trademark Examining Attorney who placed these many dictionary entries into the record. Accordingly, she argues vehemently that these same dictionary entries (e.g., "in distinction from others: specifically"; "particularly; specifically, especially") support her position herein. In the arguments in her

¹⁹ Mirriam-Webster Online Dictionary.

brief, she follows up the connotations of the synonym "specifically" (an adverb) with reference to the adjective, "specific" (from Latin *species* 1 a: constituting or falling into a *specifiable* category b: sharing or being those properties of something that allow it to be referred to a *particular category* 2 a: restricted to a particular individual, situation, relation, or effect ... b: exerting a distinctive influence ... 3: *free from ambiguity: accurate* ... 4: of, relating to, or constituting a *species* and especially a biological species... synonyms see "*special,*" "*explicit*"...).

When we examine the noun form of the word "particular," a close synonym is "item." This connotes the concreteness of a detail or item. When we look to the adjective form of the word, there is a feeling of "definiteness" contained within the term. But certainly whenever one moves to the adverb form of the term "in particular," the parallel is an even stronger term, "particularly." Even accepting applicant's arguments, its chosen transitional term focuses on what follows as being: notable; to a distinctly greater extent or degree than is common; specifically or especially distinguished from others; peculiarly: uniquely or characteristically which

leaves the reader with a clear sense of limitations on the scope of the goods.

We find that an identification of goods or services that follows a general introduction with a more detailed explanation is acceptable when it transitions with a "close-ended" conjunctive adverb like "namely." Such transitional terms share the following characteristics: specific, definite, a full enumeration that is detailed, limited, clearly-defined, restricted, exact, precisely-expressed, unambiguous, or separate and distinct.

Based upon the *gestalt* of all the dictionary entries reviewed above, we might add terms like notable, worth-mentioning, exceptional, specifiable, explicit, or accurate.²⁰

By contrast, an unacceptable identification of goods has a transitional term in the form of an "close-ended". Historically, one of the most frequent "informalities" corrected during the initial examination of trademark applications is requiring that the indefinite term "including" be amended to the definite word "namely." Transitional terms like "including," "and the like" and

²⁰ Clearly, this is not intended to suggest specific transitional terms, but simply to capture the essence of close-endedness.

"such as" share the following characteristics: general, indefinite, universal, broad, unlimited, vague, or partial.

Based upon the dictionary entries reviewed above, we might add the following antonyms: for example, of no particular significance, just a for-instance, among others, by-the-by, or *inter alia*.

The similarity is that both close-ended and open-ended transitions may suggest that the listing is not exhaustive. However, with the close-ended conjunctive adverb, what follows is important - as contrasted with the more matter-of-fact listing suggested by the open-ended transition.

Applicant complains that the Trademark Examining Attorney is responsible for the limits placed on its attempts to clarify its original identification of goods. However, we find that applicant, at the least, inadvertently limited the scope of goods with its own choice of transitional terms in the original application.

The TMEP discussion of inclusive terminology (§ 1402.03(a)) quoted above does not purport to offer up for trademark applicants or for the Trademark Examining Operations an exhaustive listing of English-language transitions for use in identifying goods or reciting services. We suspect that the TMEP does not include a

listing of "in particular," "especially" or "particularly" because applicants seldom use these particular transitional terms. While we do not underestimate the intricacies and challenges of this particular formalities practice presented to trademark counsel and to Trademark Examining Attorneys alike, we do find that the ready availability of free, online resources to assist with this task provided by the Trademark Office is unprecedented.²¹

In summary, we find that "in particular" is equivalent to "namely" for purposes of determining the scope of an identification of goods, and therefore, we conclude that applicant's rights would be restricted by the follow-on language limiting the goods at the time of filing to one use in particular.

Decision: The refusal to register is affirmed as to International Class 1. The application for the trademark **PERACLEAN** in connection with the goods contained in International Classes 3 and 5 will be sent on to publication, and further processing consistent with Section 66 of the Lanham Act.

²¹ For example, <http://www.uspto.gov/main/trademarks.htm> includes easy access to THE US ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL.