

Full Class Heading Does Not Cover "All Services" in the U.S.

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First published on Mondaq

Trademark owners outside the United States often find it useful to file U.S. applications based on priority from an application or registration in their home country, or as an extension of protection from an International Registration under the Madrid Protocol. A recent decision from the U.S. Trademark Trial and Appeal Board ("TTAB") highlights why trademark owners should consider drafting the description of goods and services in their home country registration to comply with U.S. Patent and Trademark Office ("USPTO") practice if they are planning to use that registration as a basis for registration in the U.S.

Background

On May 3, 2011 Fiat Group Marketing & Corporation Communications S.p.A. filed an extension of protection to the United States based on its International Registration No. 1082074, seeking registration of FIAT 500 for a wide variety of goods and services in Classes 6, 9, 14, 16, 18, 25, 28, 30, and 35. The extension of protection identified the Class 35 services by listing only the full class heading: "advertising services; business management; business administration; office functions."

In response to the USPTO's requirement to provide a more specific description of services, Fiat sought to amend the Class 35 description to include "retail store and on-line retail store services featuring a wide variety of consumer goods of others." The USPTO Examiner refused Fiat's request to add these services on the ground that they exceeded the scope of the original application.

Fiat argued that the amendment was not beyond the scope of the original application because its Class 35 description constituted the full class heading and the full class heading is presumed to encompass all of the goods or services in a particular class. Fiat argued further that retail store and online retail store services are included under the umbrella term "business management services" because operating a retail store involves the management of a business.

Decision

On January 31, 2014, the TTAB issued a precedential decision upholding the refusal to add "retail store and online retail store services featuring a wide variety of consumer goods of others" on the basis that these services exceeded the scope of the original application. See *In re Fiat Group Marketing & Corporate Communications S.p.A.*, Serial No. 79/099154 (TTAB Jan. 31, 2014).

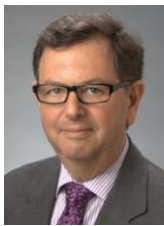
The TTAB held that under USPTO practice the full class heading does not cover all the goods or services in an international class. Rather, the scope of the identification of services must be determined by considering the ordinary meaning of the words in the application, in this case, "advertising," "business management," "business administration," and "office functions."

In determining the ordinary meaning of "business management," the TTAB took judicial notice of a dictionary definition for "business management" defining the term as the process and result of applying certain concepts and techniques to a business organization to help that organization to achieve its goals, objectives, and mission. The TTAB further noted that to qualify for trademark protection the service must be rendered in commerce for others. The TTAB observed that "business management" entailed a "business-to-business service with one company helping another company function better in its business. Retail store services, on the other hand, involve entities bringing together different goods for retail purchase by consumers." As such, the retail store and online retail store services did not fall within the scope of "business management services."

Take-Away

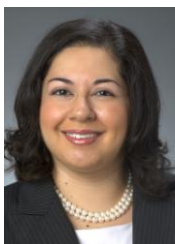
Filing an application for the full class heading provides the broadest scope of protection in many countries, but not in the United States. The USPTO will look only at the ordinary meaning of each term in the application to determine the scope of the application. Therefore, if a trademark owner anticipates that its home country registration may be used as a basis to claim priority or as a basis for registration in the United States, then the home country registration should list the specific goods or services that are critical to the company's business.

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