

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NIIT Limited

Serial Nos. 75/887,968; 75/887,969; 75/887,970; 75/887,971;
75/887,973; 75/888,281; 75/888,283; and 75/888,379

Marc B. Harrison of Venable, Baetjer, Howard & Civiletti,
LLP for NIIT Limited.

Cheryl L. Steplight, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

On January 6, 2000 NIIT Limited filed the above
intent-to-use applications to register eight composite NIIT
marks for goods which were identified as "computer
software" in class 9.¹

¹ These applications also include services in classes 41 and 42.
However, the issue on appeal relates solely to the goods in class
9.

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The Trademark Examining Attorney, in her first office action in each of the applications, advised applicant that the identification of goods was unacceptable because it was indefinite and required applicant to specify the function of its computer software. In its response, applicant stated that it intended to use the marks in connection with a variety of goods, and thus, the identification of goods should be accepted "as is." The Examining Attorney was not persuaded and issued a final office action in each application requiring applicant to amend the identification of goods and refusing to register the mark in the absence of compliance with the requirement. Again, the Examining Attorney pointed out that applicant must indicate the function of its computer programs.

Applicant filed a notice of appeal and a request for reconsideration in each application. By way of the request for reconsideration, applicant amended the identification of goods in the applications to read as follows:

Computer software for use in conjunction with conducting classes, seminars, and conferences and workshops in the field of computer hardware and software usage and information technology; computer software for use in conjunction with computer consulting services, computer software consulting services, computer software writing services, technical consultation for others in the field of computer aided engineering and

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engineering drawings, the design of computer software and computer hardware for others and computer programming for others.

The Examining Attorney denied each request for reconsideration. Both applicant and the Examining Attorney filed briefs, but no oral hearing was requested. The eight cases have been consolidated and this single opinion is being issued for the cases.

The sole issue on appeal is whether the identification of goods, as amended, is acceptable. The Examining Attorney, referencing Trademark Manual of Examining Procedure Section 1402.02(d), contends that computer programs must be identified with specificity so as to avoid the issuance of unnecessary refusals of registration under Section 2(d) of the Trademark Act. With the rapid growth in computer programs and the increasing degree of specialization, the Examining Attorney argues that it is especially important that broad descriptions of computer programs not be permitted, unless the particular function of the program is also indicated. As to applicant's amended identification of goods, in particular, the Examining Attorney argues that the language "for use in conjunction with" in the identification does not sufficiently specify the function of applicant's computer

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programs and would hinder Examining Attorneys in making appropriate refusals under Section 2(d).

Applicant, on the other hand, argues that its amended identification of goods complies with the requirement set forth in the Examining Attorney's final office action.

Trademark Manual of Examining Procedure Section 1402.03(d) is titled "Identifying Computer Programs with Specificity" and states, in relevant part, that:

Any identification of goods for computer programs must be sufficiently specific to permit determinations with respect to likelihood of confusion. The purpose of requiring specificity in identifying computer programs is to avoid the issuance of unnecessary refusals of registration under 15 U.S.C. §1052(d) where the actual goods of the parties are not related and there is no conflict in the marketplace. (citation omitted). Due to the proliferation of computer programs over recent years and the degree of specialization that these programs have, broad specifications such as "computer programs in the field of medicine" or "computer programs in the field of education" should not be accepted unless the particular function of the program in that field is indicated. For example, "computer programs for use in cancer diagnosis" or computer programs for use in teaching children to read" would be acceptable.

In this case, we agree with the Examining Attorney that the amended identification of goods is not sufficiently definite. In the absence of language specifying the function of applicant's computer programs,

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it is all but impossible to discern their nature. For example, as noted by the Examining Attorney, the language "Computer software for use in conjunction with classes, seminars, and conferences and workshops in the field of computer hardware and software usage and information technology" is broad enough to encompass computer programs in the nature of a spreadsheet for recording grade point averages to computer software containing course, testing and evaluation materials. Similarly, the language "Computer software for use in conjunction with computer consulting services, computer software consulting services, computer software writing services, technical consultation for others in the field of computer aided engineering and engineering drawing, the design of computer software and computer hardware for others and computer programming for others" is broad enough to encompass computer software for word processing to computer software for use in creating other computer software. Thus, it would be difficult for Examining Attorneys to make proper refusals under Section 2(d) on the basis of the language in applicant's amended identification of goods.

In view of the foregoing, we find that applicant's amended identification of goods is unacceptable.

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Decision: The requirement to amend the identification of goods and the refusal to register in the absence of an acceptable amendment is affirmed in each application.