
Saving Costs In the U.S. Trademark Process – Draft The Identification Of Goods And Services Narrowly

Description

By [John E. Ottaviani](#)

One of the most common reasons U.S. trademark applications receive Office Actions is that the identification of goods and services covered by the application is indefinite or too broad. The U.S. Patent and Trademark Office (USPTO) requires that the identification of products and services be very specific. This practice is different from that in other countries, where broad categories of goods and services can be claimed. As a result, the description of goods and services filed in a national application in another country or in an International Registration often needs to be modified and narrowed before the U.S. application will be approved.

Very often the identification of goods and services used in the applicant's country of origin is drafted to claim many items in the class rather than the specific goods being protected, in order to obtain as broad a scope of protection as possible. Listings of goods and services in multiple classes, extending for several pages, are common. When an application to register the mark is then filed in the U.S., either based on the registration in the country of origin under the Paris Convention, or by extension of the International Registration under the Madrid Protocol, very often the applicant is greeted with a lengthy Office Action from the USPTO requiring a number of amendments to the identification of goods and services. At this point, in order to avoid abandonment of the application, the applicant will be required to engage the services of a U.S. attorney to prepare and file the response.

If at all possible, the identification of goods and services should be amended before filing the US application. The USPTO has a narrower standard than that used in many countries and requires the listing of goods and services to use definite terms, not overly broad language. These terms can be found in the USPTO's "Acceptable Identification of Goods and Services Manual," (ID Manual), which is available online [here](#). The identifications in the ID Manual generally are accepted in the examination process without objection. Thus, the applicant, either with the assistance of its own attorney or with a US trademark attorney, can select the most appropriate terms for the applicant's goods and services at the outset and avoid the expense of having to respond later to a lengthy Office Action regarding the identification of goods and services.

Even if the application has already been filed, the applicant is permitted to amend the application voluntarily prior to the time the application is examined. There is generally a 2 to 4-month period between the time the initial application is filed and when it is examined. Filing a voluntary amendment to narrow the identification of goods and services during this time can also avoid the expense of having to respond later to a lengthy Office Action.

In our next post, we will provide you with tips on how to save time and money by confirming that the mark is in use on each item listed in the U.S. application or registration.

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