

UNITED STATES PATENT AND TRADEMARK OFFICE

19 APR 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard Ferris : BEFORE THE
Trademark: TEE-MAIL : TRADEMARK TRIAL
Serial No: 75-589448 : AND
Address: 3521 Glenbrooke Road APPEAL BOARD
Fairfax, VA 22031
ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Scott M. Oslick, Examining Attorney, Law Office 108
(David Shallant, Managing Attorney) for the United States
Patent and Trademark Office

The applicant has appealed the trademark examining attorney's refusal to register the service mark TEE-MAIL on the grounds that the specimen does not show use of the mark for the stated services. 37 C.F.R. Sections 2.56 and 2.88(b)(2).

FACTS

On November 25, 1998, the present application was filed to register the mark TEE-MAIL,¹ set forth as a typed drawing, for services in International Class 35, ultimately identified as follows: Wholesale and retail distributorship featuring golf equipment, golf and sports clothes, golf books, audio cassettes, video cassettes, compact disks and CD-ROMs which may be accessed by way of a global computer network.

¹ U.S. Application Serial No. 75-589448, filed on November 25, 1998, based on Section 1(b) of the Trademark Act, 15 U.S.C. Section 1051(b).

The application was published for opposition on November 30, 1999. Applicant filed a statement of use on February 15, 2002. On August 16, 2002, the Examining Attorney refused registration on the grounds that the specimen submitted by Applicant did not show use of the mark for the stated services.

On September 6, 2002, Applicant filed a response, arguing that the specimen of use was acceptable. On October 3, 2002 after considering Applicant's arguments in support of registration, the Examining Attorney issued a final refusal.

On March 3, 2003, Applicant filed a response to the final refusal of registration, submitting another portion of its web page as a substitute specimen. On June 12, 2003, the examining attorney refused this specimen and, as a courtesy, allowed the Applicant an additional thirty days to file an acceptable specimen or appeal to the Trademark Trial and Appeal Board. On March 18, 2003, unknown to the Examining Attorney, the Applicant had filed an appeal. The Office officially entered this "request for reconsideration" as received on July 14, 2003.

On October 22, 2003, the Examining Attorney denied Applicant's request for reconsideration and the present appeal ensued.

ARGUMENTS

I. *General Rules of Analysis for Service Mark Specimens*

A service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. 37 C.F.R. §2.56(b)(2). To show service mark usage, the specimens must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A.

1973) (term that identified only a process held not registrable as service mark, even though applicant was rendering services and the services were advertised in the same brochure in which the name of the process was used); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART perceived as informational matter rather than as service mark for art dealership services, where the term is displayed inconspicuously in specimen brochure amid other informational matter, in the same size and font of type as the rest of the brochure text); *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimens, found to identify the applicant's ratings instead of its rating services); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE did not function as mark for restaurant services, where the specimens showed use of mark only to identify one character in a procession of characters, and the proposed mark was no more prominent than anything else on specimens); *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986) (journal advertisement submitted as specimen showed use of ONE OF THE SIGNAL COMPANIES merely as an informational slogan, where the words appeared only in small, subdued typeface underneath the address and telephone number of applicant's subsidiary); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977) (use of mark as one of many pictures in applicant's brochure would not be perceived as an indication of the source of the services); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) (business progress reports directed to potential investors do not show service mark use for medical services); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not identify franchising services); *In re Reichhold*

Chemicals, Inc., 167 USPQ 376 (TTAB 1970) (technical bulletins and data sheets on which mark was used merely to advertise chemicals do not show use as a service mark for consulting services).

A specimen that shows only the mark, with no reference to the services, does not show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997) (tags affixed to decorated Christmas tree that bear the mark "TREE ARTS CO. and design" and the applicant's location, but make no reference to services, fail to show use for "design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees"); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994) (labels affixed to packaging of valves do not show use of mark for custom manufacture of valves); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (bumper stickers showing only the mark do not show use to identify "association services, namely promoting the interests of individuals who censor the practice of drinking and driving"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (cutouts showing mark with no reference to the services held unacceptable for automotive service center); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (iron-on transfer clothing patches in the form and shape of a cartoon animal mark, distributed as free promotional items to restaurant customers at counters, held insufficient to identify restaurant services).

II. *Applicant's Specimen Does Not Show Use of the Mark for the Stated Services*

Applicant's specimen in the present case consists of printouts of several pages of Applicant's website. These specimens show the mark directly above a photograph of three golf putters. The pages that follow feature a detailed explanation of the features and

specifications of these putters. These specimens do not show use of the mark in connection with Applicant's online wholesale and retail distributorship services.

The item submitted by the Applicant as a substitute specimen on July 14, 2003 shows the mark listed in the search results of a Google search for "split-grip putter handles." Notably, the "TM" designation, and not the "SM" designation, appears to the right of the wording TEE-MAIL in these search results. Like the applicant's original specimens, this specimen does not reference online retail and wholesale distributorships. Rather, like the Applicant's original specimen, this specimen only references goods, namely, golf putters.

In support of registration, Applicant argues that its use of the mark in connection with the online wholesale and retail distributorship services can be inferred from the materials contained in the specimens. However, a careful review of the specimens demonstrates that this is not the case. To show service mark usage, the specimens must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001); *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985); *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975). Nothing in the Applicant's specimens would lead potential consumers to believe that the mark TEE-MAIL identifies Applicant's online retail and wholesale distributorships. The

specimens make no mention of such services; nor do they infer usage of the mark for such services. Although the original specimen contains the wording "For information call or write Tee-Mail: handle@teemail.com," in the context of the entire specimen, potential consumers would most likely perceive this statement to refer to the goods described in the specimen, but not the applicant's online retail and wholesale distributorships.

Similarly, aside from being an unacceptable specimen because it does not show use of the mark *by the Applicant*, potential consumers will not perceive the mark as used in the substitute specimen as referring to online retail or wholesale distributorships. Rather, potential consumers will perceive the mark as referring to golf club grips, i.e., the only item mentioned in the excerpt.

The Board has repeatedly held that a specimen showing only the mark with no reference to the services does not show proper service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989); *In re Riddle*, 225 USPQ 630 (TTAB 1985); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980). The Applicant's specimens in the present case make no reference to online retail and wholesale distributorships. Moreover, use of the mark for such services cannot be inferred based on Applicant's use of the mark on or in connection with golf putters and/or golf putter grips. Thus, the specimen of use is not acceptable because it does not show use of the mark for the stated services.

CONCLUSION

The Applicant's specimen of use does not show use of the mark for the stated services. Therefore, the Board is respectfully requested to affirm the refusal to register that issued under 37 C.F.R. Sections 2.56 and 2.88(b)(2).

Respectfully submitted,



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