

TTAB

**IN THE U.S. PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Serial No.: 76/068267  
Filing Date: June 12, 2000  
Mark: BRAIN WEDGIES  
Applicant: Marco Polo Explorers, Inc.  
Law Office: 111  
Examining Attorney: Darshini Satchi

  
03-21-2002  
U.S. Patent & TMO/TM Mail Rcpt Dt. #01

Box TTAB Fee  
Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial & Appeal Board for the final decision of the U.S. Patent and Trademark Office Examining Attorney refusing registration of the above-referenced mark, which decision was mailed on October 2, 2001. A copy of Applicant's response to the Final Office Action requesting reconsideration of the final refusal, filed simultaneously with this Notice of Appeal, is enclosed.

Pursuant to Trademark Rule 2.6, a check in the amount of \$100 is enclosed. Please charge any additional fees which may be required, or credit any overpayment to our Deposit Account No. 500735.

Respectfully submitted,

Marco Polo Explorers, Inc.

By: 

Name: Daniel B. Runk  
Keating, Muething & Klekamp, P.L.L.  
1400 Provident Tower  
One East Fourth Street  
Cincinnati, Ohio 45202  
513-579-6479  
Attorney for Marco Polo Explorers, Inc.

Dated: 3-21-02

CERTIFICATE OF EXPRESS MAIL

"Express Mail" mailing label number: EL867100991US

Date of Deposit 3-21-02 hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Sonja Pinner  
Sonja Pinner  
962337.1

RESPONSE TO OFFICE ACTION NO. 1

Trademark: BRAIN WEDGIES  
Serial No.: 76/068267  
Applicant: Marco Polo Explorers, Inc.  
Examining Attorney: Darshini Satchi, Law Office 111  
Mailing Date of Office Action: October 2, 2001  
Applicant's Attorney: Daniel B. Runk  
Keating, Muething & Klekamp, P.L.L.  
1400 Provident Tower  
One East Fourth Street  
Cincinnati, Ohio 45202  
(513) 579-6479

This Office Action responds to each deficiency noted by the Examining Attorney in the above-referenced Office Action. Applicant respectfully requests that the Examining Attorney reconsider the final refusal to register. A copy of the Notice of Appeal filed simultaneously with this response is attached.

RESPONSE

Specimen Fails to Refer to Identified Services

The Examining Attorney has refused registration stating that the mark merely identifies a concept not used in conjunction with any type of services as used on the specimen of record. Applicant respectfully disagrees.

It is well settled that a term used to identify both a concept and services rendered in connection with the concept may constitute a service mark within the meaning of the Lanham Act. See In re United Merchants and Manufacturers, Inc., 124 U.S.P.Q. 11 (T.T.A.B. 1959) and In re Stafford Printers, Inc., 152 U.S.P.Q. 248 (T.T.A.B. 1967). As noted in In re C.I.T. Financial Corp., 201 U.S.P.Q. 124 (T.T.A.B. 1978), “[w]hile the Act defines the term service mark, it does not define the broad term services. Similarly, the legislative history of the Act addresses the term ‘service mark’ but sheds little light on what was intended to be meant by services. It would appear self-evident that no attempt was made to define ‘services’ simply because of the plethora of services that the human mind is capable of conceiving. This, *ipso facto*, would suggest that the term be liberally construed.” (quoting American International Reinsurance Company, Inc. v. Airco, Inc., 197 U.S.P.Q. 69 (C.C.P.A. 1978)). The CIT court further noted that “the statute makes no distinction between services on the basis of primary

incidental or ancillary. They need only be services. The fact that a service may be incidental to a principal service or to the sale of goods does not make it any less of a service or make a mark used in the sale or advertising of such service any less a service mark.” (quoting In re John Breuner Company, 136 U.S.P.Q. 94 (T.T.A.B. 1963)) In CIT, the applicant had made its primary services available under the mark CIT and used the mark CITATION SERVICES in furtherance of its primary services; however, the CITATION SERVICES mark did not possess a separate and distinct identity from the primary CIT services. The Board looked to the advertisement of the services under the CITATION SERVICES mark and permitted registration as a service mark because special benefits could accrue to customers from the use of the services. Similarly, Applicant uses the services rendered under its mark BRAIN WEDGIES to provide its primary services under its MARCO POLO EXPLORERS, BIG IDEAS and HIGH CONCEPTS house brands.

In In re International Environmental Corporation, 230 U.S.P.Q. 688 (T.T.A.B. 1986), the examiner refused to register the mark INTERNATIONAL ENVIRONMENTAL CORPORATION for distributorship services based on a specimen consisting of a customer survey bearing the mark. The court held that the specimens were sufficient because although the specimen did not specifically refer to the distribution services, the survey was “wholly consistent with applicant’s claim that the survey is a means by which it offers its distributorship services to the public.” This is similar to Applicant’s booklet (shown as the second substitute specimen) that accompanies the services rendered by Applicant. In In re Universal Oil Products Company, 177 U.S.P.Q. 456 (CCPA 1973), the court stated that “[t]he minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.” See In re Advertising & Marketing Dev., Inc., 821 F.2d 614 (Fed. Cir. 1987) (holding ‘direct association’ requirement does not create an additional or more stringent requirement for registration beyond that set forth in the Lanham Act.) Further, the T.T.A.B. has stated that the direct association test means that the mark must be used in such a way in advertising that “it would readily be perceived as identifying such services.” See e.g. In re Moody’s Investors Service, Inc., 13 U.S.P.Q.2d 2043 (T.T.A.B. 1989).

In accordance with In re Universal Oil and In re Moody’s, the three specimens submitted by Applicant clearly show a direct connection between the mark and the Applicant as the source of the indicated service. The initial specimen shows BRAIN WEDGIES marked with the “TM” notice and refers to it as a “thought that discombobulates your current way of thinking by creating a new connection with your brain’s neurons” within a paragraph describing the creation of a vibe to enhance creative thinking. The preceding and subsequent paragraphs discuss the services of Applicant. This alone describes the services rendered in connection with the mark. The first substitute specimens further describes a BRAIN WEDGIE as “giving brains a creative kick” next to a paragraph that describes the services offered by Applicant as “[a] process based on understanding your business, the trends that drive your category or industry, competitive pressures manufacturing, channels and product development capabilities, management wishes and desires.” The source of the services is clear and the connection between the mark and services is available from the specimen record. In the present case there is a direct association between the offer of business marketing, consulting and planning and research and development services and the BRAIN WEDGIES mark. As noted in the specimens, BRAIN WEDGIES is part of the marketing, consulting, planning and research and development services provided in connection with other marks of Applicant, including MARCO POLO EXPLORERS, BIG

IDEAS and HIGH CONCEPT. The uses of the BRAIN WEDGIES mark in the specimens clearly set forth the mark in such a way that it will be perceived by prospective customers as identifying a proprietary term that designates only Applicant's services.

Although Applicant may refer to these services as a "concept," "idea" or "thought," such designations should not be controlling. The references are to services that Applicant provides its customers. The mark should therefore be registerable. The following patented processes all achieved registration and are recognized as service marks of their owners:

SANFORD-PLUS	Registration No. 2,453,220
META-LAX	Registration No. 1,098,549
OSMONICS	Registration No. 2,281,764
THERMOMASTER	Registration No. 2,287,083

Further, this exact issue has been litigated for nearly identical services with very similar specimens with the T.T.A.B. for the NEW PRODUCT PHYSICS mark. Attached is a copy of the T.T.A.B. opinion for the NEW PRODUCT PHYSICS mark (Reg. No. 1,940,327).

#### Identification of Services

Applicant hereby wishes to amend the identification of services to the following:

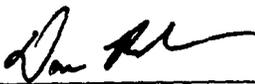
Business marketing consulting and business planning services; business research services, namely researching business trends, industries and product lines; business organizational consultation services, namely assisting companies in developing business models (Int. 35)

Research and development of new products for others (Int. 42).

Applicant remains hopeful that with this additional information, Examining Attorney will reconsider the final refusal and pass the mark to publication. However, in light of the final refusal, a copy of the Notice of Appeal filed simultaneously herewith is attached with this response.

Respectfully submitted,

Dated: 3-21-02

  
\_\_\_\_\_

Daniel B. Runk, Attorney for Applicant

Attachments

962289.1

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Richard Saunders International, Inc.

---

Serial No. 74/294,309

---

Lynda E. Roesch of Dinsmore & Shohl for applicant.

Eleanor K. Meltzer, Trademark Examining Attorney, Law Office  
10 (Ron Sussman, Acting Managing Attorney).

---

Before Simms, Seeherman and Hanak, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Richard Saunders International, Inc. (applicant) seeks to register NEW PRODUCT PHYSICS for "educational services -- namely conducting classes, seminars and lectures in the field of developing the ability to generate breakthrough ideas and to use the mind more effectively." The application was filed on July 13, 1992 with a claimed first use date of August 10, 1991.

Citing Sections 2, 3 and 45 of the Lanham Trademark Act of 1946, the Examining Attorney refused registration on the basis that "the specimens of record do not show the applied-

for mark used in such a manner as to demonstrate the necessary mark/service connection. ... Analyzed both separately and together, applicant's [two] specimens fail to demonstrate the necessary 'direct association' between the mark NEW PRODUCT PHYSICS and the educational service of conducting classes, seminars, and lectures." (Examining Attorney's brief, pgs. 2-3).

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

The Examining Attorney has made it clear that she "has not refused applicant's proposed mark on the basis that applicant is not providing a service," nor has she refused registration "because she believes the proposed mark to be incapable of acting as a source identifier for applicant's services." (Examining Attorney's brief, p. 2). Rather, as previously noted, the Examining Attorney has refused registration solely on the basis that purportedly, applicant's two specimens fail to satisfy the "direct association" test. In other words, applicant's specimens purportedly fail "to show a 'direct association' between the mark and the services named in the application." In re Advertising & Marketing, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987).

In our view, applicant's specimens do show a direct association between the mark NEW PRODUCT PHYSICS and

applicant's services of conducting classes, seminars and lectures. Accordingly, the refusal to register is reversed.

The first specimen submitted by applicant is titled "Jump Start Your Brain." The text of this first specimen states that applicant "will teach you the proprietary ... exercises that leading corporations pay hundreds of thousands of dollars to utilize such as ... New Product Physics." The words NEW PRODUCT PHYSICS appear in the text followed by the designation "TM."

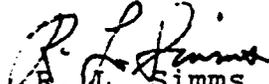
The second specimen features the words NEW PRODUCT PHYSICS in prominent fashion at the top. Once again, the designation "TM" appears after the words NEW PRODUCT PHYSICS. Furthermore, beneath the words NEW PRODUCT PHYSICS there appear in smaller lettering the words "New product inventing ...."

During the examination process, applicant submitted the declaration of its president (Doug Hall) who stated that applicant's specimens "are used both in the sale and promotion of the services and in the actual rendering of the services." (Hall declaration paragraph 2).

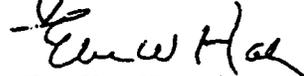
Considering the materials of record in their totality, and particularly applicant's second specimen, we find that applicant utilizes the words NEW PRODUCT PHYSICS in such a manner so as to create a "direct association" between the words and applicant's educational services of conducting classes, seminars and lectures. Stated somewhat differently, we believe that prospective consumers of

applicant's educational services, upon seeing the specimens, would view NEW PRODUCT PHYSICS as a proprietary term designating only classes, seminars and lectures emanating from applicant.

Decision: The refusal to register is reversed.

  
R. L. Simms

  
E. J. Seeherman

  
E. W. Hanak

Administrative Trademark Judges  
Trademark Trial and Appeal Board

15 JUN 1995

Certificate of Express Mail

"Express Mail" mailing label number: EL867100988 US

Date of Deposit: 3-21-02

I hereby certify that these papers are being deposited with the United States Postal Service "Express Mail Post Office Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, Box Response - NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Sonya R. Pinner  
Sonya R. Pinner



**KEATING, MUETHING & KLEKAMP, P.L.L.**

ATTORNEYS AT LAW

1400 PROVIDENT TOWER • ONE EAST FOURTH STREET • CINCINNATI, OHIO 45202  
TEL. (513) 579-6400 • FAX (513) 579-6457 • www.kmklaw.com

**DANIEL B. RUNK**  
DIRECT DIAL: (513) 579-6479  
FACSIMILE: (513) 579-6457  
E-MAIL: DRUNK@KMKLAW.COM

March 21, 2002



**Via Express Mail**

03-21-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

Assistant Commissioner of Trademarks  
Box TTAB Fee  
2900 Crystal Drive  
Arlington, VA 22202-3513

Re: BRAIN WEDGIES -- Serial No. 76/068267

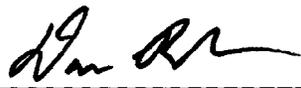
Dear Honorable Madam:

Enclosed please find, submitted in triplicate, a "Notice of Appeal" by Marco Polo Explorers, Inc. for the BRAIN WEDGIES mark, Serial No. 76/068267 along with a check in the amount of \$100 for the filing fees. Also enclosed is a copy of the Applicant's response and request for reconsideration filed simultaneously with this appeal.

Kindly acknowledge receipt of the enclosures by stamping and returning the enclosed postcard. Please charge any additional fees which may be required, or credit any overpayment to our Deposit Account No. 500735.

Sincerely,

KEATING, MUETHING & KLEKAMP, P.L.L.

By:   
Daniel B. Runk

Enclosures

cc: Mr. Marc Marsan