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Mailed: May 29, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re LaBellarte

Serial No. 76526520

Thomas G. Gardiner and Ryan McPhail of Gardiner Koch & Weisberg for Michael LaBellarte.

Kevin S. Corwin, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).<sup>1</sup>

Before Quinn, Hairston and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On June 27, 2003, Michael LaBellarte ("applicant") filed an application for registration of the mark THE SOFT ROOM (in standard character form) on the Principal Register under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), for "artistic/creative editing and design services, editorial consultation, post production solutions to advertising agencies, software to design rooms." In the

<sup>1</sup> The application has been re-assigned to the present examining attorney.

course of prosecuting his application, applicant amended his mark to SOFT ROOM (deleting the word THE) and amended his identification of services to the following, which is the operative identification of services in this application:

"Preparing audio-visual presentations of creative images, sound and text, and any combination thereof, in electronic, photographic, print-based, film-based and artistic mediums for use in advertising, solicitation and persuasive communication" in International Class 35;

"Editing services, namely, written text editing, video editing, film editing, and audio editing, of creative images, sound and text, and any combination thereof, in electronic, photographic, print-based, film-based and artistic mediums for use in advertising and persuasive communication; Post-production services, namely, videotape production, multimedia entertainment software production services, and television production services of creative images, sound and text, and any combination thereof, in electronic, photographic, print-based, film-based and artistic mediums for use in advertising, solicitation and persuasive communication" in International Class 41; and

"Graphic art design services of creative images, sound and text, and any combination thereof, in electronic, photographic, print-based, film-based and artistic mediums for use in advertising and persuasive communication; Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others in the areas of advertising, solicitation and persuasive communication" in International Class 42.

On February 19, 2004, applicant filed an amendment to allege use, alleging that the mark was first used anywhere

and first used in commerce at least as early as October 18, 2000 for the services in each International Class. The examining attorney rejected the specimen for each International Class. The examining attorney also rejected each of the additional specimens filed on July 6, 2004, December 26, 2006, October 1, 2007 and May 24, 2008. In his final action dated November 26, 2007, the examining attorney refused registration of the application under Sections 1, 2, 3 and 45, 15 U.S.C. §§ 1051-1053 and 1127, because applicant's mark, as used on the submitted specimens of use, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services.

After applicant appealed the examining attorney's refusal of registration, both applicant and the examining attorney filed briefs. We affirm the refusal.

Section 1 of the Trademark Act and Trademark Rule 2.76(b)(2) provide that an amendment to allege use must be accompanied by a specimen of the mark as actually used in commerce. Trademark Rule 2.76(b)(2) refers to Trademark Rule 2.56 for the requirements for specimens, which in turn requires a specimen showing the mark as actually used in the sale or advertising of the identified services. See Trademark Rule 2.56(b)(2).

The question of whether a designation functions as a mark for the identified services is determined based on the specimens and other information of record. In order to show service mark use, the specimen must show use of the mark in a manner that would be perceived by the relevant public as identifying applicant's services and indicating their source. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973).

The original specimen submitted with the amendment to allege use for each International Class, consists of two pages from an advertising brochure, which states in relevant part:

Because of the unique module design of Outsider editing and design environments, Outsider is able to offer clients an opportunity to have Outsider inside their own work place. Outsider environments are based on our proprietary soft room principle that allows effortless rotation of award winning creative editors and designers directly into the privacy of your own office.

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Outsider has developed its editing and design environments around its proprietary soft room principle. This principle dispenses with equipment in the actual creative room thus allowing creatives and Outsiders to concentrate on the project at hand and not be distracted by the clanking and humming of machinery. This also maximizes the available work space for all involved to stretch out and be comfortable. Each room is decorated with seating and artifacts that

stimulate the creative mood and are pleasing to the eye, body and mind.

Applicant does not use SOFT ROOM as a source identifier in the original specimen for any of the services recited in applicant's identification of services. "Soft room" is identified as a proprietary principle, described as "dispensing with equipment in the actual creative room thus allowing creatives and Outsiders to concentrate on the project at hand and not be distracted by the clanking and humming of machinery." As used in this specimen, embedded in text and identifying a principle used in "editing and design environments,"<sup>2</sup> "soft room" does not distinguish applicant's recited services from others or indicate the source of applicant's services. Compare, *In re Universal Oil Products, supra* (term that identifies only a process does not function as a service mark, even where services are advertised in the same specimen brochure in which the name of the process is used); *In re J.F. Pritchard & Co. and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979) (proposed mark used only to identify a liquefaction process in brochure advertising the services does not function as a mark, because there is no direct association between the

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<sup>2</sup> The specimen shows certain wording such as "soft room" in the color red rather than the color black, in which the remaining text appears. Purchasers would not attribute any trademark

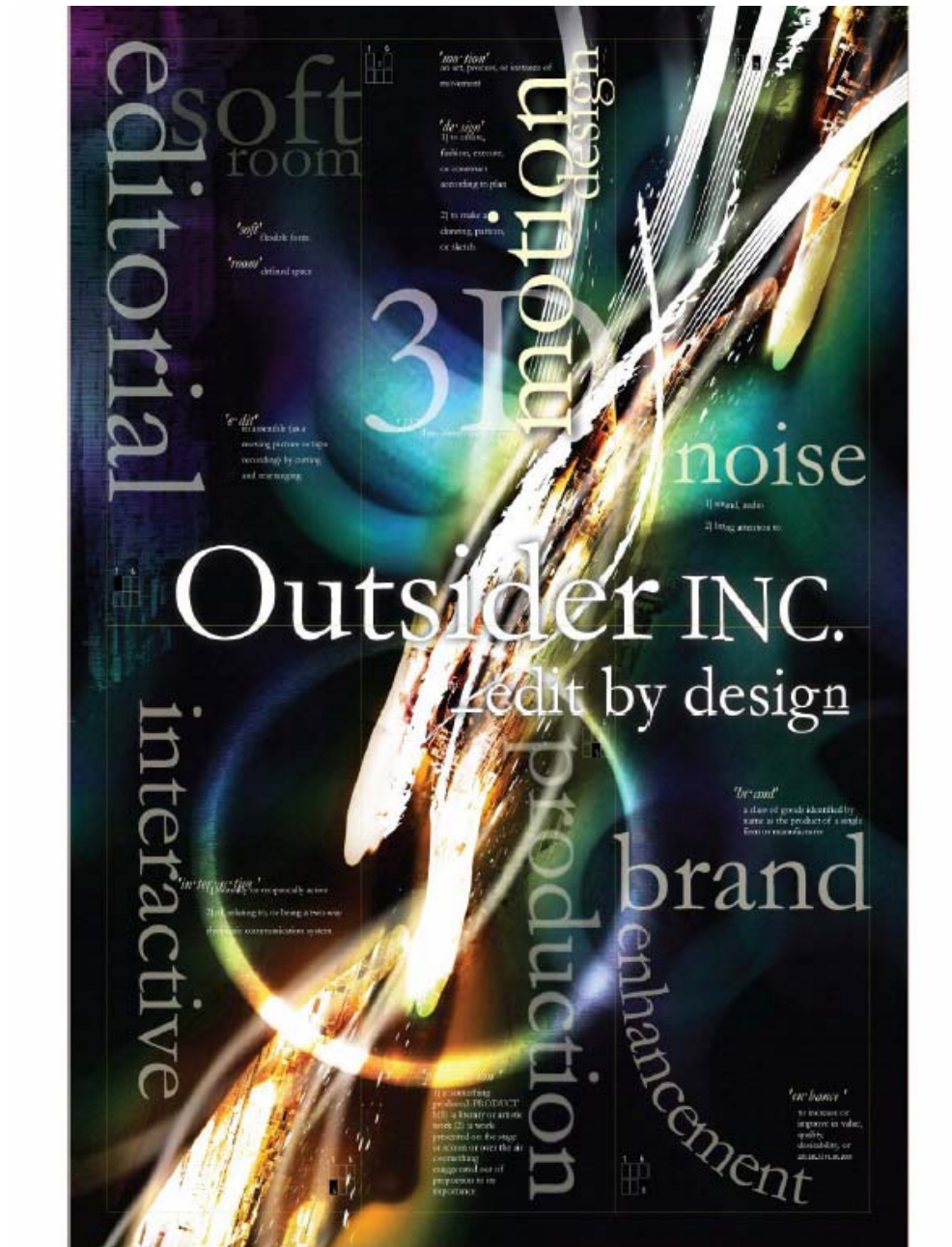
mark and the offering of services). Thus, we agree with the examining attorney that the original specimen does not exhibit use of SOFT ROOM as a mark for applicant's services.

The substitute specimen filed on July 6, 2004 contains, in relevant part, essentially the same text quoted above, and the specimen filed on December 26, 2006 appears to be identical to one of the pages applicant filed with its original amendment to allege use. The examining attorney properly rejected these two substitute specimens for the same reasons mentioned in the preceding paragraph.

On October 1, 2007, applicant filed two additional specimens which it characterized as "advertisements." "Soft room" appears alone on the top left portion of the first advertisement, depicted below:

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significance to "soft room" due to this difference in color because other wording is also in red.



A definition of "soft" and a definition of "room" are located under "soft room." Because "soft room" is in the same font and size as other wording arranged randomly on the specimen, namely, "noise", "brand", "production" and "enhancement," and definitions of these words are also

provided on the specimen, "soft room" on the specimen would not even be perceived as a service mark.

The second advertisement submitted on October 1, 2007 is reproduced below:



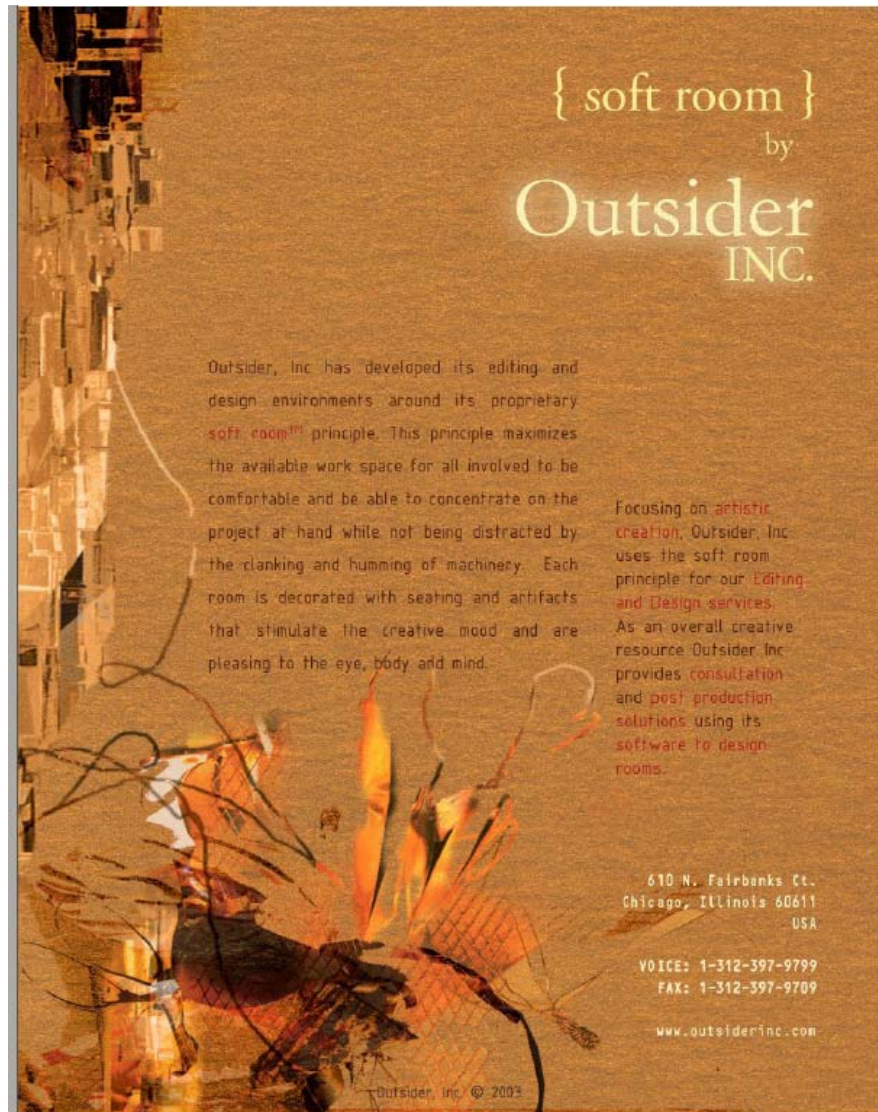
By referring to a media room with certain capabilities, and by labeling the "Soft Room system" proprietary, from this specimen, purchasers would not perceive "Soft Room" as the source identifier of any of applicant's services.

We now turn to the remaining specimen, namely, the specimen submitted on May 24, 2008, which comprises what applicant has labeled as "a corporate advertisement brochure Outsider has used in the marketing of its design and editing services." The entire specimen, submitted for each International Class, is reproduced below:<sup>3</sup>

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<sup>3</sup> In case the text is not clear from the reproduction of the specimen, we set forth the text below:





Outsider, Inc. has developed its editing and design environments around its proprietary soft room principle. This principle maximizes the available work space for all involved to be comfortable and be able to concentrate on the project at hand while not being distracted by the clanking and humming of machinery. Each room is decorated with seating and artifacts that stimulate the creative mood and are pleasing to the eye, body and mind.

Focusing on artistic creation, Outsider, Inc. uses the soft room principle for our Editing and Design services. As an overall creative resource Outsider, Inc. provides consultation and post production solution using its software for design rooms.

"Soft room" again is identified as a proprietary principle. In the paragraph on the right, the specimen states that "Outsider, Inc. uses the soft room principle for our Editing and Design services." The specimen states that "soft room" is a principle; and that principle is used in rendering editing and design services. There is no direct association of "soft room" with the services listed in the application. Further, "soft room" at the top of the specimen similarly would not be perceived as a service mark for the editing and design services mentioned in the specimen; the identification of "soft room" as a principle in the text of the specimen precludes a direct association with the stated services and there is nothing else in the specimen to make the necessary direct association.<sup>4</sup>

In view of the above, we find that the specimens submitted by applicant do not satisfy the requirements of the Trademark Act or the Trademark Rules in that they fail to show the matter sought to be registered functioning as a service mark.

**Decision:** The examining attorney's requirement for specimens which demonstrate the mark sought to be

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<sup>4</sup> In his brief, the examining attorney maintains that applicant did not provide the proper declaration in support of this specimen. We need not address the sufficiency of the declaration because we affirm the examining attorney's rejection of this specimen.

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registered used in connection with the services set forth  
in the application is affirmed for each International  
Class.