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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Diapulse Corporation of America

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Serial No. 76592393

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Myron Amer of Myron Amer, P.C. for Diapulse Corporation of America.

Elizabeth M. Winter, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

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Before Grendel, Walsh and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Diapulse Corporation of America has appealed from the Trademark Examining Attorney's refusal to register its mark WIRELESS MEDICAL TECHNOLOGY for "electromagnetic energy treatment of a patient" in Class 44.[1] The Examining Attorney refused registration on the ground that the mark does not function as a service mark. Specifically, the Examining Attorney argued that the specimen of use does not

[1] Application Serial No. 76592393, filed May 14, 2004. On June 10, 2005, applicant filed an amendment alleging use claiming June 3, 2005 as its dates of first use anywhere and first use in interstate commerce.

show the mark used in connection with the sale or advertising of electromagnetic energy treatment of a patient. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs.

We affirm.

The specimen submitted with the amendment alleging use is a four page brochure for applicant's DIAPULSE Wound Treatment System.[2] The mark sought to be registered is displayed on the last page of the brochure in the following manner:

> **Diapulse**® *Wireless Medical Technology*™
>
> The proprietary **Diapulse**® System produces non-thermal pulsed high frequency, high peak power electromagnetic energy.
>
> There are no wires to attach on a patient and operating parameters are the same as all previous models of **Diapulse**®.
>
> **Diapulse**® can be used safely over any area of the body with no danger of hyperpyrexia or tissue damage.
>
> The body is as much electrical as it is chemical. Through decades of research published in medical journals around the world, **Diapulse**® is proven to be a safe, effective adjunct for patient recovery and comfort.
>
> **Diapulse**® is indicated for the palliative treatment of postoperative edema and pain in superficial soft tissues.

[2] On March 9, 2006, applicant filed a substitute specimen consisting of the last page of the previously filed brochure.

Applicant filed a copy of U.S. Patent 6,652,444 B1 entitled "Supplemental Diabetic Treatment Method" with its appeal brief. The Examining Attorney lodged an objection to the patent on the ground that the evidence was not timely filed. The objection is well taken. 37 C.F.R. §2.142(d); TMEP §710.01(c); TMBP §1207.01. Accordingly, the copy of the patent will be given no consideration. Nevertheless, even if we considered the patent, it would not change our decision on the merits because the patent is irrelevant to the issue *sub judice*.

Applicant argues, in essence, that the reference in the specimen to applicant's product does not prohibit the mark sought to be registered from also acting as a service mark.

The sole issue on appeal is the acceptability of the brochure specimen as evidence of service mark use. The Examining Attorney has not challenged applicant's statement that it renders electromagnetic energy treatment services, that electromagnetic energy treatment services are registrable services, or that a mark may function as both a trademark and a service mark.

The problem that the Examining Attorney has with the brochure specimen is that it makes absolutely no reference to the applicant's services. It is the Examining

Attorney's position that a service mark specimen must make some reference to the services or be used in the rendering of the services, otherwise there will be no association between the mark sought to be registered and the services specified in the application.

A service mark specimen must show use of the mark in a manner that will be perceived by potential purchasers as identifying applicant's services and indicating their source. *In re Universal Oil Products, Co.*, 476 F.2d 653, 177 U.S.P.Q. 456 (C.C.P.A. 1973); *In re A La Vielle Russie, Inc.*, 60 U.S.P.Q.2d 1895 (T.T.A.B. 2001); *In re Moody's Investors Service Inc.*, 13 U.S.P.Q.2d 2043 (T.T.A.B. 1989); TMEP §1301.04(a).

"Where the mark is used in advertising the services, the specimen must show an association between the mark and the services for which registration is sought. A specimen that shows only the mark, with no reference to the services, does not show service mark usage." TMEP §1301.04(b), *citing, In re Adair*, 45 U.S.P.Q.2d 1211 (T.T.A.B. 1997); *In re Johnson Controls, Inc.* 33 U.S.P.Q.2d 1318 (T.T.A.B. 1994); *In re Duratech Industries Inc.*, 13 U.S.P.Q.2d 2052 (T.T.A.B. 1989); and others.

"A specimen that shows the mark as used in the course of performing the services is generally acceptable. Where the record shows that the mark is used in performing (as opposed to advertising) the services, a reference to the services on the specimen itself may not be necessary." TMEP §1301.04(b); *In re Metriplex Inc.*, 23 U.S.P.Q.2d 1315 (T.T.A.B. 1992); *In re Eagle Fence Rentals, Inc.*, 231 U.S.P.Q. 228 (T.T.A.B. 1986); *In Red Robin Enterprises, Inc.*, 222 U.S.P.Q. 911 (T.T.A.B. 1984). However, in determining whether a specimen is acceptable, the Examining Attorney must consider applicant's explanation of how the specimen is used along with any other available evidence that shows how the mark is used. TMEP §1301.04(b); *In re International Environmental Corp.*, 230 U.S.P.Q. 688 (1986).

In the case *sub judice*, the specimen makes absolutely no reference, not even an indirect reference, to the service of providing electromagnetic energy treatment to a patient. Moreover, there is no evidence that the mark sought to be registered is used in connection with advertising electromagnetic energy treatment services or that it is used in connection with the rendering of those

services.[3] The crux of our analysis is that a purchaser or prospective purchaser of applicant's services (either electromagnetic energy treatment services or the rental of applicant's product) would view the mark in the brochure as referring to applicant's product, the **Diapulse®** electromagnetic medical treatment system. We have no basis upon which to conclude that purchasers would regard the mark as anything other than a trademark.

Because the specimen does not show the mark used to identify and to distinguish applicant's electromagnetic energy treatment of a patient, the refusal to register under Sections 1, 2, 3, and 45 of the Lanham Act is affirmed.

Decision: The refusal to register is affirmed.

[3] In its appeal brief, applicant explains that it leases its device to patients who use the product for an electromagnetic energy treatment and then return it.