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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Contractor Express

Serial No. 76682478

Myron Amer, Esq. for Contractor Express.

Mariam Aziz Mahmoudi, Trademark Examining Attorney, Law
Office 112 (Angela Wilson, Managing Attorney).

Before Hairston, Zervas and Kuhlke, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Contractor Express to register the mark DESIGN EXPRESSIONS (in standard character form with a disclaimer of the word "DESIGN") for services identified as "referral to building contractors needing building materials or sources of supply of building materials" in International Class 35.¹

¹ Serial No. 76682478, filed October 1, 2007, alleging dates of first use of June 18, 2007.

The trademark examining attorney has refused registration on the ground that the specimen does not show use of the mark in connection with the identified services.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs; applicant filed a reply brief. We affirm the refusal.

A copy of applicant's specimen is reproduced below:

The advertisement is for 'THE EXPRESS LINE' magazine, Volume 1, No 1, Summer 2007. The main headline is 'Design Expressions — a big boost for your business.' Below this, a sub-headline asks 'What's bigger than an elephant, has more choices and options than a candy store and pampers you more than your favorite aunt?' The text describes a new 'Design Expressions Showroom and Design Center' that is currently under construction and will be 'bigger, better and staffed by our Special Order Department to get you what you want, and how you want it.' It promises 'almost triple the space' and 'more products, more displays and best of all more selection.' The ad includes several images: a small inset photo of a person in a showroom, a large photo of a kitchen cabinet, and two larger photos of kitchen interiors. The logo 'designEXPRESSIONS SHOWROOM AND DESIGN CENTER' is prominently displayed. At the bottom, it says 'Watch for our grand opening event in the Fall'.

Applicant indicates that the mark is used on "advertising and promotional materials." Applicant's specimen appears to be in the nature of an advertisement.²

The examining attorney has not challenged applicant's statement that it renders the services of "referral to building contractors needing building materials or sources of supply of building materials" or that such services are registrable. Rather, it is the examining attorney's position that prospective purchasers will not perceive the mark DESIGN EXPRESSIONS as identifying the source of the identified referral services when the mark is used in an advertisement which refers to a showroom and design center. According to the examining attorney, the specimen makes no mention of referral services; while the specimen informs prospective purchasers about certain features of applicant's showroom and design center, it is silent on the source of referral services.

Applicant, on the other hand, argues that the specimen shows a direct association between its mark and the

² We note that subsequent to filing its main brief, applicant filed a copy of another advertisement showing use of DESIGN EXPRESSIONS. Applicant requests that the advertisement be "enter[ed] of record." Trademark Rule 2.142(b) provides that the record in an application should be complete prior to filing of the appeal. This advertisement was not submitted during the prosecution of the application and it will not be considered.

identified services. Applicant has submitted the declaration of its Vice-President, John Lucas, who states, in pertinent part, that:

2. Our customers are contractors who come to our facility at which, as noted on the specimen of record, they consult with our staff in "our Special Order Department to get [what they] want and how [they] want it;"
3. Accordingly, it is my experience that in our facility our contractor customers receive our DESIGN EXPRESSIONS-identified referral services..."

Trademark Rule 2.56(b)(2) specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." To show service mark usage, the specimen must show use of the mark in a manner that would be perceived by potential purchasers 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); *In re La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001). Furthermore, "[w]here 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." TMEP §1301.04(b), citing, *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); and others.

We find that DESIGN EXPRESSIONS, as it appears on the specimen, would not be perceived by purchasers as a service mark for the services of "referral to building contractors needing building materials or sources of supply of building materials." Rather, purchasers are likely to view DESIGN EXPRESSIONS as referring to applicant's showroom and design center. Indeed, the specimen includes the following statements: "It's our brand new Design Expressions Showroom and Design Center" and "With almost triple the space of our present showroom, Design Expressions will feature more products, more displays and best of all more selection." Additionally, at the bottom of the specimen there is a reference to "DESIGN EXPRESIONS Showroom and Design Center." When used in these ways, DESIGN EXPRESSIONS clearly refers to applicant's showroom and design center.

Furthermore, we are not persuaded that the statement on the specimen that applicant's showroom and design center is staffed by a "Special Order Department to get you what you want, and how you want it" would create in the mind of purchasers a direct association between applicant's mark DESIGN EXPRESSIONS and the identified referral services. A special order department is not the same thing as the services of "referral to building contractors needing

Ser No. 76682478

building materials or sources of supply of building materials." Purchasers viewing applicant's specimen would not perceive DESIGN EXPRESSIONS as a service mark for such referral services.

In view of the foregoing, we find that the specimen fails to demonstrate use of DESIGN EXPRESSIONS for the referral services identified in the application.

Decision: The refusal to register is affirmed.