

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: April 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marion L. Lonegro

Serial No. 76695362

Myron Amer of Myron Amer, P.C. for Marion L. Lonegro.

Julie Watson, Trademark Examining Attorney, Law Office 109
(Dan Vavonese, Managing Attorney).¹

Before Grendel, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Marion L. Lonegro to register in standard characters the mark SENSITIVITY AWARENESS on the Principal Register for "fund raising and educational seminars."²

The trademark examining attorney initially refused registration under Section 2(e)(1) of the Trademark Act on

¹ The involved application was reassigned to the above-noted examining attorney during prosecution thereof.

² Application Serial No. 76695362 was filed January 21, 2009, based on applicant's allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act.

the ground of mere descriptiveness. In addition, the examining attorney noted that the recited services fall into more than one International Class and required applicant to clarify or limit the recitation of services, in accordance with Trademark Rule 2.71(a), by specifying the type of "fund raising" in International Class 36 and the subject matter of the "educational seminars" in International Class 41.

In response thereto, applicant requested that the recitation of services be amended to "publications for charitable fund raising" in International Class 16. In addition, applicant filed an amendment to allege use and requested amendment of the involved application to seek registration on the Supplemental Register. With the amendment to allege use, applicant submitted the following specimen of use, identified as "an image applied by a rubber stamp to the packaging of publications used for fund raising:"

SENSITIVITY AWARENESS

The examining attorney ultimately withdrew the refusal based upon mere descriptiveness, accepting both the amendment to allege use and amendment to seek registration on the Supplemental Register. However, the examining

attorney continued the requirement that applicant submit an acceptable amendment to the recitation of services and issued a requirement that applicant submit an acceptable specimen of use. When the examining attorney made final these requirements, applicant appealed. Applicant and the examining attorney filed main briefs and applicant filed a reply brief.

For the reasons discussed below, we affirm.

Amendment to Recitation of Services

We turn first to our determination with regard to applicant's proposed amendment to her recitation of services. Section 7(c) of the Trademark Act provides, in part, as follows:

Contingent on the registration of a mark on the principal register provided by this Act, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration...

15 U.S.C. §1057. Thus, the identification of goods or services in an application defines the scope of those rights established by the filing of an application for registration on the Principal Register. See TMEP §1402.06 (6th ed. 2009). An applicant may not expand those rights through amendment of the identification of goods or services. See TMEP §1402.06(b) (6th ed. 2009).

In accordance therewith, amendments to the identification of goods or services are governed by Trademark Rule 2.71(a), which provides as follows: "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services." 37 C.F.R. §2.71(a). Accordingly, an applicant may not amend an identification of goods or services to add or substitute a term that is not logically included within the scope of the terms originally identified or that is otherwise qualitatively different from the goods and services as originally identified. See TMEP §1402.06(a) (6th ed. 2009). In addition, TMEP §1402.07(d) (6th ed. 2009) provides, in part, as follows:

If the applicant proposes an amendment to the identification of goods and services, and the examining attorney determines that the amendment is unacceptable, the examining attorney should refer to the identification of goods before the proposed amendment to determine whether any later amendment is within the scope of the identification. In such a case, the applicant is not bound by the scope of the language in the proposed amendment but, rather, by the language of the identification before the proposed amendment.

Thus, the scope of the goods or services as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments. See TMEP §1402.07 (6th ed. 2009).

In this case, applicant's services were originally identified in her application as "fundraising and educational seminars." As noted by the examining attorney, the wording "fundraising" and "educational seminars" is indefinite and, in addition, recites services falling into more than one International Class. See TMEP §1402.03 (6th ed. 2009). Nonetheless, the recitation clearly encompasses the services of fundraising in Class 36 and educational seminars in Class 41. In accordance with the above authorities, applicant is limited in any proposed amendment to her recitation of services solely to narrowing or clarifying the originally recited fundraising and educational services. Applicant's proffered amendment of her recitation of services to goods, namely, "publications for charitable fundraising" in International Class 16 falls outside the scope of the original.

Applicant explains her proposed amendment by asserting in her August 31, 2009 response to the examining attorney's Office action that certain charities prohibit telephone or door-to-door solicitations and that "forsaking telephone and door-to-door solicitations leaves only solicitation for charitable fund-raising effort the use of 'Publications' and that applicant's recitation thereof is not outside the scope of the activity involved" (August 31, 2009

communication, p. 2). However, applicant cites to no authority to support her apparent contention that limitations on the manner in which organizations conduct fundraising allows applicant to amend her recitation of, inter alia, fundraising services to recite goods falling outside the scope of the original. To the contrary, it is settled that once the extent of an identification has been established, it cannot be expanded later. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); and *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). In this case, the wording "fundraising" and "educational seminars" establishes the parameters of applicant's recitation of services. Applicant therefore is limited in any amendment solely to narrowing or clarifying the nature and type of the applied-for "fundraising" and "educational seminars" with greater particularity. See TMEP §1402.03(a), *supra*. Inasmuch as the proposed amendment to the recitation of services to identify related goods neither narrows nor clarifies the original recitation of services, it was properly rejected.³

³ Applicant's remedy, in the event she seeks to register her mark for "publications for charitable fundraising," is to file a new application for her mark identifying such goods.

Specimen Submitted with Amendment to Allege Use

Next, we turn to our determination regarding applicant's proposed specimen of use. While applicant does not address this refusal to register in her briefing of the case, we will not consider the matter to be conceded but rather will consider the refusal on its merits.

Trademark Rule 2.34 provides, in part, that an application based on use in commerce must include one specimen showing how the applicant actually uses the mark in commerce. See 37 C.F.R. §2.34(a)(1)(iv). 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." See 37 C.F.R. §2.56(b)(2). Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." See 15 U.S.C. §1127.

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. See *In re*

Monograms America Inc., 51 USPQ 1317 (TTAB 1999). The mark must be used in such a manner that it would be readily perceived as identifying the source of such services. *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614 2 USPQ2d 2010 (Fed. Cir. 1987); and *In re Metrotech*, 33 USPQ2d 1049 (Com'r Pats. 1993). See also TMEP §1301.04 (6th ed. 2009). Thus, the issue before us is whether the specimen of record creates a direct association between applicant's SENSITIVITY AWARENESS mark and the services, namely, fundraising and educational seminars as specified in the application.

In this case, we first find that the specimen submitted by applicant with her application displays her SENSITIVITY AWARENESS mark. Inasmuch as applicant applied for her mark in standard character form, the mark as it appears in stylized form in her specimen of use is considered to agree with the mark as it appears in the drawing. See Trademark Rule 2.52(a); 37 C.F.R. §2.52(a). See also TBMP §807.03(e) (6th ed. 2009).

However, we further find that applicant's specimen fails to show the requisite direct association between the mark and the activities described thereunder. *Cf. In re Adair*, 45 USPQ2d 1211 (TTAB 1997); and *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994). Specifically,

the specimen is a "stamping applied by a rubber stamp on the packaging of the goods" (August 31, 2009 communication).⁴ Nonetheless, applicant applied to register her mark in connection with services and, as discussed above, her proposed amendment of the recitation of services to goods, namely, "publications for charitable fundraising," is unacceptable. Because applicant's specimen fails to make any reference to the recited services or otherwise provide any information which creates a direct association between applicant's SENSITIVITY AWARENESS mark and her services, it is not acceptable as evidence of applicant's use of her mark in connection with such services. We note, in that regard, that there is no evidence of record that charitable fundraising or educational services are so inherently unusual that the typical methods of displaying a service mark therefor, e.g., signage or advertisements, would be unavailable. Cf. *In re Metriplex, Inc.*, 23 USPQ2d 1315 (TTAB 1992); and *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984).

As a result, we find that applicant's specimen fails to create a direct association between her SENSITIVITY

⁴ With this communication, applicant also submitted a brochure from the "Make-A-Wish Foundation" including information regarding the latter's fundraising policies. We note, however, that applicant did not submit such as a substitute specimen and, in any event, applicant's mark does not appear on this brochure.

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AWARENESS mark and applicant's recited fundraising and educational services. We therefore conclude that the specimen of record is not adequate to support the use of the mark in connection with the identified services.

Decision: The refusal to register on the ground that applicant's proposed amendment of the recitation of services falls outside the scope of the original recitation is affirmed. The refusal to register on the ground that the specimen is unacceptable evidence of service mark use in connection with the identified services is affirmed.