

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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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 R & B Receivables Management, Inc.

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Serial No. 77855168

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James P. Hanrath, of Much Shelist Denenberg Ament &  
Rubenstein for R & B Receivables Management Inc.

Khanh M. Le, Trademark Examining Attorney, Law Office 113  
(Odette Bonnet, Managing Attorney).

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Before Walters, Kuhlke and Shaw, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

R & B Receivables Management, Inc., applicant, has  
filed an application to register R&B SOLUTIONS in standard  
characters on the Principal Register for services  
ultimately identified as:

financial advisory, consultancy, and risk  
management services in the fields of healthcare,  
medical bills, student loans, default aversion,  
loss mitigation, and debt recovery and  
litigation; health care financial advisory,  
consultancy, and risk management services,  
namely, providing financial information;  
insurance claim financial evaluation, assistance,

eligibility, and processing services for Medicaid and governmental and private health care programs; financial services for health care providers, namely, risk management, collection, and reimbursement services; financial counseling and providing financial assistance for uninsured and underinsured patients; medical bill payment services; insurance claims administration services, namely, medical insurance identification and third party medical payer identification services; servicing of student loans, namely, student loan default aversion and loss mitigation services; student loan advisory, consultancy, and risk management services; financial services, namely, arranging of modified loan terms in the nature of deferment, forbearance, and alternative repayment structures for lenders, servicers, and borrowers" in International Class 36.

The application was filed on October 22, 2009, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), based on an allegation of first use and use in commerce on May 13, 2003.

The examining attorney has refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1127, (see also 37 C.F.R. 2.56(b)(2)), on the ground that the specimen of use does not "evidence an association between the mark and the services specified in the application." Br. p. 2.

The appeal has been fully briefed. We affirm the refusal to register.

As a preliminary matter, we address applicant's "alternative request" made for the first time in its brief

that "if the Board finds Applicant's specimen insufficient, Applicant requests [the] opportunity to amend the application from an actual use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b)." <sup>1</sup> Br. p. 6. Once an application has been considered and decided on appeal it will not be reopened except for the entry of a disclaimer or upon order of the Director. Trademark Rule 2.142(g). See also *In re Societe D/Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784, 1789 (TTAB 2003) (Board has no authority to grant applicant's request made for the first time in its appeal brief to amend application to seek registration on an intent-to-use basis); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§1217, 1218 (3<sup>rd</sup> ed. 2011); Trademark Manual of Examining Procedure (TMEP) §1501.06 (7<sup>th</sup> ed. 2010) and cases cited therein. In view thereof, the request is denied.

As a specimen of use, applicant submitted a picture of the mark displayed on a sign in front of a building and on a building:

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<sup>1</sup> During prosecution of the application, although the examining attorney highlighted the option of amending the basis of the application to seek registration under Section 1(b) of the Act, applicant never requested in the alternative to amend to the Section 1(b) basis. TBMP § 1215.



Under the Trademark Act, an application must include, "such number of specimens or facsimiles of the mark as used as may be required by the Director." 15 U.S.C. §1051(a)(1). See also 37 C.F.R. §2.56(b)(2). Specimens serve to evidence an applicant's "use in commerce." "Use in commerce" is defined, in pertinent part, as follows:

... For purposes of this chapter, a mark shall be deemed to be in use in commerce- (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...

Trademark Act Section 45, 15 U.S.C. §1127.

A service mark is defined as any word, name, symbol, or device used:

... to identify and distinguish the services of one person, including a unique service, for the services of others and to the source of the services...

Id.

The rule implementing the statute provides:

A service mark specimen must show the mark as actually used in the sale or advertising of the services.

Trademark Rule 2.56(b)(2), 37 C.F.R. 2.56(b)(2).

When the specimen of use shows the mark in the rendering of the services, it need not disclose the nature of the services. For example, in *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992) the computer printouts displaying the mark without disclosing the services was acceptable because it shows use of the mark as it appears on the computer terminal while in the course of rendering the services to the actual consumer.

However, when a service mark is used in advertising the services the specimen must show an association between the mark and the services for which registration is sought in order to comply with the statutory requirement that the mark "identify and distinguish the services." A specimen that shows only the mark, with no reference to the services, does not show service mark usage. *In re wTe Corp.*, 87 USPQ2d 1536 (TTAB 2008); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989). There must be a "direct association" which "is implicit in the statutory definition of 'a mark used ... to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services.'" *In re*

Advertising & Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987), quoting, Trademark Act Section 45, 15 U.S.C. §1127.

The examining attorney explains that the "photograph is not acceptable as a specimen of use for the financial advisory services because it does not contain any reference at all to the financial services specified in the application. Applicant responds that the specimens show the mark on "frontal street signage and office building signage bearing the mark where the services are rendered." Br. p. 3. Further, applicant highlights that the description of the specimen on the application states, "consisting of a(n) photograph of the mark appearing on office signage where services are rendered." Id. Applicant contends that the signage where the services are rendered presents "a sufficient nexus to the rendering or performing of the mark [sic] services or the sale of such services." It is applicant's position that the statement in the application that the sign appears at and on the building where the services are rendered is enough.

As noted above, specimens showing a mark used in rendering the services need not disclose the nature of the services, however, specimens consisting of advertising of the services must disclose the nature of the services to

create an association between the mark and the services. Here, the signage is not used in the rendering of the service. The sign is not providing financial advisory services as the computer was providing data transmission services at the time that mark was displayed. Rather, the sign, beyond merely directing an existing client to applicant's location, is more similar to advertising and without some reference to the services the sign does not associate the mark with the services. In other words, while it may indicate a source, it is a source in a vacuum unconnected to any service, at least without prior knowledge of an existing client. Therefore, the issue is not resolved by the statement in the application because it does not resolve the question of whether potential consumers associate the mark with the services. Certainly, as applicant states, public signage at an office "is a normal commercial use of the mark"; however, absent some reference to the nature of the services on the sign, it does not associate the mark with the applied for services and therefore is not sufficient to support the application for registration. Upon seeing this sign, it could be literally for anything that one might find in an office park.

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In view of the above, we find that the specimen does not serve to show use of the mark R & B SOLUTIONS as a service mark in connection with the services identified in the application.

**Decision:** The refusal to register under Sections 1 and 45 of the Trademark Act is affirmed.