

**From:** Rutland, Barbara  
**Sent:** Fri 6/10/05 10:03 AM  
**Subject:** TRADEMARK APPLICATION NO. 78241396 - 801073-7002/

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 78/241396

APPLICANT: Caruso Property Management, Inc.

**\*7824139  
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**CORRESPONDENT ADDRESS:**  
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**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

**MARK:**

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 801073-7002/

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the Trademark Examining Attorney's Final Refusal to register as a trademark a miscellaneous design for use in connection with "Dissemination of advertising material for others; preparing and placing advertisements for others; promoting the goods and services of others through promotional offers; promoting the sale of goods and services of others through the distribution of printed material" in International Class 35 on the grounds that the specimens of record do not show use of the mark for the International Class 35 services specified.

## **FACTS**

On April 23, 2003, the applicant applied for registration of a miscellaneous design on the Principal Register. Applicant was advised in an Office Action mailed on November 3, 2003, that the specimen of record was unacceptable because the mark as displayed on the specimen did not match the mark displayed on the drawing. In addition, the specimen did not show use of the mark in connection with the International Class 35 services identified in the application. On March 11, 2004, a response from the Applicant was received wherein the Applicant provided substitute specimens and the declaration in support of such specimens. In an Office Action mailed on March 31, 2004, applicant was advised of the finality of the requirement for acceptable specimens on the basis that while the substitute specimens were acceptable to evidence use of the mark for the Class 36 services only, they were not properly verified and thus could not be accepted until verification of the substitute specimens was received. On October 7, 2004, applicant submitted an acceptable verified statement supporting use of the substitute specimens and this requirement was withdrawn. This appeal, together with an amendment to the recitation of services (marked as Exhibit A), followed.

## **ISSUE ON APPEAL**

**WHETHER THE SPECIMENS OF RECORD ARE ACCEPTABLE TO EVIDENCE USE OF THE APPLIED-FOR MARK IN INTERNATIONAL CLASS 35.**

## **ARGUMENT**

**THE SPECIMENS OF RECORD DO NOT EVIDENCE USE OF THE MARK IN CONNECTION WITH THE IDENTIFIED SERVICES IN INTERNATIONAL CLASS 35.**

Preliminarily, the examining attorney objects to the proposed amendment to the recitation of services submitted by applicant with its brief on appeal. “The record in the application should be complete prior to the filing of an appeal.” 37 C.F.R. Section 2.142(d). The amendment, being inappropriate at this time, has not been considered. Should the examining attorney be reversed on appeal, she requests that the application be remanded to her for consideration and entry of the amendment prior to publication in the Official Gazette.

The applicant has applied for registration of a miscellaneous design for use in connection with “Dissemination of advertising material for others; preparing and placing advertisements for others; promoting the goods and services of others through promotional offers; promoting the sale of goods and services of others through the distribution of printed material; providing business marketing services” in International Class 35.

In order to evidence use of its mark in connection with services in International Class 35, the applicant submitted substitute specimens showing the design mark appearing in a printed brochure containing discount coupons for establishments located within the Applicant’s shopping center. These brochures are clearly targeted to the shopping mall patrons, not to the business owners within the shopping mall. They do not offer advertising services to the business owners. They do not offer promotional services. They do not offer any of the services listed in the International Class 35 recitation. They are not even targeted toward the appropriate customer base, the shopping mall business owners. They may even be the ultimate result of a business owner availing itself of the applicant’s Class 35 services, but not necessarily so. They simply do not evidence nor offer the International Class 35 services. *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999); *In re Adair*, 45 USPQ2d 121 (TTAB 1997); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975); TMEP §§1301.04 *et seq.*

There is no reference whatsoever in any of these specimens to any type of advertising or promotional services. Thus, there is nothing in the specimens that would create an association between the design mark and the International Class 35 services.

A service mark specimen must show use of the mark “in the sale or advertising of services.” Trademark Act Section 45, 15 U.S.C. §1127; 37 C.F.R. §2.56. Therefore, a specimen is unacceptable if it does not show use of the service mark in relation to the identified services. There must be a direct association between the mark sought to be registered and the services specified in the application, with sufficient reference to the services in the specimen to create this association. *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999); *In re Adair*, 45 USPQ2d 121 (TTAB 1997); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975); TMEP §§1301.04 *et seq.*

In this case, these specimens fail to identify or offer the International Class 35 services for which registration is sought such that there is a direct association between the applied-for mark and the services indicated in the application.

The case relied upon by the Applicant, *West Fla. Seafood Inc. v. Jet Restaurants*, 31 USPQ2d 1660 (Fed. Cir. 1994) is not particularly on point with the facts in this case. Unlike this case, *West Fla. Seafood* involved a Petition to Cancel on the basis of prior use wherein appellant relied upon advertisements to demonstrate priority.

*In re Advertising & Marketing Development Inc.*, 2 USPQ2d 2010 (Fed. Cir. 1987), is more applicable to this case. The Federal Circuit in *In re Advertising & Marketing Development* held that the TTAB had erred in finding that the appellant had not shown use of its mark for its promotional services. In that case, the appellant sought registration for the mark THE NOW GENERATION for "PROMOTING THE SALE OF GOODS AND/OR SERVICES OF AUTOMOBILE DEALERS, FINANCIAL INSTITUTIONS AND RETAILERS THROUGH THE

DISTRIBUTION OF PRINTED PROMOTIONAL MATERIALS AND BY RENDERING MERCHANDISING AND SALES PROMOTION ADVICE." *Id.* at 2011. The Court noted that "[i]t is not enough for the applicant to be a provider of the services; the applicant also must have used the mark to identify the named services for which registration is sought." *Id.* at 2014. The Court found that the appellant's specimens met this test, as appellant had submitted a letterhead specimen sent to financial institutions and automobile dealers stating that appellant was the "creators, producers and *suppliers* of THE NOW GENERATION sales *promotion services* and specialized advertising campaigns *for* automobile dealers, financial institutions and retailers." *Id.* at 2015 (emphasis in original). Unlike this case, the appellant's specimens were directed to the appropriate and relevant consumer base, and they clearly demonstrated use of the mark on or in connection with the named services for which registration was sought such that a direct association between the mark and the services results from the particular use or display of the mark.

Also on point is *In re Admark, Inc.*, 214 USPQ 302 (TTAB 1982). The applicant in the *Admark* case was an advertising agency seeking registration of the mark "THE ROAD AUTHORITY" for advertising agency services. Specifically, the applicant developed advertising campaigns whose focus was often a slogan or mark. The applicant made the slogan "THE ROAD AUTHORITY" available to tire and auto accessory stores by means of territorially exclusive license agreements. In refusing registration of a mark for advertising services, the TTAB stated, "the mark or slogan that is the focus of an advertising campaign for a client's goods or services cannot be said to function as a service mark for the licensor's -- applicant's -- advertising agency services." *Id.* at 303. TTAB further stated, "the mark 'THE ROAD AUTHORITY' does not serve to identify and distinguish applicant's advertising services; 'THE ROAD AUTHORITY' and the advertising campaign it represents are, instead, the things being offered by means of applicant's advertising agency services." *Id.*

## CONCLUSION

For the foregoing reasons, the refusal to register the mark because the specimen does not show use of the mark for International Class 35 services should be affirmed.

Respectfully submitted,

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