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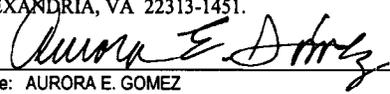
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

Applicant : Caruso Property Management, Inc.
Serial No. : 78/241,396
Filed : April 23, 2003
Mark : Design Only
Docket : 158989-0002/T04613US
Law Office : 105
Attorney : Barbara Rutland, Esq.

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THE FOREGOING IS
BEING DEPOSITED THIS 6TH DAY OF APRIL 2005 WITH
THE UNITED STATES POSTAL SERVICE AS FIRST-
CLASS MAIL IN AN ENVELOPE ADDRESSED TO:
COMMISSIONER FOR TRADEMARKS P. O. BOX 1451,
ALEXANDRIA, VA 22313-1451.


Name: AURORA E. GOMEZ



APPLICANT'S APPEAL BRIEF

04-11-2005

U.S. Patent & TMOtc/TM Mail RcptDt. #74

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Los Angeles, California 90067
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I. INTRODUCTION

Caruso Property Management, Inc. ("Applicant") appeals from the final decision of the United States Patent and Trademark Office Examining Attorney refusing registration of the above referenced mark. Applicant has amended the application to delete the services "providing business marketing information." The Amendment is submitted as Exhibit A hereto. Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision and allow the mark.

The Examining Attorney refused to allow registration on the basis that the substitute specimen filed March 8, 2004 ("substitute specimen") did not show use of the mark in connection with the specified services of International Class 35.¹ Applicant timely filed its Notice of Appeal of the Examiner's decision. Applicant contends that the specimens submitted in support of the services in Class 35 show the mark in respect of the particular services identified, especially in view of the Exhibit A Amendment.

II. THE SPECIMENS SUBMITTED SHOW THE MARK USED IN CONNECTION WITH THE CLASS 35 SERVICES IDENTIFIED

By way of background, Applicant clarifies that, as can be observed from the specimen of record, The Grove is a large and extremely popular outdoor shopping

¹ The Final Office Action required Applicant to file a declaration or affidavit, pursuant to 37 C.F.R. § 2.20, verifying that the substitute specimens were in use in commerce at least as early as the filing date of the application for both Classes 35 and 36. The requested Declaration Under 37 CFR § 2.20 for both Classes 35 and 36 was timely filed on September 28, 2004. Applicant understands that no issue remains with respect to the registrability of the mark with respect to Class 36, and that this Appeal pertains to the refusal with respect to Class 35.

center/shopping environment in Los Angeles, resembling a beautiful village more than the prototypical shopping mall. There are fine dining restaurants, movie theatres, and upscale stores in a lushly landscaped environment, as well as grassy areas overlooking a large, sculptural water fountain, where shoppers, diners, moviegoers and other visitors can relax and watch live entertainment. There is a logo used in various ways in connection with the shopping center environment. Additionally, the logo is used in connection with advertising, promotional and business for others, namely, the tenants of the Applicant's shopping environment. That logo is the mark sought to be registered herein.

The Application is a multi-class application in Classes 35 and 36. With respect to the claimed "Retail Shopping Center Services," in Class 36, the Examining Attorney found the specimens to be proper, and merely requested a Declaration which, as noted in Footnote 1 and of record, was timely filed in response to the Final Office Action.

Hence, this Appeal concerns Class 35, and specifically the Applicant's specimens with respect to Class 35. Applicant urges that the substitute specimens filed by Applicant are sufficient to show use of the mark in connection with the enumerated services of Class 35.

Trademark Rule 2.56 regarding service mark specimens reads, in part, "A service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 C.F.R. §2.56(b)(2). Most specimens supporting a service mark registration appear in the form of advertisements; West Fla. Seafood v. Jet Rests., 31 F.3d 1122, 1126 n.6 (Fed. Cir. 1994) ("Advertisements may constitute acceptable 'specimens' of use.").

The application on appeal lists the services in Class 35 as:

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 information.

Per Exhibit A, the Applicant has amended the application to delete "providing business marketing information." The identification of the remaining services specifies that each of the services listed above is done on behalf of others. These others, as is evident from the substitute specimen, are the tenants within the Applicant's shopping center. Applicant's substitute specimen for Class 35 shows the use of the mark in connection with each of these services.

The Class 35 substitute specimen brochure of record advertises (through an educational children's tool) establishments within Applicant's shopping center; namely, Pottery Barn Kids, Barnes and Noble, Nordstrom, and Gap Kids. The brochure supports the claimed services of "Dissemination of advertising material for others," because, for example, Pacific Theaters benefits from this advertisement offered in connection with the mark sought to be registered, as do Wishing Bear, Pottery Barn Kids, Barnes and Noble, Nordstrom, and Gap Kids.

The substitute specimen brochure for Class 35 includes coupons for a dollar off a movie tray at Pacific Theatres as well as twenty-five (25) percent off any animal outfit at Wishing Bear. Both Pacific Theatres and Wishing Bear are establishments located within Applicant's shopping center, as is apparent from the substitute specimen itself. Applicant advertises and promotes the goods and services of others through the distribution of this

EXHIBIT A

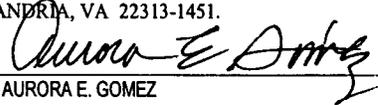
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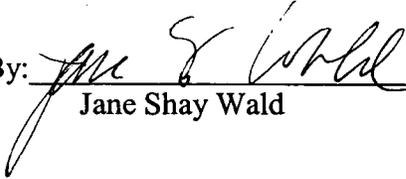

Name: AURORA E. GOMEZ

AMENDMENT

Applicant amends the application by deleting from the identification of services in Class 35 of the application the following: "Providing business marketing information." Applicant believes the Application is in condition for allowance and respectfully requests the same.

Respectfully submitted,
IRELL & MANELLA LLP

Dated: April 6, 2005

By: 
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