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Mailed:
March 29, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Christian Broadcasting, Inc.

Serial No. 85058128

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Before Seeherman, Quinn and Kuczma, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This is an appeal by International Christian Broadcasting, Inc. (hereafter "applicant") of a refusal to register its mark in Class 35 for "retail store services featuring novelty items, namely, hats, magnets and key chains."¹ The mark, HEROES UNDER GOD and design, appears below, and is described as follows:

¹ Application Serial No. 85058128 also includes services in Classes 38, 41 and 45, but there has been no refusal of registration for these classes.

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The mark consists of a free form outline in the shape of a stylized "H" with star-shaped cutouts, within it portions of white stars with a blue background with white stars in the upper left corner, and red and white stripes throughout. The outline is in the color black. The wording "HEROES UNDER GOD" is in the color black and under the stylized "H" with black stars between the words, and a red line above and below "HEROES UNDER GOD.

The colors blue, red, white and black are claimed as a feature of the mark.



The application was filed June 9, 2010 under Section 1(a) of the Trademark Act, asserting January 31, 2009 as the date of first use and first use in commerce.

Registration has been refused with respect to the services in Class 35 pursuant to Sections 1 and 45 of the Trademark Act, §§ 1051 and 1127, and Trademark Rules 2.34(a)(1)(iv) and 2.56, 37 C.F.R. §§ 2.34(a)(1)(iv) and 2.56. It is the examining attorney's position that the specimens submitted by applicant fail to show use of the mark in commerce in connection with the identified services.

Trademark Rule 2.34(a)(1)(iv) lists, as a requirement for an application filed under Section 1(a) of the Trademark Act, "one specimen showing how the applicant actually uses the mark in commerce." Rule 2.56(a) requires a specimen showing the mark as used "in the sale or advertising of the services in commerce," and Rule 2.56(b)(2) provides that "a service mark specimen must show the mark as actually used in the sale or advertising of the services."

Applicant has provided three substitute specimens that we reproduce below:²

Specimens submitted with Oct 18, 2010, Request for Reconsideration:



² Applicant has not argued the acceptability of its original specimen or its first substitute specimen, so we need not discuss them.



Specimen submitted with March 7, 2011, Request for Reconsideration:



These specimens are photographs showing a framed representation of applicant's mark on shelves. The March 7, 2011 submission obviously is of the same subject shown in the October 18, 2010 submission, but includes the surrounding objects as well. It is clear, from the specimen submitted on March 7, 2011, that the mark is shown in clear plastic picture frames placed on shelves which feature various items, including caps and key chains and what appear to be magnets.

The examining attorney is not contending that HEROES UNDER GOD and design does not function as a mark or would not be regarded as a mark, only that the specimen does not show use of the mark as a source-indicator for the identified *services* in Class 35. "Instead, they [the specimens] show the mark being used only to indicate the source of other, non-retail store services and to indicate the source of goods being displayed on store shelves." Brief, unnumbered p. 4.³ Thus, she accepts that the framed material would be viewed as a mark for the goods. "A consumer would be inclined to view such a card as identifying the source of the goods on the shelf: in other

³ The reference to non-retail store services concerns the first substitute specimen submitted by applicant, which appears to refer to fundraising services: "Clothing Donated Personally By Dr. Paul Crouch All Proceeds Go To 'Heroes Under God.'"

words, applicant's specimens show the mark being used on point-of-sale materials." Brief, unnumbered p. 5.

Accordingly, this is not a situation in which the applied-for mark is displayed in such a way that it would not be perceived as a mark. Compare, *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (specimen does not show applied-for term as a mark because it appears in same size and font as and as part of other informational matter).

In her appeal brief the examining attorney has raised the claim that "the specimens all seem to show that some third party is providing such space, and that applicant is merely using that space to offer its goods." Brief, unnumbered p. 6. We have two comments about this argument. First, as applicant points out, there is no support for this assertion in the record, and applicant unequivocally denies the examining attorney's contention, stating that the specimen is "from its own retail location ... and shows the mark being used right in the retail setting itself." Reply brief, p. 2 (emphasis in original). Certainly if the examining attorney believed that information about the premises on which the retail store services were offered, or about other signage for the store, was relevant, she could have required, as part of an Office action, that

applicant supply such information. See Trademark Rule 2.61(b).

Second, the examining attorney has provided no support for her position that if the owner of the mark does not itself own the space in which it sells goods, it cannot *per se* be the owner of a mark for retail store services. There does not appear to us to be any *per se* reason why an entity cannot offer retail services in a portion of another entity's space, such as the section of a lobby of an office building or a business, and have the mark for the retail services offered within that other business constitute service mark use. The key question, as discussed below, is whether consumers will perceive the mark as indicating source of the retail store services in the applicant, or as the mark of the owner of the building or business providing the space in which the retail services are offered.

The examining attorney appears to take the position that in order to qualify as a service mark for retail store services, the mark must be used as the name of a store. The examining attorney has not provided any support for this position, and we are not aware of any case law that requires this conclusion. We find that a mark can function as a mark for retail store services if it identifies a section of a store even if a different name is used for the

store as a whole; retail store services can be rendered in a portion of a larger store and still constitute retail store services. Therefore, a mark that indicates origin in a portion of a store is still a mark used in rendering retail store services, and a specimen showing use of a mark for a section of a store can be an acceptable specimen. Thus, the fact that applicant's specimen does not show signage for an entire store does not mean that the specimen is unacceptable.

There are, of course, various ways in which to show use of a mark for retail store services. Perhaps most common is a photograph of the store showing the mark on exterior signage, or a newspaper or magazine advertisement for the store. See TMEP § 1301.04 (8th ed. 2011) for examples of types of acceptable specimens.

It is also true that point-of-sale displays, such as shelf-talkers, can be used as specimens for the sale of goods, as displays associated with the goods. Trademark Rule 2.56, TMEP § 904.03(g). However, the fact that a framed image of the mark is shown on a shelf next to goods, even if that use would qualify as a display associated with the goods and would be an appropriate specimen for those goods, does not in and of itself disqualify the framed image from also being an acceptable specimen for retail

store services. For example, a mark for a store placed in an exterior display window featuring a display of the goods sold within the store might very well qualify both as a display associated with those goods showing trademark use for those goods, as well as exterior signage serving as a service mark for the store. There is no compelling reason why this would not also be true for signage within a store.

The question, as with most cases involving specimens, is how the mark as shown in the specimens would be perceived by consumers. In this connection, TMEP § 1301.04(b) provides that, "in determining whether a specimen is acceptable evidence of service mark use, the examining attorney may consider applicant's explanations as to how the specimen is used... ." Apparently there was a telephone conversation between applicant and the examining attorney in which applicant did provide such an explanation.

The Trademark Rules and the TMEP provide that all relevant communications must be made part of the written record. Trademark Rule 2.191; TMEP §§ 709.04, 709.03. Unfortunately, the written record in this case contains no indication of what was said in this conversation. Nevertheless, the examining attorney states that she considered the substance of the conversation in making her

decision: "The examining attorney has carefully considered applicant's explanations, both in writing and in telephone conversation, as to how the mark is being used." Examining attorney's brief, unnumbered p. 5. Although TMEP § 709.04 encourages examining attorneys to initiate telephone or e-mail communications "whenever possible to expedite prosecution of an application," and provides that applicants may telephone or e-mail examining attorneys if they feel that a telephone call or e-mail will advance prosecution of an application, the rule and TMEP require relevant communications to become part of the written record. As explained in TBMP § 709.05, "relevant e-mail and phone communications must be made part of the record, because the USPTO uses them in decision making, and anything used in decision making must be made of record." In the circumstances of this case, where applicant's explanation presumably had some effect, we would have expected the examining attorney to memorialize the substance of the conversation in a follow-up Office action, or to have advised applicant to put this information into a written response.⁴ Obviously, we can consider only

⁴ We note that TMEP § 709.04 provides that "Notes to the File," i.e., a memorandum of a telephone conversation written by the examining attorney, must not summarize arguments or legal conclusions, but must merely list the issues discussed and

information that is in the record, and thus the explanation provided by applicant in the telephone conversation plays no role in our decision herein.

Thus, we turn to the specimens themselves. The specimen submitted by applicant on March 7, 2011 shows two framed images of the applied-for mark, on two different shelves, on which goods are also displayed, presumably for sale. Although it is somewhat difficult to make out all the details of the items in the photograph, they all seem to have a military or patriotic theme. For example, there are framed copies of the Air Force and Army anthems, replicas of military vehicles, a yellow ribbon magnet or decal with "Pray For Our Troops" written on it, and numerous items decorated with American flags or flag motifs. Consumers viewing the mark HEROES UNDER GOD and design, as shown in the specimen, could well understand it to identify the section of a retail store offering items dedicated to U.S. troops. See *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1122 (Fed. Cir. 2009), quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3.3 (4th ed. 2008): "The prime question is whether the designation in question, as actually used, will be

indicate any agreement that may have been reached, or indicate that no agreement was reached.

recognized in and of itself as an indication of origin for this particular product or service." Further supporting the conclusion that consumers would view the mark as identifying retail store services instead of goods is the fact that at least some of the items shown in the specimen bear their own trademarks, specifically, the mark FRAMOLOGY is on the double photograph frame, OLD WORLD CHRISTMAS is on another item, THE SOLDIER'S BIBLE is on the box for a third, and although we cannot clearly make it out, we can see that a trademark different from applicant's applied-for mark is on the box for the military vehicle.

The dissent suggests that the manner in which the framed image of the mark is displayed creates the commercial impression that the framed image itself is a good offered for sale, rather than a mark for the retail store services. We point out that the examining attorney has never suggested this; as noted, the examining attorney has accepted that the image would be perceived as a mark, although as a mark for goods rather than retail store services. Further, the specimen includes, immediately behind one of the framed images of the mark, what appears to be an 8½" x 11" paper in which HEROES UNDER GOD appears in large white letters on a red background at the top of

the paper, with "Our Mission" below it.⁵ Given the juxtaposition of this material with the framed image, it does not appear to us that consumers would view the framed image as merely a good for sale.

We also note that, in contrast to some service mark specimens that were found unacceptable because the nature of the service was not apparent from the specimen, here the specimen shows the mark actually being used as part of the rendering of the service, i.e., next to the goods being offered for sale. Compare *In re WTE Corp.*, 87 USPQ2d 1536 (TTAB 2008) (mark used as part of a return address label affixed to boxes mailed to customers does not show a connection between the mark and the service of contract processing of metals). Thus, the mark shown in the substitute specimens in this application is seen in the context of the rendering of the retail store services. See TBMP § 1301.04(b) and cases cited therein: "Where the record shows that the mark is used in performing (as opposed to advertising) the services, a reference to the services on the specimen itself may not be necessary."

Accordingly, we find that the substitute specimens submitted by applicant on October 18, 2010 and March 7,

⁵ Unfortunately, because of the size of the specimen, we cannot make out the rest of the text in this paper.

2011 are acceptable to show use of the applied-for mark in connection with the rendering of "retail store services featuring novelty items, namely, hats, magnets and key chains." To the extent that there is any doubt about whether purchasers would perceive the mark as shown in the specimens as a display associated with the goods rather than as a service mark identifying the source of the retail store services, as with many other grounds of refusal, we think that such doubt should be resolved in favor of applicant. Cf. *In re In Over Our Heads Inc.*, 16 USPQ2d 1653 (TTAB 1990) (Section 2(a) scandalous and disparaging); *In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008) (Section 2(a) falsely suggests a connection); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (Section 2 generic); *In re Aid Laboratories, Inc.*, 221 USPQ 1215 (TTAB 1983) (Section 2(e)(1) merely descriptive); *In re International Taste Inc.*, 53 USPQ2d 1604 (TTAB 2000) (Section 2(e)(2) primarily geographically descriptive); *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (Section 2(e)(4) primarily merely a surname).

Decision: The refusal of registration is reversed. The application will be forwarded for publication in Classes 35, 38, 41 and 45, i.e., the class for which

registration had been refused, and the three classes for which there was no refusal of registration.

Kuczma, Administrative Trademark Judge,
dissenting:

I join the majority's opinion that a mark can function as a mark for retail store services if it identifies a section of a store, but I respectfully dissent from my colleagues' ruling on the sufficiency of the applicant's specimens. Rather than evidencing service mark use, the specimens simply show framed images of the mark sitting on a shelf. As such, the framed images of the mark could appear to be actual products that are available for sale, or they could appear as displays that advertise the sale of adjacent products. In any event, the specimens do not show use of the mark in association with retail store services featuring novelty items.⁶

It is well settled that a particular designation can, under certain circumstances, function both as a trademark and a service mark. The only restriction on the registration of the same term both as a trademark and as a service mark is that the specimens filed in the service mark application must show the mark "used or displayed in

⁶ While it is not apparent from the specimen that the shelves pictured are located in a retail store, the record contains

the sale or advertising of the service" as distinguished from use on goods or in the sale or advertising of goods of the applicant. *In re Restonic Corporation*, 189 USPQ 248, 249 (TTAB 1975); *In re Heavenly Creations, Inc.*, 168 USPQ 317, 318 (TTAB 1971).

The fundamental question is what is being offered for sale under the mark. The mere advertising of one's own products is not a separate service from the sale of the goods. The critical inquiry then is whether the specimens show that applicant is using the mark as a service mark in contradistinction to use on goods or to advertise or promote the purchase of goods. *In re Landmark Communications, Inc.*, 204 USPQ 692, 695-96 (TTAB 1979). It is thus necessary to "look to the specimens of record in order to ascertain the manner in which the mark is used and the commercial impact created thereby to determine what function the mark performs under the particular circumstances." *Restonic Corp.*, 189 USPQ at 249.

No language or any other reference to retail store services is included in the framed images of the mark. Indeed, based on the manner in which the mark is used, in picture frames on store shelves without reference to any

applicant's statement that the specimens are "from [applicant's] own retail location."

services, the two framed images themselves appear as products available for purchase. Alternatively, the framed images serve to advertise the sale of the adjacent products which bear the same mark as shown in the framed images. The manner in which the mark is used in the specimens does not serve to advertise or otherwise indicate retail store services; to the contrary, it promotes the sale of the proximate products.

The test for a specimen continues to be that it ". . . must in some way evince that the mark is 'associated' with the goods and serves as an indicator of source." *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009); *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010) (at a minimum, specimen must show a direct association between the services and the mark sought to be registered) and *In re wTe Corp.*, 87 USPQ2d 1536, 1541 (TTAB 2008) (CCPA has made it clear that there must be "some direct association between the offer of services and the mark sought to be registered.").

Generally, in order to create a "direct association," the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source. *Osmotica Holdings*,

95 USPQ2d at 1668, citing *In re Aerospace Optics Inc.*,
78 USPQ2d 1861, 1862 (TTAB 2006).

Applicant's reply brief indicates that the specimens are "from [applicant's] own retail location." However, it is not enough for applicant to be a provider of retail store services; applicant must also use the mark to identify the retail store services for which registration is sought. *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987). The record is also silent as to the actual name of applicant's "retail location." Under these circumstances, it cannot be assumed that the framed images of the mark have any relationship to the name of the retail store. As recognized in *Sones*, there must be a "link" between a trademark and the products [services] for which it is used. 93 USPQ2d at 1123. Here, we are clearly missing the "link" between the mark as used in the specimens and retail store services.

The majority finds that although the specimens do not reference any services, the nature of the services is apparent from the specimens because the specimens show the mark actually being used as part of the rendering of the service, i.e., next to the goods being offered for sale. Because retail stores, by their very nature, display a

variety of products for sale, simple placement of a framed image of a mark next to goods offered for sale does not transform the image of the mark into a service mark for retail store services. Unlike signage on the front of a retail store which provides an immediate and direct association between the name of the store and the retail store services provided therein, the framed images of the mark shown in the specimens make no association with retail store services.

While there is no requirement that specimens themselves *contain* an association with the specified services, the specimens must *create* an association with the services. In those limited situations where specimens were found to be acceptable despite the fact that they did not reference the services, the specimens showed direct use of the mark in connection with the rendering of the services. In *In re Duratech Industries Inc.*, 13 USPQ2d 2052, 2054 (TTAB 1989), the Board distinguished cases such as *Red Robin*⁷ and *Eagle Fence Rentals*⁸ because they essentially involved the "wearing" of a design mark during the performance, or personification, of the services for which registration was sought. In *Eagle Fence Rentals*, the

⁷ *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984).

⁸ *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986).

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applicant did not sell any type of product, it only rendered services. 231 USPQ at 229. Thus, it was clear that the specimens showed use of the mark in connection with applicant's services.

To create an association between a mark and retail store services requires something more than the mere presence of a framed image of a mark just sitting on a retail store shelf. This is particularly so when the framed image of the mark is juxtaposed to products bearing the same mark. Accordingly, I would hold that the specimens do not show use of the mark as a service mark for retail store services and would affirm the refusal to register.