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

Proceeding	85691028
Applicant	Jeff Cowan
Applied for Mark	SIT, FLOP, POP AND LOOK
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Application No.: 85/691,028
Applicant: Jeff Cowan
Filing Date: July 31, 2012
Law Office: 110
Examiner: Dezmona J. Mizelle-Howard
Attorney Docket No.: 011104-000043
Mark: SIT, FLIP, POP AND LOOK

APPLICANT'S APPEAL BRIEF

To the Trademark Trial and Appeal Board:

INTRODUCTION

Applicant Jeff Cowan provides training services, namely educational services and materials for car dealerships, service managers, and service advisors in the automotive field. Jeff Cowan coined the SIT, FLIP, POP AND LOOK mark more than twelve years ago, and has continuously and exclusively used it to promote his services. Applicant submitted various specimens using the SIT, FLIP, POP AND LOOK mark, including promotional materials, training materials used while providing the services and photos of clothing worn by Applicant and his representatives while rendering the services. The Office Actions have refused to accept these specimens, arguing that SIT, FLIP, POP AND LOOK is merely the “subject matter” of Applicant’s workshops. Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the specimen rejections, and allow the mark to pass to publication.

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BRIEF RECITATION OF THE FACTS

Applicant filed its use-based application for registration of the mark SIT, FLIP, POP

AND LOOK for:

Educational services, namely, conducting classes, seminars, conferences, and workshops in the field of sales training and motivational speaking services for the sale services industry and distribution of training material in connection therewith.

in International Class 41 on July 31, 2012¹. The Application identifies a first use date of January 31, 2002. The submitted specimen was promotional material for Jeff Cowan's Training Workshops, indicating that they teach how to "Utilize the 'Sit, Flip, Pop and Look'® Technique." The Examining Attorney initially rejected the specimen of use as, "an advertisement that lists the subject mark as the subject matter of one of the workshops" and not showing use of the mark in association with the services, in an Office Action dated November 28, 2012 (the "initial Office Action"). The Applicant responded with arguments that the specimen properly showed use of the mark with the services and, in the alternative, submitted a substitute specimen including training materials used while rendering the services on February 6, 2013. On March 4, 2013, the Examining Attorney issued a Final Office Action maintaining the rejection (the "Final Office Action").

On September 4, 2013, Applicant filed a Notice of Appeal. Thereafter, Applicant filed a Request for Suspension and Remand, including additional specimens and evidence, on October 13, 2013. The materials included: additional training materials, a Declaration by Applicant Jeff Cowan (herein the "Cowan Decl."), and photographs of the trademark on clothing that Applicant

¹ The original application inadvertently included a typographic error indicating that the mark was SIT, FLOP, POP AND LOOK. This was corrected by a voluntary amendment filed on August 7, 2012.

and his representatives wear while rendering the services. On January 10, 2014, the Examining Attorney denied the Request for Reconsideration, and this appeal resumed.²

ARGUMENT

Applicant respectfully submits that the specimens of record are sufficient to show use of Applicant's mark for Applicant's services.

The Office Actions maintain that the mark on the submitted specimens indicates the "subject matter" of Applicant's workshops and do not show the mark used in connection with Applicant's services. Specifically, the initial Office Action asserts:

In this case, the specimen consists of an advertisement that lists the applicant's mark as the subject matter of one of the workshops. The mark is not shown in connection of the services of "conducting classes, seminars, conferences, and workshops in the field of sales training and motivational speaking services for the sale services industry and distribution of training material in connection therewith."

See also, Final Office Action, "It is merely teaching a topic in a workshop (teaching the participant to sit, flip, pop and lock [sic]) and not likely to be seen as a source identifier," and Denial of Request for Reconsideration, "the mark is not seen in connection with the provision of educational services, but rather as the subject matter of educational services presented by 'Jeff Cowan's Pro Talk.'" Applicant respectfully disagrees.

A service mark is used in commerce, when it is used to "identify and distinguish the services of one person ... from the services of others and to indicate the source of the services;" and "when it is used or displayed in the sale or advertising of services." 15 U.S.C. §1127. The Office Actions accept that the specimens are materials used in advertising and while rendering Applicant's services. The Office Actions also accept that the specimens display Applicant's use

² The initial Office Action, the Final Office Action and the denial of the Request for Reconsideration are collectively referred to herein as "the Office Actions."

of the mark. The focus of the objection seems to be the concern that the mark is used to identify “the subject matter of one of the workshops” rather than identifying Applicant’s services. Applicant respectfully submits that this is incorrect, in fact the mark identifies Applicant’s services.

In evaluating use of a specimen, it is necessary to consider the “full context” of Applicant’s use of the trademark, together with any other information in the record, to see how the applicant uses the proposed mark.” TMEP §1301.02(e); *In re ICE Futures U.S., Inc.*, 85 USPQ2d 1664, 1669 (TTAB 2008). The specimen must display the mark, “ in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source via a ‘direct association.’” *In re DSM Pharm, Inc.*, 87USPQ2d 1623, 1624 (TTAB 2008); *In re Sports Outdoor and Recreation*, Serial No. 85/108,918 *4 (TTAB Feb. 10, 2014).³ The specimens and information here show that the SIT, FLIP, POP AND LOOK mark is perceived as identifying Applicant’s services and indicating Applicant as the source. Applicant asserts that the full context shows, “that there is a direct association between the mark and the services.” TMEP §1301.02.

As a brief background yet explaining the full context, for more than 25 years, Applicant Jeff Cowan has provided training services, namely educational services and materials for car dealerships, service managers, and service advisors in the automotive field. His educational services and materials teach the arts of selling, customer service, customer retention, and communication skills and provide specific examples and explanations tailored for automotive service and sales drive managers and associates. (Cowan Decl. ¶2) The services are provided, for example, through live workshops, classes, seminars, conferences, webinars, on-site training, manuals, pocket guides, forms, and training videos available by DVD set and/or online. Jeff

³ A copy of this decision is submitted herewith.

Cowan has visited over 2,400 automobile service drives in the United States and Canada, and has trained personnel at thousands of car dealerships. (Cowan Decl. ¶3)

Jeff Cowan's educational services and materials are widely known in the automotive service sales industry. He is a regular speaker at the annual meeting of the National Automobile Dealers Association (NADA), an organization having nearly 18,000 new car and truck dealers, with 32,500 franchises both domestic and foreign. He is also a featured trainer on the NADA University Platform and a featured speaker at Dealer 20 Group meetings, groups of principals and managers from non-competing automotive dealers. (Cowan Decl. ¶4) Jeff Cowan's educational services and materials are recognized as the "Nation's #1 Service Advisor Sales Training" and he is recognized as "the modern day creator of walk-around and selling processes for service drives." (Cowan Decl. ¶5)

The SIT, FLIP, POP AND LOOK mark is an arbitrary mark coined by Jeff Cowan. (Cowan Decl. ¶9) It is not used by competitors or third parties. It has been exclusively and continuously used by Jeff Cowan since at least 2002. Applicant uses the mark SIT, FLIP, POP AND LOOK on a variety of different types of materials to promote his services, including on his website, in training materials, in presentations and even on clothing items. (Cowan Decl. ¶8) The Office Actions do not challenge or present any evidence to dispute these facts.

The Office Actions assert that the mark merely identifies the subject matter of the services - comparable to an assertion that the mark is merely descriptive. However, there is no established meaning to this coined and incongruous wording. SIT, FLIP, POP AND LOOK does not immediately describe "educational services" nor does it immediately describe any specific "subject matter" or topic. The present mark is not an arrangement of ordinary words generically or commonly identifying subject matter such as "mathematics" or "marketing 101"; indeed the

mark has no clear or recognized meaning outside of the context of the Applicant's services. It takes a multiple step reasoning process, coupled with an awareness and understanding of Applicant's services to make the connection between the mark and any specific "subject matter."

Absent an association with Applicant's training services (i.e. a source identifying use), an ordinary consumer encountering the words SIT, FLIP, POP AND LOOK would not understand what "subject matter" SIT, FLIP, POP AND LOOK identifies. It is only as identifying and in association with Applicant's training services that the mark has meaning.

Corroborating that it is a service mark, the SIT, FLIP, POP AND LOOK mark in Applicant's specimens is physically set-off from textual matter and emphasized by use of the ® symbol.⁴ Also, the fact that it is an incongruous combination of words, with a recognizable cadence, reinforces that consumers would perceive SIT, FLIP, POP AND LOOK as a mark associated with Applicant's services.

The mark is used in a way that creates a separate commercial impression that is recognized by consumers differently from merely text or merely "the subject matter." This supports that the mark is perceived as a service mark. *See* TMEP 1301.02 and *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985) (the designation QUALITY SHOWS, set off from text of advertising copy in extremely large typeface and reiterated at the conclusion of the narrative portion of the ad, held to be a registerable service mark for applicant's real estate management and leasing services, because it was used in a way that made a commercial impression separate from that of the other elements of advertising material upon which it was used, such that the designation would be recognized by prospective customers as a source identifier.); *In re Sport Outdoor and Rec.*, 85/108,918 *7 (TTAB Feb. 10, 2014) (reversing refusal of specimen when, "the specimen of use shows the mark used in a manner that would be

⁴ Use of the ® symbol is based on Applicant's Registration No. 2,787,690 for "t-shirts, button shirts and hats."

perceived by potential purchasers as identifying the applicant's services and indicating their source.")

Further, clothing items showing the trademark, such as the specimen with photos of a shirt, are regularly worn by Applicant and his staff while Applicant's services are being promoted and performed. (Cowan Decl., ¶8). As provided in the TMEP, "[a] specimen that shows the mark as used in the course of *rendering or performing* the services is generally acceptable. 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." (TMEP §1301.04(b), emphasis in original). Although the clothing items do not explicitly reference the services, they serve to show how the mark is used when the services are actually performed.

Applicant's long history of exclusive use of this coined mark supports that this mark is perceived by the public as uniquely and distinctively associated with Applicant's training services. Consumers have come to know, rely upon, and recognize the mark as identifying Applicant's services. (Cowan Decl. ¶10) This is comparable to the case of *In re ICE Futures U.S., Inc.*, where the TTAB recognized that marks referring to contract names (comparable to "subject matter") used in rendering services, where the marks were created by the applicant and had a long history of exclusive use, supported that the marks functioned as service marks:

in these cases, SUGAR NO. 11, SUGAR NO. 14 and COTTON NO. 2 not only identify the relevant contracts, contracts which are unique to applicant, but SUGAR NO. 11, SUGAR NO. 14 and COTTON NO. 2 also identify the source of the futures exchange services.

In re ICE Futures U.S., Inc., 85 USPQ2d at 1669.

We conclude so based on our analysis of the specimens themselves, the context of use and the history of applicant's exclusive use in the industry reflected in this record.

Id.

The Denial of the Request for Reconsideration summarily rejects the additional shirt specimen in one sentence, stating, “The use of the mark on the sweatshirt does not evidence the use of the mark in connection with ‘educational services.’” Other than the conclusory statement, the Denial provides no details explaining why the additional shirt specimen is not sufficient. This cursory treatment and conclusion is legal error. This is comparable to the case of *In re Red Robin Enterprises, Inc.* where the TTAB found that a photograph of a costume which is worn by a performer during the *performance* of the identified entertainment services was an acceptable manner of showing use of the mark. 222 U.S.P.Q. 911 (TTAB 1984). Similarly here, the shirts are worn by Applicant and his staff during the rendering of the educational services. Applicant asserts that the shirt is an acceptable specimen showing use of Applicant’s mark in connection with Applicant’s services.

Further, to any extent that the mark may identify the “subject” of Applicant’s training services in the sense that the Applicant uses his coined term to identify his training, Applicant’s “subject matter” is an integral and essential component of providing Applicant’s training services. (Cowan Decl. ¶9) *In re ICE Futures U.S., Inc.*, 85 USPQ2d at 1670 (“While the marks may also identify the futures contracts, again contracts which, on this record, are unique to applicant, the contracts are an integral and essential component of the identified services, that is, the operation of a futures exchange.”)

When considering the full context of use of the mark and the various specimens submitted, the mark created by the Applicant promotes Applicant’s educational and training services and identifies and distinguishes that Applicant is the source of the services.

CONCLUSION

Applicant respectfully requests that the rejection be reversed, that the specimens be accepted and that Applicant's mark be forwarded for publication and allowance. Action towards such is respectfully requested.

Respectfully submitted,

By: /Charles J. Meyer/ _____

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THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
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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 Sports Outdoor And Recreation (SOAR) Park

—
Serial No. 85108918
Serial No. 85108928

—
Mark A. Kammer and Linda W. Browning of Kammer Browning PLLC for Sports
Outdoor And Recreation (SOAR) Park.

Colleen Dombrow, Trademark Examining Attorney, Law Office 101 (Ronald R.
Sussman, Managing Attorney).

—
Before Cataldo, Gorowitz, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Sports Outdoor And Recreation (SOAR) Park filed two applications to
register on the Principal Register the marks JETTE¹ and X-RAY,² both in standard
character form, for “providing theme park services.” After initial examination, the
applications were published for opposition and notices of allowance issued.

¹ Application Serial No. 85108918 filed on August 17, 2010 under Trademark Act § 1(b), 15
U.S.C. § 1051(b).

² Application Serial No. 85108928 filed on August 17, 2010 under Trademark Act § 1(b), 15
U.S.C. § 1051(b).

Serial Nos. 85108918 and 85108928

Applicant then filed statements of use as required by Trademark Act § 1(d), 15 U.S.C. § 1051(d). The same specimen of use was submitted with each of the two the statements of use.

In each case, the examining attorney refused registration under §§ 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that the specimen of use did not evidence an association between the mark and applicant's identified services. When the refusals were made final, applicant brought this appeal. Applicant and the examining attorney have filed their briefs on appeal, and applicant has filed a reply brief.

Although the marks sought to be registered in the two applications are different, the issues raised by the two appeals are identical and the briefs and evidentiary records are substantially identical. Accordingly, the Board will address both appeals in a single opinion. Citations to the briefs refer to the briefs filed with respect to application Serial No. 85108928 unless otherwise noted. We have, of course, considered all arguments and evidence filed in each case, including any arguments and evidence not specifically discussed in this decision.

In each case, the specimen of use submitted with the statement of use is the following one-page internet advertisement:



Online Registration System

Login

Heroes' Club Membership Levels



Jette Membership
\$25/month (\$300/year)
Includes:

- 4 Tickets to the Park
- 1 MWL Bumper Sticker
- 1 MWL T-Shirt



X-Ray Membership
\$50/month (\$600/year)
Includes:

- 6 Tickets to the Park
- 1 MWL Bumper Sticker
- 2 MWL T-Shirts



Rocket Membership
\$75/month (\$900/year)
Includes:

- 8 Tickets to the Park
- 1 MWL Bumper Sticker
- 2 MWL T-Shirt
- 2 Hour Pavilion Rental



Morgan Membership
\$100/month (\$1200/year)
Includes:

- 10 Tickets to the Park
- 1 MWL Bumper Sticker
- 2 MWL T-Shirt
- 3 Hour Pavilion Rental

 Join Now!

Everyone is welcome...come play with us!

Section 45 of the Trademark Act provides, in relevant part, that a service mark is a mark that is used “to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services”; and that “a mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.”³ In order to demonstrate use of a service mark by means of an advertisement, the advertisement must display the mark “in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source via a ‘direct association.’” *In re DSM Pharmaceuticals Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008). “The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.” *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (C.C.P.A. 1973). A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989).

The examining attorney argues as follows with respect to each of the marks X-RAY and JETTE appearing on the specimen of use submitted by applicant:

the mark does not appear as a source indicator for providing theme park services. ... Specifically, the word “X-RAY” [“JETTE”] indicates a level of membership and consumers viewing the mark on the applicant’s website

³15 U.S.C. § 1127, definitions of “service mark” and “use in commerce.”

will view it as an indicator for applicant's membership services.⁴

Applicant, in response, contends:

Membership in this case is essentially the purchase of tickets for entry into the theme park.⁵

...

[W]hen viewing the full context of the use of the mark, including the "level of membership" wording, Applicant asserts that the inclusion of this wording does not interfere with the perception of the mark as a service mark for theme park services. ... [T]he membership or ticket package is an integral and essential component of the identified services, that is, providing theme park services. ...

The membership or ticket package embodies the intangible rights which are being exchanged when customers use Applicant's theme park services.⁶

The examining attorney, in support of her position, has made of record advertisements of third-party theme parks⁷ to show "that theme parks regularly have various levels of memberships or theme park ticket packages."⁸ We note, however, that these advertisements do not refer to their ticket packages as "memberships." For example, King's Dominion and Six Flags theme parks refer to them as "season passes." Universal Studios Hollywood refers to them as "1-Day Pass," "12-month No Black-Out Pass," and other similar designations. Magic Kingdom Park refers to them as "Annual Passes." Accordingly, we see little support

⁴ Examining attorney's brief at 3-4.

⁵ Applicant's brief at 3.

⁶ *Id.* at 5.

⁷ Office action of January 12, 2013, pp. 6-35.

⁸ Examining attorney's brief at 4.

in this evidence for the examining attorney's position. Applicant, on the other hand, suggests that the evidence proves applicant's point, that it is a common practice for theme parks to offer tickets in packages of varying sizes. Applicant argues, by analogy, "If Disney... identified its ticket packages as the 'Mickey', 'Goofy', and 'Donald' *ticket packages* or *membership levels*, then the public would certainly view those trademarks as source indicators for the Disney theme park services."⁹

The specimen of use at issue makes no reference to a "theme park." However, the examining attorney concedes that "the exact nature of the services does not need to be specified in the specimen..."¹⁰ The specimen does refer repeatedly to "Tickets to the Park." We see also a reference to a "Special Needs Park"; and in the slogan "Where Everyone Can Play," the words "Where" and "Play" make it clear that what is offered is a *place* in which to *play*. The remaining question is whether the specimen shows a "direct association" between the marks at issue and the offered "park" where one can play.

The marks at issue appear on the advertisement under the rubric "Heroes' Club Membership Levels" and the marks are used in the phrases "X-Ray Membership" and "Jette Membership." We see no inconsistency between these references to "membership" and applicant's claim that it is selling theme park services. The examining attorney argues that "Membership services are not theme park services..."¹¹ However, the examining attorney does not explain what she

⁹ Reply brief at 3 (emphasis in original).

¹⁰ Examining attorney's brief at 3, *citing In re Adair*, 45 USPQ2d at 1215.

¹¹ Examining attorney's brief at 6.

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means by “membership services,” nor does she explain the nature of the membership services that are supposedly offered by the advertisement. There is nothing else in the record to suggest that applicant is operating any kind of organized association, society, or other conventional type of membership organization. There mere use of the word “membership,” without other evidence, is insufficient to transform the nature of what the advertisement appears to offer on its face. Potential customers would perceive the specimen of use as an advertisement for a park where one can play. In the context before us, it is apparent that to be a “member” is to be a “customer” of this service; and that the word “membership” is merely an alternative word for “package of tickets for multiple admissions to the park.”

Considering that “Jette Membership” and “X-Ray Membership” refer to ticket packages for admission to theme park services, we see that on the specimen of use the marks JETTE and X-RAY are closely and directly associated with the offered services: each of the two marks appears within a graphic box a few lines above the offer of (respectively) “4 Tickets to the Park” or “6 Tickets to the Park.” We find, therefore, that the specimen of use shows the marks used in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source; and that, accordingly, the specimen of use demonstrates use of the marks as service marks within the meaning of the Trademark Act.

Decision: In each case, the refusal to register is reversed.