

This Opinion is Not a
Precedent of the TTAB

Mailed: March 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Timber Creek at Okemo Number II, LLC
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Serial No. 86094929
Serial No. 86094995
(Consolidated)
—

James E. Shlesinger of Shlesinger Arkwright & Garvey LLP,
for Timber Creek at Okemo Number II, LLC.

Michelle E. Dubois, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

—
Before Goodman, Larkin, and Coggins,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Timber Creek at Okemo Number II, LLC (“Applicant”) seeks registration on the
Principal Register of the mark SOUTHFACE VILLAGE in standard characters, and
the mark shown below



both for services identified (as amended) as “providing an Internet portal offering information in the fields of real estate concerning the purchase and sale of new homes and condos,” in International Class 36.¹

The Trademark Examining Attorney has refused registration of Applicant’s marks under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053, and 1127, on the ground that the activities recited in the amended identifications are not registrable services. When the refusals were made final, Applicant requested reconsideration in both cases,² which was denied.³ Applicant subsequently appealed in both cases, and on Applicant’s motion, 4 TTABVUE (Serial Nos. 86094929 and 86094995), the Board consolidated the two appeals and ordered that they could be presented on the same briefs. 5 TTABVUE 1-2 (Serial Nos. 86094929 and 86094995).⁴ Applicant and the Examining Attorney have filed briefs. We affirm the refusals to register.

¹ Application Serial No. 86094929 to register the standard character mark, and Application Serial No. 86094995 to register the composite mark, were both filed on October 18, 2013 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the marks in commerce. Both applications originally covered services in Classes 36, 37, 41, and 43. The applications were divided following allowance, and the services in Classes 36 and 37 were retained in the original parent applications. The parent applications were subsequently divided further, with only the Class 36 services remaining in the parent applications. The original Class 36 identifications of services, “leasing or renting of buildings; and providing an Internet portal offering information in the fields of real estate concerning the purchase and sale of new and resale homes and condos,” were amended to the current identifications, “providing an Internet portal offering information in the fields of real estate concerning the purchase and sale of new homes and condos,” when Applicant filed its statements of use in the two applications.

² May 14, 2018 Requests for Reconsideration (Serial Nos. 86094929 and 86094995).

³ June 5, 2018 Denials of Requests for Reconsideration (Serial Nos. 86094929 and 86094995).

⁴ We will cite the briefs in the TTABVUE file for Serial No. 86094929.

I. Record on Appeal

The records on appeal are identical. They consist of Applicant's original specimen, consisting of pages from its website; the declaration of Andrew E. Becker ("Becker Declaration"), an officer of Applicant, and Exhibit A thereto, webpages comprising a substitute specimen;⁵ third-party webpages made of record by the Examining Attorney;⁶ and additional pages from Applicant's website, made of record by the Examining Attorney.⁷

II. Analysis of Refusals

Although the Trademark "Act defines 'service mark,' but fails to define 'services,'" *In re Canadian Pac. Ltd.*, 754 F.2d 992, 224 USPQ 971, 973 (Fed. Cir. 1985), Applicant and the Examining Attorney agree that for an activity to be a "service" within the contemplation of the Act, it (1) must be a real activity, (2) must be performed to the order of, or for the benefit of, someone other than the applicant, and (3) must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service. 6 TTABVUE 12 (Applicant's Brief) (citing TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") Section 1301.01(a) (Oct. 2018)); 8 TTABVUE 4 (Examining Attorney's Brief) (citing *Canadian Pac. Ltd.*; *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB

⁵ May 14, 2018 Requests for Reconsideration at 2-13.

⁶ August 14, 2017 Office Actions at 2-8; March 8, 2018 Final Office Actions at 2-54; June 5, 2018 Denials of Requests for Reconsideration at 2-49.

⁷ June 5, 2018 Denials of Requests for Reconsideration at 50-55.

1984); *In re Integrated Res., Inc.*, 218 USPQ 829 (TTAB 1983), and *In re Landmark Commc'ns, Inc.*, 204 USPQ 692 (TTAB 1979)).

The Examining Attorney “does not deny that the offering and provision of information concerning the purchase and sale of new homes within applicant’s development is a real activity,” and she acknowledges that the “provision of such information is also for the benefit of potential customers.” 8 TTABVUE 5. Accordingly, the only issue on appeal is whether the service identified in the involved applications is qualitatively different from anything necessarily done in connection with the performance of Applicant’s other services.⁸

The Examining Attorney cites TMEP Section 1301.01(a)(iii) and *Landmark Commc'ns* for the proposition that in deciding this issue, we must first “ascertain the nature of the applicant’s principal activity under the mark in question (i.e., the performance of a service or the provision of a tangible product),” and then “determine whether the activity identified in the application is in any material way a different kind of economic activity than what any provider of that particular product or service normally provides.” 8 TTABVUE 5. She argues that it “is reasonable to conclude from the specimens as a whole that SOUTHFACE VILLAGE is the name of a development

⁸ Applicant notes that “the U.S. Patent and Trademark Office Manual of Acceptable Identification of Goods and Services specifically designates the Applicant’s services as an acceptable recitation and the services were approved for publication.” 6 TTABVUE 12. The mere fact that Applicant’s identification of services appears in the Manual does not establish that Applicant is using its marks in connection with a service that is qualitatively different from Applicant’s other services. In that regard, the distinct service described in the approved identification could reasonably be interpreted on its face to apply primarily to entities such as real estate brokers providing “information in the fields of real estate concerning the purchase and sale of new homes and condos” built by others, rather than to developers like Applicant, who build and sell new homes and condos themselves.

and that applicant's principal activity is acting as the developer of this property as well as being the exclusive sales agent for the property." *Id.* She points to a statement made by Applicant during prosecution that its "principle [sic] activity is the development, construction, maintenance and management of a ski resort and all activities associated with it."⁹

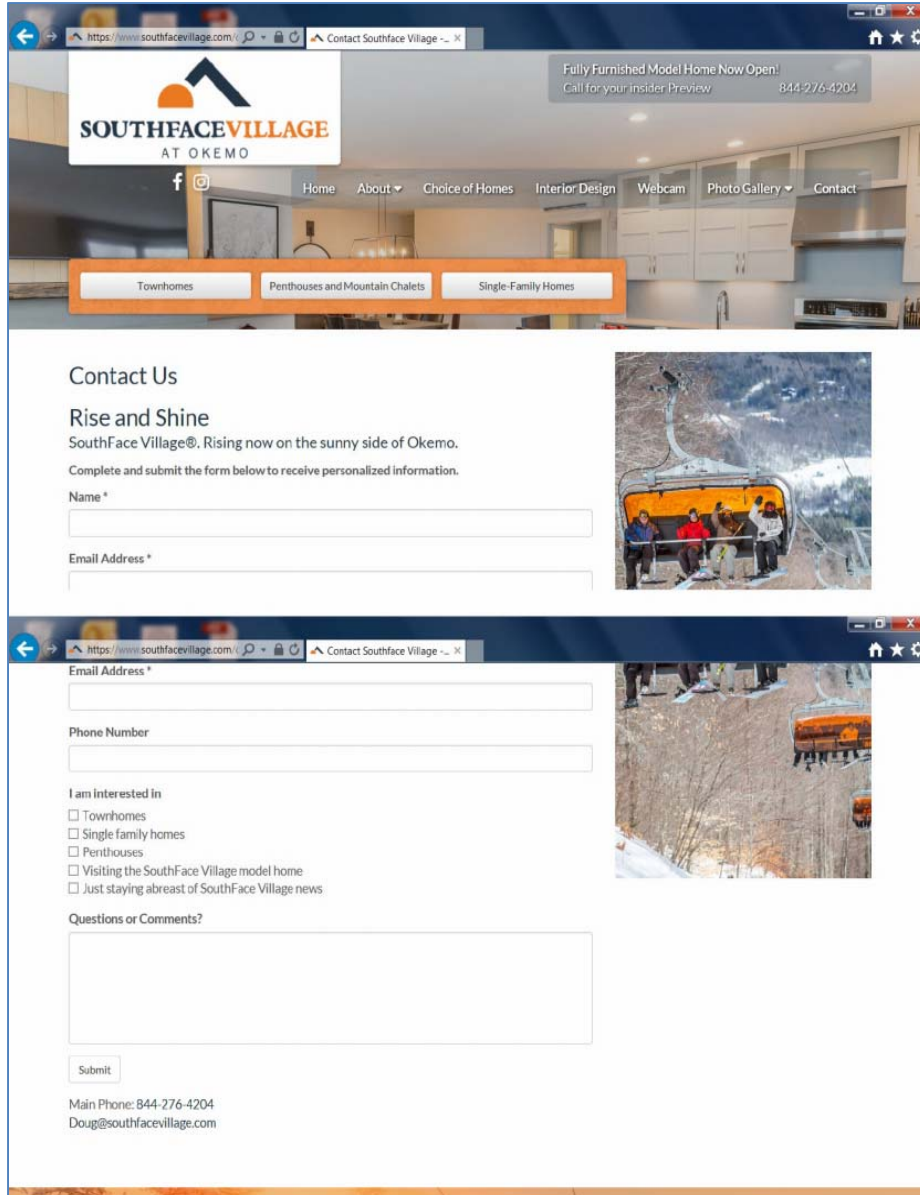
The services in Class 37 that were divided out from the two applications were "building construction; residential and commercial building construction, and construction maintenance and renovation of property." Applicant argues that it "provides a variety of distinct services associated with planning and laying out residential communities for others, and the sale of real estate and homes relating thereto," but claims that those services "go far beyond and above what the average ordinary individual would do in merely constructing and selling a home on a piece of land for [sic] which he has purchased." 6 TTABVUE 12-13. Applicant's acknowledged involvement in "the sale of real estate and homes relating" to its "planning and laying out residential communities for others," *id.* at 12, is reflected in its specimens, both of which are webpages directed to people who are interested in purchasing property in "SouthFace Village," which is described on Applicant's original specimen as "[r]ising now on the sunny side of Okemo."¹⁰

A. Applicant's Original Specimen

Applicant's original webpage specimen is reproduced below:

⁹ February 15, 2018 Responses to Office Actions at 1.

¹⁰ "Okemo" is a mountain in Vermont that is the home of a ski resort. June 5, 2018 Denials of Requests for Reconsideration at 51.



¹¹ July 7, 2017 Statements of Use at 2-3.

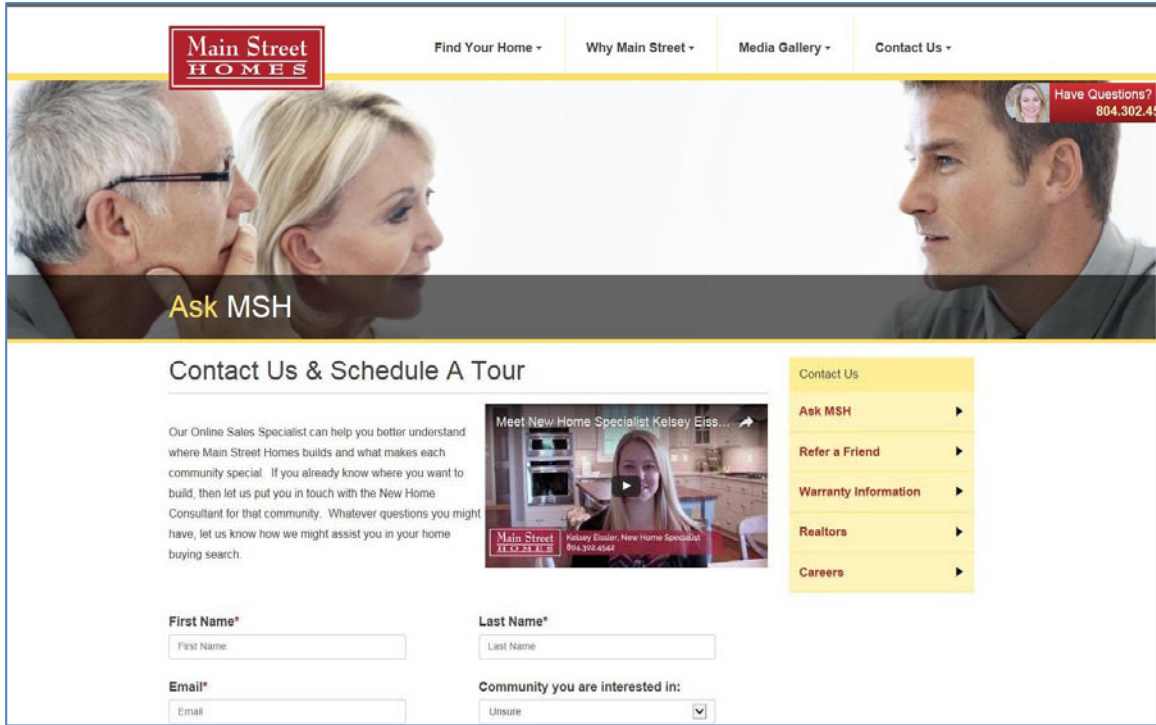
Applicant characterized this specimen as “advertising and promotional material,”¹² and the webpage advertised and promoted properties to be developed by Applicant at SouthFace Village by offering information concerning the purchase and sale of new homes and condos. Applicant’s webpage urged visitors to “Contact Us” and to provide personal information relevant to a possible purchase of property at the development, including information about whether visitors were interested in purchasing townhomes, single-family homes, or penthouses, visiting a SouthFace Village model home,¹³ or simply receiving information regarding the progress of the development.

The Examining Attorney made of record third-party webpages showing that other real property developers, including sellers of resort properties, provide similar online access to information about their developments in the course of selling their properties.¹⁴ One example is reproduced below:

¹² July 7, 2017 Statements of Use at 1.

¹³ The upper right-hand corner of the webpage touted the availability of a “Fully Furnished Model Home Now Open!”, and urged prospective purchasers to “Call for your insider Preview.”

¹⁴ August 14, 2017 Office Actions at 2-9; March 8, 2018 Final Office Actions at 2-19. We may consider “the customs and practices of the industry or business” together with other record evidence in determining whether Applicant’s purported service is qualitatively different from its other services. *Landmark Commc’ns*, 204 USPQ at 695.



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As with Applicant’s specimen, this webpage is directed to visitors engaged in a “home buying search,” and in the course of advertising and promoting homes to be developed, it urges visitors to contact the developer, provide information, and schedule a tour. Applicant’s original specimen is similar in nature and function to this website and to several of the other developer websites in the record.

Applicant’s original specimen makes it clear that Applicant’s “Internet portal offering information in the fields of real estate concerning the purchase and sale of new homes and condos” is a means of advertising and promoting its Class 37 services of “building construction; residential and commercial building construction, and construction maintenance and renovation of property,” which Applicant acknowledges include “the sale of real estate and homes relating thereto.” 6

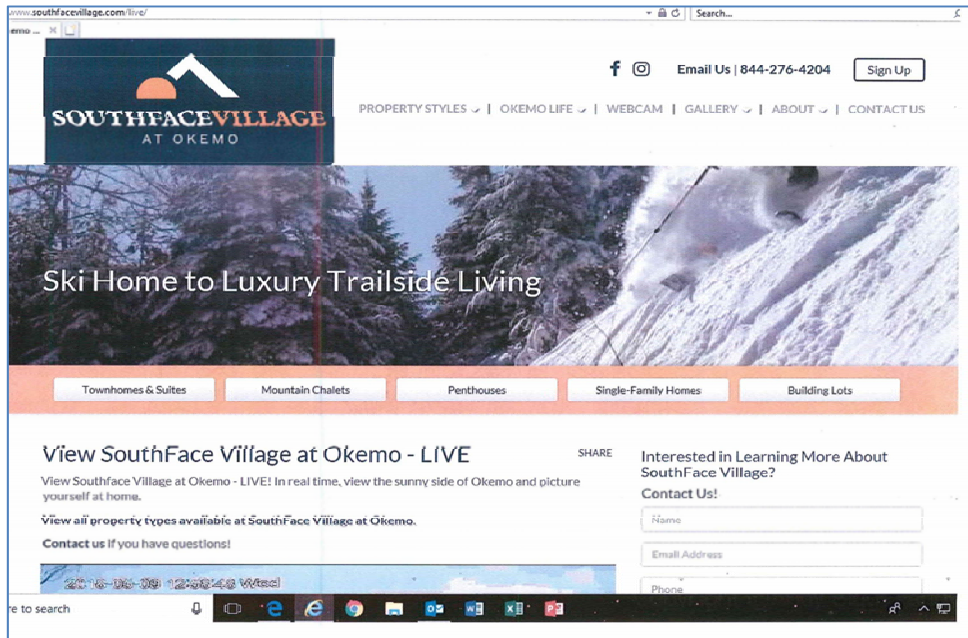
¹⁵ August 14, 2017 Office Action at 2.

TTABVUE 12. Indeed, Applicant could not sell the new homes and condos that it develops at SouthFace Village without “offering information . . . concerning the purchase and sale of” those new homes and condos, and its original specimen shows that its Internet portal is simply a means for providing such information. Applicant’s purported service of “providing an Internet portal offering information in the fields of real estate concerning the purchase and sale of new homes and condos” is thus not a service that is separate and distinct from Applicant’s other services because it is not qualitatively different from anything necessarily done in connection with the performance of those services. *Cf. Landmark Commc’ns*, 204 USPQ at 695 (the mere advertising of one’s own product is not a separate service); *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207, 1209 (Fed. Cir. 1987) (“activities which are ‘necessarily done’ in connection with the sale of one’s goods are the quintessential ‘routine or ordinary’ activities associated with the sale of one’s goods”).

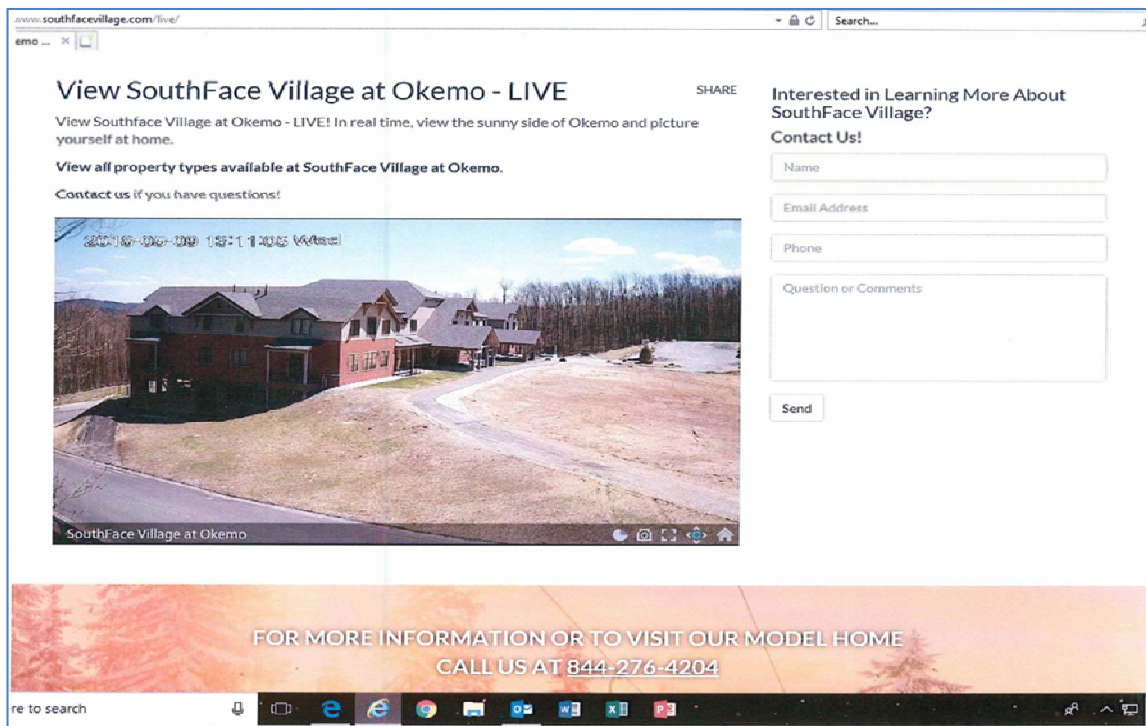
B. Applicant’s Substitute Specimen¹⁶

As noted above, Applicant submitted multiple webpages as part of a substitute specimen as Exhibit A to the Becker Declaration. We reproduce them below:

¹⁶ Like the original specimen, Applicant described the substitute specimen as “advertisement and promotional material.” May 14, 2018 Requests for Reconsideration at 1.



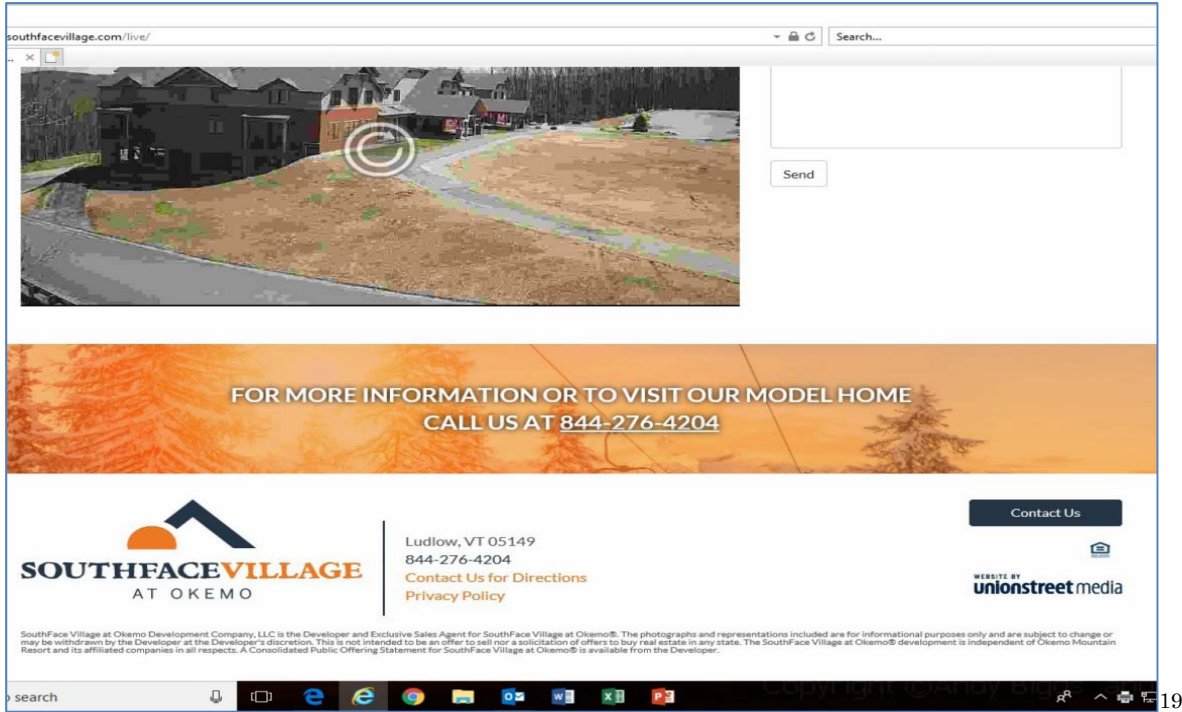
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¹⁷ May 14, 2018 Requests for Reconsideration at 8, 11 (Becker Decl. Ex. A).

¹⁸ *Id.* at 9, 12 (Becker Decl. Ex. A).



These webpages state that visitors to Applicant’s website can “[v]iew all property types available at SouthFace Village at Okemo” in real time. Mr. Becker explained that Applicant’s website features a webcam option that is displayed on the substitute specimen, Becker Decl. at 2,²⁰ and that by using the webcam, a visitor to the website “can view the entire property and specific properties available for sale” and “can monitor the progress of a home being built on the property.” *Id.* He further testified that the website permits direct contact between a salesperson and a user who “has an interest in purchasing or building a home.” *Id.* In its brief, Applicant characterizes the web portal as “a tool used to assist any user with all of [the] services” performed

¹⁹ May 14, 2018 Requests for Reconsideration at 10, 13 (Becker Decl. Ex. A).

²⁰ The Becker Declaration does not contain numbered paragraphs.

by Applicant and its various sub-contractors, and Applicant argues that the substitute specimen is thus not a “mere ‘contact page’” 6 TTABVUE 13.

The Examining Attorney responds that Applicant’s “live webcam provides instant information concerning those properties for sale, such progress of construction and design features of homes being built.” 8 TTABVUE 7. She made of record webpages of companies in various businesses,²¹ including those of real property developers,²² which feature webcams that enable visitors to obtain information about the goods and services provided by the various businesses. We reproduce a portion of one below:



The Examining Attorney argues that these third-party webpages “demonstrate that the provision of links to a webcam, or live pictures from scenes near the location of

²¹ June 5, 2018 Denials of Requests for Reconsideration at 2-55.

²² *Id.* at 30-41, 47-55.

²³ *Id.* at 30. The website of this developer offered “live footage of a few of our projects in progress and under construction.” *Id.* at 31.

the provision of the services, is a common feature of websites that are functioning to provide general information about a company and its offerings.” 8 TTABVUE 6.

Applicant acknowledges that, as a general matter, “[t]he potential consumer or the actual purchaser of Applicant’s homes and condos uses [Applicant’s] internet portal to gain additional information regarding the services performed” by Applicant in the course of developing properties at SouthFace Village. 6 TTABVUE 12. Applicant’s webcam enables such a potential or actual purchaser to “monitor any property or the progress of a home as it is being built on the property.” *Id.* at 6. The substitute specimen thus offers visual, real-time information, rather than dated verbal or written information, regarding the properties available for purchase and the status of properties under development.

Although the information available through the webcam is provided through a different medium, and takes a different form from the information offered through Applicant’s original specimen, the webcam information available through Applicant’s substitute specimen is similarly used to advertise and promote the sale of properties to prospective purchasers, or in the course of rendering Applicant’s development services. We agree with the Examining Attorney that providing such information through the webcam in Applicant’s substitute specimen “is merely ancillary to applicant’s primary business,” and “part and parcel of developing and offering [Applicant’s] homes for sale.” 8 TTABVUE 7. Like Applicant’s original specimen, its substitute specimen does not show that its purported service of “providing an Internet portal offering information in the fields of real estate concerning the purchase and

sale of new homes and condos” is qualitatively different from anything necessarily done in connection with the performance of Applicant’s other services.

Decision: The refusals to register are affirmed.