

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Linguistique et Intelligence : BEFORE THE  
Artificielle (dba Lidia S.A.)  
Trademark: LIDIA RETRIEVER : TRADEMARK TRIAL  
Serial No: 75980776 : AND  
Attorney: Fritz L. Schweitzer, Jr. : APPEAL BOARD  
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DEC 30 2002

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant, Linguistique et Intelligence Artificielle, (dba Lidia S.A.) (hereinafter "Lidia S.A."), has appealed the trademark examining attorney's refusal to register the mark LIDIA RETRIEVER on the ground that the specimens are unacceptable as evidence of actual service mark use in connection with consultation services. It is respectfully requested that the refusal be affirmed.

**STATEMENT OF FACTS**

On December 29, 1998, Lidia S.A. filed an application to register the mark LIDIA RETRIEVER for use in connection with its business consultation directed to the research and scientific analysis of the syntax of written and verbal communications, with particular regard to discerning the main ideas of such communications and their associated ideas, especially to enable intelligent indexing of such communications. On July 3, 2001, the examining attorney refused registration on the ground that the specimens accompanying Applicant's statement of use

are unacceptable as evidence of service mark use. TMEP section 1301.04 et seq.; 37 C.F.R. Sections 2.56 and 2.58.

In a response received on July 31, 2001, the applicant traversed the refusal, arguing that the specimen submitted was in fact the principle vehicle used by Applicant in solicitation of services that are the subject of this application. The examining attorney found this argument unpersuasive.

On February 21, 2002, the examining attorney issued a Final Office Action. On September 4, 2002, the Applicant filed a notice of appeal.

### ISSUE

WHETHER THE SPECIMENS SUBMITTED ARE UNACCEPTABLE AS EVIDENCE OF ACTUAL SERVICE MARK USE SUCH THAT THE REFUSAL TO REGISTER IS PROPER.

### ARGUMENTS

To show service mark usage, the specimens must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identified only a process held not registrable as service mark, even though applicant was rendering services and the services were advertised in the same brochure in which the name of the process was used); *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimens, found to identify the applicant's ratings instead of its rating services); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977) (use of mark as one of many pictures in applicant's brochure would not be perceived as an indication of the source of the services); *Intermed*

*Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) (business progress reports directed to potential investors do not show service mark use for medical services); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not identify franchising services); *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970) (technical bulletins and data sheets on which mark was used merely to advertise chemicals do not show use as a service mark for consulting services).

Where the mark is used in advertising the services, the specimen must show an association between the mark and the services for which registration is sought. **A specimen that shows only the mark, with no reference to the services, does not show service mark usage.** *In re Adair*, 45 USPQ2d 1211 (TTAB 1997) (tags affixed to decorated Christmas tree that bear the mark "TREE ARTS CO. and design" and the applicant's location, but make no reference to services, fail to show use for "design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees"); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994) (labels affixed to packaging of valves do not show use of mark for custom manufacture of valves); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (bumper stickers showing only the mark do not show use to identify "association services, namely promoting the interests of individuals who censor the practice of drinking and driving"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (cutouts showing mark with no reference to the services held unacceptable for automotive service center); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (iron-on transfer clothing patches in the form and shape of a cartoon animal mark, distributed as free promotional items to restaurant customers at counters, held insufficient to identify restaurant services). *See also* TMEP §1301.04(c) and cases cited therein.

Here, the specimens do not show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's consultation services and indicating their

source. In fact, the examiner finds no reference to any services provided by Lidia S.A. for the benefit of others. Therefore, the consumer can make no reasonable association between the mark and consultation services.

The examiner refers to Applicant's specimen of use which contains the following statements:

**"Retriever lets you identify** evolving trends more quickly and accurately, demonstrating to your customers that you are really listening to them".

**"Only Lidia Retriever allows you to work with large qualitative databanks,** to access and evaluate all the ideas expressed, and to segment these ideas based on the strength of their relationship to the dynamic/search ideas."

**"By identifying the ideas that are essential to a respondent's point of view, it prioritizes the ideas that are most important to your customers"**.

**"A sophisticated computer model scientifically analyses text by its syntax...."**

The excerpted statements above specifically refer to LIDIA RETRIEVER as a product rather than as a person, persons or entity engaged in the provision of consultation services. To further support this conclusion the examiner notes the following statements featured on the same specimen:

**"Based on the Lidia methodology, three different Linguistwares programs** have been developed. **In addition to RETRIEVER,** LIDA DISCOVERER, analyses incoming communication... LIDIA ANAGOGE, helps ensure that your out-going communication is efficient in all written and verbal forms."

**"Through an exclusive licensing agreement** with Lidia SYNTAX Corp., the Lidia methodology is available in North America and the Caribbean, in most major languages."

These statements contradict Applicant's assertions that it does not sell or license software in connection with the LIDIA RETRIEVER mark (See Applicant's brief, pg. 4). The above referenced excerpts state specifically that RETRIEVER is one of three software programs

employing the Lidia methodology – LIDIA RETRIEVER, LIDIA DISCOVERER, and LIDIA ANAGOGE. Considering these specific references to “programs” in conjunction with small print statements near the bottom of Applicant’s specimen referencing a licensing agreement between Applicant and Lidia SYNTAX, it is difficult to fully appreciate Applicant’s position.

The applicant argues that “the Examiner has erred in taking the position that because Applicant refers to the use of computer software in providing its services, and that Applicant’s mark is part of its ‘methodology’, LIDIA RETRIEVER is used solely in association with computer software or a process in connection therewith.” The examining attorney does not conclude that in reality the mark in question is used solely in connection with computer software. The examiner’s position is that the specimens of record do not show use of the LIDIA RETRIEVER mark in connection with the promotion of consultation services.

Finally, the applicant argues that it is well established that “a term used to identify both a process and the services rendered in connection therewith constitutes a service mark within the meaning of the Trademark Act”. The applicant references the decision rendered by the Board in *In re Stafford Printers, Inc.*, 153 U.S.P.Q. 428 concluding; “that the term ‘process’ is used on the specimen does not ipso facto mean that an arbitrary mark used in conjunction therewith designates a process and not more.” The examiner does not dispute this principal as it relates to the facts of the cited case. However, the facts of the subject application and the referenced case are clearly distinguishable. The mark for which registration is sought does not reference the provision of consultation services, whereas the mark in *In re Stafford Printers, Inc.*, “**PRINTED BY STAFFORDBLEND PROCESS**” [emphasis added], specifically names printing services in addition to the process used in the printing of textiles.

CONCLUSION

The specimens of use are unacceptable as evidence of service mark use. For the foregoing reasons, the examining attorney respectfully requests that the refusal to register be affirmed.

Respectfully submitted,



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