This Opinion is not a Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Republic National LLC

Serial No. 86513101

Theodore R. Remaklus of Wood Herron & Evans LLP,
for Republic National LLC.

Edward Nelson, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

Before Kuhlke, Gorowitz and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Republic National LLC ("Applicant") seeks registration on the Principal Register of the mark REPUBLIC NATIONAL (in standard characters) for the following services:

> Real estate investment and acquisition services, namely, brokerage and management of retail shopping centers, strip centers, office buildings, residential buildings, mixed-use commercial and residential buildings, and hotels; banking and financing services; investment banking services; mortgage banking; on-line banking services; financing and loan services; financing of real estate development projects, in International Class 36; and

> Real estate development services, in International Class 37.[1]

The Trademark Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127. The refusal pertains to both classes of identified services and is based on the failure of the specimens to show use of the mark in connection with the identified services.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

Failure to Show Use of the Mark for the Identified Services

Section 1(d)(1) of the Trademark Act, 15 U.S.C. § 1051(d)(1), provides that in an intent-to-use application such as Applicant's, a timely statement of use must be filed with the requisite specimen(s) of the mark as used in commerce. According to Trademark Act Section 45, 15 U.S.C. § 1127, a service mark is used in commerce "when it is used or displayed in the sale or advertising of services." *See also* 37 C.F.R. § 2.56(b)(2). Such use may be established by: (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed as a service mark in advertising the services, which encompasses marketing and

[1] Application Serial No. 86513101, filed on January 23, 2015, based on an allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant filed its Statement of Use on February 4, 2016, claiming January 2015 as both the date of first use and the date of first use in commerce.

promotional materials. *See In re Way Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016). An acceptable specimen must show "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 (CCPA 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, 1214-15 (TTAB 1997); *In re Duratech Industries Inc.,* 13 USPQ2d 2052, 2054 (TTAB 1989). "For specimens showing the mark in advertising the services, '[i]n order to create the required '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.'" *Way Media*, 118 USPQ2d at 1698 (quoting *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010)). Specimens showing the mark used in rendering the identified services need not explicitly refer to those services in order to establish the requisite direct association between the mark and the services, but "there must be something which creates in the mind of the purchaser an association between the mark and the service activity." *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994).

In its Statement of Use, Applicant submitted, as its specimens of use, the following two digital photographs, which it states is of the front door of the facility where it provides and manages its services:

Applicant contends that the specimens it submitted with its Statement of Use displays use of its REPUBLIC NATIONAL mark as it appears on the entry door to Applicant's offices. Applicant further maintains that "there is no question that Applicant's customers would recognize REPUBLIC NATIONAL, as it appears on the entryway, as a mark identifying the services that are provided by Applicant at that office" and, therefore, "the photographs of the door to Applicant's offices constitute a specimen of the mark as use in the sale of the services."[2] Moreover, Applicant argues that its submitted specimens demonstrate how its mark is used in connection with providing its services, rather than advertising its services and, therefore, the specimens need not include an explicit reference to Applicant's services.[3] In support of its contentions, Applicant relies on the Board's decision in *In re Metriplex* ("Metriplex"), 23 USPQ2d 1315 (TTAB 1992).

Applicant's arguments are unavailing and its reliance on the Board's *Metriplex* decision is misplaced.

[2] Applicant's Appeal Brief at p. 7, 4 TTABVUE 11.

[3] Applicant's March 30, 2016, Office Action response.

Specimens consisting of advertising of the services must disclose the nature of the services to create an association between the mark and the services. Here, the front door of Applicant's business establishment that displays its mark does not reference or create a direct association with the services. In addition, displaying the mark on the front door is not using it in the rendering of Applicant's identified services. The front door embossed with Applicant's REPUBLIC NATIONAL mark is not providing real estate investment and acquisition services, banking and financing services or real estate development services; rather, the front office door of Applicant's business establishment that is imprinted with the REPUBLIC NATIONAL mark, beyond merely directing an existing client to Applicant's location, is more similar to advertising and without some reference to the services. In other words, while it may indicate the location of a particular entity, it is unconnected to any service, at least without prior knowledge of an existing client. Therefore, the issue is not resolved by the statement in Applicant's Statement of Use because it does not resolve the question of whether ***potential*** consumers associate the mark with the services. Absent some reference to the nature of the services on the front door, it does not associate the mark with the applied for services and therefore is not sufficient to support the application for registration. Upon seeing this mark displayed on the front door of Applicant's place of business, a potential consumer could not immediately identify the services being provided beyond the entryway of Applicant's offices. In other words, the fact that services are rendered within Applicant's offices is not

sufficient association or "proximity" to consider the REPUBLIC NATIONAL mark, as shown on the front door, as being displayed in the sale or rending of services.

Contrary to Applicant's arguments, the circumstances here are unlike those addressed in the Board's decision in *Metriplex*. In *Metriplex*, the applicant sought to register the mark GLOBAL GATEWAY for the transmission of data in various fields (commercial as well as personal) to subscribers to the service by means of information entry software, radio data transmission and portable terminal interface with such subscribers. *Metriplex*, 23 USPQ2d at 1316. As its specimens of use, the applicant submitted a computer screen display that appeared on a computer terminal in the course of applicant's rendering of the service. *Id*. Registration was refused by the Examining Attorney on the basis that the specimens submitted by applicant were unacceptable as evidence of actual service mark use because they did not refer to the services identified in the application. *Id*. In reversing the Examining Attorney's refusal, the Board found that the applicant's services were rendered "through a tangible item, namely, a computer terminal, so that the mark can appear on the computer screen, and the specimens show such use." *Id*. at 1317. The Board further held that "[b]ecause the specimens show use of the mark in the rendering or selling of applicant's services, not in the advertising thereof, the requirements specific to specimens which are advertising are not applicable." *Id*.

Thus, the holding in the *Metriplex* decision is inapposite here where the front door of Applicant's business establishment that displays Applicant's REPUBLIC NATIONAL mark does not, in and of itself, render Applicant's services as the

computer was providing data transmission services at the time that mark was displayed in *Metriplex*. Instead, Applicant's front door more is more similar to an advertisement of Applicant's identified services. As such, the requirements for specimens which are advertisements, i.e., the specimens 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, are applicable here. [4]

Moreover, as displayed, Applicant's mark could also function as Applicant's trade name or a source indicator for a myriad of undisclosed services. *See In re Advertising and Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) ("It is not enough for the applicant to be a provider of services; the applicant also must have used the mark to identify the named services for which registration is sought."); *see also* TMEP §1202.01 (January 2017) (The name of a business or company name is a trade name and the Trademark Act does not provide for registration of trade names). To the extent that Applicant's existing customers already know that it is Applicant's mark does not mean that Applicant's front door signage itself is what created that

[4] In its Request for Reconsideration and in further support of its argument that the specimens it has submitted demonstrate service mark usage, Applicant also relies on the Board's unpublished decision in *In Re Ames Department Stores, Inc.*, 2000 WL 1720157 (TTAB November 2, 2000). *See* Applicant's August 23, 2016, Request for Reconsideration. Although Board policy allows citation of all Board decisions, a decision designated as not precedential is not binding upon the TTAB. *In re Luxuria s.r.o*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011); TBMP § 101.03 (January 2017). Since they have no precedential effect, the Board will generally not discuss them in other decisions. We therefore see no need to discuss that case in this opinion. We also point out that, although Applicant has quoted the Board's discussion of the specimens that were submitted in the *Ames* case, that evidence is not of record herein, and the quotation of what the Board stated about those specimens has not been given any evidentiary weight in our determination herein.

association, or in other words, served as the source identifier. The fact that signage on an entry door can be a normal commercial use of a mark does not mean that words used on the front door of a business establishment are a mark associated with certain services rather than, for example merely a trade name, without, at a minimum, creating an association with the services.

In view of the above, we find that Applicant's specimens do not serve to show use of the mark REPUBLIC NATIONAL as a service mark in connection with the services identified in the application.

Decision: The refusal to register under Sections 1 and 45 of the Trademark Act is affirmed.