

This Opinion is Not a  
Precedent of the TTAB

Mailed: March 27, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Bear Omnimedia LLC*  
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Serial No. 87009944  
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S. Wolfe Thompson of Wolfe Thompson PS,  
for Bear Omnimedia LLC.

Eugenia K. Martin, Trademark Examining Attorney, Law Office 114,  
K. Margaret Le, Managing Attorney.

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Before Taylor, Masiello, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Bear Omnimedia LLC (“Applicant”) seeks registration on the Principal Register of the mark BEARPLAY in standard characters for services identified in the application, as amended, as “magazine publishing; publication of entertainment magazines for gay men,” in International Class 41.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87009944 was filed on April 21, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claim of first use of the mark and first use in commerce at least as early as May 27, 2011.

The Trademark Examining Attorney has refused registration of the mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, on the ground that Applicant's specimen of use does not show use of the mark in commerce in connection with the identified services. After the Examining Attorney made the refusal final, Applicant requested reconsideration, which was denied. The case is fully briefed. We affirm the refusal to register.

### **I. Prosecution History and Record on Appeal**

Much of the prosecution of this application involved the issues of whether Applicant's claimed mark was "merely descriptive" of the identified services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and whether Applicant's claimed mark had acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Those issues are not before us on appeal. In the office action making final the refusal to register, the Examining Attorney stated that the mere descriptiveness refusal had been obviated because Applicant had made a sufficient showing of acquired distinctiveness.<sup>2</sup>

With respect to the issue on appeal, Applicant described the original specimen submitted with its application as the "[c]over of [a] magazine showing the mark." In the first Office Action, the Examining Attorney refused registration on the ground that the identified services were "magazine publishing," but that on the submitted

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<sup>2</sup> July 18, 2017 Office Action at 1. Applicant nevertheless devoted virtually all of its main appeal brief to a discussion of these issues. 4 TTABVUE 6-20. Applicant's only substantive discussion of the sufficiency of its specimens is in its reply brief. 6 TTABVUE 5-8.

specimen, “the mark is only shown in use as the title of a publication.”<sup>3</sup> Applicant purported “to meet [the] Specimen Required Refusal” by seeking to amend its application to identify its services as follows:

Entertainment in the nature of visual and audio performances, namely, theatrical performances; entertainment, namely a continuing musical, variety, news, and dramatic shows broadcast; providing entertainment information in the field of adult entertainment at the specific request of end-users by means of telephone or global communications networks; entertainment services, namely, providing on-line adult entertainment information for adults; organizing community cultural events; electronic publication of text and graphic works recorded on electronic media, including, CD, DVD and online featuring adult entertainment; organizing exhibitions of erotic entertainment of interest to adults; and publication of entertainment magazines for men.<sup>4</sup>

In a second Office Action, the Examining Attorney rejected the proposed amendment to the identification of services because it exceeded the scope of the services identified in the application, and maintained and continued the specimen refusal.<sup>5</sup> Applicant responded by again seeking to amend the identification, this time to “Magazine publishing, namely, providing on-line adult entertainment information for gay adults including online featuring of adult entertainment,” and by submitting a substitute specimen consisting of another magazine cover.<sup>6</sup>

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<sup>3</sup> August 10, 2016 Office Action at 1.

<sup>4</sup> September 22, 2016 Response to Office Action at 5.

<sup>5</sup> February 18, 2017 Office Action at 1.

<sup>6</sup> April 27, 2017 Response to Office Action at 15-16.

In the Office Action making final the specimen refusal, the Examining Attorney again rejected the proposed amendment because it exceeded the scope of the services identified in the application, and suggested that Applicant amend its identification to “magazine publishing; publication of entertainment magazines for gay men,” if accurate.<sup>7</sup> She rejected Applicant’s specimen because “the services are identified as magazine publishing, but the mark is not shown in use for these services” but rather “as the title of the applicant’s magazine, [which] does not identify the publisher of the magazine.”<sup>8</sup>

Applicant filed a Request for Reconsideration in which Applicant adopted the Examining Attorney’s suggested identification of services,<sup>9</sup> and submitted additional claimed specimens consisting of magazine covers, internal magazine pages, and photographs.<sup>10</sup> Applicant argued that its “[i]dentification of ‘services’ . . . should actually be ‘products’” and that its “goods are specifically identified by the mark which the examining attorney calls a ‘title.’”<sup>11</sup> Applicant stated that “[i]n fact, applicant publishes products, namely a ‘Presentation of works of visual art or literature to the public for cultural or education purposes.’”<sup>12</sup> The Examining Attorney accepted the

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<sup>7</sup> July 18, 2017 Office Action at 1.

<sup>8</sup> *Id.*

<sup>9</sup> July 18, 2017 Request for Reconsideration at 1.

<sup>10</sup> *Id.* at 2-34.

<sup>11</sup> *Id.* at 1.

<sup>12</sup> *Id.*

amendment to the identification of services, but denied the request for reconsideration regarding the specimen refusal.<sup>13</sup>

## II. Specimen Refusal

A use-based application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), must be supported by a “specimen showing how the applicant uses the mark in commerce. . .” 37 C.F.R. § 2.34(a)(1)(iv).

Applicant seeks registration of BEARPLAY for the services of “magazine publishing; publication of entertainment magazines for gay men.” A service mark is deemed to be in use in commerce “when it is used or displayed in the sale or advertising of the services” and “the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.” 15 U.S.C. § 1127. The specimens of use of a service mark “must show an association between the mark and the services.” *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876 (TTAB 2017). An acceptable service mark specimen “must show the mark sought to be registered used in a manner that demonstrates a direct association between the mark and the services. Essentially, the mark must be shown in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source.” *Id.* (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1301.04(f)). A service mark “must be ‘used in such a manner that it would readily be perceived as identifying’ the services,

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<sup>13</sup> September 11, 2017 Denial of Request for Reconsideration at 1.

which is ‘determined by examining the specimens of record in the application.’” *Id.* (quoting *In re Moody’s Investors Serv. Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989)).

As discussed above, during prosecution Applicant submitted multiple purported specimens consisting of covers of, and pages from, volumes of an adult magazine directed to gay men entitled BEARPLAY. The applied-for mark appears on the cover of the magazine and at the bottom of pages next to the page number.

The Examining Attorney notes that Applicant claimed during prosecution that it produces products, not services, and that Applicant “has not applied for a trademark for goods such as magazines or online publications.” 7 TTABVUE 4. She argues that Applicant “has applied for a service mark for magazine publishing services” and that the “resulting products are the publications, but use of the mark as the title of the publications does not show the mark in use with the services listed in the application.” *Id.* She further argues that it “is well established that a term that is used only to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark,” and concludes that “the mark BEARPLAY is used only to identify the title of the product produced by the applicant” and that “[b]ecause the mark only identifies the products produced, the specimens do not show use of the mark in commerce.” *Id.*

Applicant makes several arguments in response in its reply brief, but none of them squarely addresses the relevant amended identification of services: “magazine publishing; publication of entertainment magazines for gay men.” First, Applicant argues that its magazine covers “clearly show applicant’s Proposed description of

goods and services, namely: Magazine publishing, namely, providing on-line adult entertainment information for gay adults including online featuring of adult entertainment; and publication of entertainment magazines for gay men.” 6 TTABVue 5. As noted above, the Examining Attorney declined to permit amendment to the referenced “Proposed description of goods and services” during prosecution because that description exceeded the scope of the original identification of services.<sup>14</sup>

Second, Applicant argues that none of the 45 International Classes “specifically mention ‘magazine’ or ‘publication’ or ‘publishing,’” and that the class description for Class 41 comes closest to what Applicant claims it does, which is to “publish[] BEARPLAY ‘to entertain or to engage the attention of others’ particularly ‘on-line adult entertainment information for gay adults including online featuring of adult entertainment.’” *Id.* at 5-6.<sup>15</sup> Applicant’s identification of services does not cover providing on-line adult information for gay adults.

Third, Applicant correctly states that to “be registrable as a service mark, the asserted mark must function both to identify the services recited in the application and distinguish them from the services of others, and to indicate the source of the recited services, even if that source is unknown.” *Id.* at 6. Applicant argues that “the specimens for service [sic] show use of the mark ‘in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their

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<sup>14</sup> July 18, 2017 Office Action at 1.

<sup>15</sup> This description of the services that fall within International Class 41 appears in TMEP Section 1401.02(a).

source,” *id.* (quoting *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008)),<sup>16</sup> because the “specimens submitted here correctly shows [sic] the mark BEARPLAY used specifically for ‘on-line adult entertainment information for gay adults including online featuring of adult entertainment.” *Id.* at 7. These arguments again do not address Applicant’s actual identification of services.

Finally, Applicant argues that the magazine “BEARPLAY also includes informational services ancillary and important to gay men, like HIV awareness” and that the “mark is also used for publication of advertisements of interest to gay men.” *Id.* The record is devoid of evidence to support either claim, but the identification of services does not cover either purported service in any event.

The services identified in the application are “magazine publishing” and “publication of entertainment magazines for gay men,” while the specimens of use are covers and pages from Applicant’s own magazine. As explained in the TMEP, the “publication of one’s own periodical is not a service, because it is done primarily for applicant’s own benefit and not for the benefit of others.” TMEP Section 1301.01(b)(iii) (Oct. 2017) (citing *In re Billfish Int’l Corp.*, 229 USPQ 152 (TTAB 1986); *In re Alaska Nw. Publ’g Co.*, 212 USPQ 316 (TTAB 1981); *In re Landmark Commc’ns, Inc.*, 204 USPQ 692 (TTAB 1979), and *In re Television Digest, Inc.*, 169 USPQ 505 (TTAB 1971)). Magazine publishing services must be rendered for the benefit of someone other than the publisher of the magazine. *Alaska Nw. Publ’g Co.*,

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<sup>16</sup> None of the cases cited by Applicant in support of any its arguments involved publishing services.



212 USPQ at 317. The magazine cover specimens submitted by Applicant may support registration of BEARPLAY in Class 16 as a trademark for magazines (which Applicant described during prosecution as its “goods [that] are specifically identified by the mark which the examining attorney calls a ‘title’”),<sup>17</sup> but they do not show an association between the mark and the services of “magazine publishing” or the “publication of entertainment magazines for gay men” for others. *Keep A Breast Found.*, 123 USPQ2d at 1876; *see also Alaska Nw. Publ’g Co.*, 212 USPQ at 317 (affirming refusal to register the title of a section of a magazine published by applicant as a service mark for magazine publishing services). They thus do not show use of the claimed mark in commerce in connection with the services identified in the application.

**Decision:** The refusal to register is affirmed.

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<sup>17</sup> July18, 2017 Request for Reconsideration at 1.