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 Finlistics Solutions Corp.

Serial No. 87722652

Jeffrey J. Schwartz of Schwartz Law Firm, P.C., for Finlistics Solutions Corp.

Crystal Yi, Trademark Examining Attorney, Law Office 123, Susan Hayash, Managing Attorney.

Before Thurmon, Deputy Chief Administrative Trademark Judge, Wolfson and Dunn, Administrative Trademark Judges.

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

Finlistics Solutions Corp. ("Applicant") seeks registration of the mark FINLISTICS CLIENTIQ for "Business development consulting services, namely, providing temporary use of non-downloadable software for analyzing, calculating, measuring, modeling, and forecasting business and financial performance," in International Class 42.[1]

The Examining Attorney refused registration under Sections 1 and 45, 15 U.S.C. §§1051, 1127, because the specimen "does not show a direct association between the

[1] Application Serial Number 87722652, filed December 15, 2017 based on an alleged use in commerce at least as early as August 1, 2016. 15 U.S.C. § 1051(a).

applied-for mark and the identified services; thus the specimen fails to show the applied-for mark in use in commerce…."[2] Applicant never addressed the specimen refusal, and for that reason, we dismiss the appeal.

I. The Prosecution Record

The Examining Attorney raised three issues in the first Office Action:[3]

- registration was refused under Section 2(d);
- registration was refused under Section 1 and 45 because the specimen did not show use of the mark in commerce; and
- Applicant was required to amend the classification and identification of the services.

Applicant responded to the Office Action by amending the services and by arguing that confusion was not likely.[4] Applicant did not request reconsideration or respond to the specimen refusal under Sections 1 and 45. The Examining Attorney accepted the amended identification of services and issued a final likelihood of confusion refusal under Section 2(d) and under Sections 1 and 45. *See* Trademark Manual of Examining Procedure (TMEP) §713.02, 718.03 (2019).

Applicant filed this appeal on April 9, 2019. No request for reconsideration was filed. In its Appeal Brief, Applicant addressed only the likelihood of confusion refusal under Section 2(d), and did not respond to the specimen refusal under Sections 1 and

[2] Office Action dated March 27, 2018 at TSDR 4. The Examining Attorney also refused registration under Section 2(d), 15 U.S.C. § 1052(d), but we do not reach that refusal.

[3] *Id.*

[4] Response to Office Action dated September 27, 2018.

45. The Examining Attorney addressed both refusals in her brief. No reply brief was filed.

II. Dismissal for Failure to Prosecute

We dismiss the appeal due to Applicant's complete failure to respond to the specimen refusal. Applicant had four potential opportunities to respond to this refusal. First, it could have (and should have) addressed this refusal in its response to the first Office Action. Second, it could have filed a request for reconsideration after the final Office Action and addressed the specimen refusal in the request. Third, Applicant could have (and should have) addressed the specimen refusal in its Appeal Brief. Fourth, after seeing the Examining Attorney raise the specimen refusal in her Appeal Brief, Applicant could have filed a reply brief to respond to the specimen refusal.[5] "[B]ecause Applicant failed to address the [specimen refusal] both before the Examining Attorney and in its appeal brief, dismissal of the appeal is appropriate." *In re Rainier Ent.,* 2019 USPQ2d 463361, *3 (TTAB 2019).

III. The Specimen Does Not Show Service Mark Use in Commerce

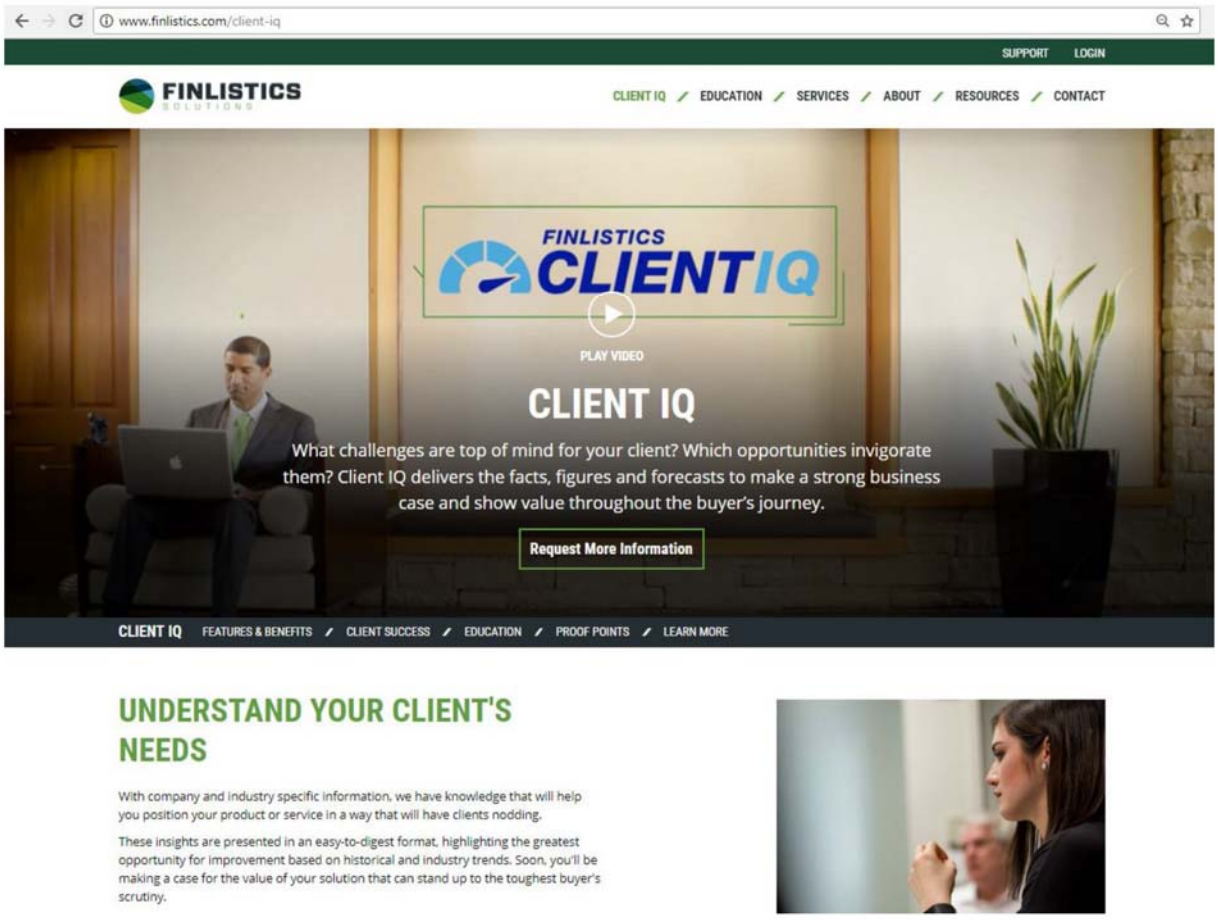
Because we dismiss the appeal for Applicant's failure to address the specimen refusal, we need not address the merits of the refusal. However, for sake of completeness, we discuss the specimen refusal below. As noted, we do not consider the Section 2(d) refusal.

[5] We are not suggesting that a single response to the refusal **in a reply brief** would be sufficient. Such an eleventh-hour attempt to respond to an issue raised from the beginning of prosecution would be questionable, but that issue is not before us. We merely note that Applicant never responded to the specimen refusal, even though it was clearly presented by the Examining Attorney three distinct times during the prosecution and appeal of this application.

A service mark is used "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce…" 15 U.S.C. § 1127. The application identifies "Business development consulting services, namely, providing temporary use of non-downloadable software for analyzing, calculating, measuring, modeling, and forecasting business and financial performance."[6] Applicant filed a use-based application, which requires evidence of service mark use in commerce on or before the filing date. 15 U.S.C. § 1051(a); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042 (Fed. Cir. 2015); Trademark Rule 2.34(a)(1)(iv), 37 C.F.R. § 2.34(a)(1)(iv).

The sole evidence of use submitted by Applicant was the specimen shown below. This specimen displays the FINLISTICS CLIENTIQ mark, but it is not clear what services are being promoted. There is a reference to delivery of "facts, figures and forecasts to make a strong business case and show value throughout the buyer's journey," but that statement is too ambiguous to support the recitation, as can be seen below.

[6] Application Serial No. 87722652.



To constitute a valid specimen, the item must clearly show use of the mark in the "sale or advertising" of at least some of the services identified in the application. 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 promotional materials. *In re WAY Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016) (citing *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316-17 (TTAB 1992) (an acceptable specimen need not

explicitly refer to the services if it "show[s] use of the mark in the rendering, i.e., sale, of the services")).

Although the specimen at issue here appears to promote some services, it does not promote the recited services. There is a heading titled "UNDERSTAND YOUR CLIENT'S NEEDS" and under this heading is the following text:

> With company and industry specific information, we have knowledge that will help you position your product or service in a way that will have clients nodding.
>
> These insights are presented in an easy-to-digest format, highlighting the greatest opportunity for improvement based on historical and industry trends. Soon, you'll be making a case for the value of your solution that can stand up to the toughest buyer's scrutiny.

There are references to clients and buyers in the specimen, but nothing clearly identifies the provision of non-downloadable software relating to business or financial performance. Accordingly, we find this specimen fails to show a direct connection between the FINLISTICS CLIENTIQ mark and the services identified in the application.

The application lists "analyzing, calculating, measuring, modeling, and forecasting business and financial performance" as features of the non-downloadable software through which Applicant's consulting services are offered. Taking this identification together with the specimen, we read the application as referring to software used via the Internet to provide business consultation services that include the specific types of actions listed above. The specimen makes no direct mention of software for taking any of these actions, though it does suggest that at least some

type of analysis will be performed. The specimen refers in only the most general way to the services identified in the application. That is not sufficient.

In addition, the specimen at issue here does not show the rendering of any services. At most, it advertises or promotes services, though as we note above, it isn't clear what exactly those services are. The rules applicable to uses of a service mark in connection with the actual rendering of the services are of no relevance here because the specimen does not show the services being rendered.

We find the specimen too vague to constitute a valid service mark use in the advertising or promotion of the services. We further find the specimen fails to show that the services were actually being rendered when the application was filed. Advertising of services constitutes trademark use only if the services are being rendered at the time. *Couture*, 113 USPQ2d at 2044. The specimen fails to show whether any services were actually rendered on or before the filing date of the application, and therefore, it is insufficient to support this use-based application.

IV. DECISION

The appeal is dismissed and registration to Applicant is refused.