

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: November 4, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re California Highway Patrol

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Application Serial No. 88796327

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Mary E. Coombe of Koeller, Nebeker, Carlson & Haluck, LLP
for California Highway Patrol.

Leah N. Barrett, Trademark Examining Attorney, Law Office 126,
Andrew Lawrence, Managing Attorney.

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Before Bergsman, Shaw, and English,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

California Highway Patrol (“Applicant”) seeks registration on the Principal
Register of the mark MADE FOR MORE (in standard characters) for

(Based on Use in Commerce) Advertisement and publicity services by websites, online digital banner display, social media, print, online search engine, electronic mail, digital video, and digital radio; Digital advertising services; Employment recruiting services; Magazine advertising; On-line advertising on computer networks; Personnel recruitment, in International Class 35; and

(Based on Intent to Use) Advertisement and publicity services by television, radio, mail; Advertisement via mobile phone networks; Advertising by mail order;

Advertising in periodicals, brochures and newspapers; Banner advertising; Cinema advertising; Direct mail advertising services; Electronic billboard advertising; Employment recruiting and staffing services provided via text messaging; Newspaper advertising; Radio advertising; Recruitment and placement of personnel in the field of LAW ENFORCEMENT; Taxi top advertising, in International Class 35.¹

The Examining Attorney refused to register Applicant's mark under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053 and 1127, on the ground that Applicant is not rendering a service within the meaning of the Trademark Act. The Examining Attorney contends Applicant uses MADE FOR MORE as a mark for recruiting its own personnel, and recruiting your own personnel is not a registrable service.

We reproduce below Applicant's specimen of use:



¹ Serial No. 88796327 was filed on February 13, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce and under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant's claim of first use anywhere as of December 6, 2019, and use in commerce as of January 6, 2020.

In the application, Applicant describes the above-noted specimen of use as “a website printout showing the mark used for online and digital advertising, personnel recruitment, employment recruitment, magazine and social media advertising.”

During the prosecution of the application, Applicant explained:

- “The services claimed are in relation to advertisement and recruitment for law enforcement purposes.”²

- “The mark’s purpose is to engage the public in potential career paths and opportunities, with the ability to engage in a career for the greater good of society and to protect one’s fellow citizens. As applied, [Applicant] is the owner of the mark, using the mark for employment and recruiting for law enforcement services.”³

- “The business of [Applicant] is a California state law enforcement agency, with the mission to provide the highest level of safety, service, and security for the general public. The main purpose of the CHP is not for employment or recruitment services, and thus the mark applied for here is separate and qualitatively different from CHP’s principal activity of assuring the safe, convenient and efficient transportation of people and goods on California’s highway system.”⁴

² November 3, 2020 Response to Office Action (TSDR 4).

When we cite to the record, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system by page number in the downloadable .pdf format.

³ *Id.*

⁴ *Id.* at TSDR 5.

I. Preliminary Issue

Applicant, in its November 3, 2020 Response to Office Action, listed six applications for marks for recruiting services purportedly registered for military organizations.⁵

In response, the Examining Attorney noted that Applicant did not properly make the marks of record and further noted that it was unclear whether Applicant was submitting a list of registrations or applications.⁶ The Examining Attorney explained how Applicant should properly submit third-party registrations.⁷

Rather than submit a request for reconsideration to properly submit copies of the third-party registrations, Applicant, in its brief, again listed the six applications for marks for recruiting services for military organizations asserting that the mark have been registered.⁸

The Examining Attorney, in her brief, objects to the list of applications/registrations on the ground that Applicant did not properly submit the applications/registrations.⁹ As noted above, in her November 20, 2020 Office Action,

⁵ November 3, 2020 Response to Office Action (TDSR 5).

⁶ November 20, 2020 Office Action (TSDR 2).

⁷ *Id.* at TSDR 3.

⁸ Applicant's Brief (4 TTABVUE 13-14).

⁹ Examining Attorney's Brief (6 TTABVUE 3-4).

The Examining Attorney also objected to the list of applications/registrations on the ground that the applications/registrations were not timely submitted pursuant to Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). However, because Applicant did not submit copies of any applications/registrations, the objection that the evidence is untimely is moot.

the Examining Attorney explained the requirements for how Applicant may make third-party registrations of record.

Even if these identified marks are registrations, the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record. *See In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018) (citing *In re 1st USA Realty Prof'ls*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974)); TBMP §1208.02; TMEP §710.03.

To make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TBMP §1208.02; TMEP §710.03.¹⁰

As best we understand Applicant's argument in its Reply Brief, Applicant argues that it did not intend to make the third-party applications/registrations of record. Instead, Applicant wanted to bring them to the Examining Attorney's attention to demonstrate that similar entities have registered similar services.¹¹ Applicant also argues that the Examining Attorney did not timely inform Applicant how it should properly submit the third-party registrations.¹²

We sustain the Examining Attorney's objection and we do not consider the list of applications/registrations. First, if Applicant wanted to bring the registrations to the Examining Attorney's attention, it was incumbent on Applicant to make them of record as the Examining Attorney instructed.

¹⁰ November 20, 2020 Office Action (TSDR 3).

¹¹ Applicant's Reply Brief (7 TTABVUE 3).

¹² *Id.* at TSDR 4.

Second, the Examining Attorney timely instructed Applicant how to make the registrations of issue. Applicant first referred to the list of registrations in its November 3, 2020 Response to Office Action. The Examining Attorney, in her November 20, 2020 Office Action, explained how Applicant should make the registrations of record. That Office Action explained that Applicant had six months to exercise one of the following options:

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

- (1) A request for reconsideration that fully resolves all outstanding requirements and refusals;¹³ and/or
- (2) An appeal to the Trademark Trial and Appeal Board with the required filing fees.

TMEP §715.01; see 37 C.F.R. §2.63(b)(1)-(2).¹⁴

Applicant did not file a Request for Reconsideration, rather on May 10, 2021, it filed a Notice of Appeal.

Nevertheless, even were we to overrule the objection and consider the list of applications/registrations, the list of applications/registrations has little, if any, probative value. First, we must consider each application on its own record. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Rodale*

¹³ Under Trademark Rule 2.63(b)(3), 37 C.F.R. § 2.63(b)(3), the applicant may file a request for reconsideration before the deadline for filing an appeal to the Board or petition to the Director. The Request for Reconsideration may include new evidence. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (new evidence may be filed with request for reconsideration).

¹⁴ November 20, 2020 Office Action (TSDR 4).

Inc., 80 USPQ2d 1696, 1700 (TTAB 2006). Even if prior registrations have some characteristics similar to Applicant's application, the USPTO's allowance of registrations is not binding on the Board. *Id.*; *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013); *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009).

Second, Applicant incorrectly contends:

Other public agencies, like Applicant, have applied for, and been granted registration on the Principal Register, marks for recruitment – exactly as applied for by Applicant – and such marks have been deemed valid service marks, owned by those agencies, to recruit for their own agency.¹⁵

The description of services in the third-party registrations include employment counseling, placement, career networking services, employment agency services, and promoting the interests of military personnel with respect to recruitment and retention that based on the description of services the purported registrants render to the benefit of others (i.e., presumably employees).¹⁶ On the other hand, Applicant's description of services includes employment-recruiting services, personnel recruitment, employment recruiting and staffing services, and recruitment and placement of personnel in the field of law enforcement that Applicant performs to fill its employment requirements. Thus, the description of services in the list of applications/registrations is different from the description of services in the application at issue.

¹⁵ Applicant's Brief (4 TTABVUE 13).

¹⁶ Applicant's Brief (4 TTABVUE 13-14).

II. Whether Applicant's description of services are registrable activities.

The issue raised on appeal is whether Applicant's description of services, including employment-recruiting services, personnel recruitment, employment recruiting and staffing services, and recruitment and placement of personnel in the field of law enforcement is a "service" within the meaning of Sections 3 and 45 of the Trademark 15 U.S.C. §§ 1053 and 1127.

Section 3 of the Trademark Act of 1946, 15 U.S.C. § 1053, provides in pertinent part:

Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks used in commerce shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trade-marks....

The provision of Section 45 of the Trademark Act of 1946, 15 U.S.C. § 1127, relating to service marks states:

The term "service mark" means any word, name, symbol, or device, or any combination thereof ... to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of services, even if that source is unknown.

The Trademark "Act provides no definition of a 'service' and the legislative history gives no guidance beyond the general principle that, for the first time, marks of businesses engaged in rendering services ... were made registrable. Further refinement was left to the [USPTO], and to the courts." *In re Dr Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207, 1208 (Fed. Cir. 1987); *In re Canadian Pac. Ltd.*, 754 F.2d 992,

224 USPQ 971, 973 (Fed. Cir. 1985). “No attempt was made to define ‘services’ simply because of the plethora of services that the human mind is capable of conceiving.” *Canadian Pac.*, 224 USPQ at 973 (quoting *Am. Int’l Reinsurance Co. v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69, 71 (CCPA), *cert. denied*, 439 U.S. 866 (1978)). Thus, “services” is a term of “broad scope.” *In re Advertising & Mktg. Dev., Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2013 (Fed. Cir.1987). Nevertheless, not every activity constitutes a service within the meaning of the Trademark Act. *Dr Pepper*, 5 USPQ2d at 1208.

The following criteria have evolved for determining what constitutes a service:

(1) A service must be a real activity;

(2) A service must be performed to the order of, or for the benefit of, someone other than the applicant; and

(3) The activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant’s goods or the performance of another service.

Dr Pepper, 5 USPQ2d at 1209 (ordinary promotional activities of one’s own goods do not constitute a registrable service); *Canadian Pac.*, 224 USPQ at 973 (“[A] service must be performed for the *benefit of others* than the applicant.” (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1301.01 (1985))); *Advertising & Mktg. Dev.*, 2 USPQ2d at 2014 (a service should be viewed as “the performance of labor for the benefit of another.”); *In re Betz Paperchem, Inc.*, 222 USPQ 89, 90 (TTAB 1984) (listing the three criteria); *In re Landmark Commc’ns, Inc.*, 204 USPQ 692, 695

(TTAB 1979) (“[T]o be separately recognizable, as services, an applicant’s activity must be qualitatively different from anything necessarily done in connection with the sale of goods.”).

A. Whether the activities in Applicant’s description of services are a real activity.

The activities in Applicant’s description of services, including employment-recruiting services, personnel recruitment, employment recruiting and staffing services, and recruitment and placement of personnel in the field of law enforcement are real activities. The Examining Attorney does not contend otherwise.¹⁷

B. Whether Applicant performs the activities in Applicant’s description of services for the benefit of someone other than Applicant.

The Examining Attorney contends that the activities described in Applicant’s description of services are for Applicant to recruit personnel to perform law enforcement activities for Applicant and, therefore, they are not primarily for the benefit of others.¹⁸ To corroborate her contention, the Examining points to the specimen of use reproduced above.

Here, the applicant is the California Highway Patrol, and the specimen is an advertisement to recruit individuals to join the California Highway Patrol, so that the Applicant can carry out its primary duties. The advertising and recruiting services are not performed for third parties, rather, it is merely performed for the Applicant itself. Thus, considering TMEP §1301.01(a)(ii), applicant is the primary beneficiary of the recruitment and hiring services,

¹⁷ Examining Attorney’s Brief (6 TTABVUE 5).

¹⁸ Examining Attorney’s Brief (6 TTABVUE 5).

and those services are not performed for the benefit of others.¹⁹

Applicant argues, to the contrary, the public is the beneficiary of the activities in its description of services, including employment-recruiting services, personnel recruitment, employment recruiting and staffing services, and recruitment and placement of personnel in the field of law enforcement for the following reasons:

- Even without formal recruitment, Applicant would continue to exist;
- Applicant does not need to rely on recruitment services to perform its functions;
- Applicant has chosen to implement the services to provide information “to those that may be interested or intrigued by such a career path.”;
- “The entire purpose behind the Mark is to enable Applicant to provide for the betterment of the people of California, not Applicant itself.”²⁰

Again, while [Applicant] seeks protection for use of the Mark in relation to the claimed services, [Applicant] is not the primary beneficiary of the services claimed. The people of California have always been, and remain to be, the ones to benefit from the services claimed by the application given Applicant’s nature as a public entity, created to serve and protect the people of California.²¹

The controlling question is who primarily benefits from the activity for which Applicant is seeking registration. If Applicant performs the activity primarily for the benefit of others, the fact that Applicant derives an incidental benefit is not fatal. *In*

¹⁹ Examining Attorney’s Brief (6 TTABVUE 6).

²⁰ Applicant’s Brief (4 TTABVUE 9-10).

In its Reply Brief, Applicant reiterates that it will remain in existence whether it recruits employees or not and postulates that it is not receiving a benefit from the services as it would stay in existence either way. Reply Brief (7 TTABVUE 5).

²¹ Applicant’s Brief (4 TTABVUE 10).

re Venture Lending Assocs., 226 USPQ 285, 286 (TTAB 1985). On the other hand, if the activity primarily benefits Applicant, it is not a registrable service even if others derive an incidental benefit. *Dr Pepper*, 5 USPQ2d at 1210 (contest promoting applicant's goods not a service, even though benefits accrue to winners of contest); *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1676 (TTAB 2013) (finding that intranet website was used solely for internal purposes for respondent's benefit does not constitute a registrable service because the primary beneficiary of any services provided under the mark should be individuals or entities other than the party rendering the services."); *In re Alaska Nw. Publ'g Co.*, 212 USPQ 316, 317 (TTAB 1981) (stating "[t]hat the activities and operations associated with the production, advertising or sale of the product may be indirectly beneficial to purchasers of the product is immaterial to the question of registrability of the mark as a service mark."). In other words, when Applicant performs an activity or service for itself, we do not consider that activity or service to be a registrable service.

In the appeal before us, Applicant's description of services is essentially employee recruiting services for itself. This is clearly an activity that Applicant is rendering for itself to fill positions in its ranks. Applicant, in its arguments, leaves out the key fact that the recruitment activities at issue are for hiring Applicant's own employees as opposed to rendering recruiting services for other employers or some other activity that primarily benefits employees or potential employees. In fact, the TMEP uses analogous recruitment activities as an example of activities that do not comprise a registrable service.

Similarly, a company that sets up a personnel department to employ workers for itself is merely facilitating the conduct of its own business, while a company whose business is to recruit and place workers for other companies is performing employment agency services.

TMEP § 1301.01(a)(ii).

We find Applicant performs the activities in the description of services primarily for its own benefit, rather than the benefit of others.

C. Whether the activities in Applicant's description of services are qualitatively different from anything necessarily done in connection with the performance of another service.

The essence of this requirement is whether the activity at issue is a normally expected, routine or required activity in connection with Applicant's primary business. *See Dr Pepper*, 5 USPQ2d at 1208 (“[I]t has become a settled principle that the rendering of a service which is normally ‘expected or routine’ in connection with the sale of one’s own goods is not a registrable service whether denominated by the same or a different name from the trademark for its product.”); *Landmark Commc’ns*, 204 USPQ at 695 (“[T]o be separately recognizable, as services, an applicant’s activity must be qualitatively different from anything necessarily done in connection with the sale of goods.”).

The Examining Attorney contends that Applicant's advertising and recruiting for its own employees is not sufficiently different from anything necessarily done in connection with its principal law enforcement activities because every business needs

employees and hiring and recruiting employees is merely incidental to Applicant's primary mission.²²

Applicant argues, to the contrary, that its principal activity is the safety and security of California communities.

While employees are in fact involved in carrying out its principal activity, that is not to say that hiring employees is Applicant's principal activity. That logic would provide that there would be no business or entity that could register such a service mark, because until robots are used to perform all functions, every business and entity needs employees to carry out its principal activity.²³

Recruiting and hiring one's own employees is not in any material way a different kind of economic activity done in connection with that which any business or organization normally performs. There is nothing of record indicating that Applicant's services, including employment-recruiting services, personnel recruitment, employment recruiting and staffing services, and recruitment and placement of personnel in the field of law enforcement are anything other than routine activities performed by any law enforcement agency or other business.

We find that the activities comprising Applicant's description of services are not qualitatively different from anything necessarily done in connection with Applicant's core law enforcement activities.

D. Conclusion

Because the activities comprising Applicant's description of services are not

²² Examining Attorney's Brief (6 TTABVUE 7-8).

²³ Applicant's Brief (4 TTABVUE 11).

rendered primarily for the benefit of one other than Applicant and are not sufficiently distinct from Applicant's core business, we find that the activities in Applicant's description of services is not a registrable service.

Decision: We affirm the refusal to register Applicant's mark MADE FOR MORE on the ground that Applicant is not rendering a service within the meaning of Sections 1, 2, 3 and 45 of the Trademark Act.