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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re G.A. Modefine S.A.

Serial No. 74/049,538

Herbert Dubno of The Firm of Karl F. Ross, P.C., for G.A.
Modefine S.A.

Priscilla Milton, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Simms, Cissel and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 12, 1990, applicant, a Swiss company, filed an
application to register the mark "GIORGIO ARMANI" on the
Principal Register for "retail store services," in Class 42.
The application was based on applicant's assertion that it
possessed a bona fide intention to use the mark in
connection with these services in commerce. The application
further noted that the name "Giorgio Armani" identifies a
living individual whose consent is of record. In accordance
with applicant's authorization, an Examiner's Amendment

issued in which applicant claimed ownership of three subsisting registrations and amended the recitation of services to read as follows: "retail store services in the field of clothing." The application was accordingly passed to publication under Section 12(a) of the Act.

A Statement of Use was filed. The specimens of use submitted with it were found to be unacceptable by the Examining Attorney because they did not show use of the mark in connection with the services set forth in the application. New specimens of use which show the mark used in connection with retail store services in the field of clothing were required by the Examining Attorney.

When the requirement for new specimens was made final, applicant appealed to the Board. Along with the notice of appeal, applicant filed a substitute specimen and a supporting declaration. The Examining Attorney maintained the requirement for specimens which show the mark used in connection with the services specified in the application, noting that the specimens applicant had submitted show the mark used with business management assistance or franchising services.

The specimens submitted with the Statement of Use and the one submitted thereafter are the only evidence in the record of how the mark is used. One specimen is a copy of a "Management Agreement" that applicant entered into with an affiliate retail clothing store business. Under the terms of the agreement, applicant promises to provide specific

services as the "exclusive manager of the Boutique." Accounting, cash management, personnel management, payroll services, insurance and other management services are specified, but the agreement does not show the mark sought to be registered used in connection with any of these activities.

Also submitted with the agreement, however, were invoices to one of applicant's retailers for "management fees." These invoices display the mark at the top of the letterhead.

The specimen submitted by applicant with the notice of appeal in an attempt to satisfy the requirement for acceptable specimens is a copy of a letter to a prospective customer. The mark is shown at the top of the sheet, and the text advises the prospect that applicant provides "advertising, public relations, display and retail management services." It goes on to explain that bookkeeping and inventory systems are two of the retail management services it is able to render.

Next, applicant offered to amend the recitation of services to "business management assistance, namely, services to retail stores," or to "retail store services, namely, business management assistance for retail store business." The appeal was suspended and the application was remanded to the Examining Attorney for consideration of the proposed amendments. She held them to be unacceptable on the ground that the proposed language designates services

that are not within the scope of the identification of services in the Notice of Allowance.

Applicant then amended the application to state its services as follows: "retail store services, namely, directing, coordinating and supervising conduct of retail establishments including providing financial accounting and bookkeeping services, coordinating purchase of merchandise and distribution of inventory and supervising implementation of marketing and advertising strategy," in Class 42. The Examining Attorney maintained her position that the amended version of applicant's services is unacceptable because it exceeds the scope of what the words "retail store services in the field of clothing" are understood to mean.

The appeal was resumed. Applicant supplemented the briefs it had previously filed, and the Examining Attorney filed her brief. Both applicant and the Examining Attorney argued their positions at the oral hearing held before the Board.

The issues before us in this appeal are the acceptability of the most recently proposed amendment to the recitation of services and the acceptability of the specimens, i.e., whether the specimens show the mark used in connection with the services identified in the application, as applicant has been allowed to amend it.

Two underlying legal principles govern the resolution of this appeal. One is that the specimens of use submitted with an application must show the mark used to identify the

services which are specified in the application. Section 1(a)(1)(A) and (C) of the Act. The second is stated in Trademark Rule 2.71(b), which provides that "The identification of goods or services may be amended to clarify or limit the identification, but additions will not be permitted." As the Examining Attorney points out, the Trademark Manual of Examining Procedure, Section 804.10(b), elaborates on the rule. It directs Examining Attorneys to allow amendments if they serve to "...restrict one or more of the items by inserting qualifying language or substituting more specific language," or "...to insert an item which is equivalent to or logically encompassed by an item already included in the identification of goods and services." Amendment is not permitted, however, where the term or wording which is proposed is not logically included within the scope of the terms in the existing identification. TMEP Section 804.09(b) notes that "The scope of the goods and services, as originally identified or as amended by an express amendment, establishes the outer limit for any later amendments."

In the instant case, applicant takes the position that "retail store services in the field of clothing" encompass the services the specimens show applicant renders under the mark to the operators of retail clothing stores. Consistent with this contention, applicant argues that the most recent amendment to the recitation of services specifies services

which are within "retail store services in the field of clothing."

The Examining Attorney maintains that the specimens do not show the mark used to identify retail store services in the field of clothing, and that the proposed amendment to the recitation of services represents an impermissible broadening of the services set forth in the Notice of Allowance.

It does not appear to be oversimplifying to state that the question before us is whether "retail store services" include the types of services applicant renders to the operators of retail stores, i.e., whether activities such as bookkeeping and accounting services, inventory procurement and distribution, and supervising the implementation of marketing and advertising strategy are kinds of retail store services. If so, the specimens are acceptable and the amended recitation of services is both acceptable and unnecessary.

We agree with the Examining Attorney that the specimens do not show the mark sought to be registered used in connection with retail store services in the field of clothing. We also agree that the services the specimens show that applicant provides to retail clothing store operators are not encompassed within what retail store services in the field of clothing are normally understood to be.

It is well settled that services are activities performed for the benefit of others. Retail store services in the field of clothing are the services rendered to the consuming public by a business operating a retail clothing store. As the Examining Attorney points out, the dictionary defines a retail store in terms of "a place of business... in which merchandise is sold primarily to ultimate consumers." (Webster's Third New International Dictionary, 1938(1986). The addition of the term "services" to "retail store" simply refers to the activity conducted in such a store. The Patent and Trademark Office, as also noted by the Examining Attorney, has viewed "retail store services" as "the activity of gathering together various products, making a place available for purchasers to select goods (often in numerous locations for the convenience of those purchasers) and providing other necessary means for consummating purchases." Marshall, Trademark Examining Operation, 82 TMR 94, 108 (1992).

The management and business services with which applicant uses this mark are not the services a store renders to its retail clothing customers, but rather are services applicant performs for the business entities which provide such store services. The latter are clearly not included within the former. The fact that the services applicant renders are performed for the benefit of clothing store businesses simply does not make them clothing store

services. The activities are fundamentally different. Not even the beneficiaries of the services are the same.

Applicant therefore must lose this appeal on both counts. The specimens do not show the mark used to identify the services set forth in the application at the time of issuance of the Notice of Allowance, and the proposed amendment to specify the services rendered to the operators of retail clothing stores represents an impermissible broadening of the services as previously set forth in the application. Accordingly, the requirement for acceptable specimens is affirmed, as is the refusal to accept the proposed amended recitation of services.

R. L. Simms

R. F. Cissel

C. E. Walters
Administrative Trademark Judges
Trademark Trial & Appeal Board