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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **River Oaks Furniture, Inc.**

Serial No. 74/**334,620**

**Charles C. Garvey, Jr. of Pravel, Gambrell, Hewitt, Kimball
& Krieger for River Oaks Furniture, Inc.**

Thomas V. Shaw, Trademark Examining Attorney, Law Office 102
(Myra Kurzbard, Managing Attorney)

Before Rice, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

River Oaks Furniture, Inc. has applied to register
SOFAS & MORE, as shown below, for "retail store services in
the field of sofas, loveseats, lamps, tables and rugs sold
as a package."¹ Applicant has disclaimed the exclusive
right to use SOFAS apart from the mark as shown.

¹ Application Serial No. 74/334,620, filed November 25, 1992,
and asserting first use and first use in commerce as of April 9,
1992.



Sofas
& More

Registration was finally refused pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1123, on the ground that the applied-for term is not used as a service mark. The Examining Attorney asserts that the specimens of record do not evidence use of the mark in the sale or advertising of the identified services. It is the Examining Attorney's position that in the promotional flyers submitted by applicant the mark is used solely to identify furniture combinations, rather than to identify retail store services. The Examining Attorney also objected that the specimens of record are unacceptable because they are temporary printer's proofs.

Applicant has appealed. Applicant and the Examining Attorney filed briefs,² but an oral hearing was not requested.

² In its brief applicant requested that the Board review the file of Registration No. 1,531,265. This file was never made of record. The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office. See **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974).

The question of whether a term functions as a mark for the identified goods or services must be determined on the basis of the specimens, as well as any other materials evidencing use which are of record. In this case, the only such submissions are the specimens, which consist of a four-sided color "flyer" featuring packages of various living room furniture groupings. Reduced size copies of these pages are reproduced in the appendix to this opinion.

As used in the specimens, the commercial impression of SOFAS & MORE is that of a trademark for the furniture packages, rather than as a service mark for retail store services in the field of the various items of furniture. For example, on the cover page is the legend, "FREE! When you purchase the *STORE NAME*, SOFAS & MORE 7 pc. LIVING ROOM PACKAGE GROUP." Consumers would view SOFAS & MORE in this legend as identifying the furniture, namely, the 7-piece living room package group, while the "*STORE NAME*" would be perceived as a service mark for the retail store services.

Page 2 of the flyer contains the sentence "Buy a 'Sofas and More' Package Group and SAVE!" Again, as used in this phrase, SOFAS AND MORE would clearly be seen as a trademark for the furniture group. Page 2 also includes the text "*STORE NAME* Wraps It All Together" followed by the marks SOFAS & MORE and RIVER OAKS and design. Here, too, the "*STORE NAME*" is the service mark for the retail store services, with the SOFAS & MORE and RIVER OAKS marks acting as trademarks for the goods. This impression is reinforced

by the pictures of boxed furniture with the mark RIVER OAKS and design on the packaging. On page 3, there is a listing of the prices of the individual pieces in the package group, with the total price for the 7 piece package. The mark SOFAS & MORE appears as part of the picture showing the furniture package, giving the impression that it is the trademark for the furniture.

Thus, after carefully reviewing the specimens of record, we find that they do not show use of SOFAS & MORE as a service mark for the identified "retail store services in the field of sofas, loveseats, lamps, tables and rugs sold as a package."

Although we affirm the refusal of registration on the ground that the applied-for term does not function as a service mark for the identified services, in order to render a complete opinion we turn to the second refusal by the Examining Attorney, namely, the specimens are unacceptable because they are temporary printer's proofs and are not, in fact, in actual use. In considering the refusal we will assume, arguendo, that the specimens show use of the mark in connection with retail store services, as opposed to goods,

Applicant claims that its mark is used by furniture stores which are licensees of applicant's. However, it appears that if and when these flyers are used by applicant's licensees in connection with advertising their retail store services, the name of the store is substituted for the phrase "STORE NAME" where it appears on the flyers.

Otherwise, consumers would have no way of knowing who was rendering the retail store services, or where the store services are being rendered.

The fact that an "insert store name" legend, rather than an actual store name, appears on the specimens shows that these particular flyers are not used to advertise any retail store services. We agree with the Examining Attorney that they are in the nature of printer's proofs, or mock-ups which are used to solicit retailers to carry applicant's product line. They do not meet the requirement of Trademark Rule 2.58 for the submission of specimens of the mark as used in the sale or advertising of the retail store services since, by their very nature, these flyers, with STORE NAME on them, would not and could not be used as actual advertisements. We note applicant's attorney statement "that it is the understanding of the undersigned that the flyers are used as inserts in newspapers or direct-mail advertising, not simply given to existing customers in the stores." Brief, p. 4. However, applicant has not submitted any flyers bearing the name of a licensee store.

Applicant has also argued that its specimens are facsimiles and therefore acceptable. Trademark Rule 2.58(a) provides that specimens or facsimiles, as specified in Rules 2.56 and 2.57, of the mark used in the sale or advertising of the services shall be furnished. Rule 2.57 makes it clear that facsimiles may be furnished when it would otherwise be too difficult, because of the mode of applying

the trademark to the goods, to furnish actual labels, containers, and the like. In such a case, the facsimile is to be a "suitable photograph or other acceptable reproduction." Section (b) of that rule goes on to state that "a purported facsimile which is merely a reproduction of the drawing ... will not be considered to be a facsimile depicting the mark as used on or in connection with the goods or in connection with the services." It is clear from a reading of these rules that the specimens to be furnished must be the actual item, or a photograph or reproduction thereof, which is used on the goods or in the advertising of the services. Because applicant's flyers, by their very nature, cannot be in actual use in connection with the advertising of retail store services, they cannot be considered facsimiles within the meaning of Trademark Rule 2.57.

Decision: The refusal to register on the grounds that the applied-for term does not function as a service mark for the identified services, and that the specimens are not acceptable because they do not show actual use of the mark, is affirmed.

J. E. Rice

E. J. Seeherman

Ser No. 74/334,620

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board