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Paper No. 12

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valley Dental, Inc.

Salem

Serial No. 74/651,840

S/30197

Paul Grandinetti of Cammerata & Grandinetti for Valley
Dental, Inc.

Dominic J. Salemi, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney)

Before Cissel, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge.

On March 27, 1995, applicant filed the above-identified
application to register the mark "SUGAR BUGS" on the
Principal Register for "promoting dental services and dental
health," in Class 42. Applicant claimed first use and first
use in interstate commerce since January 4, 1988, and stated
that the mark is used "by printing it on signs, brochures,
booklets, letterhead, labels, bulk mail, novelty items, and
custom printed products[,] by broadcasting on radio and
television, and by other ways customary in the trade." The

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application included as specimens photocopies of the illustration shown below.



The Examining Attorney found the specimens to be unacceptable as evidence of service mark use of the words sought to be registered. Trademark Rule 2.58 was cited as support for the requirement for specimens which showed the words sought to be registered used to identify the services set forth in the application. Additionally, that recitation of services was found to be indefinite because the "method" by which applicant promotes dental health and dental services was not specified. Amendment to the recitation of services was required, and the Examining Attorney suggested that applicant amend to state that the promotion was rendered "through personal visits by a costumed character."

Applicant responded by amending the application to restate the service as "promoting dental services and dental health through informative promotions," in Class 42.

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Applicant explained that it "promotes its dental services and dental health through informative promotional material that is oriented to children. The promotions are signs, brochures, and advertisements and include characters in stories and/or cartoons that promote good dental practices. The characters and stories are always associated with applicant's dental centers and the service."

Submitted with this explanation were seven declarations from applicant's customers. In each, the declarant avers that he or she is familiar with applicant's advertisements for its services of promoting dental health and dental services, as well as with a number of the marks applicant is seeking to register. Each declarant further asserts that he or she has come to associate the services provided by applicant with the various specified marks, including the "SUGAR BUGS" mark.

Following the erroneous holding by the Patent and Trademark Office that the application had been abandoned when the amendment was not timely matched with the application file, the application was reinstated. The Examining Attorney made the requirement for substitute specimens final with the second Office Action on June 20, 1996. Trademark Rule 2.58 was again cited as the basis for the requirement for substitute specimens. Again the Examining Attorney required amendment to the recitation of

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services because the existing one was found to be indefinite, and again he suggested adoption of the wording "promoting dental services and dental health through personal visits by a costumed character."

Applicant timely filed a notice of appeal. Submitted concurrently with the appeal was an amendment restating the services as "promoting dental health to children." Also submitted were substitute specimens, supported by a declaration from applicant's vice president to the effect that the substitute specimens show use of the mark prior to the filing date of the application. The substitute specimens are copies of newspaper advertisements for applicant's services.

The advertisements are in the form of cartoon strips titled "THE ADVENTURES OF MYRTLE MOLAR AND THE TOOTH TOTS." The cartoons show various tooth-shaped cartoon characters with names like Bertha Bicuspid, Myrtle Molar, and Clifford Cornelius Canine, referred to collectively as the "TOOTH TOTS." In the first cartoon story, Clifford is shown falling into a body of water labeled "CAVITY PIT " The Tooth Tots collectively yell out to him, "DON'T LET THOSE SUGAR BUGS SCARE YOU WE'LL GET YOU OUT!" Two unlabeled insect-like characters are shown in the foreground of that frame of the cartoon. Clifford is retrieved by the Tooth Tots by means of a rescue line made of dental floss. In

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the final frame, Myrtle Molar urges kids to remember to brush, take good care of their teeth, and see their dentists regularly.

The second cartoon story also features the Tooth Tots. In this episode, Bertha Bicuspid is being attacked by six unlabeled characters. "HELP," she calls, " THE SUGAR BUGS ARE AFTER ME." The Tooth Tots come to Bertha's rescue with toothpaste, brushes and floss, and she proclaims that her friends are her heroes. Myrtle Molar closes the story with the assertion that "YOU CAN WIN THE BATTLE AGAINST ROTTEN SUGAR BUGS TOO! JUST MAKE SURE TO BRUSH DAILY, EAT WELL AND SEE YOUR DENTIST REGULARLY."

A third substitute specimen is a printed advertisement for applicant's services. The ad features Myrtle Molar and shows applicant's name, Valley Dental, but does not show the mark sought to be registered.

On February 13, 1997, the Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the amendment and substitute specimens. The record, however, does not reflect action by the Examining Attorney on the remanded application. Applicant filed its brief on February 18, 1997. The Examining Attorney's responsive brief was subsequently entered into the record, and applicant filed a reply brief on May 12, 1997. No request was made for an

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oral hearing. Because the brief of the Examining Attorney clearly takes into account the amended recitation of services, we are considering this appeal now as if the Examining Attorney had timely responded to the Board's remand order by reconsidering the application and then maintaining the requirements for new specimens and an amended recitation of services.

Based on careful consideration of the record in this application, as well as the pertinent legal authorities, we hold that amendment to the recitation of services is not necessary, but that the requirement is proper for different specimens which show use of "SUGAR BUGS" as a service mark for promoting dental health to children.

There can be no disputing the fact that at times during the prosecution of this application, both the Examining Attorney and counsel for applicant have argued the specimen requirement as if the central focus of the dispute has been whether or not the specimens must specifically refer to the fact that applicant promotes dental health to children. Each time the requirement for new specimens was made, however, the Examining Attorney made it clear that what are necessary are specimens which show the mark used to identify the service. In his brief, he characterizes this issue on appeal as a refusal to register "under Sections 2, 3 and 45 of the Trademark Act on the ground that the aforesaid

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character name did not function as a service mark as it did not identify the services for(sic) which applicant claims to be rendering." Although those particular sections of the statute had not been previously mentioned, we believe this language is simply another way of characterizing the issue he raised in every Office Action and in his brief, and which was argued by applicant in every response and in its appeal brief, i.e., whether the specimens show "SUGAR BUGS" used to identify the services set forth in the amended application.

The first issue we needed to resolve, however, was the requirement for a more definite recitation of services. As amended, the services are specified as "promoting dental health to children." We see nothing indefinite about this language. The service, i.e., the activity being performed for the benefit of others, is plainly stated as promoting dental health. Applicant goes on to state that this service is rendered to children, although that aspect of the service is not as significant as the promotional activity itself. "Promoting dental health to children," or even just "promoting dental health," is a definite statement specifically identifying the service applicant renders. It is not necessary to specify the means by which this is accomplished. In any event, we can see no legal, logical, or evidentiary basis for the Examining Attorney's repeated suggestion that applicant promotes dental health "through

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personal visits by a costumed character." It escapes us why promotion by a costumed character would be acceptable, but promotion through the use of printed materials apparently would not be.

In summary on this point, the existing recitation of services is specific and definite enough. We note for the record that if applicant were only promoting its own services under the mark, registration as a service mark for these promotional services would not be proper because it is not a service to promote one's own services. This is apparently not the case, however. Applicant promotes dental health to children in general, rather than its own dental services in particular. In any event, the Examining Attorney has never refused registration on the basis that what applicant does under the mark is not a service because applicant is only promoting its own services.

Turning to the second issue on appeal, whether the specimens show applicant's use of "SUGAR BUGS" as a service mark for the service of promoting dental health to children, as noted above, we find that the specimens of record do not show the term sought to be registered used as a mark for these services. While the story lines in each of the cartoon specimens involves characters referred to as "SUGAR BUGS," and the pictorial representations in each cartoon undoubtedly are intended to represent these characters,

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nowhere on these specimens is "SUGAR BUGS" used as a mark for applicant's services. The mere fact that these "characters" in the two stories are referred to as "SUGAR BUGS" does not, in and of itself, make that term a service mark for applicant's services. As the Board noted in the case of *In re Morganroth*, 208 USPQ 284, 287, (TTAB 1980), "[t]he salient question is whether the designation in question, as used, will be recognized in itself as an indication of origin for the particular product or service. That is, does this designation create a commercial impression separate and apart from the other material appearing on the label or advertisement." That commercial impression as a service mark must be readily apparent from the use of the term. It must not blend in with other matter so well that it is difficult or impossible to discern which element is supposed to constitute a service mark. *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985).

The Board has previously held that the name of characters used in printed publications and entertainment services is not necessarily a trademark or service mark for such goods or services. In the case of *Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897 (TTAB 1988), the word "Romulans," had been used by opposer in television dramas, printed materials and a host of other collateral products, but it was held to be only a character name, which

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was not entitled to trademark or service mark protection. The Board pointed out that "while the statute provides for registration of character names, it does not mean that the name of any character is registrable. It is essential that the character name have been used as a service mark (or a trademark) in order to be eligible for registration. (footnote 5 on page 1899).

In the case now before the Board, the specimens show the term "SUGAR BUGS" used not as a service mark, but merely as the name of a group of characters in the cartoon storyline. We are without credible evidence that the term used in this context would be viewed or understood as a designation of the source of applicant's services of promoting dental health to children.

The seven declarations described earlier in this opinion do not persuade us to the contrary. In our judgment, neither the original specimens nor the substitute ones could reasonably lead anyone to understand that "SUGAR BUGS" is anything other than the name of a group of characters in applicant's stories.

In summary, the recitation of services in this application, as amended, is sufficiently definite, but the specimens of record do not show the term used as a service mark in connection with the rendering of the specified services of applicant.

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Accordingly, the requirement for amendment to the recitation of services is reversed, but the requirement for additional specimens which show the term used as a service mark for the specified services is affirmed.



R. F. Cissel



E. J. Seeherman



E. W. Hanak
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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