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16 MAR 1998

THIS DISPOSITION
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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.

Same
as
1.111-2 E/30 ?

Serial No. 74/651,843

Paul Grandinetti of Levy, Zito & Grandinetti for Valley
Dental, Inc.

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

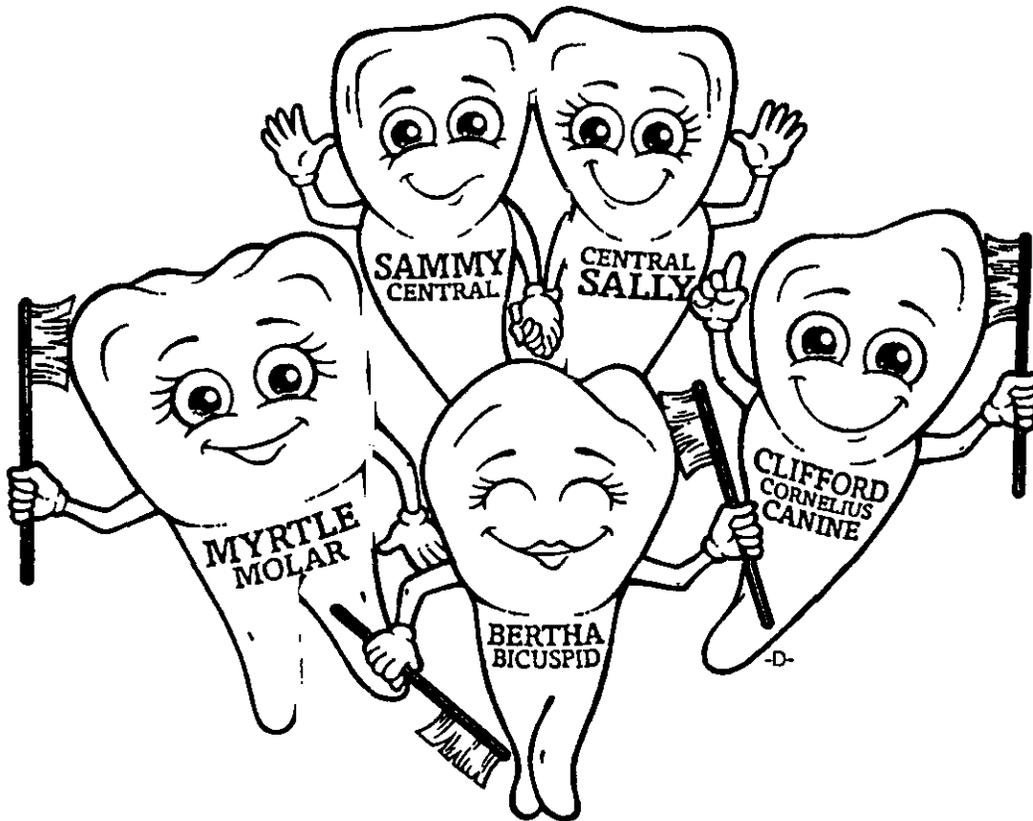
Before Cissel, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge.

The above-identified application was filed on March 27,
1995, seeking registration on the Principal Register of the
mark "CLIFFORD CORNELIUS CANINE" as a service mark for
"promoting dental services and dental health," in Class 42.
Applicant claimed first use and 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

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other ways customary in the trade." The application included as specimens photocopies of the sheet shown below.



Brush Club™

VALLEY
DENTAL 
SM

(209) 348-1212
(800) 209-DENTAL

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The Examining Attorney found the specimens to be unacceptable as evidence of service mark use of the term sought to be registered because they contain "no reference to a service." The Examining Attorney cited Trademark Rule 2.58 and required specimens which showed the term sought to be registered used to identify the services set forth in the application. Additionally, amendment to the recitation of services was required because the original recitation was found to be indefinite. The Examining Attorney suggested adoption of the following language: "promoting dental services and dental health through (explain method e.g. through personal visits by a costumed character.)"

Applicant responded by amending the recitation of services to restate them as "promoting dental services and dental health through informative promotions in Class 42," and offered the following explanation of how the mark is used in connection with applicant's services: "The applicant 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."

Submitted with this explanation were twenty-seven declarations from applicant's customers. In each, the declarant avers that he or she is familiar with applicant's

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advertisements for its services of promoting dental health and dental services, as well as a number of the marks applicant seeks to register. Each declarant further asserts that he or she has come to associate the services provided by applicant with the specified marks, including the mark "CLIFFORD CORNELIUS CANINE."

Following reinstatement of the application after the Office had erroneously held it to be abandoned when applicant's amendment was not timely associated with the application file, the Examining Attorney made the requirement for substitute specimens final with the second Office Action. Applicant was again advised that the specimens of record were "unacceptable as evidence of actual service mark use because they contain no reference to a service." 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 services because the existing one was found to be indefinite. He once again suggested adoption of "promoting dental services and dental health through personal visits by a costumed character."

On December 20, 1996, applicant appealed. Submitted with the notice of appeal was an amendment to the recitation of services. The application was amended to specify the services as "promoting dental health to children."

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Also included were substitute specimens, supported by a proper declaration as to use at least as early as the filing date of the application. The specimens are copies of pages from a promotional brochure which applicant states is given to children as part of the service of promoting dental health. The brochure features a cartoon strip bearing the title "THE ADVENTURES OF MYRTLE MOLAR AND THE TOOTH TOTS'" One page shows a tooth-shaped cartoon character labeled "MYRTLE MOLAR" entreating a group of similar characters, including one labeled "CLIFFORD CORNELIUS CANINE," to " tell the kids why coming to Valley Dental is so much fun'" "CLIFFORD CORNELIUS CANINE" points out that they get to "watch the newest movies for kids." Games and coloring are mentioned by other characters as other reasons why it is fun to go to the dentist's office. Kids are invited to join the "Tooth Tots Club," which is identified as being for kids 2-12 years old. Applicant's name is shown on a balloon illustration. The MYRTLE MOLAR character is shown on the second page of the brochure, along with eight children, under the heading "Where going to the dentist is fun!" The third page of the brochure prominently features two mixed-up word puzzles and a maze. Applicant's name is shown, as are three small versions of tooth-shaped characters in the maze, but the mark sought to be registered is not legible on this page of the specimens.

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On February 13, 1997, the Board instituted the appeal, and then suspended action on it and remanded the application to the Examining Attorney for consideration of the amendment and the substitute specimens.

The record does not reflect action on the remanded application by the Examining Attorney, however. 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, but did not request an oral hearing. Because the Examining Attorney's brief appears to take 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 the requirements for different specimens and an amendment to the recitation of services are unnecessary. This application is in condition for publication. The specimens applicant has submitted are acceptable evidence of applicant's use of the term it seeks to register as a service mark for the services set forth in the application,

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as amended, and that amended recitation of services is not unacceptably indefinite.

We note for the record that we are disregarding the language in the Examining Attorney's brief relating to the previously unmentioned "refusal to register the character name 'CLIFFORD CORNELIUS CANINE' under Sections 2, 3, and 45 of the Trademark Act on the ground that the aforesaid character name does not function as a trademark." We are interpreting his words concerning those sections as simply another perspective on the issue that was raised by the Examining Attorney in every Office Action and his brief, and which was argued by applicant in every response and in its appeal brief, i.e., whether the specimens show the mark sought to be registered used to identify the services set forth in the application, as amended.

At the outset of our discussion of the merits of this appeal, we should address the issue of the requirement for a more definite recitation of applicant's services. As amended, the services are specified as "promoting dental health to children." We fail to see anything indefinite about this wording. The service, i.e., the activity 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

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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 unnecessary 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 personal visits by a costumed character." It eludes us why promotion through a costumed character would be acceptable, but promotion through the use of cartoon characters apparently would not be.

In summary, 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 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.

As indicated above, we find that the specimens do show that applicant uses "CLIFFORD CORNELIUS CANINE" as a service

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mark for applicant's services of promoting dental health to children. The Examining Attorney argues that the specimens of record are unacceptable because they do not specifically mention the promotion of dental health. The mere fact that the specimens of record do not specifically state that applicant offers "CLIFFORD CORNELIUS CANINE brand services of promoting dental health to children," however, does not disqualify the specimens.

Section 1 of the Lanham Act provides for the registration of marks used in commerce to identify services, and paragraph (A)(1)(C) of that section requires that specimens or facsimiles of a mark as used must be submitted along with the application, drawing and fee. The Court of Customs and Patent Appeals, in *In re Universal Oil Products Company*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973), discussed the requirement of Section 45 of the Act that in order for a mark to be registered as a service mark, it must be used in the sale or advertising of services. In his opinion in that case, Judge Rich, citing *Ex Parte Phillips Petroleum Co.*, 100 USPQ 25 (Com'r Pats. 1953), noted that the specimens in an application must show a "direct association" between the offer of services and the mark sought to be registered.

An example of how this standard can be met is provided in the more recent case of *In re Advertising & Marketing Development Inc*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir.

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1987). There, the Court took into account the specimens of record, as well as affidavits from purchasers of applicant's services stating that they considered the mark sought to be registered to identify the services specified in the application. The Court concluded that the specimens submitted with the application showed the mark used to identify the services named in the application.

The situation in the case now before us is clearly analogous to that one. Here, the specimens show the mark sought to be registered used in materials which applicant provides to children as part of the service of promoting dental health to them. The cartoon character labeled "CLIFFORD CORNELIUS CANINE" appears in ways obviously intended to create in a child's mind a friendly and inviting image for having dental health maintained through the use of dental professionals like applicant. The original specimen shows him smiling while brushing himself with a toothbrush. The second page of the substitute specimen shows the character labeled "CLIFFORD CORNELIUS CANINE" touting the advantages of joining the TOOTH TOTS CLUB, which is clearly another vehicle by which applicant promotes dental health to children. As we noted above, the name "VALLEY DENTAL" appears on every page of the brochure, and it is clearly presented on the original specimen along with applicant's telephone number. Applicant has explained that these

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materials are distributed to children in connection with the service of promoting dental health. Moreover, in addition to being performed for children at applicant's dental clinics, applicant states that these services are provided without charge at educational and other institutions. Applicant has shown that the materials are used as part of its program to promote dental health to children. The direct association in the mind of a child receiving this informational material between "CLIFFORD CORNELIUS CANINE" and the advantages of good dental health is plainly established.

Further, just as in the Marketing Development Inc. case, supra, not only are we presented with these unambiguous examples of the use of the mark in the kinds of ways such a mark would be used in connection with the specified services, we also have statements from a number of the purchasers of the services that they have come to associate the services of applicant with the mark. While this would not be persuasive evidence without specimens which show the mark used in connection with the specified service, this evidence confirms what the specimens establish, that applicant uses the mark in ways that create a direct association in the minds of purchasers between the mark and the services.

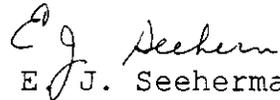
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In summary, the recitation of services in this application, as amended, is sufficiently definite, and the specimens of record show the mark sought to be registered used in connection with the rendering of the specified services.

Accordingly, the requirements for additional specimens and amendment to the recitation of services are reversed, and the application will proceed to publication.



R. F. Cissel



E. J. Seeherman



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