

THIS DISPOSTION IS NOT CITABLE  
AS PRECEDENT OF THE TTAB           AUG. 27, 99  
  U.S. DEPARTMENT OF COMMERCE  
  PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Solutions NOW

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Serial No. 74/645,035

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Donald R. Piper, Jr. of Dann, Dorfman, Herrell and  
Skillman, P.C. for Solutions NOW.

Angela Lykos, Trademark Examining Attorney, Law Office 102  
(Thomas Shaw, Managing Attorney).

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Before Hanak, Hohein and Wendel, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Solutions NOW (applicant) seeks to register UNBUNDLING  
for "technical consultation and research in the fields of  
engineering and product development." The intent-to-use  
application was filed on March 7, 1995. Subsequently,  
applicant filed a statement of use alleging a first use  
date of January 28, 1996 and submitting three specimens of  
use.

The Examining Attorney refused registration pursuant to Sections 1, 2, 3 and 45 of the Trademark Act "on the basis that the proposed mark merely identifies a process." (Examining Attorney's brief page 1). When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

As the Examining Attorney acknowledges, if "the name of the process is used to identify both the process and the services rendered by means of the process by the proprietor thereof, the designation may be registrable as a service mark." (Examining Attorney's brief page 3). This legal proposition was fully explained in In re Universal Oil Products, 476 F.2d 653, 177 USPQ 456 (CCPA 1973).

The key to understanding whether the term UNBUNDLING identifies (1) only a process and is thus not registrable, or (2) identifies a service or a service and a process and is thus registrable must be determined by reviewing applicant's specimens of use. In pertinent part, applicant's specimens read as follows:

Solutions NOW ... has designed and developed a new process to help military scientists use their knowledge and experience to create new strength in the commercial economy. ... The first of these heretofore missing links is a way to identify the know-how of the individual military

technologist ... The interview uncovers the individual subject's way of knowing ... rather than the components of an invention or the military task on which the person worked. In this way the process of UNBUNDLING (SM) focuses on the individual technologist.

Applicant has made of record evidence showing that it has marketed its services to private corporations as well as to various components of the United States military, such as the Office of Naval Research.

We find that the specimens of use demonstrate that applicant is rendering a specific service under the mark UNBUNDLING. Put quite simply, applicant's services consist of assisting military personnel in transferring their technical knowledge to the civilian field.

We recognize that in its specimens of use, applicant itself has used the word "process." However, applicant could have just as easily used the word "service" in lieu of the word "process." Thus, applicant could have stated in its specimen of use that it "has designed and developed a new service to help military scientists use their knowledge and experience to create new strength in the commercial economy." Likewise, applicant could have said that "in this way the service of UNBUNDLING (SM) focuses on the individual technologist." To focus on applicant's use of the word "process" in lieu of the word "service"

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incorrectly places form over substance. In any event, we believe that, at a minimum, applicant's mark UNBUNDLING identifies both a process and a service, and thus pursuant to Universal Oil Products is registrable as a service mark.

Decision: The refusal to register is reversed.

E. W. Hanak

G. D. Hohein

H. R. Wendel  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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