

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG. 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kranco Browning, Inc.

Serial No. 75/086,700

Joseph Schaeff of Killworth, Gottman, Hagan & Schaeff for
applicant.

Richard A. Straser, Trademark Examining Attorney, Law
Office 104 (Sydney Moskowitz, Managing Attorney).

Before Simms, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Kranco Browning, Inc. has filed a trademark
application to register the mark ORLEY MEYER for "cranes,
hoists and parts therefor," in International Class 7, and
"installation, inspection, maintenance, repair, upgrading,

Serial No. 74/498,247

and modernization services in the field of cranes and hoists," in International Class 37.¹

The Trademark Examining Attorney has finally refused registration on the ground that the specimens of record are unacceptable evidence of use of the mark in connection with the services identified in the application.²

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Applicant originally filed two different specimens with its application. "Specimen 1" is a decal showing the mark in the following context:

¹ Serial No. 75/086,700, filed April 10, 1996, based on use of the mark in commerce in each class, alleging dates of first use and first use in commerce at least as early as 1963.

² This application contains two classes, identifying goods in International Class 7 and services in International Class 37. The final requirement for substitute specimens pertains only to the specimens in connection with the services identified in Class 37. The issue on appeal pertains only to this requirement with respect to the services identified in Class 37. However, as applicant has not requested a division of this application, unless applicant should ultimately prevail in an appeal of the Board's decision, the Board's affirmance of the refusal to register will result in the abandonment, in due course, of the entire application. Unlike an offer of disclaimer after issuance of a decision in an appeal (See, Trademark Rule 2.142(g)), the Rules of Practice do not permit the reopening of an appeal to accept a request to divide or a declaration in support of substitute specimens.

"Specimen 2" is a photocopy of what appears, in view of the nail or screw holes in each corner, to be a plaque that is approximately 10 inches by 3½ inches. The following is a reproduction:

In response to the Examining Attorney's initial requirement for substitute specimens in support of the services identified in International Class 37, applicant characterized its specimens of record as including "photographs of signs which are used in connection with applicant's goods and services [and are] attached to applicant's goods and also to applicant's trucks." Applicant included line drawings of trucks showing an OM design thereon that includes, in small print at the bottom, the words ORLEY MEYER.³

³ Unlike photographs, these line drawings do not show use of the mark on trucks.

In response to the Examining Attorney's final requirement for acceptable service mark specimens, applicant stated "[t]he specimens in question consist of business cards, letterhead and envelopes bearing the mark for which registration is sought."⁴ Applicant included with this response a photocopy of applicant's brochure, which clearly shows the mark and indicates both goods and services of the type identified in the application. Additionally, applicant submitted excerpts of articles from the LEXIS/NEXIS database about applicant's company.⁵ Applicant characterized these submissions as "supplemental specimens" and, thus, stated that no declaration regarding use was required.

The Examining Attorney reinstated the finality of his requirement for substitute specimens, noting that the use of such specimens must be verified by applicant as the record contains no acceptable verified specimens in support of the identified services.

With its notice of appeal, applicant requested reconsideration and submitted samples of blank letterhead

⁴ We note that this statement completely contradicts applicant's earlier statement describing the nature of the specimens. Considering the specimens themselves, the Board questions whether either statement adequately describes the nature of the specimens of record.

⁵ Articles discussing or describing applicant and authored by third parties are not, under any circumstances, evidence of use of the mark by *applicant* for either goods or services.

stationery, business cards and envelopes. Applicant declined to submit a declaration in support of this submission as well.⁶ The Examining Attorney denied the request for reconsideration, noting that the recent submission does not contain thereon any indication of the nature of the services and, thus, is unacceptable as supplemental material because the material does not explain or corroborate the original specimens. The Examining Attorney added that this submission does not qualify as substitute specimens since use of these items in connection with the identified services since at least as early as the filing date of the application had not been verified.⁷

From a review of the record, this appears to be a case where clear communication and an understanding of the Trademark Rules of Practice might have avoided this appeal altogether or, at least, simplified the issues. It appears that the advertising brochure, at least, might have been an acceptable specimen of use if it had been properly

⁶ We note that, in its brief, applicant incorrectly identifies as the specimens of record, the letterhead stationery, business card and envelope submitted with its request for reconsideration. However, as a verification of the use of this material at least as early as the filing date of the application was never submitted, this material *is not* considered the specimens of record.

⁷ Applicant is required to submit an affidavit or declaration attesting to use of the mark, on the specimens submitted, since at least as early as the filing date of the application. See, Trademark Rules 2.58 and 2.59, 37 CFR 2.58 and 2.59.

verified. However, the specimens of record consist of the previously-referenced decal and plaque.⁸ Thus, the sole question before us is whether the specimens of record are acceptable as evidence of service mark use in connection with the identified services.

It is well established that a term used as a trademark may also perform the function of, and be registered as, a service mark, provided that the specimens in the service mark application show the mark used or displayed in the sale or advertising of services, as distinguished from use on goods. *In re El Torito Restaurants, Inc.*, 9 USPQ2d 2003 (TTAB 1988); *Amica Mutual Insurance Company v. R. H. Cosmetics Corp.*, 204 USPQ 155 (TTAB 1979); *In re Restonic Corporation*, 189 USPQ 248 (TTAB 1975) and cases cited therein. The term "service mark" is defined, in pertinent part, in Section 45 of the Trademark Act, 15 U.S.C. 1127, as "any word, name, symbol, or device, or any combination

⁸ The specimens of record are the specimens originally submitted with the application, *i.e.*, the decal and the plaque. There is no question that the additional material submitted by applicant (*i.e.*, the drawings of trucks, the advertising brochure, the LEXIS/NEXIS excerpts, and the blank letterhead stationery, business card and envelope) cannot be considered as substitute specimens as no verification under Trademark Rule 2.59 was filed in connection with any of this material. Thus, it is unnecessary to address applicant's and the Examining Attorney's arguments in this regard. The only additional inquiry is the extent to which this "supplemental" material renders the specimens of record acceptable as evidence of use of the applied-for mark in connection with the identified services.

thereof (1) used by a person . . . to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown."

As the Board stated in *In re Moody's Investor's Services, Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989),

Implicit in this statutory definition is a requirement that there be a direct association between the mark sought to be registered and the services specified in the application, i.e., that it be used in such a manner that it would be readily perceived as identifying such services. (*citations omitted.*)

In this case, we are not determining whether applicant actually offers the identified services. Rather, we are determining whether ORLEY MEYERS functions as a service mark in connection with the recited services, which necessarily depends on how that term is used and how it is perceived by potential recipients of the services. To determine what the perception of a term is, we must look to the specimens of record which show how the term is used in the marketplace. *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986).

In this regard, there is no requirement that the specimens must, in all cases, contain a statement as to the nature of the services. *See, In re Metriplex, Inc.*, 23 USPQ2d 1315 (TTAB 1992); *In re Eagle Fence Rentals, Inc.*,

Serial No. 74/498,247

231 USPQ 228 (TTAB 1986). However, while the nature of the services does not need to be specified in the specimens, there must be something that creates in the mind of the purchaser an association between the mark and the service activity. *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994).

In the present case, it is our view that no such association can be made between the mark and the service activity from the specimens of record. The specimens of record contain no indication, either direct or implicit, that applicant renders the identified services of maintenance, repair, etc. of cranes and hoists. To the contrary, the specimens merely identify the entity that is applicant.

Further, the supplemental materials bear no relationship to the specimens of record, thus, they cannot be considered to truly "supplement" the specimens of record. Nor, as applicant argues in its brief, do these materials "*further* illustrate" applicant's activities. The term "further" implies that the original specimens illustrate the nature of applicant's services, which they do not. The supplemental materials do not include any photograph of either the decal or plaque appearing as a sign on applicant's service center or as a sign on a truck

Serial No. 74/498,247

clearly used for rendering the specified services, any of which would supplement the specimens of record in a way that indicates their use of the mark in connection with the identified services. Since we have already concluded that the supplemental material cannot substitute for the original specimens, as none of this material meets the requirements of Rule 2.59, it is unnecessary to consider whether the individual supplemental items would be acceptable specimens of service mark use if properly verified.

Serial No. 74/498,247

Decision: The refusal is affirmed on the ground that the Examining Attorney properly required substitute specimens because the specimens of record do not evidence use of the mark as a service mark in connection with the services identified.

R. L. Simms

C. E. Walters

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