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Paper No. 23  
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dick's Clothing and Sporting Goods, Inc.

Serial No. 75/094,815

Hugh D. Jaeger for Dick's Clothing and Sporting Goods, Inc.

Doritt Carroll, Trademark Examining Attorney, Law Office 115  
(Tomas Vlcek, Managing Attorney)

Before Simms, Hohein and Bucher, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Dick's Clothing and Sporting Goods, Inc., a New York corporation, has filed an application to register the mark, "WE'LL SUPPLY THE STUFF, YOU SUPPLY THE DREAM," for sporting equipment, including basketball equipment, baseball equipment, inline skates."<sup>1</sup> Accompanying the application were specimens consisting of a television screen displaying this slogan. Both

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<sup>1</sup> Serial No. 75/094,815, filed on April 26, 1996, which alleges dates of first use of April 1, 1995. While applicant did not indicate a class of goods, based upon the identification of goods as listed in the application, the Trademark Pre-examination Unit of the United States Patent & Trademark Office correctly assigned it the preliminary class of International Class 28 (Toys and Sporting Goods).

the television image and the area surrounding the television were devoid of any sporting equipment, as seen below:



The Trademark Examining Attorney took the position in the initial Office Action that the identification of goods in the original application was indefinite. Essentially this was a requirement to delete the unacceptable term "including" and to replace it with the acceptable term "namely," and to list individually by their common commercial name all the sporting good items in International Class 28 on which applicant had made use of this matter in interstate commerce. The Trademark Examining Attorney also noted that the specimens of record were unacceptable to show use of the alleged trademark for goods, and that replacement specimens should be submitted (e.g., tags, labels, containers, etc.) supported by a substitute declaration.

Applicant responded by suggesting an amendment to read as follows: "electronic advertising, video tapes for sporting equipment, namely sporting goods stores."

The Trademark Examining Attorney then refused this rather confusing, proposed amendment as being beyond the scope of the original identification of goods. Applicant's counsel clarified applicant's field of activity for the Trademark Examining Attorney, and argued for registration as follows:

This mark is used for advertising of sporting equipment, including basketball equipment, baseball equipment, and inline skates. Applicant is a sporting goods store. Even though the services may not be a consistent description as the Examiner may desire, it is certainly within the intent that the mark is used in advertising, as seen on the specimens, for sporting goods.  
(Applicant's response of January 1998, pp. 1-2)

At that point, the Trademark Examining Attorney went final on the grounds (i) that applicant's identification of goods was still indefinite, and that applicant's proposed amendment to the identifications of goods cannot be allowed, and (ii) that the specimens originally submitted by applicant cannot support use of this alleged mark on sporting goods.

Applicant has appealed, and briefs have been filed. Applicant did not request an oral hearing. We affirm as to both grounds of refusal to register.

The totality of applicant's appeal brief is contained herein:

Applicant believes that the statement of services was clear, that the specimens ... supports (sic) the statement of services, and that it was in the intent of the application that the mark is used to sell sporting equipment through advertising, such as on television. It is also believed that the Examiner could allow such an amendment to be made. The specimens are also deemed to be proper and the Examiner, by Examiner's Amendment, could have revised the method of use clause. It is believed that all of the necessary requirements have been made for treating this service mark for the sale of sporting goods. Applicant's counsel is a very reasonable person, having been a Patent Examiner himself, and just asks that the Trademark Examiner reconsider the position, and then telephone Applicant's counsel to discuss the issues in this brief, prior to writing the Examiner's brief.

Identification of goods is unacceptable

The original identification of goods was found to be indefinite. Inasmuch as no acceptable amendment to the identification of goods has been accepted by the Office, we are left with a listing of goods that is still indefinite, and hence unacceptable. We also agree with the position of the Trademark Examining Attorney in refusing to accept the amended identification of goods / recital of services. If permitted to make this change, applicant would be going from sporting goods to a genre of services. This amendment, if permitted, could well modify applicant's channels of trade, and affect other

du Pont factors.<sup>2</sup> Were the Office to permit applicant undue latitude in changing the identification of goods or recital of services during the course of prosecuting an application, it could well jeopardize the rights of a third party (e.g., someone prepared to adopt a similar mark sometime after April 1996 who had searched the records of the United States Patent & Trademark Office and then made a decision on potential instances of likelihood of confusion). Such a party might well rely to its detriment upon the scope of the original identification of goods. At the very least, such services would be placed in a different class than were the goods under the Nice International Classification system. In any event, permitting applicant to change the identification of goods contained in its original application to a proposed recital of services would be a clear expansion of the identification of goods, and hence would be violative of 37 C.F.R. §2.71(a). We find that the original intent-to-use rules, as reflected in a dozen years of Office practice, have established a reasonable and pragmatic system for applicants, while taking into consideration the important interests of third parties operating in the marketplace.<sup>3</sup>

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<sup>2</sup> In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973) sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

<sup>3</sup> The Trademark Examining Operation is correct in interpreting this rule with care. A primary objective of the constructive use provisions of the intent-to-use system (§7(c) of the Lanham Act as

Need for substitute specimens

As decided above, this application must be restricted to sporting goods in International Class 28. As the Trademark Examining Attorney argues, the alleged mark appearing as a still frame from a video image on a television screen is little more than a "picture" of the mark or an artist's drawing of the mark, and therefore is not acceptable as a specimen showing trademark use for the goods.<sup>4</sup> This isolated television screen creates no association with items of sporting goods and hence cannot

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amended) was ensuring clear notice to third parties, thereby providing greater certainty in the acquisition of trademark rights. This principle that has been followed consistently - from the time the Trademark Review Commission released its report, during the Congressional proceedings leading to passage of the Trademark Law Revision Act of 1988, through development of the Trademark Rules and the instructions contained in the first intent-to-use examination guidelines that were later reflected in the Trademark Manual of Examining Procedure (TMEP), during all the Patent and Trademark Office lectures for trademark practitioners and Trademark Examining Attorneys, as well as in specific cases decided over the past dozen years by the Commissioner [e.g., *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991) involving the mere addition of new items of clothing beyond an interim amendment during prosecution], and by the Trademark Trial and Appeal Board [e.g., *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991)]. By contrast, a looser interpretation of these provisions would have the perverse effect of creating much uncertainty.

<sup>4</sup> TMEP 905.04 Material Appropriate as Trademark Specimens

For a trademark application under §1(a) of the Trademark Act or an allegation of use under §1(c) or §1(d), specimens are required to evidence use of the mark on or in connection with the goods in commerce. Trademark Rule 2.56 states, in part: The specimens shall be duplicates of the labels, tags, or containers bearing the trademark, or the displays associated with the goods and bearing the trademark (or if the nature of the goods makes use of such specimens impracticable then on documents associated with the goods or their sale)...

The specimens may not be a "picture" of the mark, such as an artist's drawing or a printer's proof, which merely

constitute a "display associated with the goods." As shown in the photograph, this cannot be an inducement to consummate such a sale.<sup>5</sup> Hence, the Trademark Examining Attorney correctly required new specimens of use showing the mark used in connection with sporting goods.<sup>6</sup>

Consequently, the Trademark Examining Attorney's requirement for substitute specimens showing that applicant's mark identifies the goods as identified is well taken.

Decision: Accordingly, the refusal to accept the proposed amended identification of goods / recitation of services is affirmed as is the requirement for acceptable substitute specimens.

R. L. Simms

G. D. Hohein

D. E. Bucher

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illustrates what the mark looks like and is not actually used on or in connection with the goods in commerce.

<sup>5</sup> In her appeal brief, the Trademark Examining Attorney tersely described the contents of the photograph as merely being "... a television screen atop a cluttered desk...").

<sup>6</sup> Moreover, even if applicant's requested amendment to the identification of goods, *supra*, were appropriate under Rule 2.71(c), these photographs would still not be acceptable as service mark specimens.

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Administrative Trademark  
Judges, Trademark Trial and  
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