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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tim Allyn Patterson

Serial No. 75/294,104
Serial No. 75/294,107

James M. Graziano of Duft, Graziano & Forest, P.C. and Steven P. Hollman of Hogan & Hartson L.L.P. for Tim Allyn Patterson.

Martha L. Fromm, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Seeherman, Chapman and Holtzman[1], Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On May 19, 1997, Tim Allyn Patterson filed two applications, both for "printed materials, namely, magazines and newspapers containing general information and articles of interest to men, and general merchandise catalogs containing items of interest to men" in

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[1]Administrative Trademark Judge Holtzman has been substituted for Administrative Trademark Judge McLeod, who was on the panel at the oral hearing but left government service before these cases were decided. See In re Bose Corporation, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); and Jockey International, Inc. v. Bette Appel Unltd., 216 USPQ 359 (TTAB 1982). See also, TBMP §§802.04 and 803.

International Class 16[2]; and both based on applicant's assertion of a bona fide intention to use the marks in commerce. Application Serial No. 75/294,104 is for the mark MUSCLE WITH ATTITUDE; and application Serial No. 75/294,107 is for the mark TESTOSTERONE-MUSCLE WITH ATTITUDE. The marks were published for opposition on December 16, 1997; and notices of allowance issued in both applications on March 10, 1998. Applicant filed statements of use on September 9, 1998 (via certificates of mailing) asserting dates of first use and first use in commerce of March 5, 1998.

Registration has been finally refused in both applications because applicant has failed to submit acceptable specimens. Specifically, the Examining Attorney asserts that the specimens submitted by applicant do not show use of the marks on the identified goods as required by Trademark Rules 2.56 and 2.88.

Applicant has appealed, and briefs have been filed. A single oral hearing was held, and the appeals are hereby decided in a single opinion.

The specimens submitted by applicant (identical in

[2] Applicant's original identifications of goods read: "Printed Materials such as magazines, newsletters, catalogs, newspapers, periodicals."

both applications) are printouts of a page from applicant's website. A photocopy of applicant's specimen is reproduced below:

Applicant has not submitted any substitute specimens.

The Examining Attorney contends that specimens submitted with a statement of use must show use of the mark on the goods identified in the application; that applicant's specimens (printouts from an on-line publication) evidence service mark use for the International Class 42 service of an on-line publication; and that such specimens are unacceptable in these applications because a printout from an on-line publication does not establish use of the mark for applicant's

identified printed materials in International Class 16. While acknowledging that on-line publications and printed publications are related, the Examining Attorney argues that they are not interchangeable, specifically contending that on-line magazines are a service disseminated in electronic form and may or may not be printed by the consumer, whereas a printed magazine is a product disseminated in printed form; and that the identifications, international classifications, method of use by the applicant and the consumer, requisite specimens, and channels of trade for these goods and services are completely distinct.

Applicant contends that its "magazine is published in digital form as a monthly periodical" (brief, p. 2); that a federal court has determined that printed matter can exist in electronic form under the Lanham Act[3]; that the Examining Attorney's refusal to accept applicant's specimens as evidence of use of the mark on "printed matter in the form of an on-line magazine demonstrates a lack of knowledge concerning the field of electronic publishing and Webster's dictionary" (brief, p. 5); that applicant's specimens "are, in fact, printed materials that exactly reproduce the

[3] Ludden v. Metro Weekly, 8 F.Supp.2d 7, 47 USPQ2d 1087 (DCDC 1998).

electronic signals on paper" (brief, p. 5); and that this case turns on the meaning of the word "printed" which does not exclude electronic production and dissemination. Applicant submitted Webster's Dictionary definition of "print" as, inter alia, "3.a. Lettering or other impressions produced in ink from type by a printing press or other means."

Section 1 of the Trademark Act, as well as Trademark Rules 2.56 and 2.88, require that prior to registration applicant submit a specimen showing the mark as used on the goods in commerce.[4] See also, TMEP §905. It is implicit that the specimen must relate to the goods identified by applicant in its application.

The USPTO recognizes a distinction between printed magazines and newspapers on the one hand, and on-line publications on the other, by classifying them in two separate classes, and in fact, the latter is considered to be a service, rather than an item of goods. See the USPTO "ID Manual," which lists "computer services, namely, providing on-line [indicate specific nature of publication] in the field of [indicate subject matter of publication]" in International Class 42, and "magazines" and "newspapers"

[4] The exception relating to applications filed pursuant to Section 44 is not relevant here.

in International Class 16. Moreover, USPTO classification is based on the Nice Agreement Concerning the International Classification of Goods and Services, to which the United States is a party. Each of the countries party to the Nice Agreement is obliged to apply the Nice Classification in connection with the registration of marks.[5] Accordingly, electronic distribution of magazines and newspapers is not encompassed within International Class 16.

In this case, we agree with the Examining Attorney that the specimens submitted by applicant do not show the marks sought to be registered used by applicant on "printed materials, namely, magazines and newspapers containing general information and articles of interest to men, and general merchandise catalogs containing items of interest to men." Rather, the specimens of record evidence use as a mark in connection with the service of an on-line publication. That is, the specimens of record do not support use of the marks in connection with the identified goods because they do not show applicant's use of its marks in association with the sale of the goods specified in the applications. See In re Capp Enterprises Inc., 32 USPQ2d

[5] Informationally, on-line publications are considered services under the Nice Agreement, but effective January 1, 2002, they will be classified in International Class 41, due to a restructuring of International Class 42 of the Nice Agreement.

1855 (Comm. 1993); and The Jim Dandy Company v. Silver City Mills, Inc., 209 USPQ 764 (TTAB 1981).

Applicant's argument that a federal court has determined what constitutes "printed matter" is simply incorrect. The decision in the Ludden case, supra (cited by applicant), was a denial of a motion for summary judgment in a trademark infringement case involving the title of a newspaper or magazine column. Moreover, other court cases which may discuss classification of goods or services at the USPTO would not necessarily be determinative of the administrative classification of various products and services. This Office must follow the Nice Agreement, as explained earlier herein.

Decision: The refusals to register on the basis that the specimens do not show use of the marks on the identified goods is affirmed in both applications.[6]

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[6] Applicant's alternative request (first requested in applicant's brief on appeal) that both identifications of services be amended to read "on-line computer services, namely, providing magazines and newspapers containing general information and articles of interest to men, and general merchandise catalogs containing items of interest to men" is denied. This was not timely raised as an alternative position by applicant. See TBMP §1215. It is also noted that the Examining Attorney prospectively advised applicant on page 2 of her Final office actions, that any proposed amendment to specify on-line publications in International Class 42 would go beyond the scope of the original identification of goods, and therefore is prohibited under Trademark Rule 2.71(b). See also, In re Swen Sonic Corp., 21 USPQ2d 1794 (TTAB 1991).