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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Software Architects, Inc.

Serial No. 75/501,315

James Michael Faier of Faier & Faier P.C. for Software Architects, Inc.

Susan C. Hayash, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Cissel, Chapman and Bottorff, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 12, 1998, applicant filed the above-referenced application to register the mark "SARK" on the Principal Register for a variety of computer-related services. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in interstate commerce in connection with these services.

The Examining Attorney informed applicant that although only one application fee had been submitted, it

had included services in several different classes. Based upon the information provided in the application, the Examining Attorney suggested recitations of services in Classes 35, 40 and 42, and instructed applicant on the procedure for amending the application if applicant chose to do so.

Applicant responded by amending the application to allege use of the mark in connection with its services, and amended the recitation of services, as suggested by the Examining Attorney, to set forth services in those three classes.

The Examining Attorney accepted the three amended recitations of services which she had suggested, but held that the specimen submitted with the Amendment to Allege Use was unacceptable as evidence of use of "SARK" as a service mark because it showed the term sought to be registered only as a domain name or computer address.

Applicant then submitted additional specimens along with a declaration in support of them. The Examining Attorney found that the substitute specimens showed use of the mark in connection with the services in Classes 35 and 42, but not in connection with the services in Class 40. In addition to services in Classes 35 and 42, the amended application claims use of the mark in connection with

"document data transfer and physical conversion services from one media to another, in International Class 40."

Applicant timely filed a Notice of Appeal, which was followed by an appeal brief. The Examining Attorney filed her brief on appeal, and applicant waived its previously requested oral hearing before the Board, so we have resolved this appeal based on the written record in the application and the arguments presented in the briefs by applicant and the Examining Attorney.

The sole issue for our resolution in this appeal is whether applicant's specimens show use of "SARK" as a service mark for "document data transfer and physical conversion services from one media to another." Whether or not the Examining Attorney was justified in accepting the specimens as evidence of service mark use of "SARK" in connection with the services recited in Class 35 and Class 42 is not before us in this appeal.

Section 1(a)(1) of the Lanham Act provides that an applicant must submit "specimens or facsimiles of the mark as used" with the application. Simply put, the specimens must show the mark used in association with the services in connection with which applicant seeks to register it. The manner of use of the mark on the specimens should permit potential purchasers to perceive readily the mark as

identifying applicant's services and indicating their source, even if that source is anonymous. The specimen of use must create some "direct association" between applicant's services, as identified in the application, and the mark sought to be registered. As the Examining Attorney points out, in *In re Advertising & Marketing Development, Inc.*, 2 USPQ2d 2010, (Fed. Cir. 1987), our primary reviewing court stated that "[i]t is not enough for the applicant to be the provider of services; the applicant must also have used the mark to identify the named services for which registration is sought." In the case at hand, the Examining Attorney's position is that the specimens of use do not show "SARK" used as a mark to identify and distinguish "document data transfer and physical conversion services from one media to another."

A close look at the specimens submitted by applicant verifies that this is the case. Three of the specimens are applicant's advertisements for new employees. The fourth is a company newsletter.

The first, identified as Exhibit 1 to applicant's brief, is directed to potential full-time employees interested in jobs in the field of information technology consulting. Applicant states that its firm specializes in "application development using client-server and Internet

Ser No. 75/501,315

technologies." The advertisement touts the training applicant provides for new employees as well as opportunities for advancement within applicant's organization. Outside of use as a component of two Internet addresses, the only use of the mark applicant seeks to register is in the tag line of the text of the advertisement, where potential employees are urged to "Come joined the SARK team!"

Exhibit 2 is a similar advertisement wherein applicant is attempting to attract new employees. The advertisement is titled "It's another episode of career adventures with SARKMAN." The only use of the term sought to be registered in this advertisement is in the text, where potential employees are urged to "Come speak with our SARK recruiters at the TRN Chicago Tribune Career Fair and attend our FREE SEMINAR."

A third recruiting advertisement was also submitted by applicant. It is very similar to the Exhibit 1 advertisement. Except for use as part of an Internet address, the only time the term sought to be registered is used is when potential employees are urged to "Come join the SARK team!"

The only other specimen submitted by applicant in support of registration of the mark is an eight-page

publication titled "Quarterly Sark Letter," apparently issued for the second quarter of 1997. This appears to be an internal newsletter. Its contents include information about new hires, employee promotions, employee certifications, a schedule of events which include the company picnic, company golf outing and company meetings, and "new arrivals," a list of recent births to employees. In this newsletter, applicant identifies a four-point business plan which includes enhancing recognition of applicant as a solution provider consulting company; further developing its relationship with Microsoft; increasing its Internet business; and developing employee skills in new technologies. Applicant notes that it develops custom software, implements client-server and other information technology systems and provides a variety of training programs.

"SARK" is used in only three instances in the newsletter: as the title of the newsletter, and in the text of an article about recruiting employees from universities, which refers to "the original six SARK founders," and to "SARK personnel in Chicago."

Neither the advertisements recruiting new employees for applicant nor applicant's newsletter satisfies the requirement for specimens which show the term sought to be

registered used to identify the source of "document data transfer and physical conversion services from one media to another" to prospective purchasers of these services. None of the specimens submitted by applicant appears to be promotional material directed to potential customers of these services. Moreover, even if these materials were circulated among potential purchasers of the services identified in the application, none of the specimens shows "SARK" used to identify the source of data transfer and physical conversion services. As noted above, the term is used as an adjective in connection with "team," "recruiters," "letter," "personnel" and "founders," but not in connection with the data transfer and conversion services.

As such, the specimens are not evidence of use of "SARK" as a service mark for these services. Accordingly, the requirement for acceptable specimens must be affirmed.

In its brief on appeal, at p. 11, applicant requested that in the event the Board were to affirm the requirement for specimens in support of the Class 40 services, applicant would abandon that class from the application so that the application could proceed to publication in

Ser No. 75/501,315

Classes 35 and 42. In accordance with applicant's request, reference to the services in Class 40 is deleted and the application is being forwarded for publication in Classes 35 and 42.