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Paper No. 10
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CROSSTEX INTERNATIONAL

Serial No. 76/351,049

Myron Amer for CROSSTEX INTERNATIONAL.

Verna Beth Ririe, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Hairston and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge.

CROSSTEX INTERNATIONAL (applicant) seeks to register
in typed drawing form DERMA CARE SYSTEM on the Supplemental
Register for services which ultimately were identified as
"educational services, namely, conducting classes and
workshops in the field of infection control and proper
management of hazardous material in hand contact between
dentist and patient." The application was filed on
December 17, 2001 with a claimed first use date of April 1,
2001.

The Examining Attorney has refused registration on two grounds. First, the Examining Attorney contends that applicant's original specimen of use and its supplemental specimen of use both fail to show use of applicant's mark in connection with the above identified services. Second, with regard to the supplemental specimen of use, it is the position of the Examining Attorney that it was not properly made of record because "the declaration in support of this [supplemental] specimen is insufficient as it is not signed by the person verifying the truth of the matter asserted." (Office Action No. 2 at page 2).

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.

We affirm the refusal to register on the basis that neither the original specimen of use nor the supplemental specimen of use show use of applicant's mark DERMA CARE SYSTEM in connection with "educational services, namely, conducting classes and workshops in the field of infection control and proper management of hazardous material in hand contact between dentist and patient." Because the supplemental specimen of use is defective on its merits, we need not reach the issue of whether it was properly made of

record. For the purposes of our discussion, we will assume that it was properly made of record.

As our primary reviewing Court has made clear, "it is not enough for the applicant to be a provider of services; the applicant also must have used the mark to identify the named services for which registration is sought." In re Advertising & Marketing, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) (emphasis added) citing In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). As one might gather from the "emphasis added" wording just quoted, the real issue in this case is whether applicant's specimens of use (original or supplemental) identify the services set forth in applicant's amended identification of services. In this regard, applicant's original identification of services read as follows:
"educational services in promoting infection control and proper management of hazardous materials in hand contact between dentist and patient." In her first Office Action, the Examining Attorney stated that the wording "educational services" is unacceptable as indefinite. The Examining Attorney then stated that "the applicant may adopt the following recitation of services ... if accurate." (emphasis added). In response, applicant adopted the suggested recitation of services which, as previously noted, read as

follows: "educational services, namely, conducting classes and workshops in the field of infection control and proper management of hazardous material in hand contact between dentist and patient." (emphasis added).

To cut to the quick, neither applicant's original specimen of use nor its supplemental specimen of use show use of its mark DERMA CARE SYSTEM in connection with conducting any type of classes or workshops, including in particular classes and workshops in the field of infection control and proper management of hazardous materials in hand contact between dentist and patient. Applicant's supplemental specimen of use is a five-page brochure entitled CROSSTEX DERMA CARE SYSTEM. This five-page brochure is in reality a sales brochure which describes in detailed fashion various products which applicant sells, including antimicrobial soap and protective gloves. Applicant's supplemental specimen of use is truly a sales brochure. While it features the mark applicant seeks to register, it does not in any way associate the mark with "educational services, namely, conducting classes and workshops in the field of infection control and proper management of hazardous materials in hand contact between dentist and patient."

Applicant's original specimen of use is also entitled CROSSTEX DERMA CARE SYSTEM. This original specimen of use consists of one page and it contains a series of 10 questions and answers. For example, the first question is: "Why use an antimicrobial hand soap?" What follows is a fact intensive answer. Applicant's original specimen of use does not discuss applicant's specific products which it offers for sale.

Applicant's original specimen of use is actually a "better" specimen of use than is applicant's supplemental specimen of use. This Board can easily envision a situation where applicant's original specimen of use could be used as course material in conducting classes and workshops in the field of infection control. We note in passing that applicant's original specimen of use does not discuss the subject of the management of hazardous materials in hand contact between dentist and patient.

However, the problem with applicant's original specimen of use is that it contains nothing to indicate that it actually is used as course material in conducting classes and workshops in the field of infection control and the proper management of hazardous material in hand contact between dentist and patient. Applicant's original specimen of use could just as easily serve as informational

literature that is mailed to dentists or is distributed to dentists at dental conventions. The mere mailing or distribution of applicant's original specimen of use simply does not constitute conducting classes and workshops.

This Board has been quite flexible in accepting service mark specimens of use. For example, when an applicant sought to register its mark for "commercial art design services," this Board accepted as proper service mark specimens of use letterhead stationery, business cards and the like which contained the mark because the mark itself contained the word "design." In so doing the Board stated that "it is not necessary that the specific field of design, i.e., commercial art, also appear thereon. Here, the word 'design' alone is sufficient to create in the minds of purchasers an association between the mark and applicant's commercial art services." In re Ralph Mantia Inc., 54 USPQ2d 1284, 1286 (TTAB 2000).

By analogy, had the present applicant's original specimen of use contained in a noticeable fashion such words as class, workshop or course material, we would have accepted the original specimen of use. However, as previously noted, the original specimen of use in no way makes reference to classes, workshops, courses or the like.

In another example of the Board's flexible approach to accepting service mark specimens of use, this Board accepted a computer screen display which featured applicant's mark but which did not make any reference whatsoever to the services for which applicant sought to register the mark. However, in that case "applicant explained in its declaration [that] the specimens show the mark as it appears on a computer terminal in the course of applicant's rendering of" its services, namely, the transmission of data to subscribers. In re Metriplex Inc., 23 USPQ2d 1315, 1316 (TTAB 1992).

In stark contrast, in the present case we have of record no declaration or affidavit from applicant stating that its original specimen of use is indeed material used in conducting classes and workshops. We do not even have a statement from applicant's counsel that the original specimen of use (or the supplemental specimen of use) is used as course material in classes or workshops. Instead, at page 4 of applicant's brief, applicant's counsel makes the following statements: "There is nothing of record that precludes the use of the specimens before an assembly of individuals which can be characterized as 'classes' or 'workshops.'" Logic in fact dictates that the specimens, because they are so fact intensive and also because of the

phraseology used, would be used at dentists' workshops." As can be seen from the foregoing statements of applicant's counsel, applicant's counsel never at any time stated that applicant's specimens (original or supplemental) are indeed actually used as course material at classes or workshops. Whether a mere statement by applicant's counsel would have "carried the day" as did the declaration of applicant in Metriplex is an issue which we need not decide.

One final comment is in order. At pages 4 and 5 of his brief, applicant's counsel notes that it was the Examining Attorney who suggested the addition of the wording "conducting classes and workshops" into applicant's original recitation of services. Applicant's counsel then goes on to note at page 5 of his brief that originally "there was no mention however of the unanticipated and narrow meaning that would be applied to the added references to 'conducting classes and workshops.'"

Two points should be made. First, we do not understand what applicant means by the words "narrow meaning." We have already said that had applicant's original specimen of use contained in noticeable fashion the words class, workshop or course material, then the specimen would have been acceptable. We would not have required that the specimen contain any more, such as a

description of the precise nature of the classes, workshops or courses. Moreover, it would have been acceptable if the classes and the like not only conveyed information but also promoted applicant's products.

Second, applicant's counsel acknowledges at page 5 of his brief that when the Examining Attorney suggested the new recitation of services in the first Office Action, it "was with a caveat 'if accurate.'" Applicant's counsel was not obligated to accept the Examining Attorney's suggested recitation of services. If applicant's counsel could not affirmatively state that the original specimen of use was indeed used in conjunction with classes and workshops, then he should not have adopted the Examining Attorney's suggested recitation of services.

Decision: The refusal to register is affirmed.