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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Stout Industries, Inc.

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Serial No. 75/712,594

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Paul M. Denk, Esq. for Stout Industries, Inc.

John Dwyer, Trademark Examining Attorney, Law Office 116  
(Meryl Hershkowitz, Managing Attorney).

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Before Simms, Chapman and Holtzman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On May 24, 1999, Stout Industries, Inc. (a Delaware corporation) filed an application to register the mark STOUT.COM on the Principal Register, for services identified, as amended, as "providing an on-line computer database providing information in the field of custom

design and manufacture of signs and sign bearing fascia" in International Class 40.<sup>1</sup>

The application was based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). It was published for opposition on May 30, 2000; and a notice of allowance issued on August 22, 2000. On February 20, 2001 (via certificate of mailing), applicant filed a statement of use, alleging use since January 1, 1999, and including a specimen in the form of a promotional card given out to customers and potential customers.

The Examining Attorney found the specimen did not show use of the mark in relation to the specific identified services; and required that applicant submit substitute specimens, supported by an affidavit or declaration, showing use of the mark for the identified services. Applicant then filed another statement of use, including as specimens two different photographs of a portion of two signs bearing the mark STOUT.COM; and applicant also

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<sup>1</sup> Stout Industries, Inc. filed two other applications (Serial Nos. 75/713,192 and 75/713,242), both for the mark STOUT.COM, but for different services on May 24, 1999. Those applications are also on appeal to the Board. A single decision on those two applications will issue separately. (In addition, applicant filed on that date a fourth application, Serial No. 75/712,606, for the mark STOUT.COM for "non-luminous and non-mechanical metal signs; metal sign bearing fascia" in International Class 6. It issued as Registration No. 2,474,220 on July 31, 2001.)

submitted a brochure which explains applicant's business, but does not include the mark STOUT.COM anywhere thereon.

The Examining Attorney again rejected the specimens, and made final the refusal on the ground that the specimens submitted by applicant do not show use of the mark for the services identified in the application.

Applicant appealed to the Board. Briefs have been filed, but applicant did not request an oral hearing.

The Examining Attorney's position is essentially that the specimens do not show the mark used in the sale or advertising of the identified services.<sup>2</sup> With specific regard to each specimen, the Examining Attorney contends that the brochure does not include the mark STOUT.COM anywhere in the brochure; that the two photographs show the mark STOUT.COM but they are clearly photographs of portions of signs (appearing on a vending machine for "7UP") and would not be perceived as supporting use of applicant's mark for the identified services; and that the card given

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<sup>2</sup> The Examining Attorney also argued that to be recognized as a service, the services cannot be ancillary to applicant's own business (i.e., applicant's identified services of providing an on-line computer database providing information about custom design of signs could simply be applicant's web site for its own goods and services). To be clear, the Examining Attorney has not refused registration on the ground that applicant is not performing a separate service. Rather, his refusal to register is limited to the failure of the specimens to show use of the mark in association with the identified services.

out to potential customers also shows the mark STOUT.COM but does not reference even indirectly the identified services, and based on the other wording on the specimen would be perceived as relating to marketing and sales and brand building services.

The Examining Attorney concludes that each of the specimens submitted by applicant fails to demonstrate use of the mark in association with the identified services, "providing an on-line computer database providing information in the field of custom design and manufacture of signs and sign bearing fascia" as required by Trademark Rules 2.56(a) and (b)(2) and 2.88(b).

Applicant essentially contends that its extensive usage of STOUT.COM in applicant's various materials such as cards given out to potential customers "is adequate proof of substantial and continuous usage of applicant's mark in this business of providing a custom design of signs and sign bearing fascia for others" (brief, p. 5); and that applicant has used the mark in a variety of displays to indicate source of origin, each of which supports applicant as the source of these services.<sup>3</sup>

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<sup>3</sup> In its arguments, applicant referred to its various uses of the mark as including use on a web page. The record in this application does not include a web page, offered either as a specimen or simply offered for informational purposes.

The requirements for specimens of use of a mark in connection with services differ from the requirements for specimens of use of a mark in connection with goods. Although trademarks appear directly on the goods or on the containers or labels for the goods, service marks are used in connection with the services. Implicit in the statutory definitions of a "service mark" is the requirement that there be some direct association between the mark and the services, i.e., that the mark be used in such a manner that it would readily be perceived as identifying the source of such services. See *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987); and *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997).

That is, specimens must show an association between the mark and the services for which registration is sought; and specimens which show the mark, but with "nothing directed to prospective customers of the stated services which could have created an association, direct or otherwise, between the mark and the services set forth in the application" are insufficient. See *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1319 (TTAB 1994). See also, *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989).

In this case, we agree with the Examining Attorney that the specimens submitted by applicant do not show use of the mark in connection with the services identified in the application. Rather, one specimen does not include the mark anywhere thereon and thus cannot support the application for the mark STOUT.COM. The two specimens which are portions of a sign (appearing on a vending machine for "7 UP") include the following wording:

Manufactured by Stout Sign Co.  
St. Louis Mo. Made in U.S.A.-9716127  
Authorized by Cadbury Beverages Inc.  
Total Production 925  
stout.com

This use does not indicate anything which would create in the mind of the relevant consumers an association between the mark and the service activity (providing an on-line computer database). At best, this may support trademark use for signs, but it does not support service mark use for applicant's identified services.

Finally, the card is reproduced below:

**STOUTMARKETING.**  
Building Stronger Brands Worldwide



Looking to boost sales and build stronger brands?  
Now you can find out how online:

**stout.com**

6425 West Florissant Avenue, St. Louis, MO 63136-4909 • 314.285.4600 • 800.325.8530 • info@stout.com

The wording thereon, such as:

"STOUTMARKETING  
Building Stronger Brands Worldwide";  
and

"Looking to boost sales and build stronger brands?"

does not create an association in purchasers' minds with applicant's identified services of "providing an on-line computer database providing information..." on custom design of signs. These promotional cards may identify or support a marketing or advertising service, but not that of providing an on-line information about custom design of signs.

We find the specimens of record do not support use of the mark STOUT.COM in connection with the identified services because they do not show applicant's use of the mark in association with the sale or advertising of the services specified in the application.

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**Decision:** The refusal to register on the basis that none of the specimens show use of the mark in connection with the identified services is affirmed.