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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Linguistique et Intelligence Artificielle, dba Lidia
S.A.

Serial No. 75/980,776

Fritz L. Schweitzer, Jr. of Schweitzer Cornman Gross &
Bondell LLP for Linguistique et Intelligence Artificielle,
dba Lidia S.A.

David T. Taylor, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Cissel, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 29, 1998 Linguistique et Intelligence
Artificielle, dba Lidia S.A. (a French corporation) filed
an application to register the mark LIDIA RETRIEVER on the
Principal Register, for services identified, as amended, as
"business consultation directed to the research and
scientific analysis of the syntax of written and verbal

communications, with particular regard to discerning the main ideas of such communications and their associated ideas, especially to enable intelligent indexing of such communications" in International Class 35.¹ The application, as originally filed, was based on applicant's assertion of a bona fide intention to use the mark in commerce. The method-of-use clause for the services stated that the mark would be applied to letterhead, brochures and promotional materials.

The application was published for opposition on June 6, 2000, and on August 29, 2000, the USPTO issued a notice of allowance. Applicant filed a statement of use for the Class 35 services on January 9, 2001, setting forth a date of first use and first use in commerce of February 28, 1997. The method-of-use clause now reads that the mark is applied "to brochures and advertising sheets offering the services."

The Examining Attorney noted the filing of the statement of use, but he required that applicant submit substitute specimens, supported by an affidavit or

¹ The original application was Serial No. 75/612,997 and included goods in International Class 9 as well as the International Class 35 services. However, applicant filed a request to divide out the Class 35 services, resulting in this "child" application. (The original "parent" application has subsequently been abandoned.)

declaration, showing use of the mark for the identified services. Applicant responded by submitting an "explanatory document," specifically explaining it was not offered as a substitute specimen. (Applicant's paper filed August 2, 2001 -- miscaptioned "Statement of Use Under 37 C.F.R. §2.88").²

Registration has been finally refused on the ground that the specimen submitted by applicant does not show use of the mark for the services identified in the application.³

Applicant has appealed, and briefs have been filed, but applicant did not request an oral hearing.

The Examining Attorney's position is essentially that the specimen shows use of the mark for goods, that is,

² Both the Examining Attorney and applicant subsequently treated the "explanatory document" as a substitute specimen. To clarify the record, there is only one specimen of record and that is the one submitted with applicant's statement of use on January 9, 2001. The "explanatory document" was not offered by applicant as a specimen and, moreover, was not supported by an affidavit or declaration as required by Trademark Rule 2.59.

³ The Examining Attorney also argued in the Final Office action that a term which merely designates a process, or is used only as the name of a process, is not registrable as a service mark. The Examining Attorney did not make a separate refusal to register on the ground that the mark does not function as a mark, but identifies only a process, and in his brief, the Examining Attorney expressed the issue on appeal as "whether the specimens submitted are unacceptable as evidence of actual service mark use such that the refusal to register is proper." Inasmuch as there is no separate refusal based on the term identifying only a process, that argument will not be further considered herein.

computer programs, but fails to demonstrate use of the mark in association with the identified services, "business consultation directed to the research and scientific analysis of the syntax of written and verbal communications, with particular regard to discerning the main ideas of such communications and their associated ideas, especially to enable intelligent indexing of such communications," as required by Trademark Rule 2.56.

Rather, the Examining Attorney asserts that the specimen shows use of the mark LIDIA RETRIEVER as identifying one of three software programs employing the LIDIA methodology, but does not show service mark usage.

Applicant essentially contends that there is a minimal association requirement between the specimens and the services offered; that there is no requirement for an explicit reference to the services, but rather, the specimens for services must merely show use of the mark in association with the services; that its specimen adequately focuses on the relationship between the mark LIDIA RETRIEVER and applicant's service of analyzing communications; that even if the specimen could be viewed as advertising goods as well as services, applicant has explained in the record that "Applicant's services are rendered using computer software" (brief, p. 6), and has

explicitly stated (through counsel) that applicant does not sell or license software under the LIDIA RETRIEVER mark; and that the specimen submitted is, in fact, what applicant uses to advertise and offer its services.

Applicant's specimen of record is a two-sided sheet of promotional literature. The mark LIDIA RETRIEVER, followed by the symbol "™," appears by itself at the top of the front page, in large type and in blue ink making it very prominent. It is clear the text which follows the headline (LIDIA RETRIEVER) refers to this mark. It is evident from this material that LIDIA RETRIEVER is being used as a service mark for the identified services. For example, the following statements appear on applicant's promotional literature specimen:

Only Lidia Retriever™ allows you to work with large qualitative databanks, to access and evaluate all the ideas expressed, and to segment these ideas based on the strength of their relationship to the dynamic/search ideas.

By identifying the ideas that are essential to a respondent's point of view, it prioritizes the ideas that are most important to your customers. It then puts these into context by finding the links between the ideas expressed and by understanding the strength of the associations between them.

Applicant's specimen clearly indicates that applicant's services are rendered to its customers through applicant's use of computer programs, and, in fact, applicant has so stated; but that does not mean that the mark does not also identify applicant's services. See *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992). That is, just because applicant's intangible services are rendered through the means of a tangible item, specifically, a computer program, this does not mean that applicant's mark does not also identify the services. It is true that the specimen does not make explicit reference to the services precisely as they are identified in the application, however, the specimen does indicate use of the mark for these services.

Moreover, applicant's attorney has stated that the specimen is the promotional literature which is distributed to applicant's prospective customers in the offering of applicant's identified services to its customers; and that applicant "has never sold any goods under any mark" and it "does not sell or license software in connection with the LIDIA RETRIEVER mark" (brief, p. 4).

We find that applicant's specimen shows use of the mark LIDIA RETRIEVER for applicant's identified business consulting services such that customers would perceive the

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association between the mark and the identified services.
See *In re Advertising & Marketing Development, Inc.*, 821
F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987).

Decision: The refusal to register on the basis that
the specimen does not show use of the mark in connection
with the identified services is reversed.