

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
January 23, 2003
Paper No. 9
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jo Ann T. Meany

Serial No. 78038371

Morris I. Pollack for Jo Ann T. Meany.

Maria-Victoria Suarez, Trademark Examining Attorney, Law
Office 102 (Thomas V. Shaw, Managing Attorney).

Before Seeherman, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Jo Ann T. Meany seeks registration on the Principal
Register for the mark WE'LL SEE for advisory or consulting
services.¹ The sole subject of this appeal is the refusal
of the Trademark Examining Attorney to register the
proposed mark on the ground that applicant has failed to
propose an acceptable recitation of services, and
furthermore, that the latest proposed amendment also

¹ Application Serial No. 78038371 was filed on December 8,
2000 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

exceeds the scope of the recitation of services as it was set forth in the application at the time of filing.

Both applicant and the Trademark Examining Attorney have fully briefed this case but applicant did not request an oral hearing.

As filed, the services were recited as follows:

Advisory Services, namely for; dates, appointments, meetings, excursions, occasions [sic], happenings, rendezvous [sic], escapades, undertakings, and the like.

The originally-assigned Trademark Examining Attorney found the recitation unacceptable as indefinite, and asked for additional information to help derive an acceptable recitation of services and to ensure correct classification of the services. Applicant responded with the following amendment:

Communication(s) with Clients and prospective Clients, in person, through phone discussion(s), instant message(s), E Mail(s), fax(s) [sic] mail and the like, to consider and review prospective dates, appointments, meetings, excursions, occasions, happenings, rendezvous [sic], escapades, undertakings, and the like, as well as stationary [sic], advertising, and literature, namely, calendars, greeting cards, invitations, photographs, posters, brochures, and other such goods.

The newly-assigned Trademark Examining Attorney reviewed the amended recitation and concluded that perhaps applicant was involved in some kind of "consultation services" but found the new recitation still to be indefinite. She asked for "simple, specific descriptions of the activities engaged [sic] by the applicant for the benefit of its [sic] customers" as well as more information "about the use, the primary industries of use and how the service functions" She also refused to accept the latter portion of the amended recitation (e.g., "stationary [sic], advertising, and literature, namely, calendars, greeting cards, invitations, photographs, posters, brochures, and other such goods") as being beyond the scope of the original recitation of services.

Applicant responded with yet another amended recitation of services, twice deleting the offending words "and the like" from the prior iteration while adding the new wording highlighted below:

Consulting services by way of
communication(s) with Clients and
prospective Clients, in person, through
phone discussions(s), instant message(s), E
Mail(s), fax(s) mail and the like, to
consider and review prospective dates,
appointments, meetings, excursions,
occasions, happenings, rendezvous [sic],
escapades, undertakings, and the like, as
well as stationary [sic], advertising, and
literature, namely, calendars, greeting

cards, invitations, photographs, posters, brochures, and other such goods **resulting therefrom**.

In her final refusal to register, the Trademark Examining Attorney argued that the nature of applicant's services were still unclear given the indefinite wording of the recitation as proposed. Drawing on the Trademark Acceptable Identification Goods & Services Manual, she did propose something like the following, if accurate:

Concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs rendered together in a [indicate environment, e.g., apartment complex, business conference, shopping center, etc.], in International Class 45.

The Trademark Examining Attorney also restated her refusal to register on the ground that the recurring listing of goods exceeds the original scope of the services in the application papers as filed.

In the appeal brief, applicant argues that the proposed wording is clear and most definite - that applicant is involved in appropriately-recited consulting services:

The recitation of services is now acceptable and definite. Consulting services are what are being provided by Applicant - that is most definite.

Those Consulting services are accomplished by various forms of communication between Applicant and its clients and prospective clients. Phone, E Mails, Faxes [sic], and mail are all clear english [sic] and accepted forms of communication. As such they are clear and definite.

The recitation of services continues by defining the kinds of subject matter for which Applicant consults; such as -- dates, appointments, meetings, occasions, happenings, rendezvous [sic], escapades..." and undertakings --. Here again plain english [sic] and most definite.

The recitation of services to be even more definite further defines the types of items that the consulting services might suggest as a result of the consultation as being helpful to the customer. Items such as -- stationary [sic], advertising and literature, calendars, greeting cards, invitations, photographs, posters, brochures, and other such goods - comprise a recitation of those suggested types of items. All such items comprising recommendations to the customer as a result of the consultation [sic].

The last words of the recitation of services should not be overlooked "resulting therefrom" which in common english [sic] refers back to the consulting services and is most definite [sic].

From the above it should be apparent that the Recitation of Services refers only to consulting services and in a most definite manner recites how the consultations may occur, what the consultation may concerns [sic] and the nature of the results of the consultations by way of possible recommendations.

CONCLUSION

As such, and in view of the above comments, the FINAL requirement to clarify and make more definite should be withdrawn and the Application to Register passed [sic] to publication and registration.

(Applicant's appeal brief, pp. 2 and 3)

Among other complaints, the Trademark Examining Attorney argues that nowhere has applicant provided the field(s) in which applicant's consulting services are provided. She also notes that a specific listing of goods resulting from the advisory or consulting services cannot be added to the original recitation of services, notwithstanding the vagueness of the original description.

Despite a thorough review of this application file, we are still puzzling over what services applicant intends to provide. Perhaps the Trademark Examining Attorney has guessed correctly that applicant's services should be described as some form of personal concierge or convenience services. If so, it is unfortunate that applicant failed to accept this recitation or to propose a correct modification of something understandable and definite in its place. On the other hand, in the event that applicant is providing "consulting services," the field(s) in which

the consultation is taking place is (are) critical.² This is required in determining the appropriate channels of trade (e.g., in any likelihood of confusion analysis involving this mark) and in deciding upon the correct International Class(es) of services for which applicant would be seeking a registration.

Given all the uncertainty surrounding this application, we do wish that applicant's counsel had submitted samples of advertisements, promotional materials or even a rough business plan, so that the Trademark Examining Attorney could have assisted applicant in deriving an acceptable recitation of services, or that applicant's counsel would had placed a call to the Trademark Examining Attorney so that the two of them could have worked out together a definite and clear recitation of services.

Additionally, while this application is anything but a model of clarity in drafting, applicant's listing of documents 'resulting from' the consulting services could well be seen as unnecessary verbiage that is nonetheless further defining the nature of the services. On the other hand, to the extent that these specifically-enumerated

² Although it seems clear that the seriatim listing of all of the forms of communication applicant uses are totally irrelevant.

types of documents (like stationery and brochures) are viewed as goods in trade (classified in International Class 16), they clearly would not be within the scope of the original recitation of "advisory services."

Decision: The refusal to register based upon applicant's failure to propose an acceptable recitation of services is hereby affirmed.