

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
December 9, 2004

Mailed: 1/25/05

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fusion UV Systems, Inc.

Serial No. 76268678

Jill M. Pietrini and Jessica J. Slusser of Manatt, Phelps & Phillips for applicant.

Zhaleh Delaney, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Quinn, Hairston and Walters, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Fusion UV Systems, Inc. to register the mark INVISIBLE BUT EVERYWHERE for "material treatment services in the field of polymerizing coatings, inks, powders, composite structures and gels using ultraviolet light" (in International Class 40) and "technical consultation services in the field of polymerizing coatings, inks, powders, composite structures

and gels using ultraviolet light" (in International Class 42).¹

The examining attorney refused registration on the ground that applicant failed to submit acceptable specimens showing actual use of the mark in connection with the material treatment services recited in International Class 40 in the application.²

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs, and an oral hearing was held before this panel of the Board.

The examining attorney maintains that consumers will not perceive the involved mark as identifying the source for material treatment services "when [the mark is] used in an advertisement displaying a cell phone featuring UV curing, i.e., a cell phone for which material treatment services are *complete* prior to the purchaser encountering the mark." (Brief, p. 4)(emphasis in original). According to the examining attorney, the specimen of record makes no reference to the provision of material treatment services

¹ Application Serial No. 76268678, filed June 9, 2001, based on an allegation of an intention to use the mark in commerce. Applicant subsequently filed a statement of use setting forth a date of first use anywhere and a date of first use in commerce in both classes of July 2001.

² The examining also originally refused registration on the same basis in International Class 42, but the refusal was subsequently withdrawn.

of any kind by applicant; while the specimen informs the consumer about the many uses of UV curing, it is silent on the source of such material treatment services. The fact that the specimen tells prospective consumers to contact applicant about UV curing in general, the examining attorney argues, supports at most technical information and consultation services in the field of UV curing.

Applicant contends that the Office should take a flexible approach toward specimens of the type submitted by applicant, taking into consideration the difficulty in demonstrating the use of a mark in conjunction with intangible services. According to applicant, its specimens are copies of an advertisement that appeared in the July 2001 issue of *Products Finishing* magazine. Applicant asserts that the advertisement was intended to advertise applicant's UV curing and consultation services to companies that are in the UV curing field itself, and to the industries that benefit from the process of UV curing. Applicant argues that the specimen shows a direct association between its mark and the material treatment services:

The specimen identifies Applicant, it prominently displays the mark INVISIBLE BUT EVERYWHERE, and it is used in the sale and advertising of Applicant's material treatment services. The

specimen also identifies six specific components of the pictured cellular phone for which Applicant's UV curing was used. As such, Applicant's specimen shows use of the mark in connection with material (e.g. the cell phone) treatment services.

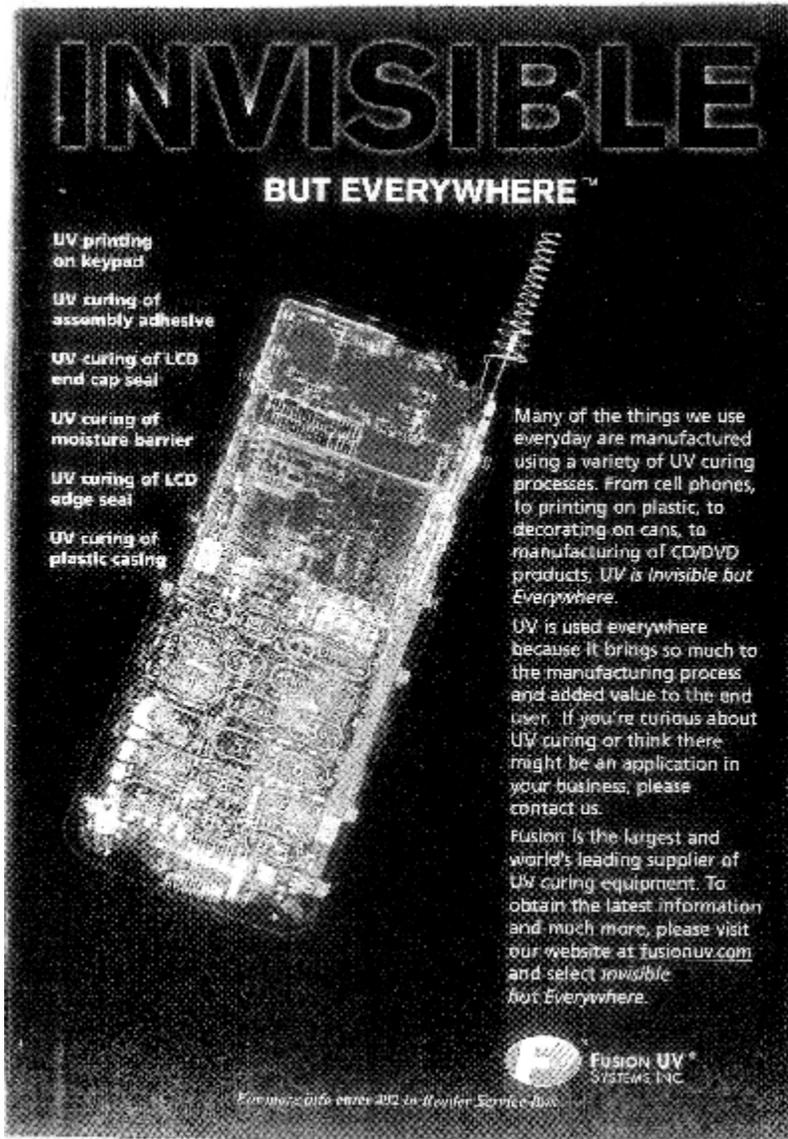
(Brief, p. 9). Applicant's customers will not believe, applicant argues, that applicant took out an entire full-page advertisement in a trade magazine to tell the UV curing community what UV curing is. Rather, "[a]pplicant's customers know what UV curing is (including the treatment necessary to perform UV curing), and they will associate INVISIBLE BUT EVERYWHERE as Applicant's 'tag' line or slogan for all of its UV curing services." (Reply Brief, p. 6).

Trademark Rule 2.56(a) provides, in part, that an application alleging use must include one specimen showing the mark as used on or in connection with the sale or advertising of the services in commerce. Trademark Rule 2.56(b)(2) further specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...."

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. In re Monograms America Inc., 51 USPQ2d 1317 (TTAB 1999). It is not enough that the term alleged to constitute the mark be used in the sale or advertising; there must also be a direct association between the term and the services. In re Johnson Controls Inc., 33 USPQ2d 1318 (TTAB 1994); and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985). The mark must be used in such a manner that it would be readily perceived as identifying the source of such services. In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); In re Adair, 45 USPQ2d 1211 (TTAB 1997); and In re Metrotech, 33 USPQ2d 1049 (Com'r Pats. 1993). See TMEP §1301.04 (3d ed. rev. 2003)

The issue, thus, is whether applicant is using INVISIBLE BUT EVERYWHERE as a mark to identify the source of its material treatment services. The determination of whether applicants' specimens show the mark INVISIBLE BUT EVERYWHERE in connection with the sale or advertising of

these services necessarily requires a consideration of the specimens. As noted earlier, applicants' specimens are copies of an advertisement that ran in a trade magazine. The specimen is reproduced below.



We find that the specimen suffices as evidence of use of the mark INVISIBLE BUT EVERYWHERE for applicant's identified material treatment services. See In re Ralph

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Mantia, Inc., 54 USPQ2d 1284 (TTAB 2000); In re Metriplex, Inc., 23 USPQ2d 1315 (TTAB 1992); and In re Ames, 160 USPQ 214 (TTAB 1968). The right side of the advertisement states, "[i]f you're curious about UV curing or think there might be an application in your business, please contact us." The left side of the advertisement lists six possible uses for the material treatment services in connection with a cell phone (e.g., "UV curing of plastic casing"). The applied-for mark and these statements are immediately juxtapositioned in the advertisement. When these statements are viewed in conjunction with one another, we find that the advertisement creates the requisite direct association between the mark and the material treatment services. We agree with applicant's following assessment: "Applicant's customers will associate the trademark INVISIBLE BUT EVERYWHERE with Applicant's UV curing services, because the specimen's explanation of how UV curing can be applied to everyday goods such as cellular telephones, will easily be seen as an advertisement that Applicant can perform such services for its customers." (Reply Brief, p. 6). As viewed by prospective customers reading the trade magazine, they would understand that applicant is offering material treatment services in the field of polymerizing coatings.

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Decision: The refusal to register is reversed.