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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Decision Analyst, Inc.

Serial No. 78139723

Larry E. Meadows of Meadows & Associates, L.L.P. for
Decision Analyst, Inc.

Linda E. Blohm, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Hairston and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application was filed by Decision Analyst, Inc. to
register the mark ICIION for services ultimately identified
as "computer software programming for others via the
internet, such programming dealing with multivariate

sampling and panel management software in the field of marketing research.”¹

The examining attorney refused registration on the ground that applicant failed to submit acceptable specimens showing actual use of the mark with the computer software programming services recited in the application.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs, but an oral hearing was not requested.

Before turning to the merits of the case, we must discuss two preliminary matters. With its brief on appeal, applicant has submitted additional specimens, to which the examining attorney has objected as being untimely, and has proposed an amendment to the recitation of services. Trademark Rule 2.142(d) provides that the record in an application must be complete prior to the filing of an appeal. After an appeal is filed, if applicant wishes to have an examining attorney consider additional specimens or an amendment to the recitation of services, the proper procedure is to file a request for remand, and to support that request by a showing of good cause. Because the additional specimens and the proposed amendment are clearly

¹ Application Serial No. 78139723, filed June 28, 2000, alleging dates of first use of June 1996.

untimely, they have not been considered. We also point out that applicant had previously proposed the identical amendment during prosecution of the application, and the examining attorney rejected it.²

Thus, the single issue on appeal is the question whether applicant's specimens show use of its mark for "computer software programming for others via the internet, such programming dealing with multivariate sampling and panel management software in the field of marketing research."

Applicant has submitted as specimens both a brochure and a printout from its Internet home page. The examining attorney contends that the brochure and printout do not "show use of the mark in connection with the identified services." (Brief, p. 3). It is the examining attorney's position that as used on these specimens, ICIION, at most, identifies the function of applicant's computer software.

In urging reversal of the refusal, applicant argues as follows:

Applicant conducts marketing research for others, including many [F]ortune 100 and 500 companies. One of applicant's primary means of conducting marketing research is via the Internet using

² We should add that applicant cannot argue, as an issue on appeal, whether its previously proposed amendment was an acceptable amendment because it never made it clear that this was an issue for appeal and therefore did not preserve the issue for appeal.

online research panels and focus groups. The mark, ICIION, is one of the sampling services Applicant provides to its clients through the customization of proprietary software. Based upon the needs of a client, Applicant modifies the software to provide specialized sampling and panel management services. [Applicant's] services connected with the Mark require manual design and manual programming by the Applicant to fulfill the specified, customized marketing research analysis based on individual client needs. Applicant does not license the software to the client; instead Applicant primarily uses the software to program customized and varied sampling and panel management requirements of a client.
(Brief, pp. 2-3).

Applicant contends that the manner in which the mark ICIION is used in applicant's brochure and at applicant's website shows a relationship between the mark and applicant's services of modifying and manipulating sampling data through applicant's proprietary software.

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) 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 merely be used in sales or advertising material, there must also be a direct association between the term and the services resulting from the particular use or display of the mark. In re Johnson Controls Inc., 33 USPQ2 1318 (TTAB 1994); and Peopeware Systems, Inc. v. Peopeware, 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 determination of whether applicant's specimens show the mark ICION in connection with the sale or

advertising of these services necessarily requires a consideration of the specimens. As previously noted, applicant has submitted both a specimen brochure and a printout of its Internet home page. ICION is used in the following manner in applicant's brochure:

Icion™ sampling

Sophisticated sampling is the key to successful Internet research. With Icion™--proprietary multivariate sampling software--we can design and pull stratified quota samples representative of target populations. Icion™ simultaneously balances samples by specified variables such as geography, gender, age, income, and ethnicity--with random selection of respondents within each sample cell.

ICION is used in the following manner at applicant's home page:

Icion™ Sampling

Icion™ is our proprietary multivariate sampling and panel management software system. Icion™ permits balanced, representative samples to be drawn from Decision Analyst's Internet panels, using various combinations of variables (geography, age, sex, income, ethnicity, etc.). A second function of Icion™ is to track respondent participation in studies and track response to each study. This careful tracking of respondent participation and response is crucial to proper management of the panel and to the correct execution of each study.

We find that neither the brochure nor the home page shows use of the mark ICION for the services recited in the application. Rather, ICION is used in

such a manner on these specimens that it would be perceived as identifying computer software per se, and not computer software programming services. Applicant itself refers to ICION as "proprietary multivariate sampling software" and a "proprietary multivariate sampling and panel management software system." The mere fact that ICION appears on applicant's brochure and homepage does not establish a relationship between the mark and the services recited in the application.

After reviewing applicant's specimens, it appears that applicant is not actually rendering computer software programming services. Rather, applicant appears to be in the business of conducting market research. Thus, this appears to be a case where applicant initially failed to accurately describe its services, and may not amend the recitation of services because it would substitute a different type of service. In any event, the specimens of record do not show use of the mark ICION for "computer software programming for others via the internet, such programming dealing with multivariate sampling and panel management software in the field of marketing research."

Decision: The refusal to register is affirmed.