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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re William A. Jones, DBA William A. Jones Co.

Serial No. 76491961

Richard W. Young and Nicole M. Murray of Gardner Carton &
Douglas for William A. Jones, DBA William A. Jones Co.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law
Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Bucher and Zervas, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant has appealed the Trademark Examining
Attorney's refusal to register the mark **MOLD-A-RAMA**
(standard character drawing). The sole issue on appeal is
the acceptability of the recitation of services.

Applicant initially recited its services as:

"personal souvenir production services in the
nature of vending machines that provide and
form plastic souvenirs" in International
Class 41.¹

¹ Application Serial No. 76491961 was filed on February 12,
2003 based upon applicant's allegation of first use anywhere and
first use in commerce at least as early as 1971.

The Trademark Examining Attorney initially refused registration of applicant's mark on the ground that the recitation of services was unacceptable as indefinite. Applicant responded to that initial Office action by requesting an amendment to the recitation of services to add, before that earlier recited language, the words "Entertainment services, namely" The Trademark Examining Attorney eventually issued a final refusal pursuant to Trademark Rule 2.32(a)(6) to register the mark on the ground that applicant failed to propose an acceptable recitation of goods or services, and furthermore, that the latest proposed amendment exceeds the scope of the recitation of services as recited in the original application, in contravention of Trademark Rule 2.71(a). This appeal followed the Trademark Examining Attorney's denial of applicant's request for reconsideration.

Applicant and the Trademark Examining Attorney have fully briefed this appeal, but applicant did not request an oral hearing. We affirm the refusal to register.

Preliminary Matter

Before turning to the merits of this case, there is one initial matter that requires our attention. The Trademark Examining Attorney objected to the newly-attached evidence

in applicant's appeal brief, i.e., copies of two third-party registrations. He argues correctly that the record in any application must be complete prior to appeal. 37 C.F.R. § 2.142(d). By contrast, applicant argues that these registrations should be considered part of the record on appeal because the Trademark Examining Attorney failed to advise applicant of the insufficiency of these registrations in a timely manner, citing to TBMP § 1208.02.

In reviewing the record, we note that applicant first submitted information about these third-party registrations in its request for reconsideration, providing the mark, recitation of services, and registration numbers. However, applicant did not submit copies of the registrations themselves, either in the form of "soft copies" or as electronic copies taken from the records of the Patent and Trademark Office database. Thus, even if the Trademark Examining Attorney, in his denial of the request for reconsideration, had informed applicant of the need for copies of the registrations, and the insufficiency of his submission, at that point in the prosecution applicant would not have been able to cure the insufficiency. Hence, the Trademark Examining Attorney did not waive his right to object to the mere listing of information about the registrations. Inasmuch as the evidence of third-party

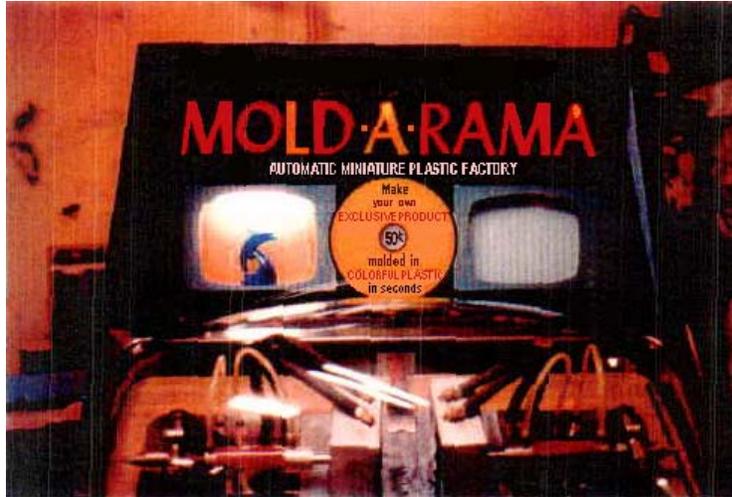
registrations in applicant's brief was newly submitted on appeal, we agree that the registrations should be excluded from the record, and we have given them no consideration.²

Applicant's position

In its brief, applicant points out that it places and maintains its MOLD-A-RAMA machines at public venues such as museums, zoos, aquariums, amusement parks and other tourist attractions worldwide. Applicant's machines are placed throughout a venue, but they are not the primary entertainment of the attraction (e.g., that being the museum, zoo, etc.). Applicant states that it is not in the business of selling these machines.

Applicant's machines manufacture souvenirs and, according to applicant, the primary attraction of applicant's machines is the entertainment provided by the miniaturized manufacturing process - an operation that is visible to the customer. The machines create souvenirs for individuals in an operation that commences when the customer deposits money in the machine. The machine, having the footprint of a soft drink vending machine, produces a plastic, molded figurine.

² We hasten to add that even if we had considered these registrations, it would not have changed the outcome herein.



Applicant notes in its brief that its "MOLD-A-RAMA services excite four of the five human senses":

Consumers can see the plastic flowing through the machine, hear the rumble of the machine as it roars to life, smell the distinct odor of molten plastic, and feel the warm souvenir as it exits the machine into the hands of the consumer.

Applicant argues that one of the reasons for the success of its services is the ability of the souvenir-producing machine to engage and entertain consumers as they watch their personal souvenirs being manufactured. According to applicant, consumers deposit coins in the machine for the pleasure of watching a small manufacturing operation create a molded souvenir in an intricate shape from molten plastic. Applicant argues that it is clearly using its MOLD-A-RAMA mark to indicate the source of entertainment provided by this miniature souvenir-manufacturing factory. Applicant also argues that with its

proposed amendment to its recitation of services (adding "entertainment services, namely" to the beginning of the recitation), it has not broadened the scope of its services, but has merely *clarified* and *limited* the recitation of services consistent with 37 C.F.R. § 2.71(a).

Position of the Trademark Examining Attorney

In his brief, the Trademark Examining Attorney contends that applicant's proposed recitation of services is unacceptable due to its indefiniteness, and furthermore, alleges that the addition of "entertainment services" results in an identification that is outside the scope of the originally filed recitation.

Applicable Law

As noted by the Trademark Examining Attorney, the identification of goods or recitation of services must be specific, definite, clear, accurate and concise. See In re Societe Generale des Eaux Minerales de Vittel S. A., 1 USPQ2d 1296 (TTAB 1986), *reversed on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). A written application must specify the particular goods or services on or in connection with which the applicant uses, or has a *bona fide* intention to use, the mark in commerce. 15 U.S.C. §§1051(a)(2) and 1051(b)(2); 37 C.F.R. § 2.32(a)(6).

Additionally, both applicant and the Trademark Examining Attorney have cited to Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a), which states that an applicant "may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services."

Analysis

The question before us is whether the proposed recitation of services, as amended: "entertainment services, namely, personal souvenir production services in the nature of vending machines that provide and form plastic souvenirs," is acceptable on its face. We find that it is unacceptable because it is indefinite.

In his appeal brief, the Trademark Examining Attorney argues that "from the wording in the identification, taken as a whole, it is entirely unclear as to whether the applicant provides Class 41 entertainment services, Class 40 souvenir production services, and/or Class 9 vending machines."

As to the last possibility, although applicant's recitation refers to the use of vending machines, the recitation, as well as the record, clearly shows that the vending machines are used in the rendering of applicant's services, but that applicant does not sell or lease vending

machines themselves. Simply referencing vending machines within the recitation does not make the recitation unclear as to whether applicant is offering goods in International Class 9 as opposed to services.

However, we do agree with the Trademark Examining Attorney's conclusion that the proposed recitation of services includes services in two classes, and is therefore indefinite. Applicant originally applied for services in International Class 41 (the classification of entertainment services) and has proposed an amended recitation beginning with the words "entertainment services, namely" On the other hand, the identification also recites "personal souvenir production services in the nature of vending machines that provide and form plastic souvenirs." Such souvenir production services in the nature of manufacturing on demand would fall in International Class 40. Because applicant's recitation includes services that may fall in Class 40 and in Class 41, we find that this hybrid recitation is indefinite, and therefore unacceptable.³

³ Having found the proposed amended recitation to be unacceptable, we do not find it necessary to reach the question of whether or not the proposed amended recitation should be barred under Rule 2.71(a).

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