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CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: July 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re PrintCo., Inc.

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Serial No. 78155673

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Miriam D. Trudell of Sheridan Ross P.C. for PrintCo., Inc.

Paul Fahrenkopf, Trademark Examining Attorney,  
Law Office 101 (Ronald R. Sussman, Managing Attorney).

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Before Grendel, Walsh and Cataldo, Administrative Trademark  
Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by PrintCo., Inc. to register  
the mark ENKLAVVOICE in standard character form on the  
Principal Register for the following services, as amended:

advertising and marketing services for others,  
namely providing a website which permits users to  
create, populate, authorize and manage databases  
of sales data and information, marketing data and  
information, product specifications; product  
pricing, catalog data, and related sales and  
marketing content; providing a website that  
allows users to organize, aggregate and summarize  
databases of sales and marketing data,

advertising text and advertising images and graphics and administer content approval.”<sup>1</sup>

The trademark examining attorney initially rejected the specimen submitted with applicant’s statement of use on the ground that it fails to indicate use of the mark as a service mark in connection with the recited services.

When the examining attorney made final the requirement that applicant submit an acceptable specimen of use, applicant appealed. Applicant and the examining attorney filed main briefs and applicant filed a reply brief.<sup>2</sup> An oral hearing was not requested.

Applicant asserts that its specimen of use “consists of two pages from Applicant’s website, which advertises and describes Applicant’s services;” (Applicant’s brief, p. 1) that, specifically, applicant’s specimen displays its ENKLAVVOICE mark and indicates that the services may be used to “[c]reate, populate, approve and manage a digital warehouse of sales and marketing information. ENCLAVVOICE aggregates all forms of text, data, and images and administers content approvals.” (Applicant’s brief, p. 2,

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<sup>1</sup> Application Serial No. 78155673, filed August 19, 2002, based on applicant’s allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act.

<sup>2</sup> The instant application was reassigned to the above noted examining attorney subsequent to the briefing of the matter currently under consideration on appeal.

quoting from specimen) Applicant explains that it provides access to its Internet website to allow customers to subscribe to the ENKLAVVOICE service to create their own advertisements; but that applicant does not provide its customers with software in any form. Applicant argues that its specimen provides information about its recited services; that it is not necessary for its specimens to specifically indicate that its services are web based; that, nonetheless its specimen informs potential customers that its services are provided via an Internet website; and that, as a result of the foregoing, its specimen is sufficient to indicate use of its ENKLAVVOICE mark as a service mark in connection with its recited services. Applicant argues in addition that the same advertisement submitted with its statement of use previously has been accepted as a specimen of use for applicant's other marks appearing thereupon.

The examining attorney maintains that applicant's specimen displays its proposed mark "in a list of features of an 'enterprise content management and cross-media publishing system' dubbed 'enklavTDW;'" (Examining attorney's brief, p. 3) that each of the "enklav" prefixed terms listed in applicant's specimen, including "enklavVOICE," merely identifies a feature of the

"enklavTDW" system; that "use of the mark to distinguish this feature of the applicant's overall system from other features does not serve to identify and distinguish the provision of a website...;" (Examining attorney's brief, p. 4) and that, as a result, applicant's mark appears to identify a featured element of a publishing system. The examining attorney argues that it is unclear from its specimen whether applicant is offering a product or a service; that it is further unclear how a consumer would engage applicant in the provision of any service; that in addition, there appears to be no explanation of applicant's services beyond the information featured on its Internet website; and that potential customers would need to undertake additional actions, such as contacting applicant or downloading a brochure, in order to understand the services offered by applicant. The examining attorney argues that, as a result, even though the submitted specimen displays applicant's proposed mark, it fails to demonstrate use of ENKLAVVOICE as a service mark in connection with the recited services.

Applicant contends in reply that its specimens clearly indicate that a potential customer can contact applicant for a demonstration of the services; that its specimen is an Internet advertisement, visible to anyone with Internet

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access; and that the specimen indicates that applicant's services are available through a hosted, secure Internet portal. Finally, applicant argues that its specimens offer a description of the services immediately following its mark; and that, as a result, its specimens offer a direct association between its ENKLAVVOICE mark and the services identified thereby.

Trademark Rule 2.88 provides, in part, that a statement of use must include one specimen showing the mark as used on or in connection with the sale or advertising of the goods or services in commerce. See 37 C.F.R.

§2.88(b)(2). Trademark Rule 2.56(b)(2) specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." See 37 C.F.R.

§2.56(b)(2). 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...." See 15 U.S.C. §1127.

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

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the specimens to create this association. See *In re Monograms America Inc.*, 51 USPQ 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. See *In re Compagnie Nationale Air France*, 265 F.2d 938, 121 USPQ 460 (CCPA 1959); *In re Johnson Controls Inc.*, 33 USPQ2d 1318 (TTAB 1994); and *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985). See also *In re Adair*, 45 USPQ2d 1211 (TTAB 1997). 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); and *In re Metrotech*, 33 USPQ2d 1049 (Com'r Pats. 1993). See also TMEP §1301.04 (4th ed. Rev. 2005).

Thus, the issue before us is whether the specimen of record creates a direct association between applicant's ENKLAVVOICE mark and the services specified in the application. The determination of whether applicant's specimen shows the ENKLAVVOICE mark in connection with the sale or advertising of these services necessarily requires a consideration of the specimen.

The original specimen submitted for applicant's

services, reproduced below, is a web page from applicant's website on the Internet.



- Industry focus
- products & services
- spotlight
- success stories
- approach



**Products & Services: Total Digital Workflow**

< **enklavTDW** is an enterprise content management and cross-media publishing system that radically improves creation and distribution of marketing content and deliverables for print, electronic and web media.

EnklavTDW helps marketing teams aggregate, organize, authorize and publish content on demand. Images and text can be re-expressed through customized templates for a variety of media. Using approved content from the asset manager assures that pricing, product images and descriptions, legal boilerplates, and logos are all published consistently in your sales kits, catalogs, direct mail, brochures and web pages.

EnklavTDW facilitates collaborative project execution between content and brand authorities, designers, brand channels and vendors. With EnklavTDW, companies will increase productivity, lower production costs, compress schedules, manage quality and consistency and eliminate redundant tasks in publishing to multiple media ... all through a hosted, secure web portal designed to match your brand. The result is more nimble and targeted communication to your marketplace.



How did we help save money?

We worked with a manufacturer to streamline their process...[read more](#)

< **enklavvision Digital Asset Manager** – Search, view and download image and graphic assets and order services like re-touching, separations and file distribution through preferred vendors.

< **enklavvoice Content Management** – Create, populate, approve and manage a digital warehouse of sales and marketing information. EnklavVoice aggregates all forms of text, data, and images and administers content approvals.

< **enklavpublisher Cross-Media Publishing** – Developing consistent marketing materials requires the re-expression of content into many media formats. EnklavPublisher collects text and graphics from the content database and flows it into templates defined by the brand authority.

< **enklavmerchant Channel Commerce Application** – Sales channels need brand-approved marketing programs for local tactical initiatives. EnklavMerchant enables online customization of marketing programs by dealers, franchisees, sales reps and distributed creative groups.

[Contact us](#) now for a demo or to download a brochure.

Our primary reviewing court has held that a "service" is "the performance of labor for the benefit of another." See *In re Canadian Pacific Ltd.*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985). The recited services involved herein clearly are a "service" under this definition, and we will presume that applicant in fact renders such services. However, the issue in this case is not whether applicant's activities constitute "services," or whether applicant in fact provides those services. Rather, the issue is whether the specimens of record demonstrate use of the mark as a service mark for those services.

As noted above, Trademark Rule 2.56(b)(2) provides that "[a] service mark specimen must show the mark as actually used in the sale or advertising of the services." When appropriate, the Board has been fairly flexible in accepting service mark specimens. See *In re Ralph Mantia Inc.*, 54 USPQ2d 1284 (TTAB 2000); and *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992).

In this case, we first find that the specimen submitted by applicant with its statement of use displays its ENKLAVVOICE mark. Inasmuch as applicant applied for its mark in standard character form, the mark as it appears in stylized form in its specimen of use is considered to

agree with the mark as it appears in its drawing.<sup>3</sup> See 37 C.F.R. §252(a). See TBMP also TBMP §807.03(e). We further find that applicant's specimens are advertisements because they show the requisite direct association between the mark and the activities described thereafter. Cf. *In re Adair, supra*; and *In re Johnson Controls, Inc., supra*.

Specifically, the specimen indicates in a paragraph immediately following the mark that a customer may utilize ENKLAVVOICE to "[c]reate, populate, approve and manage a digital warehouse of sales and marketing information," and, further, that ENKLAVVOICE "aggregates all forms of text, data, and images and administers content approvals." As noted above, applicant's recited services include advertising and marketing services for others, namely, providing a website that permits or allows users to perform many of the activities described in its specimen. A customer or potential customer viewing applicant's specimen would readily perceive the ENKLAVVOICE mark as identifying the source of applicant's website that allows users to engage the advertising and marketing services described therein. As a result, applicant's specimen creates a

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<sup>3</sup> Effective November 2, 2003, subsequent to the filing date of the involved application, Trademark Rule 2.52, 37 C.F.R. §2.52, was amended to replace the term "typed" drawing with "standard character" drawing.

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direct association between the ENKLAVVOICE mark and applicant's recited services. Contrary to the examining attorney's contentions, we find that the website does not merely describe features of a larger system, but rather describes, *inter alia*, the recited services available by means of its website under the applied-for mark. Thus, we conclude that the specimen of record is adequate to support the use of the mark in connection with the identified services.

Decision: The refusal to register on the ground that the specimen is unacceptable evidence of service mark use in connection with the identified services is reversed.