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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Siegel Group Int'l, Inc.

Serial No. 76102384

Bryan C. Reuter and Jennifer L. Thornton of Stanley, Flanagan & Reuter, L.L.C. for The Siegel Group Int'l, Inc.

Martha L. Fromm,[1] Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Bucher, Grendel and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On August 3, 2000, The Siegel Group Int'l, Inc. (applicant) filed an application to register the mark CHICKEN STOCKS in standard-character form on the Principal Register for services ultimately identified as "financial investment in the field of securities." Applicant has disclaimed "STOCKS."

[1] A different examining attorney acted on this application prior to this appeal.

The application was filed based on prior use of the mark in commerce, but applicant amended to an intent-to-use basis when the examining attorney rejected applicant's specimen of use in the initial examination.

After approval and publication of the application and issuance of the notice of allowance, applicant filed its statement of use with new specimens of use. The examining attorney also found applicant's new specimens of use unacceptable and finally refused registration, citing Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§ 1051, 1052, 1053 and 1127. In particular, the examining attorney found that CHICKEN STOCKS did not function as a service mark as used on the specimens and that the specimens did not show use of CHICKEN STOCKS in the sale or advertising of the identified services.

This appeal followed.[2] Both applicant and the examining attorney have filed briefs; applicant did not request an oral hearing. For the reasons indicated below, we affirm.

Section 1 of The Trademark Act requires that an applicant submit "specimens or facsimiles of the mark as

[2] In its brief applicant asks that we "reverse that refusal and register the mark or, alternatively, remand the matter to the district court." We are not aware of any procedure whereby we could remand this matter to a district court.

used in commerce." 15 U.S.C. § 1051. Trademark Act Section 45 provides further that a mark is "in use in commerce . . . on services when it is used or displayed in the sale or advertising of the services." 15 U.S.C. § 1127. The Trademark Rules likewise specify, "A service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 C.F.R. § 2.56(b)(2).

Trademark Act Section 45 also sets forth the fundamental definition of a service mark as a mark used "to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. § 1127. This definition is the basis for the requirement that the mark, as used in the specimen, must "function" as a service mark.

When applicant filed its application it submitted two potential specimens. The first is a copy of an article entitled "an investment strategy for the timid" by Fred Siegel explaining a strategy for investment.[3] It includes the following text, "I will show you how to build a 'chicken stock' portfolio. No, that has nothing to do with

[3] The copy does not indicate where this article may have been published.

Colonel Sanders or Popeye's. The term refers to a portfolio that's appropriate for people who are 'chicken' or afraid of the stock market."[4] Later the article states, "You can create an entire portfolio of stocks that meet the 'chicken stock' criteria." The term is used twice more in the article in the same manner. The article ends with the following biographical note on the author: "Fred Siegel is a financial-news analyst for WWL-TV and radio and portfolio manager for an international investment firm."

The second potential specimen filed with the application appears to be a form which begins "Proposal for" followed by a blank space where a client's name might be inserted. It includes headings, such as, "Your goals" and "Your retirement projection has revealed the following" with what appear to be sample entries following each. The last paragraph on the page is designated "Income/Growth" and includes the following statement: "We recommend the majority of your money (60%) be privately managed using the '**Chick Stock**' strategy. It is designed to provide higher income every year and growth on your original principal." (bold type in original)

[4] Here and in many other instances "stock" is used in the singular rather than the plural form shown in the drawing of the mark. This discrepancy was not noted by the examining attorney, and therefore, we have not considered this discrepancy in our analysis.

Applicant furnished additional potential specimens when it filed its statement of use. First applicant provided a book jacket for a book entitled Investing for Cowards by Fred Siegel. "Chicken Stock" appears a number of times on the jacket, again always as an integral part of text. For example, the back jacket includes the following text: "This is a must read for anyone who was ever afraid of, or burned by, the market. Fred's innovative 'Chicken Stock' strategy will dramatically change the way you view investing." The jacket flap states, "He shows how to use his 'Chicken Stock' strategy to pick an elite group of conservative growth stocks . . ." The jacket also includes a biographical sketch of Mr. Siegel including the following, "FRED SIEGEL personally manages and consults for over one billion dollars of assets. He has been a Portfolio Manager since 1981 and is president of The Siegel Group, Inc., an investment management firm. Executives, institutions and policy makers around the world consult with Fred and rely on his advice when making business and financial decisions."

When the examining attorney rejected this specimen applicant provided substitute specimens, including articles from The Bull & Bear Financial Report, Stock Futures & Options Magazine, Beverly Hills Times, Investment News,

Bottom/Line/Personal, and an advertisements in Radio-TV Interview Report. The articles include uses of "Chicken Stock" either in the article titles, headings or text. For example, the Bull & Bear article uses the following title, "Investing for Chickens: Master the Markets with the Chicken Stock Approach." It also includes the following heading within the article, "The Chicken Stock Strategy." The Investment News article includes the following text, "One of the key points is investing in 'chicken stocks' which he defines as companies that have produced at least 12 consecutive years of both earnings and increased dividends." Two of the articles include short biographical notes on Mr. Siegel like the one quoted above from "an investment strategy for the timid." Each of the articles talks about Mr. Siegel and his approach to investing.

The advertisement in Radio-TV Interview Report features Mr. Siegel's book and refers to "His innovative 'Chicken Stock Strategy.'" It includes a description of Mr. Siegel's "Credentials," as follows: "Fred Siegel is the author of INVESTING FOR COWARDS: Proven Market Strategies for Anyone Afraid of the Market. As President of the Siegel Group Inc. Fred consults with executives, institutions and policy makers around the world. His comments on investing are heard three times daily on WWL,

the CBS affiliate with the highest market penetration in North America, where he also hosts a two-hour weekly money talk show." The advertisement then indicates Mr. Siegel's availability for appearances.

The examining attorney also rejected these specimens and applicant filed two additional specimens with its request for reconsideration.[5] The first of these two specimens shows "Chicken Stocks" in "HTML Code of Applicant's website." For example, "Chicken Stocks" appears in a listing of "code" designated as "meta-name" and "keywords" with over fifty other terms. The surrounding text appears as follows, "401K, 401K Rollover, Annuities, Bonds, Chicken Stocks, Dow Jones, Educational IRA, Estate Planning, Financial Goals, Financial Strategy, Fred Siegel, Fred's Comments, . . . Portfolio Management Services, Retirement Planning, Retirements, Roth IRA, S&P 500 (sic), Saving, Saving Money, SEP IRA, Siegel, Siegel Group, Stocks . . ." At that time applicant also submitted an "e-zine" or "letter to investors." This document includes a heading with "Fred Siegel International Inc." and a logo to the left and the title "Chicken Stock

[5] In each instance applicant provided a statement with its substitute specimens verifying that the specimens had been used prior to the expiration of the time for filing the statement of use.

Report" to the right. The text consists of a general strategy for use in the selection of stocks concluding with a list of "Current Chicken Stocks." Repeating images of the cover of Mr. Siegel's book appear along the right side of the text.

This case presents two distinct but closely related questions regarding appropriate service mark specimens of use. Do any of the specimens of use show use of CHICKEN STOCKS as a mark, that is, does CHICKEN STOCKS "function" as a mark as used in the specimens? In re Walker Research, Inc., 228 USPQ 691, 692 (TTAB 1986); In re McDonald's Corp., 229 USPQ 555, 556 (TTAB 1985). And, do any of the specimens associate CHICKEN STOCKS with the identified services, "financial investment in the field of securities." In re Monograms America Inc., 51 USPQ2d 1317, 1318 (TTAB 1999); In re Johnson Controls Inc., 33 USPQ2d 1318, 1320 (TTAB 1994). See generally In re Universal Oil Producs. Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). To succeed in this appeal applicant must establish that at least one of the specimens satisfies both criteria.

For purposes of establishing that the designation in question functions as a mark it must be displayed in a manner that will distinguish the purported service mark from surrounding subject matter such that it will be

perceived as a source indicator; applicant's mere intention that it serve as a mark is not sufficient. In re McDonald's Corp., 229 USPQ at 556. Furthermore, ". . . not every word, name, symbol, device, etc. which is associated with an applicant necessarily functions as a trademark or service mark; to function as a mark, and hence be registrable, the designation or device must be used as a mark to identify the applicant's goods or services." In re Moody's Investors Service Inc., 13 USPQ2d 2043, 2048 (TTAB 1989). See also In re Volvo Cars of North America, 46 USPQ2d 1455, 1459 (TTAB 1998); In re Walker Research, Inc., 228 USPQ at 692.

With regard to the services, the specimen must show a direct association between the mark and the services identified in the application and not some other product or service. See In re Adair, 45 USPQ2d 1211, 1215 (TTAB 1997); In re Metrotech, 33 USPQ2d 1049, 1051 (TTAB 1993).

After a careful review of each of the specimens, we conclude that there is no specimen among the many applicant submitted which shows both use of CHICKEN STOCKS as a mark and a direct association between CHICKEN STOCKS and the identified services.

We note that the examining attorney has not questioned either that applicant is rendering the services it claims,

nor that those services are recognizable services for purposes of trademark registration. See generally In re Advertising and Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987). Accordingly, we need not address applicant's discussion of those issues.

In each instance, we must examine the specific use of CHICKEN STOCKS in the specimen to determine whether the specimen is acceptable. In re McDonald's Corp., 229 USPQ at 555.

First with regard to the "code" specimen, applicant states, ". . . the key words in a meta tag are used to index the page by a search engine, so that when a user is looking for information on 'Chicken Stocks' the individual will likely be directed to the Siegel Group's website regarding the financial services it offers. Tellingly, if a searcher was to enter 'estate planning' or 'investment management' the individual might get directed to the same website." Applicant then concludes, "The use of the mark in the meta-tag demonstrates that 'CHICKERN STOCKS' is identified with and used to promote the Siegel Group's financial planning and management services over the internet."

The examining attorney argues that applicant's use of the mark in "the meta-tag specimen" does not show use of

the mark in the sale or advertising of the identified services. We agree with the examining attorney. In fact, this specimen fails to show use of CHICK STOCKS either as a mark or in association with “financial investment in the field of securities.”

Code associated with a website is not generally visible to a visitor to a site. If it can be viewed at all, it is only by resort to a view function intended for viewing technical details regarding the operation of the site. Also, as the specimen shows, the metatag portion of the code consists of a laundry list of terms, as in an index. The display of terms in this manner does not satisfy the registration standard. That is, the use of CHICKEN STOCKS in code is not use of the term as a mark. Furthermore, contrary to applicant’s argument, this use does not “associate” the mark with the identified services. Indeed, the listing of terms in code in no way represents either use of a mark in the sale/rendering of the service, nor in the advertising of the service. Likewise, the potential uses by third-party search-engine operators of these terms in no way transforms the use into service mark use sufficient to qualify as a specimen of use.

Accordingly, we conclude that the specimen showing use of CHICKEN STOCKS in code on applicant's website is not acceptable.

Second, CHICKEN STOCKS is used on the jacket of Mr. Sielgel's book, and in each of the articles about or by Mr. Siegel. The record include the article submitted with the application as well as those submitted as substitute specimens.

Applicant argues that Mr. Siegel's book should be accepted as a specimen because "the book cover states that the book 'provides practical time-tested investment strategies.'" With regard to the articles applicant argues generally that they show that applicant offers investment services. For example, applicant states, ". . . one of the specimen articles, *Investment News*, states that 'Mr. Siegel who manages $1.5 billion for his clients through Siegel Group, Inc. in New Orleans has started parlaying his knowledge and experience into the written word.'"

In each of these publications, CHICKEN STOCKS merely identifies Mr. Siegel's "strategy" or "approach" to investing. In re Walker Research, Inc., 228 at 692. For the record we note and accept applicant's point that a designation may both identify a "process" or "strategy" and function as a mark. In re Lativ Systems, Inc., 223 USPQ

1037, 1038 (TTAB 1984). We simply conclude that CHICKEN STOCKS, as used here, fails to do the latter.

Furthermore, none of these publications include a sufficiently prominent use of CHICKEN STOCKS which would signal to clients for the identified service that it is a source indicator for that service. Rather, all of the uses display CHICKEN STOCKS as an integral element within text, again referring to the "strategy" or "approach" discussed in the publication.

Nor do any of these publications include a use which would "associate" CHICKEN STOCKS with "financial investment in the field of securities." The only potential references in any of the publications to an "investment" service are in the biographical notes regarding Mr. Siegel. These references are insufficient to create a direct association between CHICKEN STOCKS and applicant's "financial investment in the field of securities" services.[6]

Accordingly, we conclude that the specimens showing use of CHICKEN STOCKS in these publications are not acceptable.

Third, applicant has identified the specimen from Radio-TV Interview Report as an advertisement. However,

[6] Furthermore, the uses in the third-party articles are not uses by applicant, and as such, would not be proper specimens of use.

CHICKEN STOCKS is not used as a mark in this advertisement. Here too CHICKEN STOCKS is used only to identify Mr. Siegel's investment approach or strategy. In re Walker Research, Inc., 228 at 692. It is not displayed in a manner which separates it from the surrounding text as a source indicator. Also, the advertisement refers only to Mr. Siegel's availability for media appearances. It emphasizes his media experience and concludes by indicating, "AVAILABILITY: Louisiana, nationwide by arrangement, and via telephone; available as a last-minute guest." Accordingly we conclude that this specimen fails to show use of CHICKEN STOCKS as mark or use in association with the identified investment services. In re Monograms America Inc., 51 USPQ2d at 1318.

Accordingly, we conclude that the specimen showing use of CHICKEN STOCKS in the advertisement is not acceptable.

Fourth, with regard to the use of CHICKEN STOCKS in conjunction with the "e-zine" article, Applicant refers to this specimen as an "electronic newsletter." Applicant states further, "The newsletter is circulated to investors to continue to promote the Siegel Group's financial investment services and to continue to generate business

from the clients." In this case, "CHICKEN STOCK REPORT"[7] is displayed prominently and could conceivably function as a mark for goods or services. However, the "newsletter" is just that – a periodic publication which is distributed electronically. It is a product and not a service. Accordingly, CHICKEN STOCKS is not used here in association with the rendering of the identified services as applicant argues. Cf. In re Metriplex Inc., 23 USPQ2d 1315, 1316 (TTAB 1992); In re Eagle Fence Rentals, Inc., 231 USPQ 228, 230 (TTAB 1986); In re Red Robin Enterprises, Inc., 222 USPQ 911, 913 (TTAB 1984). Furthermore, there is no reference to identified services to demonstrate use of the mark in the advertising of the identified services, as applicant argues.

Accordingly, we conclude that the specimen showing use of CHICKEN STOCKS in the electronic newsletter is not acceptable.

Finally, applicant has provided what appears to be a form which could conceivably be used in the rendering of an investment service. It includes a space for a client name, and what could be tailored information and recommendations

[7] Here again we note the discrepancy between the use of CHICKEN STOCK REPORT and CHICKEN STOCKS shown in the drawing. We will not address this issue because it was not raised by the examining attorney.

for that client. If CHICKEN STOCKS had been used in this form in the manner of a mark, the specimen might be acceptable. However, in this case, as in the case of many of the other potential specimens, CHICKEN STOCKS is only used in text to refer to the approach or strategy which Mr. Siegel has developed for investing. In re Walker Research, Inc., 228 USPQ at 692.

Accordingly, we conclude that the specimen showing use of CHICKEN STOCKS in the client form is not acceptable.

In conclusion, after a careful review of all potential specimens applicant presented, we conclude that there is no specimen which both shows use of CHICKEN STOCKS as a service mark and which shows a direct association between CHICKEN STOCKS and the sale/rendering or advertising of "financial investment in the field of securities" services. We note further that our decision here would not bar applicant from seeking registration in a new application with different specimens.

Decision: The refusal to register the mark for failure to provide a proper specimen of use is affirmed.