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Paper No. 8

BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diet Fitness Corporation

Serial No. 76275674

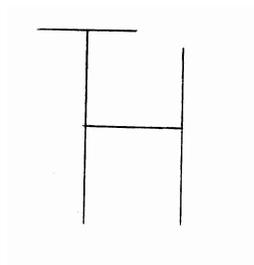
Laura J. Zerman of Snell & Wilmer L.L.P. for Diet Fitness Corporation.

Melvin T. Axilbund, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hanak, Chapman and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 22, 2001, Diet Fitness Corporation (an Arizona corporation), applied to register the mark (stylized TH) shown below



on the Principal Register for services identified as "marketing and distribution of diet and motivational plans, programs and products." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce in connection with these services.

In his first Office action, the Examining Attorney, inter alia, advised applicant that (i) the recitation of services was not acceptable because it is indefinite, (ii) the services needed to be clarified to "for others" because an activity that is ancillary to the applicant's larger business is generally not a separate service, and (iii) identifications of goods and services may only be clarified or limited pursuant to Trademark Rule 2.71(a). The Examining Attorney attached to the first Office action pages from the "Trademark ID Manual" and dictionary definitions of "marketing" and "distribution." (He also explained multiple class applications and the requirements therefor.)

Applicant responded, not with argument or explanation, but with an amendment to the recitation of services as follows:

"education courses in the field of nutrition, and educational literature distributed therewith" in International Class 41; and

"planning, executing and supervising diet programs by means of group meetings and individual consultations" in International Class 42.

The Examining Attorney found the amended recitation of services to be outside the scope of the original identification of services and impermissible under Trademark Rule 2.71(a), and he made final the requirement for an acceptable recitation of services.

Applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs on appeal. Applicant did not request an oral hearing.¹ Accordingly, we have resolved this appeal based upon careful consideration of the record before us in this application, the written arguments of applicant and the Examining Attorney, the Trademark Act, and the Trademark Rules of Practice.

In its brief, applicant contends as follows:

Applicant's services are directed to the act or process of selling, distributing, or dispersing diet and motivational programs and plans. In order to further define its specific programs and plans, Applicant amended its recitation of services to include the planning, executing and supervising

¹ Applicant referred within its brief to a separate notice requesting an oral hearing. However, no such request has ever been received at the Board. In addition, on January 7, 2004 the Board sent an order noting that it was apparent applicant no longer wished to have an oral hearing on the case and that the appeal would be decided in due course.

of diet programs by way of group meetings and individual consultations as well as providing educational courses on nutrition and accompanying literature on nutrition. By amending its services, Applicant further defined what was being marketed and distributed and how it was being marketed and distributed.

From this, applicant concludes that its proposed amendments further limit the original identification of services.

The Examining Attorney argues, *inter alia*, that the proposed amended identifications of services are broader than the original identification of services, and now include services not within the scope of the original recitation.

The rule with respect to amendment of the identification of goods or services is clear. Trademark Rule 2.71(a) reads as follows: "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services." The TMEP §1402.06 (3d ed. 2002) explains the reasoning supporting the Trademark Rule as follows:

"Trademark Act §7(c), 15 U.S.C. §1057(c), provides that filing an application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration (*see* TMEP §201.02).

Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for the Principal Register."

We disagree with applicant that "education courses ..." and "planning ... diet programs by means of group meetings and individual consultations" are limiting the original identification because they are two specific means of "marketing and distribution." To the contrary, education courses, and planning and supervising diet programs via group and individual consultations, are both services which are completely separate in nature from marketing and distribution services. The proposed services were not encompassed within the scope of the original identification of services, and it would be an impermissible expansion of applicant's original identification to allow the amendments proposed by applicant. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); and *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm. 1991).

Decision: The requirement for an acceptable identification of services is affirmed.