

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Hearing:
June 21, 2005

Mailed:
August 24, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Singapore Airlines Limited

Serial No. 76295663

Roy Goldberg of Sheppard Mullin Richter & Hampton LLP for
Singapore Airlines Limited

Jeffery C. Coward, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Seeherman, Bucher and Grendel, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Singapore Airlines Limited has applied to register
SPACEBED as a mark for "transportation of passengers by air
featuring a business class combination airline seat and
bed."¹ The application was based on an asserted bona fide

¹ Application Serial No. 76295663, filed August 3, 2001. The
services were originally identified as "transportation of
passengers by air." In the recitation of facts in its brief,
applicant indicated that the services had been amended to the
identification listed above. However, at page 9 of its brief, it
states that the identification was amended to "transportation of
passengers by air by way of renting or otherwise providing a

intention to use the mark in commerce. After the mark was published for opposition, and a Notice of Allowance issued, applicant filed a Statement of Use alleging first use and first use in commerce as of May 2002. The Examining Attorney, in examining the Statement of Use, found that the specimen submitted therewith did not show use of the mark for the services identified in the application, and required an acceptable specimen. Applicant thereupon submitted substitute specimens. After reviewing these specimens, the Examining Attorney issued a new refusal, pursuant to Sections 1, 3 and 45 of the Trademark Act, on the ground that the proposed mark, as used on the specimens, does not function as a service mark to identify and distinguish the services of applicant from those of others. Applicant submitted yet another substitute specimen in response to this refusal, and when the refusal was made final, applicant filed the subject appeal.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

business class combination airline seat and bed." This proposed identification was suggested by applicant in its response to the final Office action, but the identification was in fact amended as indicated above by the Examiner's Amendment dated July 13, 2004.

Initially, we address a procedural point. At page 8 of applicant's reply brief, it makes the statement that "if necessary, this case should be remanded to the PTO so that the record can be supplemented to show that consumers equate SPACEBED with the services provided by Singapore Airlines." We do not consider this an appropriate manner for requesting remand of an application. Such a request should have been made by a separately captioned paper, rather than being buried within a paragraph within a reply brief. In any event, applicant's request for remand, to the extent this conditional language can be considered a request for remand, has not been accompanied by a showing of good cause. See TBMP §§1207.02 and 1209.04 (2d ed. rev. 2004). It should be noted that the later in the proceeding that a request for remand is made, the stronger the reason that must be given for good cause to be found. Here, where applicant did not request (or conditionally request) remand until the filing of the reply brief, virtually the last stage of the appeal process, the reason for remand would have had to be strong indeed. However, applicant has not provided any reason whatsoever to explain its delay in attempting to submit such evidence.

The basis for the Examining Attorney's refusal is that the applied-for term, SPACEBED, simply refers to a

combination seat/bed in business class, rather than as a mark for air transportation services. The question of whether a designation functions as a mark that identifies and distinguishes the recited services is determined by examining the specimens and any other evidence in the record that shows how the designation is used. Because the only evidence in the record as to how the proposed mark is used are the various specimens submitted by applicant, we turn to a consideration of these specimens.

The original specimen consists of a brochure.² Across the middle of the cover appears the wording "introducing the Raffles Class Space Bed," with the words "Raffles Class" and designs appearing in the bottom corners. On various pages in the brochure are the following sentences and phrases:

In keeping with the tradition of providing you with the finest in luxury and comfort, Singapore Airlines is pleased to introduce the Raffles Class SpaceBed. Measuring, with armrests lowered, an impressive 69 cm (27 inches) wide and 198 cm (6 feet, 6 inches) long, this extra space allows you more freedom to work, relax or sleep.

² Only the cover of this specimen was originally scanned into the electronic record of this file. Applicant subsequently supplied a copy of the entire brochure, and the electronic record will be corrected to include all of the pages.

The first aircraft retrofitted with SpaceBeds will be flying between Singapore and London...

the biggest bed in Business Class

The Italian-Swiss designed SpaceBed offers you unparalleled comfort, from the multiple seating positions, to the lie-flat sleeping mode at a comfortable angle of 8 degrees inflight. Inspired by space-age technology, our unique cushioning conforms to your individual body shape. And because all SpaceBeds are forward facing and fitted with adjustable screen dividers, you will welcome the improved privacy and personal space when working, relaxing or sleeping.

Exclusive to the SpaceBed are the lowered armrests, which provide extra width, allowing you more room to sleep on your side or back. In addition, specially designed retractable screens provide unprecedented shoulder space, giving you a greater sense of freedom. Another nice touch is the extra storage space for shoes and other personal belongings. And if you wish to work onboard, every seat has its own 110-volt AC laptop power supply, removing the need for any cumbersome cords and adapters.

The second set of specimens consists of two two-page advertisements placed in different issues of "The Economist." The ads differ slightly in terms of the colors and the background, but the text and impression is the same. As seen below, on the left page appear the words "Singapore Airlines presents S P A C E B E D The biggest

bed in Business Class" while the facing page has a picture of a woman sleeping on a giant feather:



The text in the lower right hand corner is enlarged below:

Experience the comfort of the most spacious business class bed in the sky. Raffles Class SpaceBed offers you a new level of luxury with more space to work, relax or sleep. All, of course, while enjoying the inflight service even other airlines talk about.

A great way to fly

SINGAPORE AIRLINES

A Star Alliance Member



The third specimen (the second substitute specimen) is an advertisement in a Las Vegas newspaper. The page is

headed "Now The Far East Isn't Quite So Far Anymore," followed by a picture of a city skyline, and below that is the phrase "Introducing Singapore Airlines' Direct Service from Las Vegas to Singapore via Hong Kong." Below this are smaller pictures, and below that is the following text, which appears in relatively small print:

We are proud to introduce our new service from Las Vegas to Singapore via Hong Kong. On board our new 777LR aircraft, you'll be among the first to experience the comfort of the most spacious business class bed in the sky. Raffles Class SpaceBed offers a new level of luxury with more space to work, relax or sleep. Every passenger in every class also enjoys World Gourmet Cuisine™, created by our panel of world-renowned chefs and Krisworld, the world's most advanced inflight entertainment system with over 150 "on demand" entertainment options placing you in complete control. Fly award winning Singapore Airlines and discover service even other airlines talk about.

At the bottom right-hand corner of the page is the same logo seen above having the words SINGAPORE AIRLINES, a bird-like design, and the phrase "A great way to fly," followed by "A Star Alliance Member."

The Examining Attorney points out, and we agree, that this situation is very similar to that presented in *In re British Caledonian Airways Limited*, 218 USPQ 737 (TTAB 1983), in which the applicant had applied to register

SKYLOUNGER as a mark for the "air transportation of passengers." The Examining Attorney refused registration on the ground that, according to the specimens of record, the term sought to be registered was not used as a service mark to identify and distinguish applicant's services but instead identified a type of seat used in the rendering of applicant's services. The specimens contained the following text:

Introducing the world's most comfortable
business flight to London.

Our new SKYLOUNGERSM

Lets you sleep lying down.

British Caledonian Airways is committed
to a demanding yet highly rewarding
concept. To provide you, the long-
distance business traveler, with more
comfort than any other international
airliner.

Through the years, we believe our
luxurious First Class service has done
just that. But even the best can get
better.

That's why our First Class service now
includes the SkyloungeSM seat. Made to
British Caledonian's specifications, it
can recline to a horizontal position.
So you can actually sleep lying down.

Fully reclined, it still leaves you
plenty of room between rows. And
upright, there's even more room. It
lets the window passenger move easily to
the aisle. Even when trays are in use.

So next time business takes you to
London, ask for our SkyloungeSM Service.
We're sure you'll agree our First Class
is the most comfortable way to go.

The Board affirmed the refusal, holding that, because applicant used the word SKYLOUNGER primarily in association with seats in the first class section of its planes, the specimens of record did not evidence use of this term as a service mark. Rather, the Board found that the public was likely to associate the term with the seats that were located in the first-class section of applicant's planes, rather than with applicant's air transportation services.

Just as in British Caledonian, where SKYLOUNGER was found to refer to a seat, and not to air transportation services, in the present case SPACEBED is used in the specimens to refer to a combination seat/bed. In "The Economist" advertisement, SPACEBED is identified as "The biggest bed in Business Class" with the accompanying text "Experience the comfort of the most spacious business class bed in the sky. Raffles Class SpaceBed offers you a new level of luxury with more space to work, relax or sleep." The Las Vegas advertisement has similar language: "you'll be among the first to experience the comfort of the most spacious business class bed in the sky. Raffles Class SpaceBed offers a new level of luxury with more space to work, relax or sleep." And the brochure is replete with references to SPACEBED as being a combination seat/bed, providing the measurements of the seat, describing the

number of seating positions, the sleeping mode, the armrests, etc.

Applicant has attempted to distinguish British Caledonian by arguing that the specimens in that case referred only to the provision of a seat, but that applicant's own specimens show that SPACEBED is used to describe the service of luxury transportation. Applicant points to the language in the two advertisements that state "SpaceBed offers a new level of luxury" to argue that SPACEBED "is being used to describe the service of 'luxury' transportation by air which includes rental of a seat but is not limited to that service," and that "The service that is being offered in connection with the Mark is 'a new level of luxury with more space to work, relax or sleep.'" Brief, p. 9.

We are not persuaded by this argument. We do not believe that consumers viewing the advertisements, or indeed any of the specimens, would single out the sentence "Raffles Class SpaceBed offers a new level of luxury with more space to work, relax or sleep" from the balance of the advertisements, and particularly from the preceding sentence which, in the Las Vegas advertisement, states "you'll be among the first to experience the comfort of the most spacious business class bed in the sky" and in "The

Economist" reads, "Experience the comfort of the most spacious business class bed in the sky.". Rather than undertaking the tortured analysis that would be required by applicant's argument, consumers are likely to view SPACEBED, as used in these advertisements and brochure, as referring simply to the combination seat/bed itself, and are not as a mark for applicant's airline services.

Simply put, anyone viewing applicant's specimens would understand the term SPACEBED to refer to the seat/bed used in business class, rather than to identify applicant's air transportation services. Although applicant has specified in its identification of services that its air transportation services feature a business class combination airline seat and bed, the specimens identify only the seat/bed, and not the transportation services themselves.

Applicant also argues that British Caledonian has been overruled, or at least superseded, by In re Advertising & Marketing Development, Inc., 821 F.2d 614, 618, 2 USPQ2d 2010 (Fed. Cir. 1987). That case involved an application to register THE NOW GENERATION for promotional services.³

³ The actual identification was "promoting the sale of goods and/or services of automobile dealers, financial institutions and retailers through the distribution of printed promotional materials and by rendering merchandising and sales promotion advice."

Although one of the issues in that case was whether the specimens showed use of the mark for the identified promotional services (rather than merely the goods and services which were being promoted), much of the opinion dealt with concerns specific to advertising services. For example, the Court pointed out that the distinguishing characteristic of advertising services is that they are associated with the subject of the advertising, but that service mark registration for advertising services must be based on the use of the mark to identify the advertising services themselves. The holding of the Court was specifically about advertising services, namely, that the standard for service mark registration for advertising services is the same as that for other types of services. 2 USPQ2d at 2014. The Court also said that registration may be refused where the mark has not been used to identify the named services for which registration is sought. Id.

We see nothing in Advertising & Marketing that would overrule British Caledonian or require us to reach a different result herein. The principle still stands that the determination of whether a term functions as a mark for the services identified in an application is based on the specimens and other evidence of record in that application, and that such a determination is fact-specific, as it is

based on the particular specimens. In fact, the Court in Advertising and Marketing declined to overrule two cases involving marks for advertising services because the records in those cases were not before the Court, and the Court therefore could not determine whether in those cases the marks had been used to identify advertising services, rather than the subject of the advertising.

Moreover, the Court in Advertising & Marketing certainly did not overrule another case by its predecessor court which involved an issue and specimens very similar to those presented here and in British Caledonian. In In re Campagnie Nationale Air France, 265 F.2d 938, 121 USPQ 460 (CCPA 1959), the applicant applied to register SKY-ROOM as a mark for air transportation of passengers, and the application was refused under Section 3 and 45 of the Trademark Act because the record failed to show that SKY-ROOM was used to identify and distinguish applicant's air transportation services. The specimens advertise "The World's Most Luxurious Flight The Golden Parisian To Paris with immediate connections to all Europe" and, after the heading "Your Private 'Sky-Room'" include the text:

Your private salon by day, double
bedroom at night...Super Constellation
non-stop overnight to Paris, Friday
evening from New York. "Sky-Lounge"
chairs and spacious cocktail lounge

too. A new magnificence in famed Air France service and cuisine.

"The accompanying pictures which portray the 'SKY-ROOMS' show a man, woman and child in the day time surroundings of the room and two adults and a child in the room as, we presume, it appears when converted into a bedroom at night." 121 USPQ at 461. Below this a caption states, "Golden Parisian surcharge \$25 per person. "Sky-Room" charge \$125 for 1 or 2." The words "AIR FRANCE The World's Largest Airline" appear at the base of the ad, along with "See your travel agent or Air France" with an address.

The court found that:

Nothing in the advertisement pertaining to the "SKY-ROOM" identifies the air transportation service of appellant and there is no other evidence which reveals that the public considers "SKY-ROOM" as an identifying mark of this airline. In our opinion, the advertisement, taken as a whole, indicates that "SKY-ROOM" is used to connote a particular type of accommodation, regardless of who provides it, rather than to distinguish any service provided by appellant from similar services provided by others.

Id.

Given the clear precedential authority of Air France and British Caledonia to the present situation, we must affirm the refusal of registration. It is clear to us, from a review of all the specimens in the record, that the

term SPACEBED is not being used to identify the services recited in the application, namely, "transportation of passengers by air featuring a business class combination airline seat and bed."

Both applicant and the Examining Attorney have cited various cases in support of their particular positions. Because cases dealing with the question of whether specimens show use of a mark for the identified services are so fact specific, and because the British Caledonian case is, in our view, so directly on point, we see no need to engage in a discussion of these other cases.

Finally, with its reply brief applicant has submitted a copy of its Registration No. 2478950 for SKYSUITE for "transportation of passengers by air by way of providing a first class seat-bed." The submission of such an exhibit with an appeal brief is manifestly untimely. See Trademark Rule 2.142(d) ("The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.") Applicant had previously referred to this registration in its request for reconsideration and in its appeal brief, but as the Examining Attorney pointed out, in order to make a

registration of record, the applicant must submit a copy of the registration. Thus, the registration has not been considered.⁴ Moreover, even if the registration had been properly made of record, it would not affect our decision herein. Each case must be decided on its own facts, and we must therefore determine whether SPACEBED functions as a trademark for transportation of passengers by air based on the specimens before us, not on what another Examining Attorney might have deemed acceptable usage for a different mark used on different specimens.

Because the three sets of specimens submitted by applicant fail to show SPACEBED as a mark for "transportation of passengers by air featuring a business class combination airline seat and bed," we find that SPACEBED does not function as a service mark under Sections 1, 3 and 45 of the Trademark Act.

⁴ With its reply brief applicant also submitted a copy of a third-party registration for PRICO. The mark PRICO had been the subject of a case cited by the Examining Attorney, *In re J.F. Pritchard & Co. and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979), in which the Board affirmed a refusal of registration. The submission of this third-party registration is clearly untimely. Moreover, although applicant submitted the registration to show that the mark involved in that decision was ultimately registered, we point out that the mark that registered issued from an application that was different from the applications involved in the published decision. Because the refusal of registration was based on the insufficiency of the specimens, the fact that a registration later issued from a different application which presumably contained different specimens has no probative value in the present situation.

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Decision: The refusal of registration is affirmed.