

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
March 4, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Bayer Schering Pharma AG

---

Serial No. 76321460

---

Marilyn Matthes Brogan of Frommer Lawrence & Haug LLP for  
Bayer Schering Pharma AG.

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

---

Before Grendel, Rogers and Bergsman, Administrative  
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Bayer Schering Pharma AG, applicant herein, seeks  
registration on the Principal Register of the mark VIP BETA  
CLUB (in standard character form; CLUB disclaimed) for  
services recited in the application as "educational  
services, namely, conducting workshops, conferences,  
classes, seminars and the like in the field of multiple  
sclerosis," in Class 41, and "support group services for

persons with multiple sclerosis," in Class 42.<sup>1</sup> The application was filed as an intent-to-use application under Trademark Act Section 1(b), 15 U.S.C. §1051(b). Applicant subsequently filed a Statement of Use on April 15, 2005, together with specimens of use for each class.

The Trademark Examining Attorney has issued a final refusal to register applicant's mark in each class, on the ground that applicant has failed to comply with the Trademark Examining Attorney's requirement for submission of an acceptable specimen of use of the mark in connection with the recited services in each class.

Applicant has appealed the final refusals. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusals as to each class.

Trademark Act Section 1(d)(1) and Trademark Rule 2.88(b)(2) provide that a Statement of Use must be accompanied by a specimen of the mark as actually used in commerce. Trademark Rule 2.88(b)(2) further provides that the requirements for specimens are as set forth in Trademark Rule 2.56. Trademark Rule 2.56(b)(2) provides that a service mark specimen must show the mark as actually

---

<sup>1</sup> Serial No. 76321460, filed on October 3, 2001.

**Ser No. 76321460**

used in the sale or advertising of the services. To show service mark usage, the specimen must show use of the mark in a manner that would be perceived by potential purchasers as both identifying the applicant's services and indicating their source. *See in re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001). A specimen that shows only the mark, with no reference to the services, does not show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997); *In re Duratech Industries Inc.*, 13 USPQ2d 1318 (TTAB 1989).

Applicant's Class 41 specimen is a printout of a page from applicant's website, depicted below:

Home

# MS Pathways

ms pathways new to betaseron pathways support staying connected wellness corner

Search

text size



MS Info Center  
Information and  
Resources

MultipleSclerosis.co  
Comparative Data o  
MS treatments

BETASERON  
Information about  
this treatment

Home

Tools

Round the Clock Nurse  
Support

MS Pathways<sup>SM</sup> Coupon  
Program

VIP Beta Club

Educational Materials

E-mail Connections

**What Is MS Pathways<sup>SM</sup>?** MS Pathways is the MS <sup>best</sup> by people with MS, providing free se those with MS and their loved ones. People ways - including patients, family members partners - all have access to a comprehen work, which includes a toll-free phone line ie

*← Class 41*

### Other Berlex Websites

Berlex Laboratories  
 Female Healthcare  
 Diagnostic Imaging  
 Dermatology  
 Therapeutics  
 Oncology

### Berlex Laboratories

→ Berlex.com

### Female Healthcare

→ Mirena.com  
 → Yasmin.com  
 → Clearlyclimara.com  
 → Climararewards.com  
 → Climarapro.com  
 → Menostar-us.com



**Contact a Nurse At MS Pathways,** specialist B.E.T., is available any t or she can help a any questions at or Betaseron as offer tips to help adjust to therapy a B.E.T.A. Nurse call MS Pathway: 788-1467.

More

Join MS Pathway and select your f welcome gift — a Weekender Travel a downloadable Journal

Top of page

Top of page

The matter applicant seeks to register, VIP BETA CLUB, appears on the left as part of a menu of options which

apparently lead to various sources of information available on the website.<sup>2</sup> "VIP Beta Club" is one of the menu options, appearing directly above the options named "Educational Materials" and "E-mail Connections." "VIP Beta Club" appears in the same font size and style as "Educational Materials" and "E-mail Connections."

We find that the designation "VIP Beta Club," as it appears on the specimen, would not be perceived by purchasers as a service mark identifying applicant's Class 41 "educational services, namely, conducting workshops, conferences, classes, seminars and the like in the field of multiple sclerosis." Appearing as it does in the same position, font style and size as the generic wording "Educational Materials" and "E-mail Connections," purchasers are likely to view "VIP Beta Club" merely as another generic or informational designation and menu option, rather than as a service mark for educational services. See *In re A La Vieille Russie, Inc., supra* (RUSSIANART perceived as informational matter rather than as service mark for art dealership services, where the term was displayed in the same size and font as other informational matter).

---

<sup>2</sup> The "Class 41" notation on the specimen is a marking on the original specimen submitted by applicant.

At page 3 of its brief, applicant contends that

...the web page specimen which supports the "educational materials" provides a direct link to informational educational materials for the consumer; it is urged that the availability and promotion of such educational materials on the Applicant's internet site is more than sufficient to demonstrate use of the mark in connection with educational services.

We disagree. First, as the Trademark Examining Attorney notes, "educational materials" are not the same thing as "educational services, namely, conducting workshops, conferences, classes, seminars and the like in the field of multiple sclerosis." Second, and more fundamentally, even if purchasers would glean from the presence of the "educational materials" menu option that applicant provides the recited educational services, the designation "VIP Beta Club" is a separate and distinct menu option which fails to refer to, much less act as a source indicator for, applicant's educational services. We note that the issue before us is not whether purchasers would be able to determine from the webpage (especially from the "educational materials" menu option) that applicant in fact provides the recited educational services. We presume that applicant in fact provides such services. Rather, the

issue is whether purchasers viewing this particular webpage<sup>3</sup> would perceive the "VIP Beta Club" menu option as a service mark for such educational services. We find that they would not.

For these reasons, we find that applicant's proffered Class 41 specimen fails to demonstrate use of VIP BETA CLUB as a service mark for the educational services recited in the application. We therefore affirm the Trademark Examining Attorney's specimen refusal as to Class 41.

We turn next to the issue of whether applicant's Class 42 specimen is acceptable, that is, whether it shows use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's "support group services for persons with multiple sclerosis" and indicating their source. Applicant's Class 42 specimen is the front page of a promotional brochure, depicted below:

---

<sup>3</sup> The record does not tell us what would be displayed on the screen if the "VIP Beta Club" menu option were to be selected.

Class  
#2

VIP  
Beta Club<sup>SM</sup>

*Membership  
Benefits*

**BETASERON<sup>®</sup>**

[INTERFERON BETA-1b]  
FOR SC INJECTION

MULTIPLE SCLEROSIS  
**PATHWAYS**

800-788-1467

[www.mspathways.com](http://www.mspathways.com)

We find that this brochure cover is insufficient as a service mark specimen for applicant's Class 42 services.<sup>4</sup> Although it displays the mark in a service mark fashion (unlike the Class 41 specimen discussed above), the specimen fails to identify the recited "support group" services. The word "Club" in the mark and the wording "Membership Benefits" below the mark, as well as the wording "Multiple Sclerosis" which appears in small lettering at the bottom, might enable purchasers to infer that the services pertained to some sort of club involving multiple sclerosis. However, nothing on the face of the specimen<sup>5</sup> informs purchasers with any degree of particularity that the services offered in connection with the mark are "support group" services. A service mark specimen must not only indicate source; it also must identify the services offered in connection with the mark. *See in re Universal Oil Products Co., supra; In re Duratech Industries Inc., supra.*

For these reasons, we find that applicant's proffered Class 42 specimen fails to demonstrate use of VIP BETA CLUB as a service mark for the "support group" services recited

---

<sup>4</sup> The "Class 42" notation on the specimen is a marking on the original specimen submitted by applicant.

Ser No. 76321460

in the application. We therefore affirm the Trademark Examining Attorney's specimen refusal as to Class 42.

Finally, applicant contends that the Office has issued to applicant a registration covering a design version of applicant's VIP BETA CLUB mark, and that the specimens accepted by the Office in that application are "substantially identical" to the specimens applicant has submitted in this case. We are not persuaded. First, the specimens from the other application are not of record in this case, and we therefore cannot determine whether they are in fact "substantially identical" to the specimens submitted in this application. Second, even if the specimens which were accepted in the other application are substantially identical to the specimens submitted in this application, it is settled that we are not bound by the prior decisions of Trademark Examining Attorneys, and that we must decide the case actually before us and reach our own conclusion on the record that is before us. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

---

<sup>5</sup> The record fails to show what the inside of the brochure says, or what reference it might make to the recited support group services.

**Ser No. 76321460**

Decision: The refusals to register in Class 41 and Class 42 are affirmed.