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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Innovative Companies LLC

Serial No. 76421927

Myron Amer, Esq. for The Innovative Companies LLC

Toni Y. Hickey, Trademark Examining Attorney, Law Office 115
(Tomas V. Vlcek, Managing Attorney).

Before Hanak, Hairston and Kuhlke, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

The Innovative Companies LLC (applicant) seeks to register INNOVATIVE STONE PRODUCTS for "providing training that deals with the characteristics of granite, marble, and ceramic tile for end uses of these materials for kitchen countertops, floors, patios and related purposes." The intent-to-use application was filed on June 17, 2002. At the request of the Examining Attorney, applicant disclaimed the

exclusive right to use STONE PRODUCTS apart from the mark in its entirety.

To briefly describe the history of this application, suffice it to say that the PTO issued a Notice of Allowance on June 17, 2003. Thereafter applicant filed a specimen of use and later a substitute specimen of use.

The Examining Attorney has refused registration on the basis that applicant's "original specimen and substitute specimen of record are unacceptable as evidence of actual service mark use because they do not show use of the mark INNOVATIVE STONE PRODUCTS in connection with the services identified in the Notice of Allowance, i.e. 'providing training that deals with the characteristics of granite, marble and ceramic tile for end uses of these materials for kitchen countertops, floors, patios and related purposes.'" (Examining Attorney's brief page 2).

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We find that while applicant's original specimen of use is deficient, applicant's substitute specimen of use does indeed show use of applicant's mark in connection with

applicant's services. Accordingly, the refusal to register is reversed.

The pertinent law involving the issue in this case is well summarized as follows: "It is not enough for the applicant to be a provider of services; the applicant also must have used the mark to identify the named services for which registration is sought." In re Advertising & Marketing, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987).

Applicant's substitute specimen of use is the first page of a brochure distributed by applicant. On the left side of the first page there appears applicant's address, telephone numbers and website address. On the right side of this first page there appears from top to bottom the following three things. First, a very prominent display of applicant's mark INNOVATIVE STONE PRODUCTS, as conceded by the Examining Attorney at page 4 of her brief. Second, a picture of a kitchen countertop with various items on it as well as two chairs placed near the countertop. Third, there appears in close proximity to applicant's mark and the just described picture of a countertop the following words displayed in a prominent fashion: "Reference guide to prepare for your granite countertop templating and installation." It should

be noted that at no time did the Examining Attorney request that applicant submit additional pages from its brochure.

Applicant's services are essentially providing training that deals with the characteristics of various materials such that the end uses of these materials will result in kitchen countertops, floors and patios, as well as other possible items.

It is our judgment that the prominent wording appearing on the first page of applicant's brochure would be viewed by consumers as indicating that the brochure provides training in the installation of granite in order to create a kitchen countertop. As previously noted, this prominent wording on the first page of applicant's brochure is as follows:

"Reference guide to prepare for your granite countertop templating and installation." The word "template" is defined as follows: "a pattern, usually in the form of thin metal, wooden or paper plate for forming an accurate copy of an object or shape." Webster's New World Dictionary (2d ed. 1996). In essence, the first page of this brochure informs consumers that they will be instructed as to how to prepare a template for which they will use to overlay on a piece of granite, and then cut the granite to the shape and size of the template. This first page also informs consumers that

they will then be instructed as to how to install the granite countertop once it has been cut from a larger piece of marble using the template.

We readily acknowledge that applicant's substitute specimen does not provide training that deals with marble or ceramic tile, or that deals with any material for use in conjunction with floors or patios. The first page of the brochure merely shows use of applicant's mark in conjunction with training for the installation of granite to form a countertop, which of course would include countertops of all types including a kitchen countertops. Indeed, the picture on the first page of applicant's brochure features a kitchen countertop.

It should be noted that at no time during the course of this proceeding did the Examining Attorney object to applicant's substitute specimen on the basis that it did not evidence use of applicant's mark in conjunction with training for the installation of marble or ceramic tile, and that it did not provide training for the installation of any materials for floors or patios. Rather, the Examining Attorney's objection is that "the brochure [substitute specimen of use] submitted by applicant supports installation services, not training services." (Examining Attorney's brief

page 4). Continuing, the Examining Attorney merely speculates that "it appears that [applicant's] consumer is buying goods and receiving necessary installation services." (Examining Attorney's brief page 4, emphasis added).

The Examining Attorney never even inquired of applicant as to whether applicant is selling any goods whatsoever. The Examining Attorney's statement that "it appears that [applicant's] consumer is buying goods and receiving necessary installation services" is pure speculation. (Examining Attorney's brief page 4). Moreover, if applicant's consumers were indeed "receiving necessary installation services," then applicant's training brochure would simply be unnecessary. A professional installer would not need to be taught about templating and installation of granite countertops. Moreover, as previously noted, the prominent wording appearing on the first page of applicant's brochure reads as follows: "Reference guide to prepare for your granite countertop templating and installation." (emphasis added). By use of the word "your," applicant is clearly informing consumers that the brochure will instruct them in the installation of their granite countertop.

In short, if it was the objection of the Examining Attorney that the first page of applicant's brochure did not

cover training that dealt with marble and ceramic tile and that did not deal with floors and patios, then she should have clearly stated that this was the basis of her objection. Applicant may well have then been able to produce additional brochures that focused on other materials (marble and ceramic tile) and other end products (floors and patios). Moreover, if the Examining Attorney was concerned that applicant's training brochure was but an ancillary item involved with applicant's sale of granite, then she should have inquired of applicant if that indeed was the case. However, she did not.

With one notable exception, not applicable here, it is the policy of this Board to resolve close cases in applicant's favor. (The one notable exception involves refusals pursuant to Section 2(d) of the Trademark Act where the Board resolves the issue of likelihood of confusion in favor of the registrant and against the applicant.).

To be blunt, we find that applicant's substitute specimen of use clearly shows use of applicant's mark in conjunction with at least one of applicant's services, namely, "providing training that deals with the characteristics of granite for end uses of [this material] for kitchen countertops." Accordingly, following our

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practice of resolving doubts in applicant's favor, we reverse the refusal to register.

Decision: The refusal to register is reversed.