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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Douglas K. Kelly

Serial Nos. 76498256

Timothy Guy Smith of Raden & Smith, P.C. for Douglas K. Kelly.

Tracy Cross, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Walters, Drost, and Zervas, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 18, 2003, Douglas K. Kelly (applicant)
applied to register the mark LIBERTY BILLIARDS in the
design shown below on the Principal Register for:

Billiard tables; billiard cues; billiard game playing
equipment, billiard triangles; billiard nets; billiard
chalk; billiard bumpers; billiard bridges; billiard
balls in Class 28

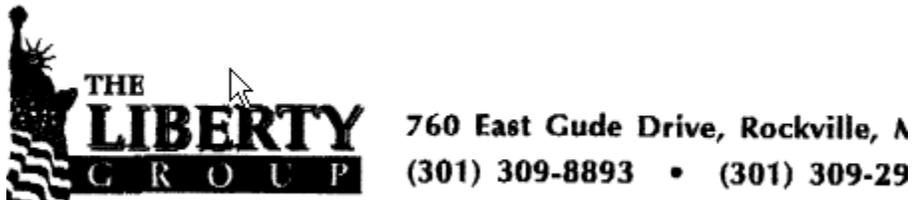
Manufacture of billiard tables to the order and/or
specification of others in Class 40.¹

¹ Serial No. 76498256. The application contains an allegation of dates of first use and first use in commerce of January 1, 2002.



Applicant has disclaimed the term "Billiards."

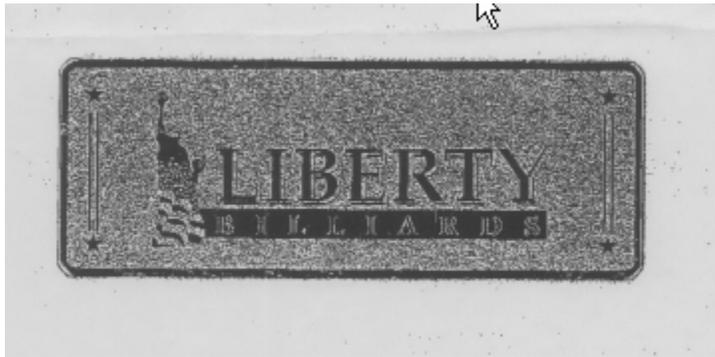
The examining attorney has refused registration on the ground that "applicant failed to submit acceptable specimens pursuant to 37 C.F.R. §§ 2.51(a)(1), 2.51(b)(1), and 2.56(b)(2)." Brief at 1. The refusal is only directed to the services in Class 40. The first specimen that applicant submitted for the services is set out below.



When the examining attorney objected to that specimen, applicant submitted another specimen, which is apparently a color version of the first specimen.



The examining attorney pointed out that the letterhead shows the words in the mark as LIBERTY GROUP while the mark in the drawing is LIBERTY BILLIARDS. The examining attorney maintained the requirement that applicant provide a proper specimen and applicant submitted the specimen shown below with an affidavit by Mr. Kelly that maintained that this "name plate ... is affixed to all Liberty Billiards pool tables."



The examining attorney found that the substitute specimen was unacceptable because there "must be a direct association between the mark sought to be registered and the services specified in the application, with sufficient reference to the services in the specimen to create this association." Office Action dated July 3, 2004.

The examining attorney's position, regarding the first two specimens, is that the "wording contained in the underlying rectangular carrier is different." Brief at 3. In addition, the examining attorney also noted that these

letterhead specimens did not reference the services. Therefore, the examining attorney found these specimens unacceptable.

Regarding the name plate, the examining attorney determined that "the specimen is acceptable for the applicant's *goods*, but not for the applicant's *manufacturing services*." Brief at 4. Again, the examining attorney pointed out that there is no reference to the services in the specimen.

Applicant responds by arguing that letterhead specimens have been accepted in the past and that the specimens do not have to refer specifically to the services.

The Trademark Act § 1(a)(1) (15 U.S.C. § 1051(a)(1)) requires an applicant who is the owner of a trademark used in commerce to file "such number of specimens or facsimiles of the mark as used as may be required by the Director." A mark is used "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." 15 U.S.C. § 1127. The Office currently requires the submission of

one specimen with use-based applications (37 CFR § 2.56(a)) and a "service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 CFR § 2.56(b)(2).

The Federal Circuit addressed the question of the proper specimens for services in the following manner:

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 *In re Universal Oil Products Co.* [476 F.2d 653, 177 USPQ 456 (CCPA 1973)], the CCPA affirmed the board's refusal to register PACOL and PENEX as marks for engineering services, even though the applicant was a provider of such services, because the marks had been used only to identify certain *processes* and not to identify the engineering services for which registration was sought. The CCPA stated that the applicant had failed to show a "direct association" between the mark and the services named in the application. The "direct association" test does not create an additional or more stringent requirement for registration; it is implicit in the statutory definition of "a mark used * * * to identify and distinguish the services of one person * * * from the services of others and to indicate the source of the services."

In re Advertising & Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987)(footnotes omitted).

There are two separate questions in this case involving applicant's specimens. The first concerns the specimens that consist of letterhead stationery and the

second concerns the name plate that applicant applies to his goods.

Regarding letterhead stationery, it "may be acceptable as evidence of service mark use, *if* it includes a reference to the service." In re Monograms America Inc., 51 USPQ2d 1317, 1319 (TTAB 1999). "To create an association between the mark and the services, the specimen does not have to spell out the specific nature or type of services. A general reference to the industry may be acceptable." TMEP § 1301.04(c) (4th ed. April 2005). See, e.g., In re Ralph Mantia Inc., 54 USPQ2d 1284, 1286 (TTAB 2000) and In re Southwest Petro-Chem, Inc., 183 USPQ 371, 372 (TTAB 1974).

However, the problem with applicant's letterhead specimens is that they do not agree with the mark in the drawing. Applicant's drawing is for the mark LIBERTY BILLIARDS and design. The wording in the letterhead specimens is for THE LIBERTY GROUP. "A drawing depicts the mark sought to be registered." 37 CFR § 2.52. The "drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services." 37 CFR § 2.51(a). Inasmuch as the mark in the drawing is not a substantially exact representation of the mark in the letterhead specimens,

these specimens are not acceptable to support the registration of the mark.

Next, we address applicant's name plate specimen. Unlike the letterhead specimens, the name plate does show the same mark that is in applicant's drawing. There is a line of cases that supports the acceptability of specimens that do not themselves set out what the services are when the specimens are used during the performance of the services. In In re Red Robin Enterprises, Inc., 222 USPQ 911, 914 (TTAB 1984), the board held that "the photographs of applicant's costume mark on a garbed performer or model, as submitted in this case and with evidence of prior registration for a collateral use, are adequate service mark specimens." In a subsequent case, the board found that a specimen consisting of a photograph of a two-color fence was acceptable for a service mark for renting chain link fences. In re Eagle Fence Rentals, Inc., 231 USPQ 228 (TTAB 1986). There, the board found that "the specimens submitted in this case are acceptable for the same reasons as were the specimens in the Red Robin case; that is, they show use of applicant's color scheme in the rendering (i.e., 'sale') of its services." Id. at 231. Furthermore, the applicant in that case had promoted the "dual-color scheme of its fencing as an indication of source." Id. In

the present case, the evidence does not show that applicant has promoted his LIBERTY BILLIARDS mark as a service mark for his services or that he has a prior registration for collateral goods. Also, unlike the Red Robin and Eagle Fencing cases, there is no evidence that the mark is used in the rendering of the services. Instead the mark is apparently applied to the product after the services have been rendered.

Because of the facts here, we find that our case law dealing with custom manufacturing services to be more relevant. In In re Johnson Controls Inc., 33 USPQ2d 1318 (TTAB 1994), the applicant applied to register the mark IRON VALVE EXPRESS for the "manufacture of fluid control products to the order and specification of consumer request." These products are known as "iron valves." The board found that while the specimens were satisfactory trademark specimens, there "would be no reason for any reasonable person to suspect that a custom manufacturing service is being identified by the mark as it is used on these labels." Id. at 1320. The same is true with applicant's name plate specimen. The examining attorney has noted that "the specimen is acceptable for applicant's goods." Brief at 7. Also, while the mark does contain the word "billiards" as the mark in Johnson Controls contained

the generic term "iron valve," there is no indication in either case that any service activity is involved.

The other case that is particularly relevant is In re Adair, 45 USPQ2d 1211 (TTAB 1997). In that case, the applicant applied to register the mark TREE ARTS CO. and design for design services in the nature of designing permanently decorated Christmas and designer trees with custom skirts for use as room accessories. The specimens were tags that were affixed to decorated Christmas trees. Again, these tags made no reference to any services. Even when considered with advertising that referred to the trees being available in custom styles, the board was not persuaded that this nebulous reference was enough to show use of the mark to identify the services.

In applicant's case, his affidavit merely states that the name plate "is affixed to all Liberty Billiards pool tables and all other Liberty Billiard Products which are sold [in] commerce." We have no basis to conclude that these name plates are actually used as a service mark. Indeed, the affiant does not even mention the services specifically. Like the Johnson Controls specimen, they appear to be attached after the services have been completed. Therefore, we agree that applicant's specimens do not show valid use of his mark as a service mark and the

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examining attorney's refusal to register the mark in Class 40 on that basis is affirmed.

Decision: The examining attorney's refusal to register the mark for failing to provide a proper specimen for the services in Class 40 is affirmed. The application will proceed to publication, in due course, for the goods in Class 28.