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THE TTAB

Mailed: June 28, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re RDS America, L.L.C

Serial No. 76525800

Eric T. Jones of Reising, Ethington, Barnes, Kisselle, P.C. for
RDS America, L.L.C.

Sanjeev Vohra, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).¹

Before Holtzman, Drost and Wellington, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by RDS America, L.L.C. to
register the mark ROUTE DISTRIBUTION SOLUTIONS (typed form) for
services ultimately identified as:²

Business marketing services in the field of hand
trucks, delivery trucks, pallet trucks, and delivery
and material handling products, rendered at the
customer's site (in Class 35).

¹ The application was assigned to Sanjeev Vohra to write the appeal
brief. A different examining attorney handled the case during
prosecution.

² Application Serial No. 76525800, filed June 27, 2003, alleging a date
of first use and first use in commerce of October 1, 2002. "ROUTE
DISTRIBUTION" is disclaimed.

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Maintenance, installation, and repair of hand trucks, delivery trucks, pallet trucks, delivery and material handling equipment, and consultation related thereto (in Class 37).

This case is on appeal from the examining attorney's final refusal to register the mark on the ground that the specimens do not show use of the mark for the identified services in Class 35 and, in effect, on the ground that the identification of services in Class 35 does not accurately describe the services.³ Section 1(a)(1) and (2) of the Trademark Act. The appeal has been fully briefed.

As background for this matter, the application was originally filed with the following recitation of services:

Marketing, specifying, installing, reconditioning, servicing, consulting concerning and delivering material handling equipment and systems incorporating hand trucks, delivery trucks, pallet trucks and associated material handling products.

In her first Office action, the examining attorney properly rejected the recitation of services on the ground that it was indefinite and included services classified in more than one class. The examining attorney suggested that the recitation be amended to the following "if accurate":

³ The refusal pertains only to Class 35. Other refusals and/or requirements in the case, including an initial refusal to register based on Section 2(e)(1) of the Trademark Act, have been resolved or withdrawn.

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Business marketing consulting services in the field of hand trucks, delivery trucks, pallet trucks and associated material handling products (in Class 35).

Maintenance, installation, and repair of hand trucks, delivery trucks, pallet trucks, delivery and material handling equipment, and consultation related thereto (in Class 37).

The specimen of use accompanying the original application is reproduced below.

RDS
Route Distribution Solutions, LLC
369 Blanding Blvd. Ste. 911
Orange Park, FL 32073
T: (866) 255-5737
F: (866) 329-4737

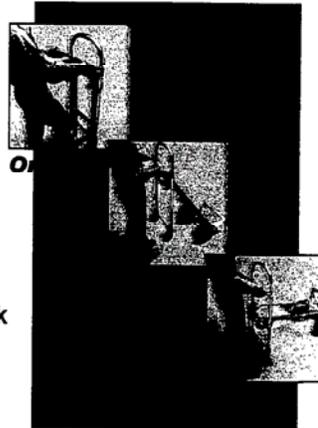
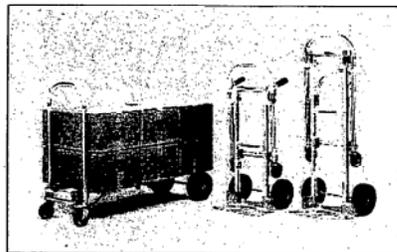
Professional Equipment for Beer Delivery



GEMINI The original convertible hand truck

Converts from 2 to 4 wheels in seconds!

As Easy as . . .



- ▼ 1,000 pound capacity
- ▼ Lightweight aluminum
- ▼ Durable, long-lasting 1/2 ton truck
- ▼ In stock for immediate shipment

Quality equipment from **MAGLINER**[®]
Quality service from Route Distribution Solutions

Handwritten initials

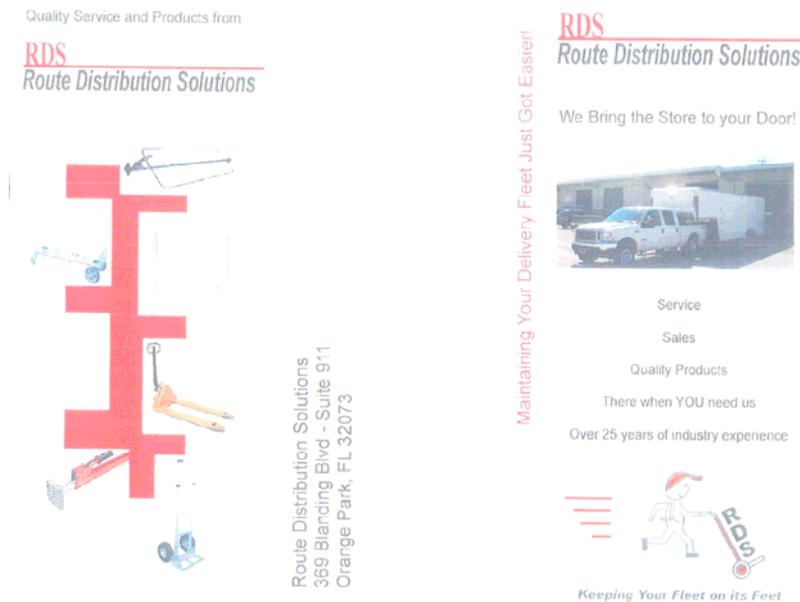
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In addition, the examining attorney rejected the specimen as evidence of service mark use on the ground that the specimen did not specifically refer to any of the services provided by applicant. She stated that the specimen shows "the mark used in and [sic] advertisement for the sale of delivery hand trucks" but that "the applicant is not selling goods on a retail basis and therefore the specimens do not reference the services listed."

In response to the refusal, applicant adopted the suggested recitation for the Class 37 services, submitted the fee for the additional class, submitted a second specimen, and amended the services in Class 35 to:

Business marketing services in the field of hand trucks, delivery trucks, pallet trucks, delivery and material handling products, and consultation related to the field.

The second specimen, a brochure, is shown below.



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This brochure shows the mark and the statement "We Bring the Store to your Door!" followed by the wording "Service" "Sales" and "Quality Products."

The examining attorney accepted the recitation for the Class 37 services as well as the new specimen for that class. The examining attorney also accepted the proposed recitation for Class 35 but issued a final refusal on the basis that the specimens "do not specifically refer to the business marketing services provided by the applicant."

Applicant then amended the Class 35 recitation to read:

Marketing services in the field of hand trucks,
delivery trucks, pallet trucks, delivery and
material handling products.

The examining attorney continued the final refusal as to the specimens and rejected the proposed recitation because "the wording 'Marketing services...' is too vague as listed." She stated that the type of marketing must [be] indicated" and she suggested the following language "if accurate":

Business marketing services in the field of hand
trucks, delivery trucks, pallet trucks, delivery and
material handling products.

Applicant then adopted verbatim the recitation suggested by the examining attorney.

In the next Office action, the examining attorney continued the refusal as to the specimens maintaining her earlier position

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that the specimens "do not specifically refer to the business marketing services provided by the applicant" and adding that "In fact, the specimens appear to be advertising for the applicant's own services which are not separate services."

The case continued in this manner with a series of proffered and rejected amendments, one of which incorporated language taken from TMEP §1301.01(a)(1) and the *Acceptable Identification of Goods and Services Manual* (ID Manual):

Business marketing services comprising gathering together various products of others in the field of hand trucks, pallet trucks, and delivery and material handling products, and transporting them to the customer's site for customer inspection, selection and purchase consummation.

The examining attorney rejected this recitation first as outside the scope of the identification as originally filed, and in a subsequent action as outside the scope of the identification as amended. She also noted that "transporting" of the goods is in a different class.

Over the course of its next few responses, applicant expressed its concern that the examining attorney was misinterpreting what applicant is actually doing; indicated that it did not understand the examining attorney's repeated contention that "the specimens appear to be advertising for the applicant's own services which are not separate services"; argued based on a dictionary definition that "marketing" means "to

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sell"; and pointed out that the term "sales" is explicitly mentioned on the specimen as well as the statement "We Bring the Store to your Door!" Applicant explained as follows:

The products, which applicant sells or markets, are not manufactured by applicant, but rather are the new goods of others.

The examining attorney dismissed these arguments, and applicant eventually settled on the following recitation which is the one currently before us:

Business marketing services in the field of hand trucks, delivery trucks, pallet trucks, and delivery and material handling products, rendered at the customer's site.

For the first time in the appeal brief, the examining attorney explains that "The USPTO considers [business marketing services] to be promoting the sale of goods and services of others through the rendering of advertising services," although the examining attorney cites no authority for that statement. While noting that the specimens indicate that applicant is selling beer delivery equipment, the examining attorney states that "neither specimen makes any reference, either direct or indirect, to conducting advertising services on behalf of others (i.e. business marketing, which is what the identification of services in Class 35 contemplates)." The examining attorney rejects applicant's contention that "marketing" is "selling" and

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that "selling" is a service arguing that "selling" is not a "business marketing service" and that, in any event, "simply selling goods is not considered to be a service at all." The examining attorney contends that although TMEP §1301.01(a)(1) "is the basis for holding that retail store[] services and similar services are considered to be" registrable services and that although, according to the examining attorney, applicant may be rendering a type of retail service, such service is outside the scope of applicant's current identification.

It is clear that the original recitation of services was unacceptable. Beyond that, the issues regarding the nature of the services and an appropriate description of the services became confused, and the case ran off track with the first suggested recitation. The first problem is that the examining attorney did not follow the procedure set forth in TMEP §1402.05 ("Accuracy of Identification") which states:

An identification is unacceptable if it is inconsistent with the goods or services indicated by the specimens, or if the ordinary meaning of the identification language is at variance with the goods or services evidenced by the specimens or any other part of the record.

Assuming "business marketing" means "advertising services," the examining attorney suggested an unacceptable recitation, one that was not supported by, and was inconsistent with, the specimen in the original application. The original specimen,

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shown above, is an advertisement, an acceptable specimen for a service. The mark is prominently displayed on the advertisement. The featured product on the advertisement is a "GEMINI® The original convertible hand truck" and the ad states that the product is "In stock for immediate shipment." Applicant also provides "Quality equipment from MAGLINER®" as noted on the bottom of the advertisement.

There is no requirement that specimens spell out the specific nature or type of services rendered. See *In re Johnson Controls Inc.*, 33 USPQ2d 1318 (TTAB 1994); *In re Southwest Petro-Chem, Inc.*, 183 USPQ 371, 372 (TTAB 1974); and TMEP § 1301.04(c) (4th ed. April 2005). A general reference in the specimen to the industry or the activity performed may be acceptable. See generally TMEP § 1301.04(c), *supra*. A review of the specimen as a whole, including the reference to GEMINI hand trucks that are "In stock for immediate shipment," suggests that applicant is selling goods, or perhaps delivering goods. But there is nothing whatsoever in the specimen to suggest that applicant is in the business of advertising goods. In fact, the examining attorney acknowledged in the first Office action that the specimen showed sales, stating "The specimens show the mark used in and [sic] advertisement for the sale of delivery hand trucks." It is unclear why, then, the examining attorney did not suggest a

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recitation that reflected a sales-related service,⁴ or at least some other activity supported by the specimen, rather than a service applicant was clearly not performing based on this specimen.

From the examining attorney's statement that "The applicant is not selling goods on a retail basis and therefore the specimens do not reference the services listed," the examining attorney might have thought that applicant was only selling its own goods, which is not a service. The trademarks, GEMINI and MAGLINER, displayed on the specimen, appear to identify other companies' products. But if the examining attorney was unsure if that was the case, she still could have suggested an appropriate "sales" recitation and then required additional specimens or inquired about the matter.

In fact, applicant made it clear in its response that these are other companies' products, expressly stating that the products which applicant sells "are not manufactured by applicant, but rather are the new goods of others." See, e.g., *In re International Environmental Corporation*, 230 USPQ 688, 691 (TTAB 1986) ("The fact that the specimens of use do not specifically mention 'distributorship services' or contain an

⁴ Based on the wording "Professional Equipment for Beer Delivery," these are goods that are sold to commercial purchasers. Thus, for example, the examining attorney might have suggested retail distributorship services in the field of hand trucks, etc.

offer to sell specific brands of goods made available by applicant through its distributorship services is not fatal. Applicant has stated for the record that these surveys are used in conjunction with its distributorship services."). If there was any doubt as to the nature of the service or how it was performed based on the first specimen, the second specimen, listing "Sales" and stating, "We Bring the Store to your Door!" made it clear that applicant was engaged in a registrable sales activity.

The situation was further complicated by the fact that the suggested wording "business marketing" was interpreted differently by applicant and the examining attorney. Applicant adopted the recitation construing the term to mean "sales," and this was entirely reasonable. We note that "business marketing" is defined in Encyclopædia Britannica (2007) as follows:⁵

Business marketing, sometimes called business-to-business marketing or industrial marketing, involves those marketing activities and functions that are targeted toward organizational customers. This type of marketing involves selling goods (and services) to organizations (public and private) to be used directly or indirectly in their own production or service-delivery operations. ...

Applicant's services fall squarely within this

⁵ Encyclopædia Britannica Online; eb.com. The Board may take judicial notice of entries in standard reference works. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *In re Hartop & Brandes*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962).

definition of "business marketing" and we can understand why applicant believed that description was appropriate.

The Office, however, apparently construes "business marketing" as an "advertising service." The problem is that the examining attorney did not explain this to the applicant at the time the recitation was suggested, or for that matter at any time prior to appeal. The examining attorney simply stated all along that "the specimens appear to be advertising for the applicant's own services which are [sic] not separate services." Absent any context, applicant was understandably confused by the examining attorney's statement having no idea what the statement meant or why it was made.

This confusion was never resolved, and at one point the applicant attempted to amend the recitation to more clearly reflect the type of "sales" service shown in the specimens as follows:

Business marketing services comprising gathering together various products of others in the field of hand trucks, pallet trucks, and delivery and material handling products, and transporting them to the customer's site for customer inspection selection and purchase consummation.⁶

⁶ It is true, as the examining attorney pointed out in rejecting this amendment, that "transporting" goods is in a different class than selling goods. However, an amendment to delete that term and to slightly change the phrasing to perhaps "making them available at the customer's site," would have resolved that particular problem. A slight variation of this wording appears as an "acceptable" identification in the ID Manual.

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However, at that point, applicant had already adopted the confusing "business marketing" service suggested by the examining attorney and applicant's amendment to indicate "sales" was rejected as outside the scope of the original and/or amended recitation.⁷

Considering the circumstances of this case, we find that the recitation of services currently of record, namely "business marketing services in the field of hand trucks, delivery trucks, pallet trucks, and delivery and material handling products, rendered at the customer's site," while not ideal, is minimally accurate. Furthermore, we find that the specimens are acceptable to show use of the mark for the services so identified.⁸

⁷ The only issue before us regarding the recitation is whether the recitation currently of record is accurate, and not whether any earlier amendment such as the proposed amendment above is acceptable. However, we feel compelled to comment on the position taken by the examining attorney with respect to this earlier amendment. First, the amendment, in fact, does not exceed the scope of the original recitation of services. The original recitation specifically listed the term "marketing" which was clearly broad enough to encompass, among other things, a sales-related service. Furthermore, it would be unfair to deny applicant an opportunity to amend an equivocal recitation, which reasonably appeared to describe its services.

⁸ However, to clarify the nature of applicant's services, applicant may wish to voluntarily amend its recitation of services to delete the reference to "business marketing" and to use wording that more clearly reflects the services actually performed; for example, retail distributorship services in the field of hand trucks, etc. In order to do this, applicant would need to file a petition to the Director in accordance with Trademark Rule 2.142(g) to reopen prosecution of the

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Decision: The refusal to register is reversed.

application for entry of the amendment. See Trademark Rule 2.142(g) and TMEP § 1501.06.