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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Astilean

Serial No. 76655997

Myron Amer for Aurel A. Astilean.

Tina Brown, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Quinn, Drost and Ritchie de Larena, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Aurel A. Astilean has filed an application to register
the mark LIFE ON DEMAND ("ON DEMAND" disclaimed) for
services identified, as amended, "health, fitness and
exercise instruction, namely, providing physical fitness
instruction."¹

The trademark examining attorney refused registration
on two bases, namely, (1) that applicant's proposed

¹ Application Serial No. 76655997, filed March 1, 2006, alleging
first use anywhere and first use in commerce on September 12,
2005.

amendment to the identification exceeds the scope of the identification; and (2) that the specimens are unacceptable inasmuch as they do not show use of the proposed mark in connection with the identified services.

When the refusals to register were made final, applicant appealed. Applicant and the examining attorney filed briefs.

IDENTIFICATION OF GOODS/SERVICES

The original identification in the application as filed read "health, fitness and exercise instruction; ongoing television programs in the nature of health, fitness and exercise instruction." Applicant specifically indicated that the identification identified services in International Class 41. In response to the examining attorney's assertion that the identification was unacceptable, applicant adopted the examining attorney's suggested identification to read "health, fitness and exercise instruction, namely, providing physical fitness instruction; ongoing television programs in the field of health, fitness and exercise instruction." Subsequently, in a response to a Section 2(d) refusal, the "ongoing television programs in the field of health, fitness and exercise instruction" were deleted from the identification, leaving the identification to read "health, fitness and

exercise instruction, namely, providing physical fitness instruction." Applicant then proposed yet another amendment to the identification, apparently in an attempt to conform the identification to the substitute specimen. Applicant attempted to amend the services "health, fitness and exercise instruction, namely, providing physical fitness instruction" in International Class 41 to goods identified as "health, fitness and exercise publications" in International Class 16. The examining attorney refused to accept and enter the amended identification because it exceeded the scope of the identification, as amended.

TMEP §1402.07(b) (5th ed. 2007) provides as follows:

An applicant may amend an ambiguous identification of goods or services (*i.e.*, an identification that fails to indicate a type of goods or services) in order to specify definite goods or services within the scope of the indefinite terminology. The policy permitting applicants to amend to specify *either* goods or services should be construed narrowly. The applicant should only be permitted to amend from goods to services, or vice versa, when the existing identification of goods and services fails to specify a definite type of goods or services *and* when the existing identification provides reasonable notice to third parties that the applicant may be providing *either* goods or services within the scope of the existing identification. [emphasis in original]

In the present case there was no such ambiguity because applicant specifically indicated, in the original application, that the identification covered services in International Class 41.

TMEP §1402.07(e) (5th ed. 2007) provides as follows:

Once an applicant amends the identification of goods or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods/services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991).

Of particular significance in the present case is the rule that an applicant may not amend a definite identification of goods to specify services, or vice versa. TMEP §1402.07(c) (5th ed. 2007).

Here applicant's amended identification of services "health, fitness and exercise instruction, namely, providing physical fitness instruction" in International Class 41 is acceptable as a definite identification. Thus, applicant is precluded from amending the definite identification of services to specify goods as applicant attempted in this case. Further, the goods listed in the

proposed amendment clearly exceed the scope of the services in the identification.

Accordingly, the refusal to enter and accept the amendment to the identification is well taken.

SPECIMENS

In view of our decision regarding the identification, the operative identification for purposes of determining the acceptability of the specimens covers services in International Class 41. The identification reads "health, fitness and exercise instruction, namely, providing physical fitness instruction."

Trademark Rule 2.56(b)(2) requires that a service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. Acceptable specimens may include newspaper and magazine advertisements, brochures, billboards, handbills, direct-mail leaflets, and the like. TMEP §1301.04 (5th ed. 2007). Where the mark is used in advertising the services, the specimen must show a direct association between the mark and the services for which registration is sought. See *In re DSM Pharmaceuticals*, 87 USPQ2d 1623, 1626 (TTAB 2008). A specimen that shows only the mark, with no reference to the services, does not show service mark usage. *In re*

Ser No. 76655997

Adair, 45 USPQ2d 1211 (TTAB 1997); and *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994).

A copy of the original specimen is reproduced below.



The original application indicates that the mark is used "on promotional materials" and that the specimen shows the mark as actually used. The examining attorney contends that the specimen is merely "a picture or a rendering" of the proposed mark, and that it fails to show an association between the mark and the identified services. Applicant contends that it obtained a registration of SPEEDFIT based on the same specimen, and "since the specimen was deemed acceptable for SPEEDFIT, it should also be deemed acceptable for LIFE ON DEMAND."

Applicant also submitted a substitute specimen, supported by a declaration. A copy of the substitute specimen, identified as a "stamping," is reproduced below.



The Examining Attorney again refused to accept the specimen because it did not reference the services identified in the application. Applicant merely states that the specimen is in the nature of a "stamping."²

Although the mark is shown in each of the specimens, there is no reference whatsoever to the services; thus, the specimens do not show service mark usage. *In re Adair*, 45 USPQ2d at 1215 ["While the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity."]. In the two specimens of record, we find nothing that would create in the mind of the purchaser a direct association between applicant's mark and the purported services.

We are not persuaded by applicant's statement that the same specimens were accepted in a co-pending application that has matured into a registration. As often stated,

² The substitute specimen accompanied an amendment to the identification to list goods in International Class 16 ("health, fitness and exercise publications"), discussed supra. While a stamping may be acceptable to show use of a designation as a trademark applied to goods, this specimen, as indicated above, does not show service mark usage.

Ser No. 76655997

each case must be decided on its own merits. Neither the Board nor the Office is bound by the prior actions of examining attorneys. *In re Sunmarks*, 32 USPQ2d 1470 (TTAB 1994). See also TMEP §1207(d)(vi) (5th ed. 2007).

The refusal based on applicant's failure to comply with the requirement to submit acceptable specimens showing service mark use is well taken.

Decision: The refusals to register are affirmed.