

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: October 7, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Astilean

Serial No. 76674369

Myron Amer of Myron Amer, P.C. for Aurel A. Astilean.

Jason F. Turner, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Drost, Walsh and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Aurel A. Astilean (applicant) applied to register the designation SPEEDFEET as a mark on the Principal Register for the following services: "unit of measuring distance in the field of health, fitness and exercise" in International Class 41. Applicant claimed first use and first use in commerce of the proposed mark as of September 1, 2006. However, the applicant did not submit a specimen of use with his application.

On July 20, 2007, the trademark examining attorney

issued his first Office action, refusing registration under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the "proposed mark merely identifies a process or system based upon the identification; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source" (July 20, 2007 Office action, p. 1). In addition, the examining attorney required applicant to submit an acceptable declaration under Trademark Rule 2.20, and to either submit a specimen of use or amend the application to seek registration under Section 1(b) of the Trademark Act.

In his August 27, 2007 response, applicant submitted a substitute declaration under Trademark Rule 2.20, and in addition submitted the following "evidentiary declaration" in support of registration of his proposed mark:

AUREL A. ASTILEAN declares:

1. he is the applicant of the above-captioned trademark application;
2. he is a well-known athlete and has participated in an Olympics;
3. he has filed patent applications for "Self-propelled Treadmill Leg Exerciser" assigned Serial Number 60/678,700 and "Bungee Cord Exercising Device" assigned Serial Number 60/749,300;
4. based on my reputation of involvement in physical fitness through exercising and my previous participation in sports, it has been my experience that what I provide to my clients that use the words SPEEDFEET they

- associate with me and I know of no occasion that these words were thought to be a mere unit of measurement in general use in the field of healthy fitness and exercise; and
5. all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

On October 26, 2007, the examining attorney issued a "final" Office action accepting applicant's declaration under Trademark Rule 2.20; continuing the refusal to register under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053 and 1127, on the ground that the proposed mark, as used in the identification, merely describes a process or system, and fails to function as a trademark or service mark and distinguish applicant's services from those of others or indicate their source; and continuing the requirement that applicant either submit an acceptable specimen of use or amend the application to seek registration under Section 1(b) of the Trademark Act.

In his November 9, 2007 response, applicant submitted a specimen of use displaying the mark SPEEDFEET, identified in the accompanying declaration as a "stamping applied by a

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rubber stamp on the packaging for the goods" (applicant's November 7, 2007 declaration). In addition, applicant requested that his application be amended to seek registration on the Supplemental Register.

Subsequently, in a December 5, 2007 Office action, the examining attorney rejected applicant's specimen on the ground that it is unacceptable to support use of the designation SPEEDFEET as a service mark; and further noted that because amendment of the application to seek registration on the Supplemental Register does not obviate the outstanding refusal to register, such amendment does not raise a new issue for examination. Thus, the examining attorney maintained the refusal to register under Trademark Act Sections 1, 2, 3 and 45 as well as the requirement that applicant either submit an acceptable specimen of service mark use or amend the application to seek registration under Section 1(b) of the Trademark Act.

In his March 10, 2008 request for reconsideration, applicant submitted an additional, unidentified and unverified, substitute specimen, reproduced below; and argued that amendment of the application to the Supplemental Register creates a new issue for examination.

World Best Speed

19/1	Man	World Record 400m (1/4 Mile)								
18/1	18/2	Man	World Record 800m (1/2 Mile)							
17/1	17/2	17/3	Man	World Record 1000m (1K)						
16/1	16/2	16/3	16/4	Man	World Record 1 Mile (1600 m)					
15/1	15/2	15/3	15/4	15/5	15/6	15/7	Man	WR 5000m (5K)		
14/1	14/2	14/3	14/4	14/5	14/6	14/7	14/8	14/9	14/10	Man - WR 10000m (10K)
13/1	13/2	13/3	13/4	13/5	13/6	13/7	13/8	13/9	13/10	Women - WR 5000m (5K)
12/1	12/2	12/3	12/4	12/5	12/6	12/7	12/8	12/9	12/10	Men - WR 10000m (10K)
11/1	11/2	11/3	11/4	11/5	11/6	11/7	11/8	11/9	11/10	Women - WR 3000m (3K)
10/1	10/2	10/3	10/4	10/5	10/6	10/7	10/8	10/9	10/10	Women - World Record 10000m (10K)
9/1	9/2	9/3	9/4	9/5	9/6	9/7	9/8	9/9	9/10	Men - WR Marathon
8/1	8/2	8/3	8/4	8/5	8/6	8/7	8/8	8/9	8/10	Women - World Record Marathon

Example: 6/8 8 x 8 = 48 Sp. 8/6 8 x 8 = 48 Sp. 12/4 12 x 4 = 48 Sp. 16/3 16 x 3 = 48 Sp.

3 Laps & 3/1



World Class Athletes

Athletes

Running people

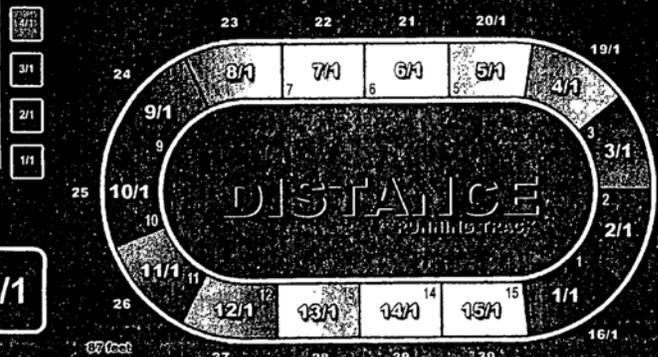
Walking people

19/1	18/1	17/1	16/1	15/1	14/1	13/1	12/1	11/1	10/1	9/1	8/1	7/1	6/1	5/1	4/1	3/1	2/1	1/1	
17/1	17/2	17/3	17/4	17/5	17/6	17/7	17/8	17/9	17/10	16/1	16/2	16/3	16/4	16/5	16/6	16/7	16/8	16/9	16/10
15/1	15/2	15/3	15/4	15/5	15/6	15/7	15/8	15/9	15/10	14/1	14/2	14/3	14/4	14/5	14/6	14/7	14/8	14/9	14/10
13/1	13/2	13/3	13/4	13/5	13/6	13/7	13/8	13/9	13/10	12/1	12/2	12/3	12/4	12/5	12/6	12/7	12/8	12/9	12/10
11/1	11/2	11/3	11/4	11/5	11/6	11/7	11/8	11/9	11/10	10/1	10/2	10/3	10/4	10/5	10/6	10/7	10/8	10/9	10/10
9/1	9/2	9/3	9/4	9/5	9/6	9/7	9/8	9/9	9/10	8/1	8/2	8/3	8/4	8/5	8/6	8/7	8/8	8/9	8/10
7/1	7/2	7/3	7/4	7/5	7/6	7/7	7/8	7/9	7/10	6/1	6/2	6/3	6/4	6/5	6/6	6/7	6/8	6/9	6/10
6/1	6/2	6/3	6/4	6/5	6/6	6/7	6/8	6/9	6/10	5/1	5/2	5/3	5/4	5/5	5/6	5/7	5/8	5/9	5/10
5/1	5/2	5/3	5/4	5/5	5/6	5/7	5/8	5/9	5/10	4/1	4/2	4/3	4/4	4/5	4/6	4/7	4/8	4/9	4/10
4/1	4/2	4/3	4/4	4/5	4/6	4/7	4/8	4/9	4/10	3/1	3/2	3/3	3/4	3/5	3/6	3/7	3/8	3/9	3/10
3/1	3/2	3/3	3/4	3/5	3/6	3/7	3/8	3/9	3/10	2/1	2/2	2/3	2/4	2/5	2/6	2/7	2/8	2/9	2/10
2/1	2/2	2/3	2/4	2/5	2/6	2/7	2/8	2/9	2/10	1/1	1/2	1/3	1/4	1/5	1/6	1/7	1/8	1/9	1/10

DISTANCE Speed/Sec (Sp) TIME Minutes

48 Sp 12/4

SPEED MPH RUN SCORE MFR/Mile



1 Sp 1/1

1 Speed Foot (Sp) = 27 feet 28 yards 26.6 meters

On April 14, 2008, the examining attorney issued a denial of applicant's request for reconsideration, again noting that applicant's proposed amendment to the Supplemental Register fails to overcome the refusal to register; and continuing both the refusal to register and the requirement that applicant submit an acceptable specimen of use.

This appeal followed. Applicant and the examining attorney have filed briefs on the issues under appeal.

Prior to our determination of the issues under appeal, we note that applicant claims use of the designation SPEEDFEET in connection with "unit of measuring distance in the field of health, fitness and exercise." We further note that in his original application; his August 17, 2007, November 8, 2007 and March 10, 2008 responses to the examining attorney's Office actions; and his appeal brief, applicant indicates that the above recitation identifies services in Class 41. We note in addition that the examining attorney did not require applicant to submit an amended identification; nonetheless, the above recitation does not appear to identify either goods or services as contemplated by the Trademark Act. See Trademark Act Sections 1, 2, 3 and 45, *supra*. While the Board possesses the authority to suspend action on an appeal and remand an

application to the examining attorney for consideration of an issue not previously raised, we see no reason to do so in this case. Cf. Trademark Rule 2.142(f) and TBMP §1209.01 and authorities cited therein. Rather, we find that the sufficiency of the recitation of applicant's services is subsumed within the refusal to register that is a subject of this appeal. Accordingly, we decline to remand the instant application, and will consider the issues on appeal based upon the services as identified.

In his brief on appeal, applicant asserts that "the main issue on appeal is whether the accompanying specimen [the March 10, 2008 specimen displayed immediately above] is acceptable for the mark SPEEDFEET" (brief, p. 1). Applicant further asserts that "a subissue is whether applicant's request to convert this application to one seeking registration on the Supplemental Register, which was refused by the Trademark Attorney as not raising a new issue was proper" (*Id.*). Applicant does not address the underlying refusal to register under Trademark Act Sections 1, 2, 3 and 45, but merely "requests that the refusal to register on the Supplemental Register should be overruled" (*Id.* at 2).

The examining attorney, in his brief on appeal, presents arguments in favor of the refusal to register

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under Trademark Act Sections 1, 2, 3 and 45 on the basis that the proposed mark merely identifies a process or system, and thus fails to function as a service mark, and also on the basis that applicant has failed to submit an acceptable specimen showing use of the designation SPEEDFEET as a service mark.

In reply, applicant quotes from applicant's "evidentiary declaration," reproduced above, in support of his contention that SPEEDFEET does not merely identify a process or system of measurement.

Failure to Function as a Mark

The Trademark Act provides for registration of a service mark which has been used in commerce. See Trademark Act Sections 1(a)(1) and 3, 15 U.S.C. §§ 1051 and 1053. The Act defines a "service mark" as a mark which is used "to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown," and further provides that a service mark is "use[d] in commerce" "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce..." Trademark Act Section 45, 15 U.S.C. §1127.

It is settled that a designation which is used merely to identify a process, method or system does not function as a service mark. As the predecessor to our primary reviewing court has stated:

The requirement that a mark must be "used in the sale or advertising of services" to be registered as a service mark is clear and specific. We think it is not met by evidence which only shows use of the mark as the name of a *process* and that the company is in the business of rendering services generally, even though the advertising of the services appears in the same brochure in which the name of the process is used. The minimum requirement is some direct association between the offer of *services* and the mark sought to be registered therefor. [Emphasis in original.]

In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). See also, for example, *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984). However, "while a term used merely to identify a process does not perform the function of a service mark, a term used to identify both a process and the services rendered in connection therewith constitutes a service mark within the meaning of the Trademark Act." *In re Hughes Aircraft Co.*, *supra*, 222 USPQ at 264. Moreover,

[t]he question of whether or not a term used as the name of a process also functions as a service mark must be determined by examining the specimens of record along with any other material made of record by applicant during the prosecution of [the application]. This will allow a determination of the commercial

impression created by the term as used by applicant.

Id. See also *Liqwacon Corp. v. Browning-Ferris Industries*, 203 USPQ 305 (TTAB 1979).

In the present case, the first specimen submitted by applicant consists of a stamping which applicant explains is applied by a rubber stamp to goods. While such a specimen may be acceptable to show use of a designation as a trademark applied to goods, the specimen fails to identify or distinguish applicant's services or to indicate their source. See Trademark Act Sections 1(a) and 45, 15 U.S.C. §§1051(a) and 1127. See also Trademark Rules 2.34(a)(1)(iv) and 2.56(b)(2). As such, the stamping submitted by applicant as his first specimen fails to support use of the designation SPEEDFEET in connection either with the services recited in his application or any other services.

Applicant does not explain the nature of his second specimen. Nonetheless, this specimen appears to display the designation SPEEDFEET as shown below

DISTANCE
SpeedFeet (Sf)

on a chart containing information relating to exercise in the field of walking and running. We have carefully reviewed this specimen, and we conclude that the

designation applicant seeks to register, SPEEDFEET, clearly is used by applicant and would be understood by purchasers as the name of a method or system that applicant uses to calculate a unit of measuring distance in connection with walking or running. However, applicant's second specimen fails either to identify applicant's health, fitness and exercise services and distinguish such services from those of others, or to indicate their source. See *Id.* Rather, SPEEDFEET merely is used to identify applicant's method of calculating a unit of measuring distance in the fields of such services.

In short, applicant has not pointed to a single instance in which SPEEDFEET is used in its specimens as a mark identifying applicant's services, per se, and distinguishing them from the services of others, and we can find no such usage ourselves. Nor has applicant submitted any additional evidence pointing to use of SPEEDFEET as a service mark. We therefore conclude that the commercial impression created by SPEEDFEET, as that designation is used in applicant's specimens, is solely that of the name of the apparently proprietary method or process that applicant uses in rendering the recited services. The specimens fail to show the requisite "direct association between the offer of *services* and the mark sought to be

registered therefor." *In re Universal Oil Products Co.*,
supra, 177 USPQ at 457. Accordingly, the designation fails
to function as a service mark for the recited services.
Applicant's conclusory argument to the contrary is not
persuasive.

Specimens Unacceptable

Based upon the discussion above, we find that the
specimens submitted by applicant fail to support use of the
designation SPEEDFEET as a service mark. The first
specimen, a stamping applied to goods, fails to demonstrate
use of SPEEDFEET as a service mark in connection with any
services. Similarly, the second, unidentified specimen
fails to demonstrate use of SPEEDFEET in connection with
any services and, in addition, is not verified by an
affidavit or declaration in accordance with Trademark Rules
2.20 and 2.59(a).

Accordingly, we find that applicant has failed to
submit an acceptable specimen showing use of SPEEDFEET as a
service mark.

Amendment to Supplemental Register

Finally, we address applicant's argument that his
amendment to seek registration on the Supplemental Register
creates a "new issue" or otherwise obviates the above

refusal to register. Section 23(c) of the Trademark Act, 15 U.S.C. §1091, provides as follows:

For purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

Thus, amendment to the Supplemental Register of an application for a mark that is otherwise capable of registration may overcome a refusal to register on the grounds that such mark is merely descriptive or deceptively misdescriptive, primarily geographically descriptive or primarily merely a surname, or on other grounds that such mark consists of matter that is not inherently distinctive, such as a configuration, color mark, or mark comprising matter that is purely ornamental. See Trademark Act Sections 2(e)(1), 2(e)(2) and 2(e)(4). See also TMEP §714.05(a)(i) and authorities cited therein.

However, in this case we have determined that the designation SPEEDFEET fails to function as a service mark. As such, we have determined that SPEEDFEET is incapable of distinguishing applicant's services from those of others. As a result, SPEEDFEET is not capable of functioning as a mark, and thus not registrable on either the Principal or

Supplemental Register. We note in that regard that the predecessor to our primary reviewing court has held that cases involving whether marks would be perceived as functioning as trademarks on the Principal Register "are pertinent here [to cases involving the Supplemental Register] so far as they relate to whether the appearance of an article may constitute a trademark, and whether it indicates origin." *In re Bourns*, 252 F.2d 582, 117 USPQ 38, 39-40 (CCPA 1958). In other words, our determination herein would be the same regardless of whether applicant applied for the designation SPEEDFEET on the Principal or Supplemental Register. As such, applicant's proposed amendment to the Supplemental Register is irrelevant to the refusal to register in this case. See TMEP §714.05(a)(i), *supra*. We further note that applicant points to no authority for his contention that the instant refusal to register may be overcome by an amendment to the Supplemental Register.

Decision: The refusal of registration under Trademark Act Sections 1, 2, 3 and 45 is affirmed. The requirement that applicant submit an acceptable specimen of service mark use is also affirmed.