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This Opinion is Not a
Precedent of the
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fittracks, Inc.

Serial No. 78100399

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102 (Thomas V. Shaw, Managing Attorney).

Before Grendel, Rogers and Wellington,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Fittracks, Inc. (applicant) applied to register the
mark CLICK2FIT in typed form, under the intent to use
provisions of the Trademark Act. The original
identification of goods/services read "Virtual sales
assistant in the Footwear manufacture & Retail industry,"
and was designated as being in International Class 25, a
class that covers footwear and clothing, but not services
related thereto.

In two office actions, the examining attorney explained that the original identification was in need of amendment, and offered applicant the option of adopting one of the following two possibilities, "if accurate": "Computer hardware and software for use in [please specify use and function] in the footwear industry, in International Class 9" and "Online retail services in the field of footwear, in International Class 42." In response to the second of these two actions, applicant adopted the latter identification.

Following issuance of a notice of allowance, applicant filed an allegation of use asserting use of the mark, and use of the mark in commerce, for the identified services since March 2003. The allegation of use included as a specimen a web page reprint of www.fittracks.com/click2fit. The page is headed "Click 2 Fit" and lists the questions "What is Click 2 Fit?" and "How does Click2Fit work?", as well as information responsive to each question.¹ Though wording on the reprinted web page is truncated, the information and accompanying illustration of the "Click2Fit interactive system" make it clear that the "system"

¹ The web page bears at the top the designation "Page 1 of 2" but a second page is not of record. The examining attorney did not inquire about the apparent second page and applicant, in responding to the examining attorney's criticism of the specimen, has not mentioned it.

involves a computerized apparatus that measures a consumer's foot in various ways and is intended to, among other things, promote proper fitting of shoes for the consumer. The specimen also touts certain benefits for shoe retailers, e.g., "Efficiently match inventory levels to customer needs and preferences."

The examining attorney refused to accept the web page specimen, asserting that it "does not show use for applicant's goods and services because there is no reference to retail footwear store services." Applicant responded by first noting that the notice of allowance listed "on-line retail services in the field of footwear" and did not mention "retail footwear store services," and second asserting that the web page specimen shows "the mark as used in connection with Applicant's offering of its goods on-line." In the alternative, applicant also submitted a substitute specimen, specifically, "a photograph of Applicant's mark as used in connection with a computer terminal at which customers can access Applicant's 'on-line retail services in the field of footwear.'" The photo clearly shows the designation "Click2fit" lettered

onto the terminal above a computer screen.² The wording and images on the screen, however, are indistinct.

In the absence of an acceptable specimen, the examining attorney issued a final refusal of registration "because applicant has failed to show use of the mark with any retail services." In particular, the examining attorney asserted that his earlier "use of 'retail store services' and not 'on-line retail services in the field of footwear' [was] inconsequential" and that it was incumbent on applicant to provide a specimen showing it provides the retail services referenced in its identification.

Applicant filed an appeal from the final refusal and requested reconsideration, and included with the latter an additional webpage specimen. Though the request for reconsideration was denied and applicant's time for filing a brief on appeal was set, applicant subsequently sought and obtained a remand to the examining attorney. We agree with the examining attorney that the request for remand did not contain any new arguments or evidence. The examining attorney once again refused to reconsider the final

² Applicant's web pages, in various places, utilize "Click 2 Fit," "Click2Fit" or "Click2fit."

refusal, the appeal was resumed, and briefs ultimately were filed.³

Applicant's brief on appeal does not discuss any relevant case law dealing with acceptable service mark specimens, and merely reiterates, in cursory fashion, arguments made during prosecution (including its request for reconsideration and for remand) as to why its specimens are acceptable. In the Office's brief, the examining attorney discusses each of the two specimens submitted prior to the appeal, and why each fails to show an association of the mark with the identified services:

Applicant does not identify how or where the original specimen makes an association between the mark and the services in the application. The specimen identifies CLICK2FIT as an interactive system that helps consumers find their shoe size. The specimen associates the mark with an interactive computer system or the technology that "provides the ideal match between consumer preferences and show retailer inventory." There is no association between the mark and actual retail services provided by applicant. ... The specimen does not advertise retail footwear services nor show the mark in the sale of retail footwear services [sic].

Applicant also submitted a substitute specimen with its response dated March 1, 2005, namely, a photo of the mark used on a kiosk. As Applicant states, this specimen "demonstrates the mark as

³ Applicant filed five extensions of time to file its brief on appeal, for the stated purpose of "gathering appropriate materials" which would overcome the refusal or render it moot. There is nothing in the record to indicate that any additional materials were submitted to the Board or examining attorney, for consideration by the latter.

used on a kiosk machine/computer device." Brief at 2. This does not show use of the mark in the sale or advertisement of the services, namely, retail footwear services. The mark identifies the kiosk. There is no mention of the retail sale of footwear or the means for consumers to purchase footwear. The fact that a consumer may be able to get "on-line" with the device in the specimen in no way means that applicant has shown use of the mark in the sale or advertising of "on-line retail services in the field of footwear." (Emphasis added [by examining attorney]).

Earlier, in the final refusal of registration, the examining attorney also noted, in regard to the kiosk photo, "If applicant is providing retail services in the field of footwear through the kiosk in the specimen, applicant should have no problem providing a picture of a screen on the kiosk where the user can actually order footwear." Applicant did not address this point in its request for reconsideration, request for remand or appeal brief.

A service mark is used in commerce "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." Trademark Act Section 45, 15 U.S.C. § 1127. "[B]ecause by its very nature a service mark can be used in a wide

variety of ways, the types of specimens which may be submitted as evidence of use are varied." *In re Metriplex Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992).

When used in advertising of services, the service mark must not merely appear in the advertising material that also discusses or offers the services, but must be associated with the services in such a manner as would be sufficient to indicate to potential purchasers or users of the services that the mark identifies the services and their source. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (C.C.P.A. 1973) ("The minimum requirement is some direct association between the offer of *services* and the mark sought to be registered therefor.") (italics in original), and *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989) (requirement is for "a direct association between the mark sought to be registered and the services specified in the application, i.e., that [the mark] be used in such a manner that it would be readily perceived as identifying such services").

When used in the actual sale of services, as opposed to their advertising, it is not per se necessary that the services be referenced, but in such cases it may be necessary to explain how the mark appears during the rendering of the service and, therefore, why the purchaser

or user of the service would recognize and associate the mark with the service. See, e.g., *Metriplex*, 23 USPQ2d at 1316 ("As applicant explained in its declaration, the specimens show the mark as it appears on a computer terminal in the course of applicant's rendering of the services.").

We agree with the examining attorney that neither specimen submitted prior to appeal is acceptable to show an association of the mark with the identified services. Nor is the web page submitted with applicant's request for reconsideration. We discuss first, the two web pages and, second, the kiosk photo.

The original web page specimen references "The FiTracks Click2Fit interactive system" as a system that shows "retailer inventory" and as one that allows shoe retailers to "match inventory levels to customer needs and preferences." While these may be considered oblique references to retailing of shoes, the overall thrust of the specimen is that applicant is the manufacturer, retailer or distributor of the system itself, not a retailer of footwear. This is confirmed by the additional information regarding applicant, specifically, additional material from applicant's web site, placed in the record by the examining attorney's action denying applicant's request for

reconsideration. This material explains how a potential purchaser of shoes uses the "Click2Fit" system to have "personal details" about his or her feet collected by the system, which will then allow the customer to "browse through the on-screen catalogue that shows which shoes are available at the particular store, and place an order immediately at the kiosk" or place an order "through the company's website for convenient online shopping."⁴

This information about the "Click2Fit" system is contained on the "Product & Technology" page of applicant's website, and reveals that the system is applicant's product. Indeed, applicant has never denied the examining attorney's contention to this effect.

In sum, applicant's original web page would not draw an association for a prospective retail purchaser of footwear (whether on-line or off-line) with applicant's mark and the service of footwear retailing. Nor would the web page specimen offered with applicant's request for reconsideration draw such an association. That consists solely of a listing headed "Product & Technology," followed by "Pedometer," "Quick2fit," "Click2fit," "Web Store" and

⁴ The web pages in evidence make clear that the "Click2Fit" system can be used either as an individual offline unit, i.e., "as a convenient kiosk with catalogue information" or to access online purchasing options.

"Fittracks Kids." There is nothing on this page that specifies what is available in the "Web Store."⁵

The examining attorney has suggested that the substitute specimen consisting of a photograph of a kiosk bearing the "Click2fit" mark would be acceptable if it not only showed the mark but also showed something readable on the computer screen below the mark that would indicate shoes are available for purchase from applicant through the kiosk. While we do not disagree with that position, we add that the photo of the kiosk might also be acceptable even if the computer screen did not show such information, so long as there was a declaration in the record explaining that prospective purchasers of footwear see the mark on the kiosk when they use it to make on-line purchases of footwear from applicant. See *Metriplex*, 23 USPQ2d at 1316.

As noted earlier, applicant's counsel introduced the kiosk photo into the record with the statement that it was "a photograph of Applicant's mark as used in connection with a computer terminal at which customers can access Applicant's 'on-line retail services in the field of

⁵ The reprint of the "Product & Technology" page that the examining attorney entered into the record shows a pointer next to "Click2fit" and then lists information about that system. However, although the web page submitted with applicant's request for reconsideration also has a pointer next to "Web Store," it points to an empty space.

footwear.'" Applicant's request for reconsideration did not discuss this specimen, but applicant's "Supplemental Request for Remand and Reconsideration" describes it as "a photo of a point of purchase display, or kiosk, showing Applicant's mark as the customer encounters it in the marketplace. It is submitted that since this specimen material displays the mark, as the purchaser encounters it in the marketplace, in connection with the retail sale of footwear, that this specimen is more than sufficient...." Very similar language is utilized in applicant's brief.

The examining attorney has on three occasions asserted that it does not appear that applicant is a retailer of footwear. See, respectively, the order denying applicant's request for reconsideration, the order denying applicant's supplemental request for remand and reconsideration, and the Office's brief on appeal.⁶ Applicant has not contested any of these assertions and did not file a reply brief. Moreover, we find it significant that applicant apparently has retreated from the language first used in support of the kiosk photo as a specimen, which states purchasers "can access Applicant's 'on-line retail services in the field of

⁶ Section "II" of the brief on appeal focuses not on the various specimens but instead on the examining attorney's argument that applicant does not sell footwear, e.g., "Applicant's website actually advertises the sale of the interactive kiosks and not the retail sale of footwear."

footwear'" via the kiosk. Subsequent references to the kiosk, in contrast, explain that it shows the mark as the customer or purchaser "encounters it in the marketplace, in connection with the retail sale of footwear." Such shift in language, in the face of the examining attorney's repeated contention that applicant is not a retailer of footwear, indicates that applicant's kiosks are used "in connection with" retailing of footwear, but not applicant's retailing of footwear. Thus, we clearly do not face a situation as in *Metriplex* whereby applicant has provided a declaration that the kiosk computer screen is used to purchase footwear from applicant.

As noted by the examining attorney in the action denying applicant's request for reconsideration, it appears that this is a case in which applicant made an erroneous choice between two identifications offered by the examining attorney when the original identification was determined to be indefinite. The examining attorney, however, only suggested adoption of either proposal if it would be accurate for applicant to do so, and cautioned applicant about the ramifications for limiting an identification.

Decision: The refusal of registration on the ground that none of applicant's specimens show use of the mark for the identified services is affirmed.