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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Standard Water Control Systems, Inc.

Serial Nos. 78165757 and 78165762

Garrett M. Weber of Lindquist & Vennum P.L.L.P. for
Standard Water Control Systems, Inc.

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(Thomas Shaw, Managing Attorney).

Before Hairston, Chapman, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 19, 2002, Standard Water Control Systems,
Inc. (applicant) applied to register two marks in typed
form on the Principal Register, SEAMLESS DISCHARGE SYSTEM
(Serial No. 78165757) and SUPERIOR SUMP SYSTEM (Serial No.
78165762). Both applications were based on applicant's
bona fide intention to use the marks in commerce and the
services were identified as "installing, maintaining, and
repairing foundation drainage systems of basement floors,
and sump pumps" in Class 37.

After the examining attorney initially refused registration on the ground that the marks were merely descriptive under Section 2(e)(1) (15 U.S.C. § 1052(e)(1)), applicant filed statements of use alleging April 19, 2003, as its date of first use anywhere and in commerce. Along with these amendments, applicant amended its applications to seek registration on the Supplemental Register and it disclaimed the words "Discharge System" in the '757 application and "Sump System" in the '762 application.

As a result of applicant's submission of specimens with its statements of use, the examining attorney made a new refusal, i.e., that the marks are not eligible for registration because the subject matter presented for registration does not function as a mark under Sections 1, 3, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1053, and 1127. Despite the amendment to the Supplemental Register, the examining attorney has cited the statutory sections 1, 3 and, 45 as a bar to registration. Applicant traversed the refusal, and argues that the terms function as marks and, as a result, this appeal followed.

In a similar case involving a mark for registration on the Supplemental Register that is refused registration on the ground that it did not function as a mark, the board observed that the "Examining Attorney, we believe

incorrectly, cited (and continued to cite) the statutory sections 1, 2, 3, and 45... Because the instant mark is now sought to be registered on the Supplemental Register, the appropriate refusal is Section 23 of the Act, 15 U.S.C. § 1191." In re Eilberg, 49 USPQ2d 1955, 1956 n.2 (TTAB 1998). Accord TMEP § 1202 (3rd ed. 2003)("The statutory basis for refusal of registration on the Supplemental Register of matter that does not function as a trademark because it does not fit within the statutory definition of a trademark is §§ 23 and 45, 15 U.S.C. §§ 1091 and 1127"). As we understand the refusal in this case, it involves the ability of the mark as presented on the specimens to identify applicant's services and not whether the mark intrinsically is able to function as a mark. Therefore, the refusal is not based on applicant's term being generic or informational matter that could never acquire trademark status.¹ Thus, the ultimate issue is the same regardless of whether applicant's term was an arbitrary term for registration on the Principal Register or, as in this case, a descriptive term for registration on the Supplemental Register. The refusal is based on the failure of the applied-for terms, as used on the specimens, to identify

¹ The amendment to the Supplement Register overcame the examining attorney's descriptiveness refusal.

applicant's services. Indeed, the examining attorney "found the substitute [along with the original] specimen unacceptable." Brief at 3. Because, under the facts of this case, the examining attorney's and applicant's arguments and evidence are equally applicable to a refusal on the Principal or Supplemental Registers, we proceed to the merits of the case. Also, inasmuch as the facts and issues in both applications are similar, we have chosen to issue one opinion that discusses both applications.²

"The question whether the subject matter of an application for registration functions as a mark is determined by examining the specimens along with any other relevant material submitted by applicant during prosecution of the application." In re The Signal Companies, Inc., 228 USPQ 956, 957 (TTAB 1986).

An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark* with respect to the goods named in the application.

In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (emphasis in original, footnote omitted).

² A copy of the opinion will be placed in both files.

Registering a mark on the Supplemental Register is an admission that the mark is merely descriptive. In re Consolidated Foods Corp., 200 USPQ 477, 478 n.2 (TTAB 1978) ("Registration of the same mark on the Supplemental register is not prima facie evidence of distinctiveness; in fact, such a registration is an admission of descriptiveness"). See also Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972). However, even on the Supplemental Register, it is necessary that a term as used on the specimens be capable of functioning as a trademark or service mark for the identified goods or services. In re Helena Rubinstein, Inc. 419 F.2d 438, 161 USPQ 606, 608 (CCPA 1969) (A term "cannot be registered as a trademark, even on the Supplemental Register, *unless it is intended primarily to indicate the origin of the goods and is of such a nature that the ordinary purchaser would be likely to consider that it indicated such origin*"(italics added)).

Therefore, we will look at applicant's specimens because they are critical in determining whether the terms for which applicant seeks registration are capable of functioning as service marks for applicant's services of installing, maintaining and repairing foundation drainage systems of basement floors and sump pumps. Applicant has

submitted the same specimens in both cases so we will discuss the display of the terms together.

Applicant's first specimen, an Internet page of applicant, begins with the title "Standard Water Offers a Superior Solution." The text then continues:

Our system design and installation reflects our commitment to provide your home with protection against water seepage problems both now and into the distant future. We allow for unpredictable changes in water saturation and sediment infiltration that can occur as a foundation ages. The Standard Water solution includes:

- A. Drain Holes ...
- B. Cove Plate ...
- C. Washed Rock used under and around drain tile as a drainage medium and filter envelope.
- D. Rigid PVC Drainage Pipe - large holes allow fast, efficient drainage and virtually eliminate clogging. Rigid pipe remains at a continuous descending slope to sump basin.
- E. A Plastic Moisture Barrier placed between the system and the newly finished concrete floor.
- F. Superior Sump SystemSM that is the finest quality available and meets or exceeds all state code requirements. The system includes a high quality structural grade sump basin with a bolted down steel cover for controlled access and safety, along with a premium grade, totally automatic submersible pump with check valve and high water alarm.
- G. Seamless Discharge SystemSM is designed not to crack, break, or leak and be virtually indestructible.

The specimen includes a drawing of a basement with the system installed and the letters in the text above relate to where the various items would be found in the drawing.

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The other specimen of record is a standard form contract. On the right side of the contract are a series of eleven boxes that can be checked to become part of the contract, which are followed by four boxes with blank lines. The eleven specific boxes include:

Rigid PVC Drainage pipe descending grade to basin ___ ft.

Washed rock drainage filter medium to envelope draitile/basin

7/8" drainage hole drilled in all main and joining cavities

Extruded PVC cove plate and drainage system on footing ___ ft.

Poly sheeting moisture barrier between draitile system and new cement

Remove existing concrete floor and place new concrete

New concrete may bevel, slope up towards wall

Removal of all concrete and other debris from job site

Superior Sump SystemSM

Includes: High quality structural grade sump basin with bolted down steel cover. Premium grade totally automatic submersible pump with check valve. High water alarm.

1¼" Seamless Discharge SystemSM

Finished walls may need trimming

"The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless

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words have been so used they cannot qualify." Bose Corp., 192 USPQ at 215. Furthermore, 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).

The CCPA has noted that:

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.

In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) (emphasis omitted).

In two cases involving passenger air transportation services, this direct connection was missing even though the terms SKY-ROOM and SKYLOUNGER were used on the specimens. In re Compagnie Nationale Air France, 265 F.2d 938, 121 USPQ 460, 461 (CCPA 1959) ("Nothing in the advertisement pertaining to the 'SKY-ROOM' identifies the air transportation service of appellant and there is no

other evidence which reveals that the public considers 'SKY-ROOM' as an identifying mark of this airline") and In re British Caledonian Airways Limited, 218 USPQ 737, 738-39 (TTAB 1983) ("It is clear from the specimens that the term SKYLOUNGER makes reference, in three out of four instances, to the reclining seats used in a section of applicant's aircraft. While there is no noun accompanying the term SKYLOUNGER in the initial and most prominent use, it is clear from the context that it is also being used there to identify applicant's seats.").

On the specimens in this case, both of applicant's terms SEAMLESS DISCHARGE SYSTEM and SUPERIOR SUMP SYSTEM refer to something specific. The pump system is described as "the finest quality available and meets or exceeds all state code requirements. The system includes a high quality structural grade sump basin with a bolted down steel cover for controlled access and safety, along with a premium grade, totally automatic submersible pump with check valve and high water alarm." The description in the specimen is referring to a system and not the service of installing the system. The disposal system is listed as a 1¼" system and it is designed not to crack, break, or leak and be virtually indestructible. These descriptions are of

a physical item and not of a service of installing drainage systems.

Applicant argues that it is installing products manufactured by others, therefore applicant maintains that it is performing a service. To the extent that applicant is performing a service, it would have to use its terms as proper service marks to identify these services on the specimens. In re Johnson Controls Inc., 33 USPQ2d 1318, 1320 (TTAB 1994) (“[T]he labels submitted as specimens with this application do not show use of the mark sought to be registered as a service mark for the custom manufacture of valves. If the application sought registration as a trademark for these fluid control products, these specimens would clearly be satisfactory, but that is not the issue here); Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320, 323 (TTAB 1985) (“No direct association is demonstrated by the insignificant use of ‘Peopleware’ in the sentence at the bottom of the card. Exactly what is intended by the term in that sentence is unclear, but in any case its use in the sense of an adjective modifying ‘emphasis’ does not, in our opinion, associate it with the services Haelsig advertised in a manner which approaches the level of service mark use.”). See also In re Adair, 45 USPQ2d 1211 (TTAB 1997) (Mark TREE ARTS CO. and design may

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function as a mark for goods but specimen did not show the term used as a mark for the service of designing permanently decorated Christmas trees).

We also note that both terms include the word "system," which suggests that applicant is providing goods and not services. Furthermore, while applicant argues that its contract lists the things to be installed, the eleven items listed do not show service mark usage for those items. Applicant's original specimen listed seven items: Drain Holes, Cove Plate, Washed Rock, Rigid PVC Drainage Pipe, A Plastic Moisture Barrier, Superior Sump System, and Seamless Discharge System. The contract lists a slightly longer list of things "To be installed and/or performed." Simply including a term in a list of items to be performed under a contract does not establish that the items are services and not goods. For example, advertising for oil change services that identifies a list of items included with the service, e.g., "BRAND X Oil" and "BRAND X Oil Filters" does not, by itself, demonstrate that BRAND X is a service mark for oil change services. When prospective purchasers encounter the terms "Superior Sump System" and "Seamless Discharge System," they are not likely to see these terms as service marks for the installation services. Just as the terms SKY-ROOM and SKYLOUNGER were held to not

function as service marks for the air transportation of passengers services, so applicant's terms as used on its specimens are not capable of functioning as service marks to identify its services.

Merely because an applicant's term appears on specimens for the goods or services does not mean that the term itself is used as a trademark or service mark or that purchasers would perceive the term as a mark. Bose, 192 USPQ at 216 (SYNCOM used on instruction sheets did not function as a trademark for loudspeaker systems. "[I]t is quite apparent that, in the specimens of record, only INTERAUDIO identifies the loudspeaker systems for high-fidelity music reproduction as originating with appellant and distinguishes such goods from those manufactured and sold by others. The mark SYNCOM merely relates to a speaker-testing computer."). See also In re Moody's Investors Service, Inc., 13 USPQ2d 2043, 2049 (TTAB 1989):

That is, the significance of the symbols, as they are used in the specimens, is that of rating symbols (i.e., indications of applicant's opinion of the investment quality of debt instruments), not service marks. While it is not inconceivable that a particular designation could be used, and therefore function, both as a rating symbol and as a trademark or service mark, applicant's designation "Aaa" is not so used in the specimens of record.³

³ The board indicated that it was "inclined to agree" with the examining attorney's point that the designations appear to be registrable as certification marks. 13 USPQ2d at 2043 n.5.

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We also note that applicant has used the service mark symbol along with the terms for which it seeks registration. The use of the use of the letters "TM" or "SM" does not by itself convert a term that does not function as a trademark or service mark on the specimens into one that does. British Caledonian Airways, 218 USPQ at 739; In re Caserta, 46 USPQ2d 1088, 1090 (TTAB 1998).

When we view the terms SEAMLESS DISCHARGE SYSTEM and SUPERIOR SUMP SYSTEM, as they are used on applicant's specimens of record, they are not capable of functioning as marks that identify the source of applicant's installation, repair, and maintenance of drainage systems and sump pumps services.

Decision: The refusal to register is affirmed in both applications.