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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cross Hueller, LLC

Serial No. 78568912

Richard J. McKenna of Foley & Lardner LLP for Cross
Hueller, LLC.

Mark Sparacino, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Grendel, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark LASALLE (in standard character form) for Class
37 services recited in the application as "maintenance,
repair and remanufacture of assembly machinery and

metalworking machines to the order and specification of others."¹

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark in Class 37 on the ground that applicant has failed to submit an acceptable specimen of use. Specifically, the Trademark Examining Attorney contends that the specimen submitted by applicant fails to show use of LASALLE as a service mark for the recited Class 37 services. See Trademark Act Sections 1(a)(1) and 3, 15 U.S.C. §§1051(a)(1) and 1053; Trademark Rules 2.56(a) and 2.56(b)(2), 37 C.F.R. §§2.56(a) and 2.56(b)(2).

The appeal is fully briefed. After careful consideration of the specimen at issue and the arguments of counsel, we affirm the refusal to register.

Applicant's proffered service mark specimen is a page from an advertising brochure, depicted below:

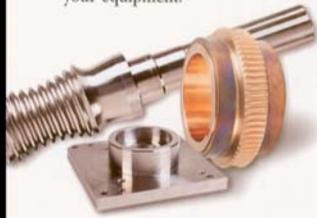
¹ Serial No. 78568912, filed on February 16, 2005. The application is based on use in commerce, and December 31, 1957 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce. The application also seeks registration of the mark for numerous Class 7 goods generally identified as "machine parts for use with assembly machinery and metalworking machinery, namely..." The Trademark Examining Attorney has not refused registration as to Class 7.

Solutions ... for maximum uptime.

EXHIBIT A

Our original and spec-quality parts

The Aftermarket Group is backed by top experts in the business. We can make your whole operation more productive. To save you money and eliminate downtime, we upgrade and enhance—rather than reverse engineer and copy. Whatever your productivity needs, we bring you the latest technology available for your equipment.



Fast service, high value

... for new or reconditioned machine components, fixtures, index tables, transfer drives, slide units, service manuals and an array of components for domestic products, as well as the European products we support. We feature Moglice® machine reconditioning using moldable, low-friction, high-compressive-strength material that improves performance and extends machine life.

Inventory of critical and long lead-time items

To get you back up and running right away, we inventory critical and long-lead items for immediate shipment. These include components such as feed and traverse drive parts, index table parts, spindle assemblies, turrets and many others. If timing is tight, we can expedite your order for rapid delivery. And if we don't have your part on the shelf, we know where to get it — now! *Service is our business.*

Knowledgeable parts specialists

The Cross Hüller order desk is staffed with specialists, dedicated to each of the various product lines now available under the



We Offer Relief From Replacement Parts Headaches.

Thyssen umbrella. You're assured of dealing with dedicated and knowledgeable individuals who understand your problem.

We provide:

- ▶ Original and spec-quality parts
- ▶ Immediate response to requests
- ▶ Complete machine reconditioning
- ▶ Capital projects
- ▶ Spare parts lists



- ▶ Replacement parts quotations
- ▶ Parts matrices for machine groups
- ▶ Related support services

Quick engineering-record access

We maintain extensive engineering records to assure that your parts order is filled promptly and accurately. Returning to the OEM eliminates the need to reverse engineer and copy, a common cause of part failure and poor fit.

Custom part-making

If you don't have a print or can't find the part, we can make it for you. We can expedite your parts, utilizing the resources of Cross Hüller to manufacture them. And, because we have the most extensive library of prints for the machine tools represented by Thyssen, we can save you time and money.

Experienced technical sales consultants

Cross Hüller Aftermarket Sales Consultants can evaluate your equipment, providing cost-saving solutions to maintenance headaches. With many years of special machine experience, our sales staff offers consultation for preventive maintenance, in-house inventories of repair parts, machine reconditioning, and other maintenance programs and capital projects.

Electronic parts ordering, 24 hours a day

(FAX or EDI) Our parts ordering line is open 24 hours, seven days a week to respond to your every need. Orders received after regular business hours will be responded to at the beginning of the next business day ... in the shortest possible time.

Your Source For Parts • Manuals • Complete Reconditioning

In the specimen, the LASALLE designation appears in the center graphic, which depicts a lozenge or pill box or tin holding twelve pills, nine of which bear words and/or logos. The LASALLE logo appears on the first pill of the second row of pills. The other marked pills bear what appear to be the designations HÜLLER MILLS, CROSS HÜLLER, CROSS, BENDIX MACHINE TOOL, BUHR, MICHIGAN, COLONIAL BROACH and AVEY. Printed on the inside of the cover of the pill box, directly above the pills bearing these various designations, are the words (ending with a colon) "Parts, service manuals and complete reconditioning for the Cross Hüller family of machine tools:". Directly below the depiction of the pill box are the words "We Offer Relief From Replacement Parts Headaches." The text of the advertisement includes, under the heading "We provide:", the words "Complete machine reconditioning." The right column of the advertisement includes the following text under the heading "Experienced technical sales consultants": "Cross Hüller Aftermarket Sales Consultants can evaluate your equipment, providing cost-saving solutions to maintenance headaches. With many years of special machine experience, our sales staff offers consultation for preventive maintenance, in-house inventories of repair parts, machine reconditioning, and

other maintenance programs and capital projects." Under the heading "Knowledgeable parts specialists" appears the following text: "The Cross Hüller order desk is staffed with specialists, dedicated to each of the various product lines now available under the Thyssen umbrella. You're assured of dealing with dedicated and knowledgeable individuals who understand your problem." At the bottom of the page, in an oval background, appear the words "Your Source For Parts • Manuals • Complete Reconditioning."

In support of registration, applicant argues that the specimen advertisement "includes a graphic in the middle of the page that shows the LASALLE mark directly below the text '[p]arts, service manuals and *complete reconditioning* for the Cross Hüller family of machine tools' (emphasis added). This use of the LASALLE mark immediately adjacent to such text is clearly a use in connection with the identified services in Class 37." (Applicant's main brief at 4.) Applicant goes on to argue:

The graphic shows a conventional metal box such as an aspirin container or a throat lozenge container with a series of white pills or lozenges in the container. Many of the pills/lozenges have a trademark depicted thereon, one of which is the LASALLE mark. Immediately below this graphical depiction of the pills is the statement "We Offer Relief from Replacement Parts Headaches." Imprinted in the lid of the metal box is a statement "Parts, service manuals

and complete reconditioning for the Cross Hüller family of machine tools." [Omission of ending colon is sic in applicant's brief.] The marketing ploy depicted in this advertising brochure is quite clear. Namely, the Applicant is suggesting that the customer is suffering from some ailment and that the Applicant has the necessary medicine to cure or otherwise provide relief for the customer's ailments. In this case, the particular ailment is replacement part headaches, service manuals and reconditioning of machine tools and the relief provided by the applicant is a pill bearing the mark at issue, namely LASALLE. Immediately surrounding this graphical depiction are a series of statements [quoted *supra*] specifically calling out Applicant's maintenance, repair and remanufacturing services.

(*Id.* at 4-5.)

For his part, the Trademark Examining Attorney argues that although the advertisement includes both a depiction of the designation LASALLE and text specifically referring to the recited services, that in itself does not suffice to establish use of LASALLE as a service mark. He notes that LASALLE appears solely in small lettering on one of the nine "pills" contained in the pill box directly beneath the text reading "Parts, service manuals and complete reconditioning for the Cross Hüller family of machine tools:". He argues that LASALLE would be understood by purchasers merely as the trademark for one of the nine product lines in applicant's "family of machine tools," and not as a service mark for the Class 37 services themselves.

"The pill box graphic merely advertises the individual product lines that may be reconditioned by applicant. Therefore, the mark LASALLE, along with the eight other depicted marks, are clearly used as trademarks representing product lines of the Cross Hüller family of machine tools, and are not shown as service marks for the identified international class 37 services." (Brief at unnumbered p.4.) Pointing to the advertisement's text which refers to "[t]he Cross Hüller order desk" and to "Cross Hüller Aftermarket Sales Consultants," he further argues that purchasers will perceive "Cross Hüller," not LASALLE or any of the other eight product line marks, as the service mark for the recited services.

After careful review, we find that the designation LASALLE, as it appears on the specimen, would not be perceived as a service mark for the recited Class 37 services.² Rather, LASALLE would be perceived solely as a trademark for applicant's Class 7 goods, i.e., as the name of or trademark for one of applicant's machine tool product lines.

² We are assuming for purposes of this decision that purchasers viewing the actual advertisements will be able to read the LASALLE designation on the pill, although we note that it appears on the specimen in small and somewhat illegible lettering.

LASALLE and the other eight designations appearing on the lozenges or pills appear immediately after the wording "the Cross Hüller family of machine tools:". LASALLE and the other designations thus would be perceived not as separate service marks for applicant's recited services, but rather as the trademarks for the various product lines that applicant services under its Cross Hüller service mark. Such a perception would be reinforced by the other references in the advertisement's text to Cross Hüller as the source of the services, i.e., "the Cross Hüller order desk," and "Cross Hüller Aftermarket Sales Consultants."

For these reasons, we find that the specimen of record fails to demonstrate use of LASALLE as a service mark for the recited Class 37 services.

Applicant also contends that the present application to register LASALLE for the recited Class 37 services is a companion application to another application which applicant filed on the same day, Serial No. 78568909, seeking registration of the mark CROSS for identical Class 37 services. That application matured to registration as Registration No. 3238879 on May 8, 2007. Applicant notes that the specimen it submitted in that companion application, which was accepted (by a different Trademark Examining Attorney) as an acceptable service mark specimen,

is identical to the specimen at issue in this appeal, displaying the CROSS mark and the LASALLE mark in the same manner. Applicant contends that if the specimen was deemed acceptable in the companion case, it should be deemed acceptable in the this case as well, which presents an identical record.

In support of this argument, applicant relies on TMEP §702.03(a)(ii) dealing with "Companion Applications Previously Assigned," which provides as follows:

If TRAM indicates that a companion application has been assigned to a different examining attorney, the examining attorney should not transfer his or her application to that person. However, the examining attorney must review the electronic record of the earlier companion application before taking action in a later companion case, and should act consistently, unless it would be clear error to do so. If the examining attorney believes that acting consistently with the prior action(s) would be erroneous, he or she should bring the issue to the attention of the managing attorney or senior attorney.

Applicant argues that "[i]n view of the fact that the Trademark office has already registered Applicant's application for the CROSS mark, Applicant submits that passing the application for the LASALLE mark to publication is warranted, and accepting the Class 37 specimen for the present application would not constitute clear error. ...

Accordingly, the Trademark Office should treat the companion applications consistently and accept the Class 37 specimen in the present case, as is required by TMEP section 702.03(a)(ii)." (Reply brief at 9.)

We find applicant's "no clear error" argument to be unavailing. The issue of whether the Trademark Examining Attorney has complied with the "clear error" rule is a procedural examination issue which is reviewable by way of petition to the Director, not by way of an appeal to the Board. The Board's determination on appeal is limited to the correctness of the underlying substantive refusal to register. *See, e.g., In re Jump Designs LLC*, 80 USPQ2d 1370 (TTAB 2006); *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997).

It is settled that our decision as to the registrability of applicant's mark must be based on our own analysis of the record before us in the case presently on appeal, regardless of any non-precedential and non-binding contrary conclusion that may have been reached by a Trademark Examining Attorney in a different case. Consistency in examination practice is an Office goal, but it is secondary to the Board's obligation to reach the correct result in the case actually before us. *See, e.g., In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564

(Fed. Cir. 2001); *In re Lighthouse Inc.*, 82 USPQ2d 1471 (TTAB 2007). *Cf. In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

For the reasons discussed above, we have found on the record before us that applicant's specimen fails to demonstrate use of LASALLE as a service mark for the recited Class 37 services.

Decision: The refusal to register as to Class 37 is affirmed. The application shall proceed to registration as to Class 7.