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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dale G. Paulson dba Association Research Group

Serial Nos. 74/381,796 and 74/381,797

Dale G. Paulson for Dale G. Paulson dba Association Research
Group

Frances G. Smith, Trademark Examining Attorney, Law Office
103 (Kathy Erskine, Managing Attorney).

Before Simms, Seeherman and Hohein, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Dale G. Paulson doing business as Association Research
Group (applicant) has appealed from the final refusal of the
Trademark Examining Attorney to register the marks SHAPERS
and MAILBOXERS for market research and business consulting
services.¹ The Examining Attorney has refused registration

¹ Application Serial Nos. 74/381,796 and 74/381,797, both filed
April 22, 1993, based upon applicant's bona fide intention to
use the marks in commerce. After notices of allowance were
issued in these two cases, applicant submitted statements of use
with accompanying specimens, asserting use of the marks in
commerce since September 16, 1991.

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in each case under Sections 1, 2, 3 and 45 of the Trademark Act, 15 USC Sections 1051, 1052, 1053 and 1127, because the specimens allegedly do not show use of the marks sought to be registered as service marks to identify applicant's services and that, therefore, these asserted marks do not function as service marks. Applicant's attorney and the Examining Attorney have submitted briefs and an oral hearing was held in connection with both of these appeals. Although these cases have not been formally consolidated, they were heard at the same time and we shall decide these cases in one opinion.

The manner of applicant's use of these asserted marks is shown below (from applicant's promotional materials—a fact sheet and workbook):



ALLEGIANCE is a new marketing system specifically designed for associations. While associations may know their members by traditional demographic categories (such as gender, job title, age, etc.), most would agree that more is needed.

ALLEGIANCE uses survey research to divide your members into nine categories so that each category can be targeted effectively.

THE NINE ALLEGIANCE CATEGORIES

- MAILBOXERS: only want involvement through the mail.
- RELEVANT PARTICIPANTS: attend conventions, seminars if relevant.
- SHAPERS: most active and want to shape association policy.
- COGNOSCENTI: want the association to add to their fund of knowledge.
- ALTRUISTICS: share the values of the association.
- STATUS CONSCIOUS: the association improves their image.
- COMPARISON SHOPPERS: ask if this association measures up to others.
- DOUBTERS: ask if this association is really for them.
- NON-RELEVANTS: ask why they are in this association.

ALLEGIANCE® TAGGING CODES

MARKETING IMPLICATIONS FOR ULI MEMBERS

Allegiance Categories

The three-digit tagging code for each member is figured by looking at how the member distributes 100 points among the Allegiance Categories. This question can be printed on a membership application, in a survey, in a magazine, at a meeting, etc. The order of the categories always remains the same as shown below. (Note that the names of each category—Mailboxers, Relevant Participant, etc.—are shown in italics but are not printed for the member to see.)

- ___ Primarily want involvement with ULI through the mail *(1-Mailboxer)*
- ___ Attend meetings when relevant for networking or information. *(2-Relevant Participant)*
- ___ Want to shape ULI policy by serving on board or committee. *(3-Shaper)*
- ___ At renewal time compare ULI to other org's or info sources. *(4-Comparison Shopper)*
- ___ ULI provides info not available elsewhere or opportunities to publish. *(5-Cognoscenti)*
- ___ ULI enhances my status with my peers or within the industry *(6-Status Conscious)*
- ___ ULI promotes values I share such as bringing together a broad range of public and private interests and contributing to higher standards of land use. *(7-Altruistics)*
- ___ I still evaluate ULI info and am undecided about continuing membership. *(8-Doubter)*
- ___ My status has changed and ULI is no longer relevant. *(9-Non-Relevant)*

Applicant states that he has designed a system under the registered mark ALLEGIANCE which identifies nine types of association members based upon why they join and stay members of associations. SHAPERS and MAILBOXERS are two of these nine types. According to applicant, each member of an association fills out a "tagging" form and, based on his or her answers, applicant assigns a marketing code to each member of the association. The association then enters these codes into its data base and then the association is able to "target market" to save money and to provide more personalized service to its members.

Applicant's mark categorizes members (customers) of an association for the purposes of marketing. This categorization is based upon a one-page form that each customer completes. On the form, the customer distributes 100 points among several items. Based upon their answers, the Applicant assigns a three-digit code to each customer and the association then enters these codes into its data base. "Shapers" for example do, or want to, actively participate and shape the association's policy by serving on committees, as a local officer, or on the national Board of Directors. There are nine categories of customers, and the program is conducted under the service mark "Allegiance."

Applicant's appeal brief, p. 3. It is applicant's position that the names sought to be registered identify, in addition to the names of categories of persons, services for those persons. According to applicant, he conducts focus groups

of SHAPERS, for example, and has developed marketing strategies for SHAPERS. Applicant also states that seven of his categories have been registered as "trademarks" using the identical specimens as those submitted in these appeals.²

On the other hand, the Examining Attorney argues:

The survey asks customers' members to distribute 100 points among several items. The applicant tallies the results of the points and assigns a primary and secondary "Allegiance" category to each member. The program is conducted under the service mark "Allegiance." The applicant does not conduct "market research and business consulting" under the names of the separate categories. These names are merely used to identify the group or groups to which each individual member is assigned, based upon their scores.

Final Refusal, p. 1. It is the Examining Attorney's position that the associations, which are applicant's customers, come to applicant for assistance in recruiting new members and retaining present members. Through applicant's surveys and questionnaires, applicant divides his customers' members into nine categories. The applicant has given names to each of these categories, one of which is SHAPERS, which identifies those members in an association

² The Examining Attorney correctly argues that neither the prior registrations nor copies of their files have been made of record by applicant. The Examining Attorney also argues that each case must be decided upon its own facts and that the Board is not bound by prior conclusions of Examining Attorneys in other

who are the most active in the organization and want to shape its policies. The Examining Attorney argues that the specimens of record show that, for example, SHAPERS is only a category or name of a group of people defined by applicant under his marketing scheme. Other names are used to identify groups of people to which those individual members are assigned based upon their scores in response to survey questions.³

Whether a term functions as a service mark depends on how it is used and perceived by users and purchasers of applicant's services. To determine how it is used and may be perceived by users and purchasers, we must look to the specimens of record. In re Mortgage Bankers Association of America, 226 USPQ 954 (TTAB 1985). Of course, it must be kept in mind that not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as trademarks or service marks, regardless of an applicant's intent. In re Morganroth, 208 USPQ 284 (TTAB 1980).

Upon careful consideration of the specimens of record and the arguments of applicant and the Examining Attorney, we agree with the Examining Attorney that the terms sought

cases. We agree. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1758 (TTAB 1991).

³ The Examining Attorney also argues that the activity of classifying people does not constitute a separate service but is merely an ancillary activity of applicant's larger business of market research and business consulting.

to be registered do not identify applicant's market research and business consulting services, but rather are terms which applicant has used to identify categories of persons of his customers (associations). While applicant uses the superscript TM next to the terms sought to be registered in his newsletters and promotional literature, it is clear that these terms are being used to identify individuals or groups of individuals within an association. For example, SHAPERS is identified as "most active and want to shape association policy" whereas MAILBOXERS is identified as "only want involvement through the mail." In applicant's promotional literature, applicant indicates that with information in an association's data base, the association is able to target market to save money, increase revenues and provide more personalized service. Associations are urged to:

*Target *Shapers* to serve on committees, develop chapters, and recruit new members...

*Send *Mailboxers* an annual index of your magazine articles or preview upcoming year

In other newsletters, applicant indicates that SHAPERS are "members who are highly active and want to shape association policy" whereas MAILBOXERS are "members who join the association primarily for the written material and seldom attend meetings." It is clear from these references

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and others of record that the terms sought to be registered are used to identify a category of association members and not to identify applicant's services (identified under the registered service mark ALLEGIANCE). Accordingly, because applicant, as shown by the specimens, is not using the terms sought to be registered as a service marks to identify and distinguish applicant's services, the refusal

of registration in each case is affirmed.

R. L. Simms

E. J. Seeherman

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial
and Appeal Board