

Hearing:
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CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 2/24/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tessco Communications Incorporated

Serial No. 74/277,559

James E. Shlesinger of Shlesinger, Arkwright & Garvey for
applicant.

K. Margaret Le, Trademark Examining Attorney, Law Office 109
(Debra S. Cohn, Managing Attorney).

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Tessco Communications Incorporated has filed a
trademark application to register the mark WIRELESS
SOLUTIONS for a "full line of parts for cellular
telephones."¹ The application includes a disclaimer of
WIRELESS apart from the mark as a whole.

¹ Serial No. 74/277,559, in International Class 9, filed May 21, 1992,
based on an allegation of a bona fide intention to use the mark in
commerce. Following issuance of a notice of allowance, applicant filed
a statement of use and accompanying specimens, on July 25, 1995,
alleging a date of first use and first use in commerce of July 7, 1995.

The Trademark Examining Attorney has issued a final requirement for applicant to submit substitute specimens, contending that the specimens of record do not show use of the mark in connection with the identified goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We reverse the refusal to register.

Following publication for opposition and issuance of a notice of allowance, applicant filed, in due course, a statement of use. With its statement of use, applicant submitted as specimens copies of its mailing label affixed to a padded envelope. The upper portion of the mail label appears as below:

In the office action of September 29, 1995, following submission of the statement of use, the Examining Attorney stated "[t]he specimens are unacceptable as evidence of actual trademark use because they appear to be mailing labels which are not associated with the full line of goods identified in the application" and noted:

As the applicant is aware, the identification of goods specifies that the applicant is using the mark on a full line of cellular phones. The applicant must furnish specimens or proof that the mark is indeed being used on a full line of products and not just one or a few cellular phones. The evidence may be submitted in catalog form.

Applicant responded by amending the identification of goods, which pertained to a full line of both cellular telephones and parts, by deleting "telephones," so that the identification now pertains only to a full line of cellular telephone parts. Applicant argued that the specimens of record are acceptable and stated that the padded envelope with mailing label previously submitted as a specimen is the normal commercial packaging for the goods herein. Finally, applicant enclosed a catalog and brochure, but not as verified specimens of use, to clarify the nature and scope of the goods in connection with which its mark is used.

In the office action of May 20, 1996, the Examining Attorney made final the requirement for substitute specimens.² She stated:

The applicant has submitted additional specimens to show use of the mark as a full line of goods;

² The Examining Attorney mistakenly considered the catalog and brochure submitted by applicant to be "substitute specimens" and rejected the same as showing use of the mark in connection with services rather than in connection with the identified goods. Even if we were to consider the brochure and catalog to be specimens of use rather than informational material, which we do not, the requirement for acceptable specimens has been made and repeated in two Office Actions and the specimens submitted with the statement of use remain of record. Thus, we do not consider the Examining Attorney's error in this regard to effect either the substance of the issue before us or its ripeness for appeal.

but the same is rejected for the reasons stated below.

. . .

Examination of the additional specimens submitted by the applicant shows that the applicant is not using the mark WIRELESS SOLUTIONS in connection with a full line of phone parts/accessories. Rather, the applicant is a mail order catalog house which uses the mark for the sale and distribution of cellular phone accessories made by others.

On September 18, 1996, applicant filed a response in which it acknowledged that it also provides distributorship services; that it distributes products manufactured by others, which may or may not bear the marks of those companies; and that such products are distributed "in the same containers having labels that display Applicant's mark." In support of its contention that its mark is used in connection with a full line of cellular telephone parts, applicant submitted a photocopy of its registration of the mark CELLDYNE for "batteries, battery chargers, power converters, antennas, covers and cases for use with portable cellular telephones" and contends that these products bearing the CELLDYNE mark are "shipped in containers (padded envelopes) that display Applicant's mark on the affixed label."

In the office action of November 12, 1996, the Examining Attorney maintained her refusal, noting, correctly, that applicant's registration of the mark

CELLDYNE for specified cellular phone parts and accessories is irrelevant to the question of whether WIRELESS SOLUTIONS is used as a trademark in connection with a full line of parts for cellular phones; and concluding that "WIRELESS SOLUTIONS is not used as a trademark in connection with a full line of cellular products because it is not associated with the mark in an acceptable manner, such as labels, hangtags, or packaging materials."

The Examining Attorney appears to have merged several distinct issues in her actions supporting her requirement for acceptable specimens and in her brief. The stated basis for the refusal and, thus, the sole question before us, is whether the specimens of record, mailing labels affixed to padded envelopes, are acceptable specimens of use of the mark WIRELESS SOLUTIONS in connection with the goods identified in this application. However, in reacting to applicant's submissions and repeating her requirement for acceptable specimens, the Examining Attorney raises two additional questions - whether applicant has demonstrated use of the mark herein in connection with a *full line* of cellular telephone parts, and whether applicant is using its mark only in connection with mail order catalog services? Since no actual refusals were issued on the basis of these additional questions, *i.e.*, either on the ground that the identification of goods is unacceptable or that the mark is

not used in connection with the identified goods, we consider these questions herein only in the context of the Examining Attorney's requirement for acceptable specimens.

Turning to consideration of the specimens of record, the padded envelope with mailing label, we note that it is well established that trademarks may, as an alternative to being affixed to the goods themselves, be affixed instead to the packaging for the goods. What constitutes packaging for goods is a factual determination that will depend upon the nature of the goods as well as upon standard commercial practices. There are no limitations in the law or precedent that would exclude from consideration as "packaging for the goods" mailing labels affixed to the container used to mail the goods. Further, there is no basis for concluding that a padded envelope with a mail label affixed thereto may not be, or is not, packaging for the goods herein. This is particularly true where, as in this case, applicant has stated that the normal commercial practice is to package the identified goods in padded envelopes of the type submitted as specimens herein. Thus, it is reasonable to conclude that the specimens herein are applicant's packaging for its identified goods. The Examining Attorney has not demonstrated otherwise.³

³ This is not to say that envelopes with labels affixed thereto will be acceptable specimens of use where the evidence in a particular case contradicts such a finding. For example, an envelope with mailing label could be considered merely the vehicle for mailing the goods rather than

While the Examining Attorney has not raised this concern, we consider, briefly, a subsidiary question, namely, whether the mark is used on the mailing label herein merely as a tradename, in which case, the mail label on the padded envelope would not be considered packaging for the goods. We find that WIRELESS SOLUTIONS is prominently displayed on the mail label in the manner of a trademark, separate and apart from the return address.

In the context of her requirement for substitute specimens, the Examining Attorney contends that applicant is rendering only mail order catalog distributorship services under the mark. The Examining Attorney drew this conclusion after reviewing the brochure and catalog submitted by applicant. The mark herein appears on the cover of both the brochure and catalog and on each page of the catalog. However, applicant's acknowledgment, supported by the evidence, that it uses the mark WIRELESS SOLUTIONS in connection with mail order distributorship services is not inconsistent with its assertion, which is also supported by the evidence, that, additionally, applicant uses the mark WIRELESS SOLUTIONS in connection with a full line of cellular telephone parts. It is well-established that a business may use the same mark in connection with both goods

packaging for the goods if the evidence in an application showed that other trademarks are affixed directly to the goods applicant places in the envelopes; or that applicant's goods or similar goods are otherwise

and services; that a business may sell goods identified by its own trademark, indicating it as the source of the goods, even if it did not manufacture those goods; and, finally, that a business may offer for sale both goods bearing its own trademarks and goods bearing the trademarks of third parties. Thus, nothing in the record before us contradicts applicant's assertion, supported by the specimens of record, that it uses the mark WIRELESS SOLUTIONS in connection with the identified goods.

Also in the context of her requirement for substitute specimens, the Examining Attorney appears to contend that applicant has not demonstrated use of its mark in connection with a full line of the identified goods. We disagree. In this case, applicant's catalog and brochure, while it does not show trademark use of the mark herein, does show numerous cellular telephone parts to which no third-party trademark is affixed. Both applicant's catalog and brochure contain pictures and descriptions of a broad range of cellular phone products and accessories offered for sale by applicant. While several of the products pictured in the catalog clearly bear trademarks other than WIRELESS SOLUTIONS, a full range of the products pictured show no trademarks affixed thereto. Thus, it is reasonable to conclude that applicant's mark on mailing labels affixed to

packaged, for example, in boxes or plastic to which a trademark is

padded envelopes, identifies those goods advertised in applicant's brochure that are packaged in such envelopes and which do not have other trademarks affixed directly thereto. This evidence supports the conclusion that applicant offers a full line of cellular telephone parts identified by the trademark WIRELESS SOLUTIONS.

In the present case, we find the specimens of record, padded envelopes with mailing labels bearing the trademark herein, to be acceptable evidence of use of the mark WIRELESS SOLUTIONS in connection with the identified goods.

Decision: The refusal based on the requirement for substitute specimens is reversed.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board

affixed, prior to being placed in the envelopes for mailing.