

THIS DEPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JUNE 16, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Autometric, Incorporated**

Serial No. 74/593,151

Jim Zegeer for Autometric, Incorporated

Dax Alvarez, Trademark Examining Attorney, Law Office 103
(Michael Szoke, Managing Attorney)

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Autometric, Incorporated applied to register ORTHOMAX as a trademark for computer software for terrain mapping.¹ The Examining Attorney refused registration on the grounds that the specimens were unacceptable as evidence of actual trademark use because they are in the nature of advertising materials, and required that the applicant submit substitute specimens. Applicant's counsel responded by stating that

¹ Application Serial No. 74/593,151, filed October 31, 1994, asserting first use and first use in commerce on June 1, 1993.

"the specimens are in the nature of displays associated with or documents associated with the goods and, thus, are matters seen by the public in association with the goods...." Response filed October 17, 1995. The response also indicated that substitute specimens were being procured. However, no further specimens were submitted. The Examining Attorney made final the requirement for acceptable specimens, and applicant thereupon filed the instant appeal.

Both the applicant and Examining Attorney filed briefs; an oral hearing was not requested.

Section 45 of the Trademark Act, 15 U.S.C. 1127, states that a mark is deemed to be in use in commerce on goods when "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale...."

The specimens submitted clearly are not placed on the goods or their containers or on tags or labels affixed to the goods. While applicant concedes that the specimens, which are a single 8½ x 11 sheet of glossy paper, printed on both sides, may be deemed advertising, applicant has simply reiterated in its brief that the specimens "are displays

associated with the goods or 'documents associated with the goods or their sales'...." p. 2.

Applicant has not provided any evidence from which we can find that the specimens are either displays associated with the goods or documents associated with the goods or their sale. It is not sufficient for applicant to simply recite this assertion; rather, this is a legal conclusion which we must draw from the specimens and any facts which applicant has made of record. In this case, however, applicant has not provided any facts whatsoever about how the specimens are used in the sale of applicant's goods.

We would also point out that the provision that documents associated with the goods or their sale are considered acceptable as specimens of use only "if the nature of the goods makes such placement impracticable." There seems to be nothing inherent in the nature of computer software for terrain mapping which would make it impracticable to, for example, apply a mark to the containers of the goods, on labels attached to the goods, or even have the mark appear on the screen when the program is in use.

Further, a review of the specimens casts doubt on whether they are associated with the goods at all. The first sentence of the copy states, "Autometric, Inc. announces the release of OrthoMAX™, a high-performance

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softcopy terrain mapping and precise geopositioning software package." The last paragraph of the material indicates the computer lines on which "OrthoMAX is available," and states that "Transition to other platforms will be announced at a later date." The advertisement ends with the statements "For more information contact: Autometric Incorporated," and "OrthoMAX is available from ERDAS as IMAGINE™ OrthoMAX™." These statements suggest that the "specimen" sheet is purely an advertising document which is announcing a new product which can be obtained from applicant, rather than material which appears with the software product in such a manner that it can be considered a display associated with the goods.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

T. J. Quinn

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