Paper No. 18
HRW

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Avtec Finishing Systems, Inc.

Serial No. 74/504,493

Hugh D. Jaeger of Avtec Finishing Systems, Inc.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Avtec Finishing Systems, Inc. has filed an application to register the mark FLUOROTRON for "metal plating compositions."[1]

Registration has been finally refused on the grounds that the proposed mark does not function as a trademark under Sections 1, 2 and 45 of the Trademark Act and that

the specimens are unacceptable as evidence of trademark use.

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

At the outset, we note that the application, as originally filed identified “metal plating” services–- rather than any goods-- and specified the manner of use of the mark as “service mark affixed to brochures.” After a priority action by the Examining Attorney in which he objected to both the identification of “goods” and the method of use clause as a description of use “as a trademark,” applicant amended its application to identify the “goods” as “metal plating compositions” and to describe the method of use as “the mark is used on the goods.” In making both of these amendments, applicant had followed the suggestions made by the Examining Attorney.

Thus, we must consider this appeal on the basis of the application as amended. Although applicant argues throughout its brief that its mark functions as a service mark for its metal plating service and that the specimens are price lists showing use of the mark for this service, these arguments are to no avail. The amended

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[1] Serial No. 74/504,493, filed March 24, 1994, claiming a date of first use in commerce of Jan. 1, 1979. Upon amendment, this date

identification is for goods described as “metal plating compositions,” not services, and, accordingly, the specimens must be viewed in reference to use for goods, not services.

Applicant’s specimens show use of the term FLUOROTRON in the following price list:

The Examining Attorney argues that these price lists, unless used as point-of-sale material, are not acceptable as specimens of use of the mark on goods. Because applicant has failed to submit any evidence that the price lists are displayed in direct association with the goods,

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was also set forth as the date of first use anywhere.

the Examining Attorney maintains that the lists cannot be considered point-of-sale material. Applicant insists, on the other hand, that since it is impossible to affix its mark to “metal plating,” the price lists must be viewed as permissible displays associated with the goods.

Section 45 of the Trademark Act, in relevant part, reads:

> For purposes of this Act, a mark shall be deemed to be in use in commerce---
> (1) on goods when---
> (A) 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...

Advertising material in general is not acceptable as specimens of use of a mark for goods when the material simply tells a prospective purchaser about the goods or promotes the sale thereof. See In re MediaShare Corp., 43 USPQ2d 1304, 1307 (TTAB 1997) and the cases cited therein. Whether such advertising material may also function as a display associated with the goods depends on whether there is evidence demonstrating that the advertising material is utilized in point-of-sale presentations for the goods. See TMEP Section 905.06.

The instant specimens are price lists, which must be viewed as one form of product literature or advertising material, and which have long been held unacceptable as evidence of use of a mark as a trademark for the goods. See In re Drilco Industrial Inc., 15 USPQ2d 1671 (TTAB 1990); and In re Bright of America, Inc., 205 USPQ 63 (TTAB 1979). Even if considered as a catalog, the price lists do not meet the qualifications set forth in Lands' End Inc. v. Manbeck, 24 USPQ2d 1314 (E.D. Va. 1992), for a catalog to constitute a display associated with the goods. Here, there are no pictures, no descriptions of the goods, and no provisions for directly ordering the goods from the catalog.

Nor is there any evidence here of use of the lists in a point-of-sale presentation, as would be another possible means of qualifying as a display connected with the goods. Although applicant states that it is impossible to affix the mark to the goods, applicant has submitted no evidence as to why it would be impracticable to physically affix the mark to goods identified as "metal plating compositions." Instead, applicant's arguments constantly refer to "metal plating," a service to which it would admittedly be impossible to affix a price list. But, as previously pointed out, we are not dealing with "metal plating" in

this application, only “metal plating compositions.” Although it is entirely possible to seek registration for the same mark both as a service mark and a trademark, in the application for the trademark the specimens must show use of the mark to identify and distinguish the goods as opposed to use in the sale or advertising of the services. See In re Willard Photo Service, Inc., 179 USPQ 117 (TTAB 1973). Price lists per se are not acceptable as specimens of use of the mark for the goods of this application.

The Examining Attorney also contends that FLUOROTRON, as used in this price list, does not function as a trademark in that it would not be perceived by the public as an indication of source. Instead, according to the Examining Attorney, the designation FLUOROTRON would simply be seen as the name of another chemical on the list.

Applicant counters with the statement that FLUOROTRON is a coined term with no generic meaning in the industry. Applicant argues that the relevant consumers would recognize that this term is not the name of another chemical, but rather a term used only by applicant, in association with its metal plating services.

We find nothing in the specimens to support the Examining Attorney’s conclusion that prospective purchasers would view FLUOROTRON as the name of another chemical. In

the first place, it should be obvious even to the layman that not all the finishes listed are described in terms of chemical elements or compounds. Terms such as “anodize,” “abrasive blasting,” or “electropolish” would be readily recognized as other than chemical names. Thus, there is no reason why FLUOROTRON would not be viewed as a mark being employed by applicant as an indicator of origin for its particular “PTFE Impregnation.” The true issue is not whether FLUOROTRON functions as a mark per se, but whether it functions as a trademark for “metal plating compositions” or as a service mark for “metal plating.” On the record before us, applicant has not established use of FLUOROTRON as a trademark for the goods defined as “metal plating compositions.”

Decision: The refusal on the ground that the specimens are unacceptable as evidence of trademark use is affirmed, but the refusal on the ground that FLUOROTRON does not function as a mark is reversed.

G. D. Hohein

B. A. Chapman

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board