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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Robert S. Laughlin

Serial No. 75/309,438

Michaela M. Barry for Robert S. Laughlin

John S. Yard, Trademark Examining Attorney, Law Office 104
(Sidney I. Moskowitz, Managing Attorney)

Before Hanak, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Robert S. Laughlin (applicant) seeks to register the mark TPE for "computer services, namely, providing an on-line bulletin board in the field of adult-oriented conversation and ideas." The application was filed on June 16, 1997 with a claimed first use date of March 1992.

Citing Section 1 of the Trademark Act, the Examining Attorney has refused registration on two grounds. First, the Examining Attorney notes that the application was

signed not by the applicant, but rather by applicant's attorney who, according to the Examining Attorney, lacked color of authority to sign the application. Second, the Examining Attorney contends that applicant's specimens of use are deficient because (1) they are "incomplete," and because (2) they do not show use of the mark TPE for the services as set forth in the application.

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

With regard to the first ground of refusal, we reverse. As previously noted, the application was filed on June 16, 1997. On June 15, 1997 applicant signed a paper styled "Power Of Attorney At Law." In that document, applicant not only authorized his attorney to sign and prosecute the application and to conduct all business with the PTO in connection with his application, but in addition, applicant stated that his attorney had personal knowledge of the statements contained in the trademark application. Thus, in view of this document signed by applicant, applicant's attorney had at least color of authority to sign the trademark application and hence the application was not void ab initio. Trademark Manual of Examining Procedure Section 803.

Subsequently, Trademark Rule 2.33(a)(3) was changed effective on October 30, 1999 to permit attorneys to sign applications on behalf of applicants provided that said attorneys have "actual or implied written or verbal power of attorney from the applicant." Clearly, based on the document signed by applicant, applicant's attorney had such power of attorney.

The PTO has taken the position that any trademark application which was pending on October 30, 1999 (as was the current application) is to be treated in accordance with Trademark Rule 2.33 as modified. Accordingly, applicant's attorney properly signed the application.

In reversing this first ground of refusal to register, we hasten to add that the actions of the Examining Attorney were quite proper at all times from the application filing date through the final paper in this file, namely, the Examining Attorney's brief dated May 10, 1999. It is certainly not the fault of the Examining Attorney that subsequent to May 10, 1999, Trademark Rule 2.33(a)(3) was altered to permit attorneys with power of attorney to sign applications.

We consider next the refusal to register on the basis that applicant's specimens of use are inadequate. As previously noted, this refusal has two prongs. First, it

is the position of the Examining Attorney that applicant's specimens of use, which applicant contends are printouts of the first page of his web page, are "incomplete" because they lack a URL destination, that is, the applicant's web address. The Examining Attorney acknowledges that not all web pages have a URL destination. Rather, it is the position of the Examining Attorney that the vast majority of web pages do. In contrast, applicant has consistently maintained his position that his specimens of use are indeed actual printouts of his first web page.

Based on the above, we find that the refusal of the Examining Attorney to accept applicant's specimens because they are "incomplete" or because they are not what they purport to be is simply not well taken. Applicant has repeatedly and consistently stated that the specimens are indeed printouts of his first web page. In addition, the Examining Attorney has conceded that not all web pages contain a URL destination. Finally, we simply note that at page two of Office Action No. 3, the Examining Attorney appears to state that he actually "visited" applicant's computer web site, and then advised applicant that "various printouts from the web site, properly submitted and verified as substitute specimens, would indeed overcome both specimen refusals." Hence, the Examining Attorney

himself has independently confirmed that applicant's specimens do indeed actually exist on the web.

We turn now to the second prong of the second ground of refusal, namely, that applicant's specimens do not show use of the mark in connection with the services for which applicant seeks registration (computer services, namely, providing an on-line bulletin board in the field of adult-oriented conversation and ideas). As our primary reviewing Court has made clear, in order to obtain a service mark registration, "the minimal requirement [for the specimens] is some direct association between the offer of services [for which registration is sought] and the mark sought to be registered therefor." In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). See also In re Advertising & Marketing, 821 F.2d 641, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) ("It is not enough for the applicant to be a provider of services; the applicant also must have used the mark to identify the named services for which registration is sought.")

While applicant's mark TPE appears prominently and repeatedly on applicant's specimens (i.e. the first page of applicant's web site), these specimens in no way associate the mark TPE with the services for which applicant seeks registration, namely, "computer services, namely, providing

an on-line bulletin board in the field of adult-oriented conversation and ideas." Stated somewhat differently, a consumer reviewing applicant's specimens (the first page of his web site) would in no way be able to ascertain that applicant's computer services are the providing of an on-line bulletin board, much less the providing of an on-line bulletin board in the field of adult-oriented conversation and ideas. There is simply no mention in applicant's specimens of an on-line bulletin board, either in those words or in similar words. There certainly is no mention in applicant's specimens of an on-line bulletin board in the field of adult-oriented conversation and ideas, either in those words or in similar words.

Nevertheless, because of certain very unusual facts present in this case, we are remanding this matter to the Examining Attorney in order to afford applicant the opportunity of submitting proper specimens (i.e. additional pages from his web site) which show use of the mark TPE in connection with the services for which registration is sought, along with a declaration (if accurate) to the effect that these additional specimens were in use as of the application filing date of June 16, 1997. We are taking this action because there is no dispute that the Examining Attorney and applicant had a number of telephone

conversations regarding the sufficiency of applicant's specimens. As previously noted, the Examining Attorney visited applicant's web site and after reviewing additional pages of his web site, found that these additional pages did show use of the mark TPE in connection with the services for which registration was sought. The recollections of the Examining Attorney and applicant differ in that applicant was under the impression that because the Examining Attorney viewed the additional pages of the applicant's web site and found that these pages showed an association of the mark with the services, that applicant need not physically submit these pages. On the other hand, the Examining Attorney's recollection is that he informed applicant that while a review of applicant's other web pages indicate that they would serve as proper specimens, nevertheless, applicant was advised that he had to physically submit copies of the specimens along with a declaration or verified statement that these additional pages were in use at least as early as the application filing date.

Accordingly, this matter is remanded to the Examining Attorney with instructions to promptly issue another office action which will afford applicant sixty days from the date of said office action in which to submit additional pages

from its web site showing use of the mark TPE in connection with the applied for services along with a verified statement or declaration to the effect that these additional web site pages (specimens) were in use at least as earliest as the application filing date of June 16, 1997.

Decision: The refusal to register on the basis that the applicant did not sign the application is reversed. The refusal to register on the basis that the specimens are "incomplete" or are not what they purport to be is also reversed. The refusal to register on the basis that applicant's specimens do not show use of the mark TPE in connection with the applied for services is affirmed. However, as explained in the preceding paragraphs, applicant is afforded the opportunity to submit proper specimens along with a verified statement or declaration (if accurate) that said specimens were in use at least as early as June 16, 1997, the application filing date.

E. W. Hanak

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board