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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Altera Corporation

Serial No. 75/349,537

Rochelle D. Alpert and Savita N. Krishna of Brobeck,
Phleger & Harrison for applicant.

Cora Moorhead, Trademark Examining Attorney, Law Office 102
(Thomas V. Shaw, Managing Attorney).

Before Seeherman, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Altera Corporation has filed an application on the
Principal Register to register the mark CLOCKBOOST for
goods identified, as amended, as "a feature of configurable
logic integrated circuits and programmable logic integrated
circuits, namely, timing circuitry."¹

The Examining Attorney has issued a final refusal
requiring the submission of substitute specimens showing

¹ Application No. 75/349,537, filed August 29, 1997, based on use in
commerce, alleging first use and first use in commerce as of June 1996.

use of the mark in connection with the goods identified in the application.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

During examination of the application and in her final refusal the Examining Attorney contended that the specimens are unacceptable because they consist of promotional materials and do not show use of CLOCKBOOST as a source indicator, and suggested that appropriate specimens would include, *inter alia*, instruction manuals.

The specimens submitted with the application are described by applicant, in its October 21, 1998, response, as "the user's instruction manual that provides the necessary information for the purchaser to use the CLOCKBOOST circuitry." Applicant states in that response that "[b]ecause the goods offered under the mark CLOCKBOOST consist of circuitry on a semiconductor device, placement of the mark on the goods is not commercially feasible."

With its request for reconsideration of June 17, 1999, applicant submitted an additional excerpt from its instruction manual, verified to have been in use prior to the application filing date, and a declaration from a customer verifying that the specimen is a technical manual,

available from applicant in hard copy or online, that he must use in connection with the CLOCKBOOST product in order to make proper use of the product.

The Examining Attorney repeated her refusal in rejecting applicant's arguments in its request for reconsideration. For the first time, in her brief, the Examining Attorney posits an entirely new basis for the requirement for substitute specimens, contending that the specimens fail to support the use of CLOCKBOOST as a trademark. She states in her brief that "the term is used in merely an informational sense [and] does not function as a trademark because it neither identifies nor distinguishes the goods of the applicant from those of others nor does it indicate the source of the goods." We will not consider this issue raised at this point in the appeal, since it is essentially a new ground for refusal. The proper procedure would have been for the Examining Attorney to file a request for remand in order to refuse registration on the ground that the specimens do not show use of CLOCKBOOST as a trademark. Trademark Rule 2.142(f)(6). See also *Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, Section 1209.02.

Further, we find no need to consider a remand *sua sponte* because, based on the record before us, the new

basis for refusal asserted by the Examining Attorney in her brief does not render the applicant's mark unregistrable. See Trademark Rule 2.142(f)(1) and *TMBP* Section 1209.01.

Considering the Examining Attorney's contention in the final refusal that the specimens are unacceptable because they consist of promotional materials and do not show use of CLOCKBOOST as a source indicator, as applicant correctly notes, the Board, in *In re Ultraflight Inc.*, 221 USPQ 903 (1984), made it clear that if printed matter included with goods functions as an integral part of the goods, such as a manual for assembling a kit for the product, placement of the mark on that printed matter constitutes use on the goods. Moreover, the Board concluded, in *In re Brown Jordan Co.*, 219 USPQ 375 (1983), that it is not necessary that purchasers see the mark for the goods before they purchase the goods.

The evidence, including the declaration of a customer, clearly establishes that it is not feasible to place the trademark on the goods and that the specimens of record function as instruction manuals. As such, the specimens are proper and the refusal based on the requirement for substitute specimens is reversed.

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Decision: The refusal on the ground that the specimens are unacceptable evidence of trademark use is reversed.

E. J. Seeherman

C. E. Walters

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board