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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Star Bridge Systems, Inc.*

Serial No. 75/606,002

John W.L. Ogilvie of *Computer Law++* for *Star Bridge Systems, Inc.*

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before *Bottorff*, *Rogers* and *Drost*,
Administrative Trademark Judges.

Opinion by *Rogers*, Administrative Trademark Judge:

Star Bridge Systems, Inc. has applied to register the mark IIADL for goods that, following amendment, are now identified as "supercomputer software development tools for describing algorithms for use on reconfigurable parallel processing supercomputers."

The application was filed under the intent-to-use provisions of the Lanham Act, was approved, published, and a notice of allowance issued. Applicant filed a statement

of use (SOU), but the examining attorney then refused registration because the specimen of use submitted with the SOU¹ was deemed unacceptable. Specifically, the examining attorney stated:

The exact nature of the specimens is unclear, thus the examiner can not determine whether the specimen is used in commerce on the goods. In addition, the applicant should note that if the submitted photocopied page is from some sort of a user manual for the goods, it must so clarify by submitting the manual or at least the cover of the manual indicating what it is. In addition, the applicant must submit the page on which trademark usage appears, not the page on which an informational statement in which the applicant asserts its rights concerning the mark appears.

The examining attorney also noted that submission of a different specimen would be an option but that applicant would have to verify, by affidavit or declaration, use of any such substitute specimen in commerce prior to the expiration of the deadline for filing the SOU.

Applicant responded to the refusal by explaining that the specimen "is a photocopy of a screen shot, which shows the mark as it is displayed in the goods on a computer

¹ The specimen is a photocopied page headed with STAR BRIDGE SYSTEMS and design, followed by a TM designation, and bearing the following statement: "Star Bridge Systems, Hypercomputer, Hypercomputing, Viva, IIADL, Hyper-specificity Processor, Gateway, Pensa, Architecture on Demand and Tools to Build Your World are marks of Star Bridge Systems, Inc., copyright 1998-1999 by Star Bridge Systems, Inc. All Rights Reserved."

screen." Applicant also argued that such screen shots are acceptable as specimens of use of a mark; that there is no authority for the examining attorney's statement that a specimen which consists of nothing more than an informational statement asserting applicant's rights to particular marks does not show trademark usage; and that use of a mark in an informational statement "serves a primary purpose of the use-in-commerce requirement, namely, providing notice to the consuming public of Applicant's mark in connection with the goods."

As an alternative to its arguments in support of the original specimen, applicant proffered a substitute specimen, which was identified as "a photocopy of the back side of page 1 of user documentation which shipped with the goods." Applicant offered to file a formal declaration as to use of the substitute specimen if "the Office indicates that this substitute specimen would be acceptable."

The examining attorney made final the refusal of registration, asserting, in regard to the original specimen, that while a computer screen shot, per se, may be an acceptable specimen, it must show proper trademark use and that the screen showing applicant's informational statement does not show such use. In addition, the examining attorney refused the substitute specimen because

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"it is a cutout from more comprehensive matter" and was not supported by an affidavit or declaration. The examining attorney noted, however, that if the applicant submitted the entire item from which the substitute specimen was derived, with an affidavit or declaration, and if the substitute specimen is thereby revealed to be part of "some sort of user manual or documentation shipped with the goods," then the refusal would be reconsidered.

Applicant filed a request for reconsideration that included the entirety of the user manual from which the substitute specimen was derived; and a supporting declaration by applicant's counsel, attesting to use of the manual in commerce prior to the deadline for filing the SOU. In the request for reconsideration, applicant clearly reserved the right to argue on appeal both that the original specimen is acceptable and that the substitute is acceptable.

The examining attorney denied the request for reconsideration, noting that the complete user manual submitted by applicant is a manual for a software product titled VIVA, not IIADL, and that the latter mark merely appears among a list of applicant's products in the VIVA manual. The final refusal of registration was maintained and applicant then appealed. Applicant and the examining

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attorney have filed briefs but applicant did not request an oral hearing.

The appeal presents us with two questions. First, is applicant's original specimen -- a reproduction of a computer screen shot taken from the IIADL program in operation, which screen shot presents a statement asserting applicant's rights in a variety of marks -- an acceptable specimen? Second, is applicant's manual for its VIVA computer program, which includes statements asserting applicant's rights in a variety of marks, including the IIADL mark, acceptable as a specimen evidencing use in commerce of the IIADL mark for the IIADL program?

Section 45 of the Lanham Act, 15 U.S.C. §1127, as amended by the Trademark Law Revision Act of 1988, provides, in part, that a mark shall be 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...."

We do not believe that applicant's goods are of a type that it would be impracticable to use the mark in one of the customary ways, such as on a tag or label or on

packaging. See *In re MediaShare Corp.*, 43 USPQ2d 1304, 1306 n.7 (TTAB 1997). Indeed, applicant has not made such a contention and, in the original application, stated that it intended to use the IIADL mark "by applying it to the goods, to computer-readable storage media and packaging for the goods, and to marketing and advertising material connected with the goods."

It is clear that the original specimen is neither packaging for the goods nor marketing and advertising material for the goods.² It is, as applicant has explained, a reproduction of a computer screen shot which a user of applicant's software would encounter. The examining attorney has conceded that on-screen use may be sufficient,³

² Marketing and advertising material, in any event, generally is insufficient to show proper trademark use, unless the material is used as a display associated with the goods or in a catalog that would qualify as such. *Compare Lands' End Inc. v. Manbeck*, 797 F.Supp. 311, 24 USPQ2d 1314 (E.D. Va. 1992) (Catalog found to qualify as display associated with goods) and *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993) (In the absence of a showing that it was impracticable to use the mark on or in connection with goods, use of mark for pharmaceutical product only on advertising directed to potential prescribing physicians held not proper trademark use). See also, *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997) (Advertising material held not to qualify as catalog display under *Lands' End* case, or as any other type of display associated with goods at point of sale).

³ Section 905.04(d) of the Trademark Manual of Examining Procedure instructs, in pertinent part, that a reproduction of a "display screen projecting the identifying trademark of a computer program ... should be acceptable as evidence of trademark use." The policy makes eminent sense, especially in view of the routine delivery of some software online without any traditional packaging. See, e.g., the following definition of "shareware"

but has argued, in essence, that the particular screen shot must show the mark "used in a manner that clearly projects a single source of the goods" and use in an "informational statement" does not function as a "source identifier."

Applicant, in contrast, argues that informational statements and lists of marks, such as its trademark notice, may influence prospective purchasers. We agree with the examining attorney that the original specimen is unacceptable.

The critical inquiry regarding material submitted as evidence of use of a mark is whether a potential customer, based on the display or use of the mark, will draw a connection between the mark and the goods or services, not with a particular corporate entity. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 USPQ2d 1660 (Fed. Cir. 1994). Section 45 of the Lanham Act, 15 U.S.C. §1127, referenced by the Court in *West Florida*, defines trademarks and service marks as words, names, symbols or devices which "identify and distinguish [goods or services] from [goods or services] of others and to indicate the source... even if that source is unknown." Applicant's original specimen

from *The Computer Glossary The Complete Illustrated Dictionary* 354 (9th ed. 2001): "Software distributed on a trial basis through the Internet, online services, BBSs, mail-order vendors and user groups."

only draws an association between applicant and its marks, not between its marks and goods or services. Thus, it is not proper evidence of trademark use.

Turning to the substitute specimen, the examining attorney argues that the user "manual clearly is for a software product named VIVA"; that the product titled VIVA has no apparent connection to the product titled IIADL; and that applicant has not even attempted to argue that the two products are so related that "it is reasonable to expect they use the same manual." Applicant's only argument on this point is that "the Examining Attorney and the Board are respectfully directed to paragraph 2 of the Declaration dated February 1, 2001." The declaration, however, only states that the substitute specimen is a copy of what "shipped with Applicant's goods as user documentation" and is not responsive to the examining attorney's points.

The Board has held that an instruction manual may be "as much a part of applicant's goods" as the goods themselves, and integral to their use, and therefore may be accepted as evidence of "affixation to the goods." In re *Ultraflight Inc.*, 221 USPQ 903, 906 (TTAB 1984). The *Ultraflight* decision even contemplated use of a mark for a computer program in a user's manual:

A similar situation would be presented in the case of a mark applied to a user's guide for a computer program, which guide must be considered an integral part of the goods themselves. By contrast, a package insert that is no more than an invoice or advertisement on which the mark appears may not be proper affixation of the mark to the goods. *Id.*

Nonetheless, we find the case at hand distinguishable from *Ultraflight*. In contemplating use of a mark for a computer program on a user manual, the *Ultraflight* panel clearly was contemplating use in the manner that was made on the instruction manual for the powered hang-glider kits that were involved in *Ultraflight*. Specifically, the mark for these kits appeared on the first page of the instruction manual and, more importantly, the manual was integral to transforming the kit into a powered hang-glider.

In the case at hand, applicant asserts that it ships the manual for its VIVA computer program with the IIADL program. The IIADL mark, however, is not on the first page of the manual, so as to identify it as accompanying the program. Rather, the only references to the IIADL mark in the VIVA manual are on two inside pages in informational statements that, like the original specimen already considered, merely list applicant's various marks. Likewise, because the VIVA manual does not discuss the

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working of the IIADL program in any way, the VIVA manual clearly is not integral to the use of the IIADL program. Indeed, it is entirely possible that the purchaser of the IIADL program would have no need to refer to the VIVA manual -- applicant has not asserted there would be such a need -- and thus, the purchaser of the IIADL program might never see the IIADL mark in the VIVA program manual. There is no requirement that a mark be visible to a purchaser of goods at the time a sale is consummated. *Ultraflight*, 221 USPQ at 905. It must, however, be used in such a manner that there will inevitably be some association of the mark with the goods.

The result might be different if applicant were shipping an IIADL manual with the IIADL program, and submitted that as a specimen. Shipping of the VIVA manual with the IIADL program is akin to the type of "package insert" or advertising that would not, even under *Ultraflight*, constitute a proper specimen evidencing use of a mark on goods.

Decision: The refusal of registration is affirmed.