

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
Jan. 30, 2004

Paper No. 34
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re William Hiley

Serial No. 75473440

Scott K. Haight of Butler, Snow, O'Mara, Stevens & Cannada,
PLLC for William Hiley.

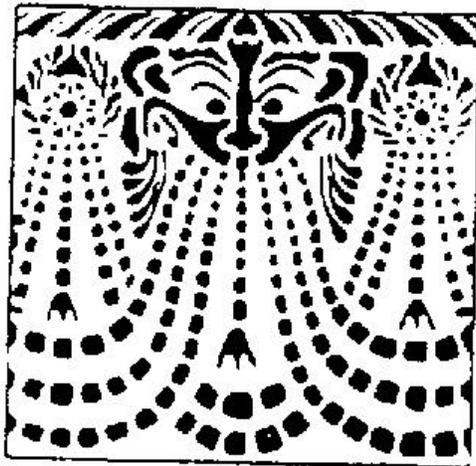
Tonja M. Gaskins, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Cissel, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration of the mark depicted
below, for goods identified in the application (as amended)
as "furniture, mirrors, picture frames, blanket boxes of
wood, cork, reed, cane, wicker, horn, bone, ivory,

whalebone, shell, amber, mother-of-pearl, meerschaum, or plastic."¹



At issue in this ex parte appeal is the Trademark Examining Attorney's final refusal to register the mark on the ground that applicant has failed to submit an acceptable specimen showing use of the mark as a trademark for the identified goods. The appeal is fully briefed, but no oral hearing was requested. We affirm the refusal to register.

¹ Application Serial No. 75473440, filed on April 24, 1998 as an intent-to-use application under Trademark Act Section 1(b), 15 U.S.C. §1051(b). In his subsequently-filed Statement of Use, applicant has alleged April 1988 as the date of first use of the mark anywhere and January 1992 as the date of first use of the mark in commerce. The application includes the following "description of mark" statement: "The mark consists of a square border surrounding a stylized chandelier having features resembling a human face." The following lining statement also appears in the application: "The lining shown in the drawing is a feature of the mark and is not intended to indicate color."

The specimens at issue are of three types. The first specimen, reproduced below, is identified by applicant as "a copy of the initial product description page of Applicant's web site ... In essence, the web site constitutes an on-line catalog depicting the goods of the Applicant..." (October 15, 2001 response to Office Action.)²

² It is not clear from the record what is the relationship between William Sheppee, Ltd., the entity identified in applicant's specimens, and William Hiley (an individual citizen of England), the applicant named in the application. Because the Trademark Examining Attorney made no inquiry on this point and apparently is satisfied with applicant's claim of ownership of the mark, that issue is not before us in this appeal.

EXHIBIT "A"

On-Line Showroom



The following is a representation of our stock
All sizes are shown as Width x Depth x
Height
Both centimeters & inches are provided

- Indian Collection
- European Collection
- Colonial Collection
- Forge Collection
- Antique Collection
- Accessories

Send mail to [A & A Systems](mailto:A&ASystems) with questions or comments about this web site.

Copyright © 1997 - 2000 William Sheppee Ltd. Last modified: May 29, 2000

Applicant: William Hiley
Serial Number: 75/473,440
Filed: April 24, 1998
Date of First Use: April, 1998
Date of First Use in Commerce: January, 1992
Mark: Miscellaneous Design

<http://www.williamsheppeeusa.com/usshowroom.htm>

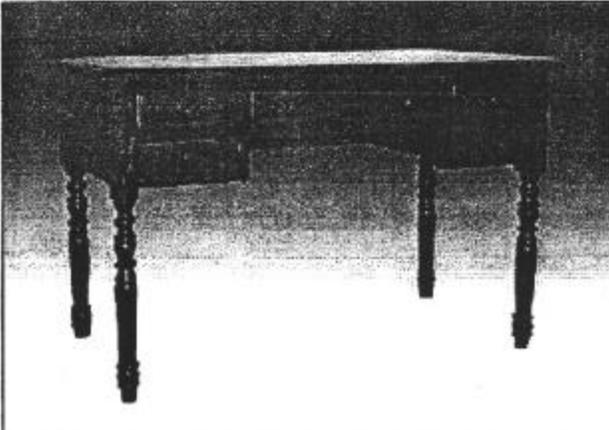
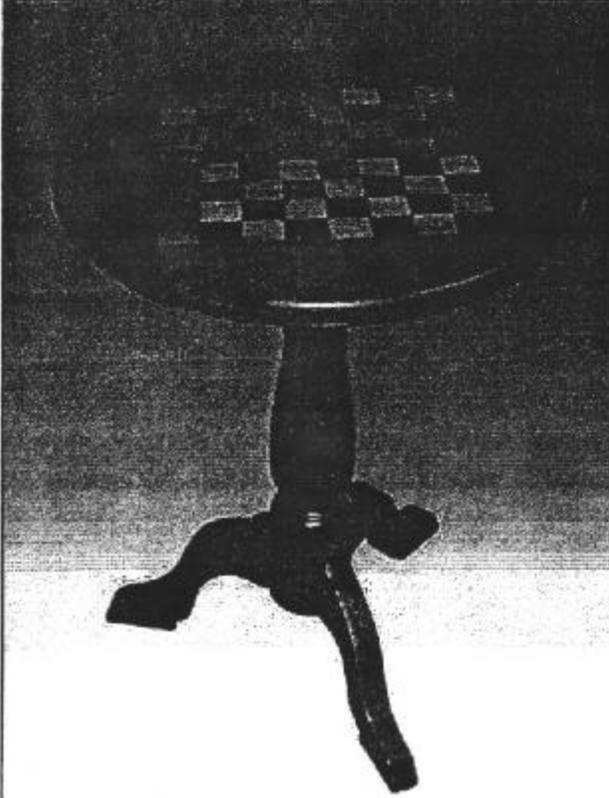
2/8/01

Applicant's specimens also include copies of numerous invoices, as well as a four-page "catalogue supplement," a representative page of which is reproduced below.³

³ With respect to the invoices and the catalogue supplement specimens, we reject the Trademark Examining Attorney's contention that these specimens should not be considered because they are not supported by a declaration averring that they were in use prior to the deadline for filing a Statement of Use, as required by Trademark Rules 2.56, 2.88(b)(2) and 2.59(b), 37 C.F.R. §§2.56, 2.88(b)(2) and 2.59(b). These specimens were submitted on February 1, 2002, within the time allotted to applicant for filing an acceptable Statement of Use (as extended pursuant to applicant's "insurance" third extension request). Therefore, we deem the invoices and the "catalogue supplement" to be timely and properly made of record as specimens, and we have considered them (and applicant's arguments regarding their acceptability as trademark specimens) in reaching our decision herein.

Ser. No. 75473440

his website which, according to applicant, are not offered as specimens but merely to further demonstrate how the website is viewed and used by purchasers. These pages include a "contact information" page at which applicant's dealer/customers may register with applicant, and pages which display photographs of and information on particular furniture items, such as the page reproduced below.

The Colonial Range-Page 2 of 2 <i>(All product codes are required in correspondence)</i>		Previous	Next
	Product Name:	Colonial Writing Table	
	Size:	121 x 71 x 81cm 48 x 28 x 32in	
	Product Code:	COL032	
	Product Name:	Chess Table	
	Size:	51 x 51 x 67cm 21 x 21 x 27in	
	Product Code:	INL031	

Pursuant to Section 1 of the Trademark Act, 15 U.S.C. §1051, an applicant seeking to register a trademark on the Principal Register must submit a specimen of the mark as used in commerce. Section 45 of the Act, 15 U.S.C. §1127, provides that a trademark is used "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, and

(B) the goods are sold or transported in commerce,...

Trademark Rule 2.56(b)(1), 37 C.F.R. §2.56(b)(1), provides that

A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

After careful consideration of the materials applicant has submitted, we find that they do not suffice as acceptable trademark specimens, whether considered individually or in conjunction with each other.

First, we find that the invoices submitted by applicant are not acceptable as trademark specimens; an

invoice is neither a label, a tag, a container, nor a display associated with the goods. See, e.g., *In re Chicago Rawhide Manufacturing Co.*, 455 F.2d 563, 173 USPQ 8 (CCPA 1972); *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979).

Next, we find that the "initial product description page" submitted by applicant (reproduced *supra* at page 4) also fails to suffice as an acceptable trademark specimen. Applicant contends that this specimen constitutes a "display associated with the goods." More specifically, in his response to the Trademark Examining Attorney's initial refusal to accept this specimen, applicant explained that

[t]he specimen submitted is a copy of the initial product description page of Applicant's web site showing the mark to be registered, along with electronic "bottons" [sic - buttons] to each side indicating the various lines or categories of Applicant's furniture, the goods for which the mark is sought to be registered. On the web site page, which constitutes the specimen, when the pointer is placed upon a specific furniture collection, the image of the logo sought to be registered is replaced with a photograph of an example of such furniture. Clicking on the appropriate furniture collection will then take one to catalog pages featuring pictures of the various pieces in each furniture collection. In essence, the web site constitutes an on-line catalog depicting the goods of the Applicant...

At pages 2-3 of his appeal brief, applicant further contends:

It is important to review the Applicant's trademark specimen as a single snapshot printout of an interactive web site that contains moving images. The buttons on the right of the web page take users to various categories of Applicant's furniture. The user selects a product category button and the subject trademark design is prominently displayed centrally each and every furniture category page. The online customer cannot view furniture items offered on Applicant's website catalog without going through a trademark display associated with the goods being offered. As the user slides his pointer around the screen to view - over the trademark image and over furniture "buttons" (without even clicking on or leaving the page) - the Applicant's trademark image is superimposed and "changes" directly over the product images as the pointer merely glides over them. Thus, the trademark is always directly associated with products being sold.

Similarly, in his reply brief (at page 5), applicant states:

When using Applicant's online catalog, Applicant's customers always see the Mark in association with the goods before ordering them. The Applicant's Specimen is a snapshot printout of an interactive point-of-sale catalog that contains changing images. The subject trademark design is prominently displayed centrally on the furniture page when a furniture dealer shops for furniture items offered in Applicant's interactive catalog. The online customer always sees the trademark display directly associated with the goods being offered because when the customer views

furniture items (by sliding a pointer around the screen - without clicking or leaving the page) the Applicant's trademark image is automatically superimposed directly over the product image.

Citing *Lands' End, Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992), applicant argues that his "on-line catalog" is a "display associated with the goods," and that the website page applicant has printed out and submitted thus is an acceptable specimen of trademark use. We are not persuaded.

In the case of *In re Bright of America, Inc.*, *supra*, the Board held that:

A display associated with the goods ... comprises essentially point-of-sale material such as banners, shelf-talkers, window displays, menus, or similar devices which are designed to catch the attention of purchasers and prospective purchasers as an inducement to consummate a sale and which prominently display the mark in question and associate it or relate it to the goods in such a way that an association of the two is inevitable...

205 USPQ at 71. Under this definition, the single-page specimen submitted by applicant does not qualify as a "display associated with the goods." The mark, as it appears on the specimen, would not be perceived by purchasers as a trademark for any of the particular goods identified in the application, because it is not displayed

in close association with any of those particular goods. Rather, the mark is displayed in close association with the words "On-Line Showroom." Purchasers viewing the mark as it appears on this page, in close association with the words "On-Line Showroom," might perceive the mark as a service mark for applicant's on-line retail or wholesale furniture store services, but they would not perceive it as a trademark for any of the particular goods identified in the application.

This case thus is readily distinguishable from prior cases in which specimens were found to be "displays associated with the goods" because the mark in question was displayed in close association with the particular goods that were the subject of the application for registration. For example, in *Lands End v. Manbeck, supra*, the printed mail-order catalog was held to be an acceptable "display" specimen because the mark KETCH was displayed in close association with a depiction and description of the particular product identified by the mark, i.e., a purse. Similarly, in *In re Marriott Corporation*, 459 F.2d 525, 173 USPQ 799 (CCPA 1972), the menu specimen was held to be an acceptable "display" because the mark, TEEN TWIST, was displayed on the menu in close association with an illustration and/or description of the particular sandwich

identified by the mark. In *In re Hydron Technologies Inc.*, 51 USPQ2d 1531 (TTAB 1999), the infomercial specimen was held to be acceptable because the mark HYDRON was displayed in close association with depictions of the particular beauty products identified by the mark.

In contrast, applicant's single-page specimen fails to display the mark in close association with a depiction or description of the particular goods identified by the mark. In fact, the specimen fails to depict or describe any particular goods at all. However, even assuming that purchasers would perceive the wording depicted on the right side of the page (i.e., "Indian Collection," "European Collection," etc.) as identifying the particular goods identified in the application, that wording is so far away from and separated from the depiction of the mark that the requisite "inevitable" association between the mark and the goods would not be made by purchasers viewing the page. Absent such an inevitable association between the mark and the goods, applicant's specimen does not qualify as a "display associated with the goods."

Applicant, in his response to the initial Office Action and in his briefs, provides rather detailed narrative explanations (quoted *supra*) of how the mark is depicted on applicant's actual website and how purchasers

using the website would be able to view the mark. For example, applicant contends that purchasers visiting applicant's website would see the mark superimposed over images of applicant's particular furniture items. However, applicant has failed to submit any specimens which bear out that contention,⁴ such as a printout of a page from the website which depicts the mark superimposed on particular furniture items (or a photograph of the computer screen upon which such page is displayed - see, e.g., TMEP §904.04(d) regarding "Specimens for Trademarks Identifying Computer Programs, Movies or Video Tapes").

The Trademark Act and Trademark Rules quoted *supra* specifically require submission of "specimens or facsimiles of the mark as used." Applicant's narrative explanations and descriptions of how the mark would be viewed by purchasers, however detailed, are no substitute for an actual specimen which depicts and demonstrates how the mark is used. The actual specimen submitted by applicant, i.e., the "initial product description page," is what is at issue

⁴ Indeed, and contrary to applicant's assertion, the additional website page printouts submitted by applicant with his request for reconsideration (one of which is reproduced *supra* at page 8) which actually depict photographs of applicant's goods do not show the mark superimposed over the photograph of the goods.

here. For the reasons discussed above, that page is unacceptable as a specimen of trademark use of the mark.⁵

Finally, the "catalogue supplement" pages submitted by applicant (one of which is reproduced *supra* at page 6) likewise are not acceptable as trademark specimens. Essentially, these pages are nothing but a price list, and price lists are not acceptable trademark specimens for the same reason that invoices are not acceptable specimens. *See In re Bright of America, supra.* Moreover, this listing of applicant's goods does not qualify as a "display associated with the goods," inasmuch as there is no evidence that it is used at the point of sale and because, in any event, the mark does not appear in close association with any of the particular goods identified in the application. The mark appears in the heading at the top of the page, in association only with applicant's trade name and address. Although this might suffice as evidence that applicant uses the mark as a service mark in connection with retail or wholesale store services in the field of furniture and accessories, it does not suffice as a

⁵ We need not and do not reach the question of whether, if applicant had submitted actual specimens which demonstrate use of the mark in the manner described in applicant's narrative explanations, such specimens would be acceptable as trademark specimens (e.g., as opposed to service mark specimens). No such specimens are in the record, and that issue accordingly is not before us.

specimen of use of the mark as a trademark in association with the identified goods.

Also, applicant cites to the wording "ITEMS ILLUSTRATED IN CATALOGUE" which appears on this price list as evidence in support of his contention that applicant in fact has a catalog which includes illustrations of the goods. However, applicant has failed to submit any such catalog (which displays use of the mark in close association with the goods) as a specimen. The price list's mere reference to such a catalog, like applicant's narrative explanations and descriptions of its online catalog, does not suffice.

In summary, we have carefully reviewed the materials applicant has submitted as specimens and applicant's arguments in support of such materials, and we find, for the reasons discussed above, that although they might suffice as service mark specimens, they do not suffice as acceptable specimens of use of the mark as a trademark for the goods identified in the application.

Decision: The Trademark Examining Attorney's requirement for an acceptable substitute specimen, and her refusal to register the mark absent such specimen, are affirmed.