

STAB

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: Tri/Mark Corporation)	
)	
SERIAL NO.: 76/159,890)	Appeal No. _____
)	
MARK: E-ACCESS)	APPEAL BRIEF
)	
FILED: November 6, 2000)	
)	
CLASS: Int'l 9)	
)	
LAW OFFICE: 113)	
)	

10-20-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #57

To the Honorable Commissioner of Patents and Trademarks
ATTN: Assistant Commissioner for Trademarks
BOX: TTAB - No Fee
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

Please enter the following Appeal Brief into the record. It urges reversal of the Examining Attorney's final refusal to register the above-stated mark dated December 13, 2001.

CERTIFICATE OF MAILING

I hereby certify that the above correspondence was mailed to the Assistant Commissioner for Trademarks, Box TTAB - NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, as first class mail, postage prepaid, this 15 day of October, 2003.

Wendy K. Marsh
Wendy K. Marsh

I. INTRODUCTION

The Examining Attorney has rejected Appellant's mark on two separate bases. First, the Examining Attorney states that "E-ACCESS" fails to function as a mark, stating that Appellant's specimen is unacceptable. The Examining Attorney has further rejected the application on the basis that the identification of goods is indefinite.

For the reasons set forth below, the Examining Attorney's rejections of the application are without merit. The Examining Attorney's final rejection should therefore be reversed, and Appellant's Statement of Use entered into the record.

II. ARGUMENT

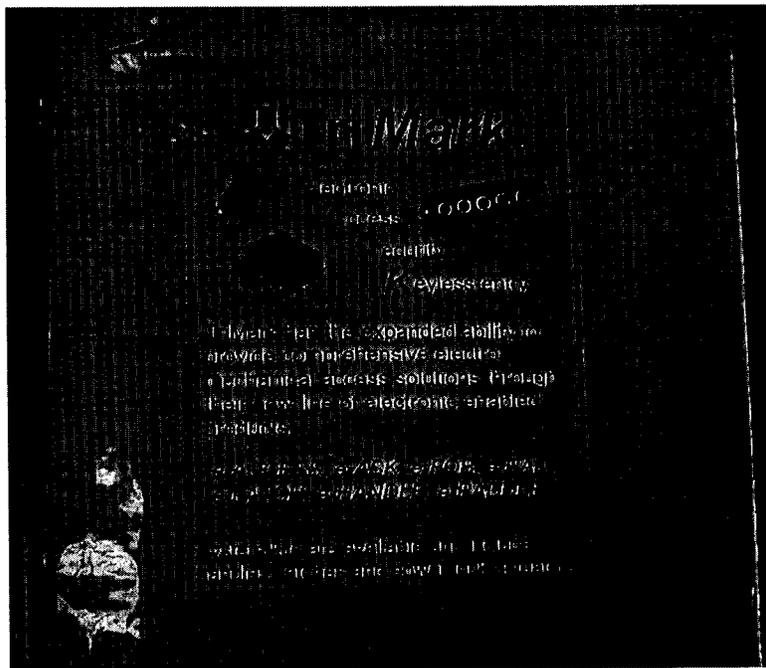
A. **Appellant's Submitted Specimen Consisting of a Product Label is *Per Se* Acceptable for Showing Use Under the Trademark Rules**

1. The Legal Standard for Trademark Specimens

TMEP § 904 describes "Material Appropriate as Specimens for Trademarks", and notes that, "[a] trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods." TMEP § 904.04 provides that "[i]n most cases, where the trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen." TMEP § 904.04(c) further notes that, "a showing of the trademark on the normal commercial package for the particular goods is an acceptable specimen." (Emphasis supplied). TMEP § 904.05 states that advertising material is generally not acceptable as a specimen for goods, and that "[a]ny material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use."

2. The Specimen at Issue

In this case, Appellant's specimen submitted with its December 6, 2002 Statement of Use is a digital photograph of a label that is applied directed to Appellant's product packaging. (See Appellant's Statement of Use). A copy of the label is shown below:



3. The Examining Attorney's Rejection

The Examining Attorney has rejected Appellant's specimen as being unacceptable as evidence of actual trademark use on the basis that it is "a mere advertisement." (March 12, 2003 Office Action, p. 2). In this regard, the Examining Attorney notes that Appellant's product label states that Applicant has a new line of electronic-enabled products and that system kits are available. (3/12/03 Office Action, p. 2). The Examining Attorney then argues that "[e]ven if the advertisement is on packaging, it is still an advertisement for goods rather than a label on the goods themselves [ie the reference to the mark is an advertisement for goods other than those in the box]." (3/12/03 Office Action, p. 2).

4. The Examining Attorney's Rejection is Erroneous as a Matter of Law Since Appellant's Product Label Does Not Cease to be a Product Label Simply Because It Contains Advertising

In this case, there is no dispute but that Appellant's submitted specimen is a label that is applied directly to the packaging for its "E-ACCESS" goods, as attested to under oath in

the Statement of Use.¹ The Examining Attorney's argument is essentially that the label is no longer a label because it contains advertising. This argument defies logic.

Appellant's "E-ACCESS" product label advertises that "TriMark has the expanded ability to provide comprehensive electro-mechanical access solutions through their new line of electronic-enabled products," including "E-ACCESS" system kits. While Appellant advertises its "E-ACCESS" goods as well as other goods on the box, the fact remains that the mark "E-ACCESS" appears on a label that is applied to the product packaging. Put another way, while the product label at issue contains advertising, it does not cease to be a product label because of this, contrary to the Examining Attorney's contention. In fact, it is respectfully submitted that most product labels contain advertising of some sort.

Ironically, based on the Examining Attorney's reasoning, Appellant's product label would have been deemed acceptable had it stated "E-ACCESS" and nothing else. Thus, under the Examining Attorney's logic, the less said on a product label, the more likely it will be acceptable for showing trademark use.

5. The Trademark Rules Require Only That a Trademark Specimen Be a Product Label

In this case, the Examining Attorney is incorrectly applying the rules pertaining to trademark specimens. Specifically, and as already set forth above, TMEP § 904.04(c) definitively states a specimen showing the trademark on a normal commercial package for the particular goods is an acceptable specimen. The rule does not go on to say that once it is determined that the specimen is applied to commercial packaging that the trademark examining attorney must then evaluate whether the specimen also contains advertising and, if so, reject the specimen. Had the rulemakers intended this to be the evaluation process, they would have specifically placed it in the rule.

¹ It is understood that the Examining Attorney is not doubting the veracity of the sworn statement in Appellant's Statement of Use.

Not only do the trademark rules not support the Examining Attorney's position, but Appellant cannot find any case or holding that stands for this proposition. In fact, prior to appealing, Appellant's attorney contacted the Examining Attorney regarding this rejection to ask for supporting precedence for rejecting the product label on the basis that it contains advertising. Appellant's attorney was referred to the Examining Attorney's supervisor, Odette Bonet, who admitted she also could not find any supporting precedence for the rejection! Even in view of this, withdrawal of the rejection was refused.

TMEP § 904.05 states that any material whose mere function is to advertise the goods is generally not acceptable for showing trademark use. This rule is consistent with the situation at hand. Here, Appellant's specimen does not function as "mere" advertising for Appellant's "E-ACCESS" goods because the specimen is also a product label. Thus, under TMEP § 904.05 the specimen is proper.

6. Conclusion as to Trademark Use

For the above-stated reasons, the submitted specimen properly shows trademark use of "E-ACCESS" on the goods of the application. The Statement of Use should therefore be entered, and Appellant's amendment of the application to the Supplemental Register should likewise be entered.

B. Appellant's Goods are Not Indefinite, nor are they Broader than the Original Identification of Goods

1. Appellant's Goods are Properly Worded and Classified in International Class 9

The Examining Attorney's next ground of rejection is that Appellant's identification of goods is not proper because the goods may fall into more than one class, and because the amended identification is allegedly broader than the original identification.

Appellant's originally submitted identification of goods read as follows:

Electronic latches, handles and locks for vehicles in the nature of agricultural, construction, recreational, buses, heavy duty trucks, utility and emergency vehicles; pickup truck caps, covers and toolboxes; electronic locks for freestanding industrial enclosures in International Class 12.

In the Office Action dated 12/13/01, the Examining Attorney stated that if the goods were electronic locks for vehicles, the goods would be in class 9. Accordingly, in its response dated June 10, 2002, Appellant amended the goods to read as follows:

Latches and handles having electronic locks for vehicular applications, namely agricultural and construction equipment, motor homes, travel trailers, utility and service trucks, ambulance and fire trucks, bus and motor coaches, light/medium/heavy duty trucks, pick-up truck toppers/covers/toolboxes, off-road utility vehicles namely, all-terrain vehicles, lawn tractors, and golf cars and industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipment in International Class 9.

In the next Office Actions dated June 27, 2002 and December 30, 2002, the Examining Attorney stated merely that the requirement "to amend the identification of goods and related classification and additional class requirements" was continued and maintained. The Examining Attorney did not acknowledge Appellant's amendment to the identification of goods nor the amendment to Class 9 from June 27, 2002 response, and accordingly did not indicate that the amendment made to the goods was in any way improper.

It was not until the March 12, 2003 Office Action that the Examining Attorney seemed to acknowledge Appellant's amendment to the identification of goods from June of 2002. Here, the Examining Attorney again reinstated the requirement to amend the identification of goods and related classification from the December 13, 2001 Office Action, then stated that "the latches and handles are in Class 12 if they are parts of class 12 vehicle goods." Thus, the Examining Attorney appears to be requiring Appellant to classify its latches and handles having electronic locks in both Classes 9 and 12.

TMEP § 1401.05 sets forth the "Criteria on Which International Classification is Based." There it states that, "[g]oods intended to form part of another product are, in principle, only classified in the same class as the end product if they cannot also be used for other purposes." TMEP § 1401.05. In this case, Appellant's handles and latches form part of the end product, namely electronic locks, and are adapted to incorporate these electronic locks. The goods have therefore been properly classified in International Class 9.

2. Appellant's Amended Identification of Goods is Not Broader than the Original Identification

Finally, the Examining Attorney argues that Appellant's omission of the word "freestanding" in the amended identification of goods renders the amended identification broader than the original. This is not the case, however.

As set forth above, the original identification recited "electronic locks for freestanding industrial enclosures." Appellant was then required to more specifically describe these industrial enclosures. (12/13/01 Office Action). Appellant therefore amended this portion of the identification to read as follows: "enclosure systems that house and protect electrical, data communications, instruments and control equipment."

It is respectfully submitted that this amendment to the goods does not render it broader than the original. In fact, the identification of Appellant's enclosures is actually narrower since it specifies the types of items enclosed, while the original identification could broader encompass any items whatsoever. Appellant's identification is therefore proper.

III. CONCLUSION

For the above-stated reasons, Appellant's submitted specimen is proper for showing trademark use. The identification and classification of goods is also proper. Appellant therefore respectfully requests that the Examining Attorney's final refusal to register dated December 13, 2001 be reversed and Appellant's mark forwarded for publication.

It is not believed that there is a fee due for this appeal. In the event that there is a fee due for this appeal, please consider this a request to charge or debit Deposit Account No. 26-0084 accordingly.

Respectfully submitted,



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