

IN THE UNITED STATES TRADEMARK  
TRIAL AND APPEAL BOARD

In Re Application of: J & J Industries, Inc. )  
Serial Number: 76/231,818 )  
Filing Date: March 29, 2001 )  
For: LTP )

Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**BRIEF ON APPEAL**

**I. Prosecution History**

On March 29, 2001, applicant filed this application to register LTP, based on use in commerce (15 U.S.C. § 1051[a]) since February 1, 2001 and accompanied by specimens showing the mark as used in commerce. The goods were identified in the application as "carpeting". The specimen label is reproduced here:



J & J C O M M E R C I A L

STYLE: 6252 Liquid

COLOR: 8887 Fusion

YARN: 100% Nylon: J&J Encore® SD *Ultima*®

WIDTH: 12 Ft.

BACKING: Woven Synthetic

WARRANTIES: LTP™ Extended Warranty

In the initial Official Action of June 15, 2001, the Examining Attorney held the specimen to be unacceptable "...because it does not show use of the mark on the goods themselves or on packaging for the goods. Rather, the mark as shown on the specimen appears to identify an extended warranty."

On December 5, 2001, applicant responded to the rejection of its specimen as follows:

"Regarding the specimens, Rule 2.56 requires specimens of the mark, '...as used on or in connection with the goods in commerce.' Applicant submits that its specimens satisfy this requirement. Applicant is selling carpeting. Its specimens are labels which are applied to its carpeting. The labels, as the examining attorney has noted refer to an extended warranty. But those labels are applied to carpeting, which is the only product applicant is offering for sale. The goods are warranted but the goods are carpeting. Therefore, the mark LTP functions to distinguish applicant's goods, i.e. carpeting."

On January 22, 2002, the Examining Attorney held in a Final Action that

"The specimen is unacceptable as evidence of actual trademark use because it **does not show use of the mark for any goods identified in the application**. Rather, the specimen of record evidence use of the mark as a trademark for warranties, namely an extended warranty. Specifically, the specimen, a label, fails to establish that consumers would perceive the applicant's mark as anything other than an extended warranty."

On April 4, 2002 applicant submitted a Request for Reconsideration, attempting to amend the identification of goods in the application. It is as follows:

"Pursuant to Rule 64(b), Applicant asks that the above identified application be reconsidered in light of the following amendment.

Please amend the above identified application as follows:

Delete the present identification of goods and insert in its place - - - carpeting sold with an extended warranty. - - -

The present identification of goods, as amended, is consistent with the specimens originally filed, and consistent with the procedure indicated by TMEP 1401.06(b)."

On April 29, 2002, the Examining Attorney held that "The amended identification of goods is unacceptable." The reasons were specified as follows:

"The proposed amendment of the identification is unacceptable because the wording '**sold with an extended warranty**' designates services that are not within the scope of the identification that was set forth in the application at the time of filing. Please note 'Providing extended warranties on carpeting' is classified in International Class 36. **While an application may be amended to clarify or limit the identification, additions to the identification are not permitted.** 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07.

\* \* \* \* \*

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. **Therefore, the applicant may not amend to include any goods that are not within the scope of the goods set forth in the present identification.**"

On May 15, 2002, Applicant filed its Notice of Appeal.

On July 8, 2002, the Trademark Trial and Appeal Board ruled that applicant's Notice of Appeal was premature and remanded the cases to the Examining Attorney.

On July 11, 2002 the Examining Attorney issued a final Official Action refusing registration for the same reasons as expressed in the earlier Official Action of January 22, 2002.

On August 4, 2002 Applicant filed its Notice of Appeal as to the Official Action of July 11, 2002.

**II. Applicant has not Attempted to Expand Its Identification of Goods**

In its application, applicant initially identified its goods as "carpeting". When the

Examining Attorney refused registration and held the specimens to be unacceptable, applicant attempted to amend the identification of goods to "carpeting with an extended warranty".

Clearly, this was not an addition to the identification of goods, but rather a clarification and limitation. It was still carpeting, but more specifically "carpeting sold with an extended warranty."

### **III. The Specimens Submitted are Appropriate and Acceptable**

The Examining Attorney seems to want specimens that demonstrate applicant's use of its LTP mark in connection with the services of providing extended warranties for carpeting. But applicant offers no such service. Applicant manufactures and sells carpeting. Labels, such as the specimen label filed with this application, are applied to the carpeting. Customers and potential customers would associate the trademarks on the label with the product to which the label is attached, i.e. carpeting.

TMEP Section 804.08(b) reads in part as follows:

"When a mark is used to identify only a component or ingredient of a product, and not the entire product, the identification should precisely set forth the component or ingredient. In other words, when it is clearly indicated by the specimens or other material in the record that the mark relates only to a distinguishable part, component or ingredient of a composite or finished product, then the application should precisely describe that component or ingredient as the goods so there will be no doubt that the mark refers only to one part and not to the entire product. It is desirable also to indicate the types of finished products of which the identified components or ingredients form a part..."

Applicant submits that its proposed identification of its goods as "carpeting sold with an extended warranty" is consistent with this provision of the TMEP. It is not really a component

nor ingredient, but rather a specific aspect of the end product, i.e. it carries an extended warranty. Therefore, "carpeting sold with an extended warranty" is an accurate and appropriate identification. Applicant submits that the Examining Attorney erred by not accepting the proposed amendment to applicant's identification of goods; and erred in not accepting the specimens submitted as showing the mark as used on the goods in commerce.

Accordingly, applicant requests that these erroneous holdings of the Examining Attorney be reversed and the case remanded.

Respectfully submitted,

GIPPLE & HALE



J.W. Gipple

Gipple & Hale  
P.O. Box 40513  
Washington, D.C. 20016  
703-448-1774 x 302

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**I hereby certify that this paper is being deposited with the U.S. Postal Service, First Class, to the Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513, this 28<sup>th</sup> day of August, 2002.**

Date: 8/28/02

Signature: Lisa Lynn Bryant

TTAB

LAW OFFICES OF  
**GIPPLE & HALE**

P.O. BOX 40513  
WASHINGTON, D.C. 20016

TELEPHONE  
(703) 448-1770

E-MAIL  
GIPPHALE@EROLS.COM

6665-A OLD DOMINION DRIVE  
MCLEAN, VIRGINIA 22101

FACSIMILE  
(703) 448-7780

August 27, 2002

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2900 Crystal Drive  
Arlington, Virginia 22202-3513



09-06-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

Re: **Application No. 76/231,818**  
**Appeal Brief**  
**Our Ref.: TMB-5851**

Dear Sir:

Enclosed please find Applicant's Brief on Appeal in the above-identified trademark registration.

If you have any questions, please let us know.

Respectfully submitted,

GIPPLE & HALE

*J. W. Gipple*  
J.W. Gipple

JWG/llb  
Enclosure

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Signature: Lisa Lynn Bryant