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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cash Systems, Inc.

Serial Nos. 76461663

Timothy A. Czaja of Dicke, Billig, Czaja, PLLC for Cash Systems, Inc.

Brian Neville, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Chapman, Holtzman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 25, 2002, Cash Systems, Inc. (applicant) applied to register the mark ALL-IN-1 ATM in standard character form on the Principal Register for "automated teller machine (ATM) facilitating credit and POS debit card advances" in Class 9.¹ Applicant has disclaimed the term ATM.

The examining attorney has refused registration on the ground that applicant failed "to provide a specimen showing

¹ Serial No. 76461663. The application contains an allegation of a date of first use and first use in commerce of July 1, 2001.

use of the mark in commerce for the identified goods" as required by 15 U.S.C. § 1051(a). The specimen at issue is set out below.



The advertisement features a dark header with a stylized signal icon above the company name "cashsystemsinc" in a bold, lowercase font. Below the name is the product title "Cash Systems All-IN-1 ATM Package". The layout includes a circular inset image of an ATM on the left, a larger image of the ATM in the center, and a list of features and services on the right. At the bottom, there are logos for various payment methods and contact information.

cashsystemsinc

Cash Systems All-IN-1 ATM Package



Increasingly, Americans are depending on ATMs for their everyday banking needs. It is estimated that 65% of all banking transactions occur through ATMs and that ATM customers spend more money.

With Cash Systems All-IN-1 ATMs your customers will have access to a standard ATM, POS debit cash advances, and credit card cash advances. You will reduce time, risk and fees associated with accepting checks and credit cards. You will also generate income from each transaction and put more spending dollars into the hands of your customers.

By placing one of Cash Systems ATMs in your store, you will attract new customers while providing them with a safer environment than outdoor ATMs. You will have the ability to advertise by using electronic couponing, on-screen advertisement and the marketing of other dispensable items of value will help build your bottom line.



Cash System Solution (CCS)

- Free shipping, installation and programming
- Free training at the time of installation
- Free complete sign package
- Free 24 Hour support
- Free on-screen & panel advertising service
- Free couponing
- Free on-line reports
- No reporting or connection fees
- Warranties
- Highest residual payout

Dimensions

- 18.5" W (470 mm)
- 33.0" D (836 mm)
- 53.5" H (1360 mm)
- 1070 lbs. Weight (488 kg)

Customer Service

- Cash Systems offers a 24 hour help line
- Customer gets 24 hour servicing, optimizing convenience and cash in their hands
- Our web site also has a support knowledge base that will help with most issues

Features

- Optional LAN connectivity, dial-up or wireless communications
- Large 15" VGA color consumer display puts power behind your graphics and advertising messages.
- Easy-to-use telephone-style tactile Braille keypad or optional 16-key keypad
- Dot-matrix or thermal consumer printer prints receipts, coupons, graphics, landscape statements.
- New faster-action universal card reader
- Large multimedia capacity with up to four cassettes: Each holds approximately 3,000 notes (345 mm capacity).
- Cash Systems All-IN-1 ATM offers a standard ATM, POS debit and credit card cash advance transactions are all available at one machine.



For more information about Cash Systems All-IN-1 ATM Package or any of the services we offer please contact one of Cash Systems specialists at 877 900.8399, or E-Mail to info@cashsystemsinc.com, or visit our website at www.cashsystemsinc.com

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Both applicant and the examining attorney discuss the case of Lands' End Inc. Manbeck, 797 F. Supp. 311, 24 USPQ2d 1314 (E.D. Va. 1992). The examining attorney argues (Brief at page 4) that applicant's specimen "fails two of the three Land's End requirements: (1) providing ordering information and (2) showing the mark in such a manner as to associate the marks with the goods." Applicant, on the other hand, argues that the mark includes a picture of the goods, is sufficiently near the picture of the goods to associate the mark with the goods, and the specimen includes the information necessary to order the goods.

The Trademark Act § 1(a)(1) (15 U.S.C. § 1051(a)(1)) requires an applicant who is the owner of a trademark used in commerce to file "such number of specimens or facsimiles of the mark as used as may be required by the Director." For goods, a "mark shall be deemed to be in use in commerce ... [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 ... [and] the goods are sold or transported in commerce." Section 45, 15 U.S.C. § 1127. The Office currently requires the submission of one specimen with use-based applications (37 CFR § 2.56(a)) and it defines a trademark specimen as "a label, tag, or

container for the goods, or a display associated with the goods." 37 CFR § 2.56(b)(1).

In 1992, the Eastern District of Virginia decided the case of Lands' End Inc. v. Manbeck, 797 F. Supp. 911, 24 USPQ2d 1314 (E.D. Va. 1992). In that case, the court determined that a catalog page containing a picture of a purse in close association with the mark KETCH and ordering information constituted a display associated with the goods. Id. The court also held that "[s]pecimens are invalid for registration purposes only if they constitute mere advertising." Lands' End, 24 USPQ2d at 1316. In the present case, applicant's specimens are clearly advertising but the question is whether they are "mere advertising."

Relying on Lands' End, the Trademark Manual of Examining Procedure sets out the following test for determining whether advertising constitutes a display associated with the goods.

[E]xamining attorneys should accept any catalog or similar specimen as a display associated with the goods, provided: (1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods, (e.g., a phone number, mailing address, or e-mail address). Any form of advertising that satisfies these criteria should be construed as a display associated with the goods.

TMEP § 904.06(a) (3rd ed. May 2003).²

We now address whether the specimen of record constitutes "mere advertising" and, therefore, is not a valid specimen. Both applicant and the examining attorney agree that the specimen meets at least one of the factors in the Lands' End test, i.e., the specimen shows a photograph of the goods. Therefore, the first dispute is whether the specimen shows the mark sufficiently near the picture of the goods to associate the mark with the goods. The examining attorney argues that "the proposed mark blends in so well with other matter on [the] specimen that it is difficult or impossible to discern what the mark is, much less associate [it] with the goods." Brief at 4. The specimen shows that the term "Cash Systems All-IN-1 ATM Package" is used below the name "CashSystemsInc." The second paragraph begins with the following statement:

² Subsequent to the briefing in this case, a new edition of the TMEP (4th ed. April 2005) was issued that changed the parenthetical (Section 904.06(a), emphasis in original) of the previous edition of the TMEP:

[E]xamining attorneys should accept any catalog or similar specimen as a display associated with the goods, provided: (1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods, (e.g., an order form, or a phone number, mailing address, or e-mail address for placing orders). Any form of advertising that satisfies these criteria should be construed as a display associated with the goods.

"With Cash Systems All-IN-1 ATMs your customers will have access to a standard ATM." Under "Features," the specimen indicates that "Cash Systems All-IN-1 ATM provides a standard ATM" and the fine print at the bottom of the page refers to the "Cash Systems All-IN-1 ATM Package."

The specimen of record contains two pictures of ATM machines and above the pictures in large type is the phrase "Cash Systems All-IN-1 ATM Package." The term is repeated several times on the specimen. There is no other identified trademark associated with the goods on the page besides applicant's trade name. In a similar case, the board held that specimens for the mark QUIETCASE were not mere advertising even though the mark QUIETCASE was only listed among several features of the goods. The board pointed out that "the particular workstation is the only product on the webpage. Thus, it is clear that this is the product to which the trademark QUIETCASE refers." In re Dell Inc., 71 USPQ2d 1725, 1729 (TTAB 2004). Furthermore, the mark was only listed as the fifth feature in the sentence: "QUIETCASE™ acoustic environment provides easy access to the system interior and supports tool-less upgrades and maintenance of key internal components." The board determined that "QUIETCASE is sufficiently prominent that consumers will recognize it as a trademark." 71

USPQ2d at 1729. Here, applicant's mark appears four times on the specimen. It is used prominently in the phrase "Cash Systems All-IN-1 ATM Package." It is also used in the sentence beginning "[w]ith Cash Systems All-IN-1 ATMs, your customers will have access..." It is also listed as a feature of applicant's ATMs: "Cash Systems All-IN-1 ATM offers..." The overall impression of the page and the use of the term convince us that the term is used sufficiently near the picture of the goods to associate the mark with the goods. It appears to be the only term that potential customers would use to refer to the applicant's specific goods.

Therefore, the only remaining question is whether the specimen contains the information necessary to order the goods. In Lands' End, 24 USPQ2d at 1316, the customer was able to "identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone." In Dell, the board held that "[w]eb pages which display goods and their trademarks and provide for the on-line ordering of such goods are, in fact, electronic displays associated with the goods. Such uses are not merely advertising because in addition to showing the goods and features of the goods, they provide a link for ordering the goods." 71 USPQ2d at 1727.

For applicant's goods, the key part of the specimen that is at issue here is the fine print at the bottom of the page, which reads: "For more information about Cash Systems All-IN-1 ATM package or any of the services we offer please contact one of Cash Systems specialists at 877.600.8399 or E-Mail to info@cashsystemsinc.com or visit our website at www.cashsystemsinc.com." Applicant argues (Brief at 13) that the inclusion of a phone number, an email address, and a website "as well as the accompanying specifications and available options described in the body of the specimen, present the information necessary to order the goods." In a previous case, the board was not convinced that the simple presence of a phone number or mailing address constituted information sufficient to order the goods. In re MediaShare Corp., 43 USPQ2d 1304, 1307 (TTAB 1997).

Several factors convince us that the information necessary to order the goods is not present in this case. First, applicant itself describes its contact points as places to obtain "more information" about the "ATM Package or any of the services we offer." Applicant's email address is listed as info@cashsystems.com, which again suggests that the email address is used to request information rather than to order the goods. Second, the

specimen makes no mention either directly or indirectly of ordering the goods. No price is listed in the advertising. Applicant's specimen also indicates that purchasers "will have the ability to advertise by using electronic couponing, on-screen advertisement and the marketing of other dispensable items of value." The purchasing process for applicant's ATM's appears to be much more complicated than purchasing a purse as in Lands' End or even configuring a computer as in Dell. It is not clear how applicant's ATMs could even be purchased by means of the e-mail address identified in the specimen. Applicant's request to contact it by mail, email, or through its website is consistent with the informational nature of the specimen. Indeed, including the email address is an indication that applicant is interested in providing additional information as opposed to simply ordering the ATM because there clearly is not enough information to order the ATM by email.

When a customer calls a phone number for information, it does not necessarily mean that the customer can place an order. The caller may be referred to a local distributor of applicant's ATMs or the customer's name may be given to a salesman who will return the call. Applicant's specimen does not lead to "a decision to purchase by filling out the

sales form and sending it in or by calling in a purchase by phone." Lands' End, 24 USPQ2d at 1316. See also In re Hydron Technologies Inc., 51 USPQ2d 1531, 1534 (TTAB 1999) (Infomercial is "a basis upon which a customer can identify the products he or she wants to purchase, make the decision to purchase them, and place the order"). Here, applicant's specimen like most advertising simply attracts a prospective purchaser's attention and encourages the purchaser to obtain more information. See MediaShare, 43 USPQ2d at 1307 ("[A]ny material whose function is simply to tell a prospective purchaser about the goods or to promote the sale of the goods is unacceptable to support trademark use"). The simple addition of a phone number or a web address to an advertisement containing some product specifications does not automatically convert mere advertising into displays associated with the goods. It would not be unusual for an advertisement to contain some product information along with contact information such as a mailing or email address.

While virtually any advertising material can lead to a decision to purchase, to be a valid specimen of use in commerce, the specimen must not only show a picture of the goods in close proximity to the mark, but it must be "calculated to consummate a sale." In re Bright of

America, Inc., 205 USPQ 63, 71 (TTAB 1979). While applicant's specimen provides a prospective purchaser some clues that might lead to a purchase of the goods, the specimen is not calculated to consummate a sale. It is designed "to tell a prospective purchaser about the goods or to promote the sale of the goods." MediaShare, 43 USPQ2d at 1307. See also In re Schiapparelli Searle, 26 USPQ2d 1520, 1522 (TTAB 1993) ("No sales are made from applicant's brochures, which bear little resemblance to the mail-order catalog with order forms in Lands' End"). Therefore, the specimen is not acceptable to demonstrate use of the mark on displays associated with the goods.

Decision: The examining attorney's refusal to register for failing to provide a proper specimen is affirmed.