THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Hearing: April 10, 2008 Mailed: July 11, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sagoma Plastics, Inc.

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Serial No. 76576594

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James C. Wray of Law Offices of James C. Wray for Sagoma Plastics, Inc.

Ingrid Eulin, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

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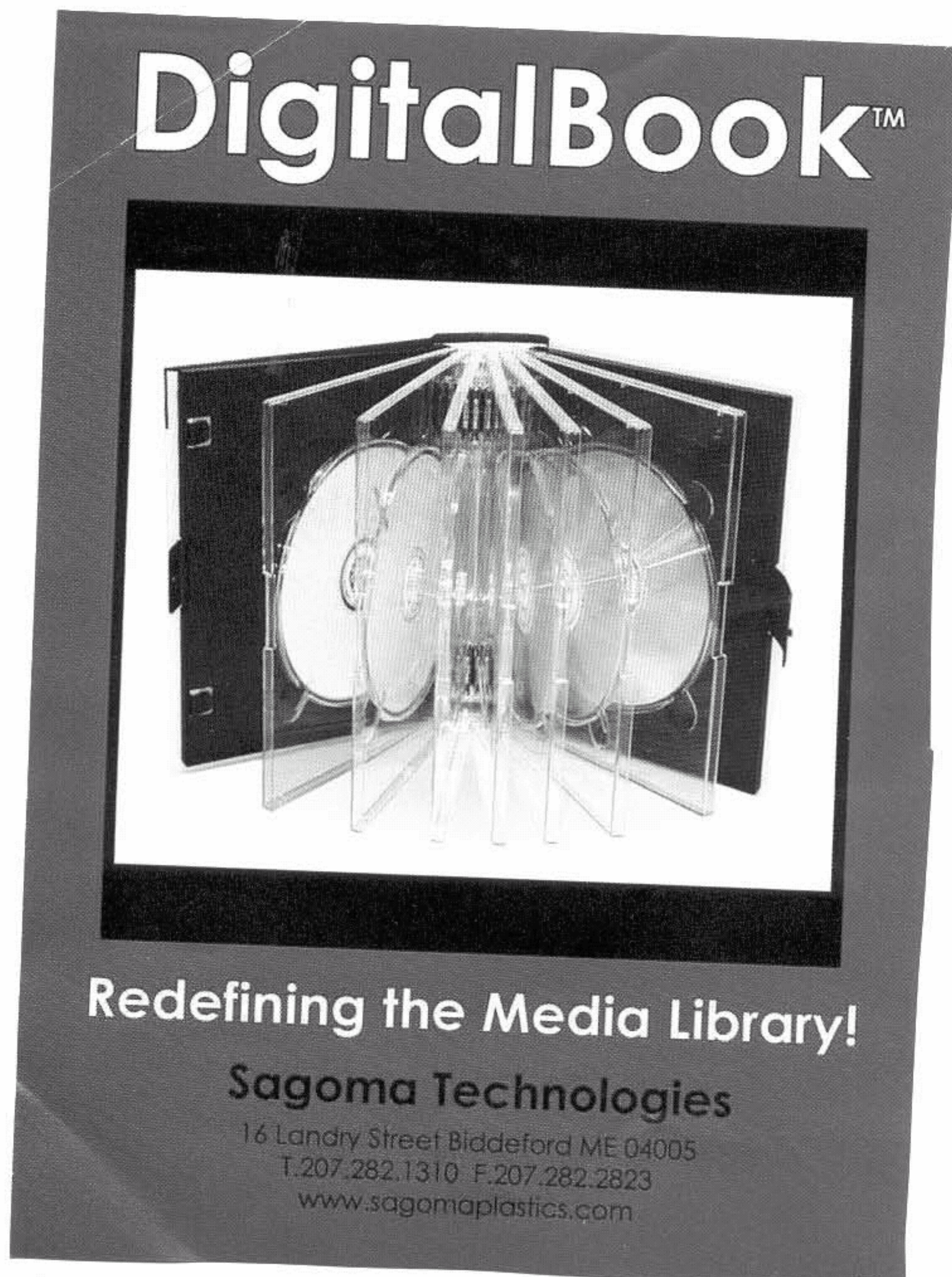
Before Seeherman, Grendel and Cataldo, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Sagoma Plastics, Inc. filed an application under Section 1(b) of the Trademark Act to register on the Principal Register the mark DIGITALBOOK, in standard character form, for goods identified as "binders and binding systems comprised of hinged clips, coordinated plastic or rigid pages for holding media tapes or discs, and stacked leaf-like trays for holding media tapes, discs, documents, small objects, and plastic or rigid disc

holders," in Class 16 (Serial No. 76576594). After the application was approved for publication and published for opposition, applicant submitted a statement of use accompanied by an advertisement as its specimen of use. The specimen is set forth below.



The trademark examining attorney refused registration on the ground that applicant's specimen does not show acceptable trademark use; namely, that the advertisement is not a display used in association with the goods. When the refusal was made final, applicant appealed.[1] Applicant and the examining attorney filed main briefs and applicant filed a reply brief. Applicant's request for an oral hearing was granted; and an oral hearing was held as scheduled on April 10, 2008.[2]

Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127, defines "use in commerce" in relevant part as follows:

> For purposes of this Act, a mark shall be deemed to be in use 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....

In accordance therewith, Trademark Rule 2.56(b)(1) provides

[1] With its request for reconsideration, applicant submitted a substitute specimen identified as a packing or shipping label affixed to its goods. Such substitute specimen subsequently was withdrawn and will not be further considered.

[2] We note that on April 14, 2008, applicant filed a communication entitled "Post Hearing Summary." Such a communication is not provided for under the Trademark Rules of Practice and, as such, has been given no consideration. *See* Trademark Rule 2.142(b)(1).

the following:

> 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.

The determination of whether a specimen is merely advertising or a display associated with the goods is a question of fact. *See In re Shipley Co.*, 230 USPQ 691, 694 (TTAB 1986). A display used in association with the goods is essentially a point-of-sale display designed to catch the attention of purchasers as an inducement to consummate a sale. *See In re Shipley Co.*, 230 USPQ at 694 ("A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location"); and *In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979).

In accordance with case law, TMEP §904.03(g) (5th ed. 2007) provides the following guidance:

> Displays associated with the goods essentially comprise point-of-sale material, such as banners, shelf-talkers, window displays, menus and similar devices.
>
> These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale....
>
> In order to rely on such material as specimens, an applicant must submit evidence of point-of-sale presentation.

Specifically with respect to catalogs, the TMEP provides that a catalog or similar display associated with the goods may be an acceptable specimen of use under the following conditions:

1. The catalog includes a photograph or picture of the goods;

2. The catalog displays the mark near the photograph of the goods so that consumers associate the mark and the goods; and,

3. The catalog 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). TMEP §904.03(h) (5th ed. 2007). "However, the mere inclusion of a phone number, Internet address and/or mailing address on an advertisement describing the product is not in itself sufficient to meet the criteria for a display associated with the goods. There must be an offer to accept orders or instructions on how to place an order." *See Id*. *See also In re MediaShare Corp.*, 43 USPQ2d 1304, 1306 (TTAB 1997) (fact sheets, catalogs, or brochures submitted as specimens were not displays associated with the goods, in part, because they did not include any information as to how to order the products or the terms and conditions under which the software was licensed).

Inasmuch as applicant's specimen clearly displays a photograph of the goods and displays the mark in close proximity to the goods such that consumers would associate the mark and the goods, the crucial factual issue in this case is whether applicant's specimen includes the information necessary to order applicant's binders and binding systems, thus making it a point-of-sale display. In this regard, applicant contends that its specimen includes its telephone number, mailing address and email address. Applicant argues that such information is sufficient to meet the requirement for including information necessary to order the goods.[3]

We note initially that there is no evidence in the record regarding how applicant sells its binders and binding systems or whether such goods may be purchased by telephone or the Internet. In this case, we have only counsel's statements to the effect that the information on the specimen of record is sufficient to order the goods. *See In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 60, 70 (TTAB 1983) ("Unfortunately we have no evidence of record to this effect and assertions in briefs are normally not recognized as evidence").

Upon examination of the advertisement submitted as

[3] Brief, p. 2-3.

applicant's specimen, we find that such specimen is more akin to the fact sheet, catalog page, or brochure submitted as specimens by the appellant in *In re MediaShare Corp.*, 43 USPQ2d 1304. In *MediaShare*, the Board noted that appellant's specimens lacked any purchasing information such as price or the conditions or terms on which appellant's software is licensed. Therefore, the inclusion of appellant's telephone number on the specimens was not sufficient to convert the specimens from mere advertising to displays used in association with the goods. *See In re MediaShare Corp.*, 43 USPQ2d at 1306. In this case, applicant's specimen does not contain any information normally associated with ordering products via the telephone or the Internet. For instance, there is no sales form, no pricing information, no offers to accept orders, and no special instructions for placing orders anywhere on the specimen. Applicant is asking us to infer from the face of the specimen that its customers may purchase applicant's goods through the telephone or through the Internet. However, at best applicant's advertisement provides applicant's telephone number and domain name as information about applicant; the telephone number and domain name do not constitute a means to order applicant's binders and binder systems by telephone or the Internet.

The present case is unlike the situation presented in *In re Valenite Inc.*, 84 USPQ2d 1346 (TTAB 2007), in which we found that appellant's webpage was an acceptable display used in association with the goods because it functioned as a point-of-sale display. The webpage contained links to appellant's "Technical Resource Center," including specification sheets, online calculators, and reference tables, as well as providing appellant's toll-free customer service telephone numbers. Accordingly, we found that appellant's webpage "provides an on-line catalog, technical information apparently intended to further the prospective purchaser's determination of which particular product to consider, an online calculator and both a link to, and phone number for, customer service information. Therefore, applicant's website provides the prospective purchaser with sufficient information that the customer can select a product and call customer service to confirm the correctness of the selection and place an order." *In re Valenite Inc.*, 84 USPQ2d at 1349-1350.

By contrast, the advertisement submitted as a specimen by applicant in this case provides no such information. Rather, and as noted above, such specimen merely contains applicant's contact information in the form of its address, telephone number and email address. As a result, after

considering the specimen submitted by applicant, and the arguments of both the applicant and the examining attorney, we find that applicant's specimen is not a display associated with the goods, and therefore is not acceptable to show trademark use of applicant's mark.

Decision: The refusal to register is affirmed.