PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

# Response to Office Action

**The table below presents the data as entered.**

| Input Field | Entered |
|---|---|
| **SERIAL NUMBER** | 76644223 |
| **LAW OFFICE ASSIGNED** | LAW OFFICE 111 |
| **MARK SECTION (no change)** | |
| **ARGUMENT(S)** | |

REQUEST FOR RECONSIDERATION

In the official action dated September 21, 2006, the Examining Attorney refuses Applicant's specimen c use because, in her opinion, the specimen is merely promotional material for Applicant's goods. Applic respectfully requests that the Examining Attorney reconsider and withdraw her refusal. Applicant's spec acceptable because it is a display associated with the goods.

In that regard, the Examiner is respectfully reminded that TMEP §904.06 instructs that a display may be as a trademark specimen. However, such a specimen must be associated directly with the goods offered and it must bear the trademark prominently. It is not necessary that the display be in close proximity to t *See In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 7 Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

As the Examining Attorney is aware, brochure display specimens must be designed to catch the attentio purchasers and prospective purchasers as an inducement to make a sale. Further, any such display must predominantly display the trademark in question and associate it with, or relate it to, the goods. The disp be related to the sale of the goods so that an association of the two is inevitable. *See In re Bright of Ame* 205 USPQ 63 (TTAB 1979), *See also In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980).

Applicant's specimen of use is a display associated with the goods because it fulfills the above criteria. Applicant reminds the Examining Attorney that the specimen in question is the Applicant's **Internet we**

In that regard, as TMEP §904.06(b) instructs, a **website page** that displays a product, and provides a me ordering the product, can constitute a "display associated with the goods," as long as the mark appears o page in a manner in which the mark is associated with the goods, and the web page provides a means fo the goods. The Trademark Trial and Appeal Board has held that web pages that display goods and their and provide for online ordering of such goods are, in fact, electronic displays which are associated with Such uses are *not* merely advertising or promotional materail, because in addition to showing the goods, provide a link for ordering the goods. In effect, the website is an electronic retail store, and the web pag talker or banner which encourages the consumer to buy the product. A consumer using the link on the w purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashi

to purchase it. The web page is thus a point of sale display by which an actual sale is made. *In re Dell Ir* USPQ2d 1725 (TTAB 2004).

In the case subjudice, Applicant's specimen is a printout of Applicant's online goods brochure, which di mark prominently, includes a detailed description of Applicant's goods, pricing of Applicant's goods, ai to order Applicant's goods - either by contacting the Applicant itself, or by contacting one of the Applic "*Authorized Dealers.*" In effect, the Applicant's website is an electronic retail store, and - as suggested a web page acts *exactly* like a shelf-talker or banner which encourages the consumer to buy the product. T appreciate this, one only needs to look at the Product Info and Product Research sections of the website feature a graphical "shelf talker" type product comparison titled "Better Wood Across the Board."

A consumer using Applicant's online website brochure to purchase Applicant's goods can easily be seei equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it. Applicant's web page brochure is thus ***a point of sale display*** by which an actual sale is made. Accordii despite the Examining Attorney's arguments to the conrtrary, the website specimen is an acceptable spec use.

In addition, while Applicant concedes that the decisions of one Examining Attorney have no bearing on determinations of another, the Examining Attorney here is respectfully informed that the specimen in qu **already been accepted in another application.** In that regard the Examining Attorney is respectfully c U.S. Trademark Registration No. 3,209,927 for the mark SAFER SOLUTIONS THROUGH SCIENCE. application, the specimen was *exactly the same* as the one in this case. However, in Registration No. 3,: specimen was found to be acceptable.

In view of the foregoing, the Examining Attorney should reconsider and withdraw her refusal, and accej Applicant's specimen of use.

Conclusion

In view of the above, Applicant respectfully requests the acceptance of its specimen of use, and the appı application for publication. Further action is respectfully solicited.

Respectfully submitted,

Steven D. Lustig

Attorney for Applicant

| SIGNATURE SECTION | |
|---|---|
| RESPONSE SIGNATURE | /Steven D. Lustig/ |
| SIGNATORY'S NAME | Steven D. Lustig |
| SIGNATORY'S POSITION | Attorney for Applicant |

| | |
|---|---|
| DATE SIGNED | 03/07/2007 |
| AUTHORIZED SIGNATORY | YES |
| **FILING INFORMATION SECTION** | |
| SUBMIT DATE | Wed Mar 07 15:28:54 EST 2007 |
| TEAS STAMP | USPTO/ROA-66.7.44.242-20070307152854706093-7664422 3-37063b6aac458d8f8f9a5936dc2666345a-N/A-N/A-20070307145359909961 |

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OMB No. 0651-0050 (Exp. 04/2009)

## Response to Office Action

## To the Commissioner for Trademarks:

Application serial no. **76644223** has been amended as follows:
**Argument(s)**
In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

In the official action dated September 21, 2006, the Examining Attorney refuses Applicant's specimen of use because, in her opinion, the specimen is merely promotional material for Applicant's goods. Applicant respectfully requests that the Examining Attorney reconsider and withdraw her refusal. Applicant's specimen is acceptable because it is a display associated with the goods.

In that regard, the Examiner is respectfully reminded that TMEP §904.06 instructs that a display may be acceptable as a trademark specimen. However, such a specimen must be associated directly with the goods offered for sale, and it must bear the trademark prominently. It is not necessary that the display be in close proximity to the goods. *See In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

As the Examining Attorney is aware, brochure display specimens must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, any such display must predominantly display the trademark in question and associate it with, or relate it to, the goods. The display must be related to the sale of the goods so that an association of the two is inevitable. *See In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979), *See also In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980).

Applicant's specimen of use is a display associated with the goods because it fulfills the above criteria.

Moreover, Applicant reminds the Examining Attorney that the specimen in question is the Applicant's **Internet website**.

In that regard, as TMEP §904.06(b) instructs, a **website page** that displays a product, and provides a means of ordering the product, can constitute a "display associated with the goods," as long as the mark appears on the web page in a manner in which the mark is associated with the goods, and the web page provides a means for ordering the goods. The Trademark Trial and Appeal Board has held that web pages that display goods and their trademarks and provide for online ordering of such goods are, in fact, electronic displays which are associated with the goods. Such uses are *not* merely advertising or promotional materail, because in addition to showing the goods, they provide a link for ordering the goods. In effect, the website is an electronic retail store, and the web page is a shelf-talker or banner which encourages the consumer to buy the product. A consumer using the link on the web page to purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it. The web page is thus a point of sale display by which an actual sale is made. *In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004).

In the case subjudice, Applicant's specimen is a printout of Applicant's online goods brochure, which displays the mark prominently, includes a detailed description of Applicant's goods, pricing of Applicant's goods, and a means to order Applicant's goods - either by contacting the Applicant itself, or by contacting one of the Applicant's "*Authorized Dealers*." In effect, the Applicant's website is an electronic retail store, and - as suggested above - the web page acts *exactly* like a shelf-talker or banner which encourages the consumer to buy the product. To fully appreciate this, one only needs to look at the Product Info and Product Research sections of the website which feature a graphical "shelf talker" type product comparison titled "Better Wood Across the Board."

A consumer using Applicant's online website brochure to purchase Applicant's goods can easily be seen as the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a store to purchase it. Applicant's web page brochure is thus ***a point of sale display*** by which an actual sale is made. Accordingly, despite the Examining Attorney's arguments to the conrtrary, the website specimen is an acceptable specimen of use.

In addition, while Applicant concedes that the decisions of one Examining Attorney have no bearing on the determinations of another, the Examining Attorney here is respectfully informed that the specimen in question has **already been accepted in another application.** In that regard the Examining Attorney is respectfully directed to U.S. Trademark Registration No. 3,209,927 for the mark SAFER SOLUTIONS THROUGH SCIENCE. In that application, the specimen was *exactly the same* as the one in this case. However, in Registration No. 3,209,927 the specimen was found to be acceptable.

In view of the foregoing, the Examining Attorney should reconsider and withdraw her refusal, and accept Applicant's specimen of use.

Conclusion

In view of the above, Applicant respectfully requests the acceptance of its specimen of use, and the approval of its application for publication. Further action is respectfully solicited.

Respectfully submitted,

Steven D. Lustig

Attorney for Applicant

**Response Signature**
Signature: /Steven D. Lustig/ Date: 03/07/2007
Signatory's Name: Steven D. Lustig
Signatory's Position: Attorney for Applicant

The signatory has confirmed that he/she is either (1) an attorney who is a member in good standing of the bar of the highest court of a U.S. state; or (2) a Canadian attorney/agent who has been granted reciprocal recognition under 37 C.F.R. §10.14(c) by the USPTO's Office of Enrollment and Discipline. He/she further confirms that (1) the applicant has not previously been represented in this matter by an authorized attorney; and (2) he/she is the applicant's attorney or an associate of that attorney.

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66345a-N/A-N/A-20070307145359909961