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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Manual Woodworkers & Weavers Inc.

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Serial No. 76653876

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Eric G. Zaiser of Dority & Manning, PA for The Manual Woodworkers & Weavers Inc.

Michael P. Keating, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

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Before Kuhlke, Taylor and Bergsman, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

The Manual Woodworkers & Weavers Inc. has filed an application to register the mark WOVEN MOMENTS, in standard character format, on the Principal Register for goods ultimately identified as "kits consisting primarily of a box, an order form, a mailer, and an authorization key code, sold together as a unit, for use in submitting an image and obtaining blanket throws and tapestries bearing

the image" in International Class 24.[1] The application includes a disclaimer of WOVEN apart from the mark as a whole.

The trademark examining attorney has refused registration on the ground that the identified goods are not goods in trade under Trademark Act Sections 1, 2 and 45, 15 U.S.C. § 1051-1052 and 1127. When the refusal was made final, applicant appealed and requested reconsideration of the final refusal. On December 6, 2007, the examining attorney denied the request for reconsideration and, on December 27, 2007, the appeal was resumed. Both applicant and the examining attorney filed briefs. For the reasons discussed below, we affirm the refusal to register.

As the examining attorney aptly points out, the crux of the issue on appeal is whether the proposed mark identifies "goods in trade;" that is, whether applicant's mark WOVEN MOMENTS is being used to identify goods that are sold or transported in commerce or that have utility to others.

At the outset, we note that we have thoroughly reviewed all of the arguments and the evidence presented by

[1] Serial No. 76653876, filed January 20, 2006, and alleging November 1, 2005 as the date of first use of the mark anywhere and in commerce.

both applicant and the examining attorney, even if such is not specifically mentioned herein. The parties' primary arguments are set forth below. The examining attorney maintains that the goods on which applicant's mark is used are not "goods in trade" because the mark is not being used to identify goods that are sold or transported in commerce or that have utility to others. The examining attorney particularly argues (emphasis supplied):

> In this case, the identified goods are kits used to obtain custom imprinted items from applicant. The kits do not give purchasers or consumers the ability to obtain custom imprinted blanket throws and tapestries from any sources other than applicant. A consumer cannot take the kits and its components to a source other than applicant to obtain the throws and tapestries. Rather, the purchase price includes the right to obtain customized woven products from applicant itself as part of its custom imprinting services. As such, the kits are only incidental items used by applicant in the ordinary course of business.
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> In addition, it is clear that in order to be "goods in trade" as those terms are understood by the Trademark Act, the goods for which registration is sought must have utility to others on a commercial scale, i.e., utility as a type of product named in the application. TMEP § 1202.06(a). Thus, the identified goods must have utility to others as a kit for use in submitting an image and obtaining blanket throws and tapestries bearing that image. As shown by the record, the kits have no such utility to consumers. Rather, the kits are only

> designed to obtain goods from applicant as part of applicant's custom imprinting business. It is clear that because the cost of the kit includes the imprinting of the image by applicant, other manufacturers will not accept the kit for use in obtaining their goods, i.e., the kits are for use only in obtaining finished goods from applicant.

(Brief, unnumbered p. 6). The examining attorney submitted web pages from applicant's website as well as from www.style-boutique.com and the catconnection.com, all featuring applicant's kits.

Applicant, on the other hand, maintains that its kits are "goods in trade" because they have a value recognized by consumers. Applicant particularly contends:

> Applicant uses WOVEN MOMENTS as a trademark; that is, Applicant places WOVEN MOMENTS on kits which move in commerce, with WOVEN MOMENTS used to identify and distinguish the kits from those manufactured and sold by others, and to indicate the source of the kits. Consumers recognize and treat Applicant's kits as goods. Thus Applicant's activity falls within the letter and the spirit of the Lanham Act, which compels registration. Moreover, since the kits move in commerce and have a substantial utility to others, the "goods in trade" refusal is inapplicable under present law, and should be reversed.

(Brief, p. 8). Applicant further contends that its kits are a unique product, that a consumer in possession of the kits possesses a product that entitles him or her to

receive a tapestry product at no extra charge, that its kits are bought, sold, exchanged and gifted by consumers as part of a trade in kits, and that the uniqueness of its kits is not a valid ground for refusing registration. Applicant has submitted copies of web pages from the websites eBay.com and amazon.com featuring its WOVEN MOMENT kits.

Section 1 of the Trademark Act, 15 U.S.C. § 1051, permits registration of a trademark that has been used in commerce. The Act defines a "trademark" as a mark which is used by a person to "identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if the source is unknown." Trademark Act Section 45, 15 U.S.C. § 1127. The same section indicates that a mark shall be deemed to be in use in commerce on goods 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." Thus, a necessary prerequisite to the establishment of rights in, and the registration of, a term as a trademark is that the subject matter to which the term is applied must be goods. Gay Toys, Inc. v. McDonald's Corp., 585 F.2d 1067, 199 USPQ 722 (CCPA 1978). However,

incidental items that an applicant uses in conducting its business (such as letterhead, invoices and business forms), as opposed to items sold or transported in commerce for use by others, are not "goods in trade." *See e.g.*, In re Shareholders Data Corp., 495 F.2d 1360, 181 USPQ 722 (CCPA 1974)(reports not goods in trade, where applicant is not engaged in the sale of reports, but solely in furnishing financial reporting services, and reports are merely conduit through which services are rendered); In re Compute-Her-Look, Inc., 176 USPQ 445 (TTAB 1972)(reports and printouts not goods in trade, where they are merely the means by which the results of a beauty analysis service is transmitted and have no viable existence separate and apart from the service); and Ex Parte Bank of America National Trust and Savings Association, 118 USPQ 165 (Comm'r Pats. 1958)(mark not registrable for passbooks, checks and other printed forms, where forms are used only as necessary tools in the performance of banking services, and the applicant is not engaged in printing or selling forms as commodities in trade).

In addition, simply affixing a mark to an item that is transported in commerce does not in and of itself establish that the mark is used on "goods." That is, items sold or transported in commerce are not goods in trade unless they

have utility to others as the type of product named in the application. *See. e.g.*, Gay Toys v. McDonald's Corp., *supra.* (plaster mockup of toy truck not goods in trade, where there is no evidence the mockup is actually used as a toy); Paramount Pictures Corp. v. White, 31 USPQ2d 1768 (TTAB 1994), aff'd, 108 F.3d 1392 (Fed. Cir. 1997) (mark not registrable for games, where purported games are advertising flyers used to promote applicant's services and have no real utilitarian function).

In the present case, while applicant's kits consisting primarily of a box, an order form, a mailer, and an authorization key code ("kits") are items that are sold in commerce, we nonetheless find that they are not goods in trade. There is no evidence that applicant is a manufacturer of boxes, order forms, mailers and/or authorization key codes (otherwise referred to by applicant as "redemption keys")[2] or that applicant is engaged in selling its kits for purposes other than providing a means by which purchasers of applicant's custom imprinting services and/or custom imprinted blanket throws and tapestries can provide proof of purchase of such blanket throws and tapestries to applicant and submit their desired

[2] Brief at p. 7.

image to applicant for imprinting. In addition, we are not persuaded by applicant's argument that its kits have additional utility such that they constitute goods in trade because they are sold by third parties, may be given as gifts or may be resold. Applicant's contention that consumers are purchasing applicant's kits to use the individual components, i.e., a box, order form, mailer and authorization key, as a general purpose kit to obtain custom imprinting services and/or custom imprinted blanket throws and tapestries from applicant, simply underscores that the kits are not goods in trade but rather merely a marketing device to sell applicant's actual goods and/or services. For example, the advertising copy for one eBay listing of applicant's kits states:

> You are buying a Woven Moments Photo to Tapestry Baby Throw Kit … that transforms your favorite photo into a woven heirloom. Perfect for 1st Birthday's, Mother's Day, Father's Day, Graduations, Reunions, Weddings- Remember loved one in a special and unique way.
>
> This is as easy as 1) Purchase the Kit and give the kit itself as a gift or 2) Select the perfect photo and 3) Submit your selected image as a photo, digital CD or upload to Manual Woodworkers & Weavers website.
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> Your Woven Heirloom will arrive ready to display in approximately 4-6 weeks, made in the USA of 100% cotton to

> display as a wall hanging, on a sofa, or over the top of the bed.
>
> The shipping fee to you is included with the price of the kit from the Manual Woodworkers & Weavers factory unless shipping outside the Continental United States.

(Req. for Recon., Exh. C). In short, nothing convinces us that applicant trades in kits consisting primarily of a box, an order form, a mailer and an authorization key code or, as applicant contends, that consumers recognize these kits as goods in trade, as opposed to the means to acquire applicant's custom imprinting services.

In this regard, the record reveals that applicant is seeking to register a marketing technique or method for its custom imprinting services and/or its custom imprinted tapestries and blanket throws. By this unique marketing method or process, a consumer can purchase a tangible stand-in for applicant's custom imprinting services and/or custom imprinted tapestries and blanket throws that can be merchandised and sold, thus giving retailers a competitive advantage, or gifted and/or resold. However, a technique, method or process is only a way of doing something, and by itself is not an activity for the benefit of others. A term that merely designates a process, or is used only as the name of a process, is not registrable as a service mark

[or trademark]. See In re Universal Oil Products Co., 167 USPQ 245 (TTAB 1970), aff'd, 177 USPQ 456 (CCPA 1973)(alleged marks used only in the context of a process and not in association with provision of the services); In re Griffin Pollution Control Corp., 517 F.2d 1356, 186 USPQ 166 (CCPA 1975)(alleged mark identifies a water treatment process but is not used as a mark); In re Hughes Aircraft Co., 222 USPQ 263 (TTAB 1984)(proposed used only in connection with a photochemical method, and there was no association between the applicant's offer of services and the proposed mark); and In re J.F. Pritchard & Co., 201 USPQ 951 (TTAB 1979)(proposed mark used only to identify liquefaction process, and not used in association with design and construction services).

We thus conclude that applicant's kits consisting primarily of a box, an order form, a mailer, and an authorization key code are not goods in trade.[3]

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[3] In the event applicant's goods were not found to be goods in trade, applicant requested the Board to "clarify the 'goods in trade' jurisprudence so that the 'utility' requirement is consistent with statutory law; that is, that the "determination of traded items as 'goods in trade' should depend on how consumers view the traded items. If an applicant moves items as part of a bona find trade, and consumers treat such items as goods, then the items should be found to be 'goods in trade.'" (Brief p. 14). For the reasons discussed above, we find no such clarification necessary. Nonetheless, it is clear that applicant seeks protection for its WOVEN MOMENTS mark. It is also apparent from this record that applicant is engaging in custom imprinting services and trades in custom imprinted blanket throws and

Decision: The refusal to register under Sections 1, 2 and 45 of the Trademark Act is affirmed.

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tapestries. We particularly observe that applicant's kits, sold under the WOVEN MOMENTS mark, would suffice as specimens for applicant's custom imprinting services, as they show the mark as it is actually used in the sale and advertising of applicant's services and identify the source of those services. Similarly, the display showing applicant's kits and a sample throw (Exhibits to the Office Action issued October 16, 2006) suffice as a display associated with the sale of applicant's custom imprinted blanket throws and tapestries, as the display serves as point of sale material.