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Subject: U.S. TRADEMARK APPLICATION NO. 77501020 - ORGANIZED GOES
BEYOND ORDINARY - 766.0060UST1 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77501020

MARK: ORGANIZED GOES BEYOND ORDINARY



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**BEFORE THE
TRADEMARK TRIAL AND APPEAL
BOARD
ON APPEAL**

APPLICANT: DV International, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

766.0060UST1

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, DV International, Inc., has appealed the refusal of registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2), on the ground that the specimen of record does not show the applied-for mark in use in commerce as a trademark.

FACTS

On June 17, 2008, applicant filed an application under Section 1(b) of the Trademark Act seeking registration on the Principal Register of the proposed mark

ORGANIZED GOES BEYOND ORDINARY for goods identified as “Plastic storage containers for household or domestic use”.

On October 22, 2008, following a review of the records of the United States Patent and Trademark Office (the “Office”), the application was approved for publication.

On February 3, 2009, the Office issued a Notice of Allowance.

On August 3, 2009, applicant filed a Statement of Use with specimen.

On September 11, 2009, an Office action was issued requiring a substitute specimen.

On March 11, 2010, applicant filed a response to office action, arguing against the specimen refusal.

On March 25, 2010, a final refusal of the specimen was issued.

The present appeal ensued.

ISSUE PRESENTED

Whether the specimen of record meets the requirements of 15 U.S.C. §1127 by showing use of the mark in commerce on the goods, on their containers or the displays associated therewith, or on the tags or labels affixed thereto, or whether the specimen of record is merely advertising material for the goods.

ARGUMENT

The power of the federal government to register trademarks is predicated on the Commerce Clause of the United States Constitution. U.S. Const. Art. I, Sec. 8, Cl. 3. Accordingly, the Trademark Act requires that a mark be in use in commerce prior to the issuance of a trademark registration. 15 U.S.C. §1051(d)(1). To show use in commerce, 15 U.S.C. §1127 requires that a mark be “placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto.” 15 U.S.C. §1127. In In re Quantum Foods, Inc., the Trademark Trial and Appeal Board (the “TTAB” or the “Board”) discussed the requirements for a web page display specimen:

[A] website page which 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 webpage in a manner in which the mark is associated with the goods . . . Web pages which display goods and their trademarks and provide for the on-line ordering of such goods are, in fact, electronic displays which are associated with the goods. Such uses are not merely advertising, because in addition to showing the goods and the features of the goods, they provide a link for ordering the goods. In effect, the website is an electronic retail store, and the webpage is a shelf-talker or banner which encourages the consumer to buy the product. A consumer using the link on the webpage to purchase the goods is the equivalent of a consumer seeing a shelf-talker and taking the item to the cashier in a brick and mortar store to purchase it. In re Quantum Foods, Inc., 94 U.S.P.Q.2d 1375, (TTAB 2010) (quoting In re Dell Inc., 71 U.S.P.Q.2d 1725 (TTAB 2004)).

In analyzing the sufficiency of a web page display specimen, the Federal Circuit in In re Sones advised the TTAB to consider such factors as whether the webpage display has a "point of sale nature" and “whether the actual features or inherent characteristics of the goods are recognizable from the textual description, given that the more standard the

product is, the less comprehensive the textual description need be.” In re Sones, 590 F.3d 1282, 1289 (Fed. Cir. 2009).

Applicant, in the present case, has applied to register the mark “ORGANIZED GOES BEYOND ORDINARY” for “Plastic storage containers for household or domestic use.” The specimen submitted by Applicant consists of a single web page showing the applied-for mark, a partial image of what appears to be a plastic container with the inscribed wording “MADE SMART ®,” and the word “SKIP” at the bottom. The specimen does not associate the mark with the goods because the plastic storage containers are neither visually discernible from the specimen, nor is there a textual description of the goods. Further, the web page does not provide a means for ordering the plastic storage containers.

Applicant argues that a display specimen need not provide a direct way to purchase the identified goods. (Applicant’s Appeal Brief at 3.) However, the Board has previously advised that “an Internet web page that merely provides information about the goods, but does not provide a means of ordering them, is viewed as promotional material, which is not acceptable to show trademark use on goods.” In re Quantum Foods, Inc., 94 U.S.P.Q.2d 1375 (TTAB 2010); See also, In re Sones, 590 F.3d at 1289 (“On remand, the PTO must consider the evidence as a whole to determine if Sones' specimen sufficiently associates his mark with his charity bracelets so as to ‘identify and distinguish the goods.’ Relevant factors include, for example, whether Sones' webpages have a ‘point of sale nature,’ and whether the actual features or inherent characteristics of the goods are recognizable from the textual description, given that the more standard the product is, the less comprehensive the textual description need be.”) Since Applicant’s specimen neither

provides a means of purchasing the plastic containers nor includes a visually discernible picture or textual description of the goods, the specimen does not serve as evidence of use in commerce.

CONCLUSION

For these reasons, the refusal of registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2), on the ground that the specimen of record does not show the applied-for mark in use in commerce as a trademark is warranted.

It is respectfully requested that the refusal of registration be affirmed.

Respectfully submitted,

/ses/

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