

Applicant:	Modern Builders Supply, Inc.	:	BEFORE THE
Trademark:	ENERGYWELD	:	TRADEMARK TRIAL
Serial No:	78/062671	:	AND
Attorney:	Oliver E. Todd, Jr. MacMillan, Sobanski & Todd, LLC	:	APPEAL BOARD
Address:	1 Maritime Plz Fl 4 Toledo, OH 43604-1853	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant appealed the examining attorney's Final Action refusing registration of the trademark ENERGYWELD for "non-metal windows and doors" on the grounds that the specimen is unacceptable as evidence of actual trademark use. 37 C.F.R. §§2.56 and 2.88(b)(2), TMEP §§904.04, 904.05 and 904.07.

STATEMENT OF FACTS

On May 9, 2001, the applicant applied for registration on the Principal Register of the trademark ENERGYWELD for "non-metal windows and doors." The application was approved for publication on August 13, 2001. On September 12, 2001, a Notice of Publication was issued and, on October 2, 2001, the trademark was published for opposition.

On December 25, 2001, a Notice of Allowance issued. On May 20, 2002, the applicant filed a Statement of Use. The examining attorney issued a Non-Final Office Action on July 2, 2002, refusing registration on the grounds that the specimen was unacceptable as evidence of actual trademark use. On October 10, 2002, the applicant

responded by presenting arguments against the refusal. Not persuaded by the applicant's arguments, the examining attorney issued a Final Action on December 2, 2002.¹

On May 22, 2003, the applicant filed its Notice of Appeal and, on July 22, 2003, the applicant filed its Brief appealing the examining attorney's Final Action.

ISSUE

WHETHER THE APPLICANT'S SPECIMEN IS UNACCEPTABLE AS EVIDENCE OF ACTUAL TRADEMARK USE UNDER 37 C.F.R. §§2.56 and 2.88(b)(2), TMEP §§904.04, 904.055 and 904.07.

ARGUMENT

THE APPLICANT'S SPECIMEN IS UNACCEPTABLE AS EVIDENCE OF ACTUAL TRADEMARK USE UNDER 37 C.F.R. §§2.56 and 2.88(b)(2), TMEP §§904.04, 904.05 and 904.07.

For a trademark application under §1(a) of the Trademark Act or an amendment to allege use or statement of use in an application under §1(b) of the Act, the specimen must show the mark as used on or in connection with the goods in commerce. TMEP §904.04. A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. 37 C.F.R. §2.56(b)(1).

In most cases, where the trademark is applied to the goods or the containers for the goods by means of labels, a label is an acceptable specimen. TMEP §904.04(a). Shipping or mailing labels may be accepted if they are affixed to the goods or to the containers for the goods and if proper trademark usage is shown. *Electronic*

¹ The application was re-assigned to the current examiner on November 1, 2002.

Communications, Inc. v. Electronic Components for Industry Co., 443 F.2d 487, 170 USPQ 118 (8th Cir. 1971), *cert. denied* 404 U.S. 833 (1971); *In re A.S. Beck Shoe Corp.*, 161 USPQ 168 (TTAB 1969).

Advertising material is generally not acceptable as a specimen for goods. TMEP §904.05. Any material, whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use. Similarly, informational inserts are generally not acceptable to show trademark use. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979). However, an instruction sheet may be an acceptable specimen. *In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984).

If material inserted in a package with the goods is merely advertising material, then it is not acceptable as a specimen of use on or in connection with the goods. Material that is only advertising does not necessarily cease to be advertising because it is placed inside a package. TMEP §904.07.

The applicant's specimen is unacceptable as evidence of actual trademark use because it does not show the mark as used on or in connection with the identified goods. TMEP §904.04. The applicant's goods are "non-metal windows and doors" and the specimen submitted is a label shown on a window. A copy of each specimen label submitted is attached for the Trademark Trial and Appeal Board's convenience. Although the specimen submitted is a label, the specimen does not show use of the mark for any goods identified in the Statement of Use. The applicant must submit a specimen

showing use of the mark for the goods/services specified. 37 C.F.R. §§2.56 and 2.88(b)(2); TMEP §1109.09(b).

In this case, the specimen label does not show use of the proposed mark for windows and doors. The mark on the specimen is for “other fine Polaris® products” which, as far as can be told by the specimen, could be for goods not specified in the application, e.g. window locks or door locks. Although, in this case, the label would be acceptable for the mark POLARIS, it is not acceptable for the proposed mark.

The applicant argues that

[t]he . . . mark ENERGYWELD is prominently displayed on the specimen label that is placed on the goods or their packaging when the goods are sold or transported in commerce. At the very least, prominent display of the Appellant’s mark ENERGYWELD on the specimen label which is placed on the goods or their packaging when sold or transported in commerce is a display associated with the goods and meets the requirements for demonstrating use of a mark in commerce within the meaning of the Lanham Act.

Assuming *arguendo* that the specimen label is considered a display, the specimen still does not show use of the mark for any goods identified in the Statement of Use. The specimen label only mentions the proposed mark in connection with a directive that promotes “other fine Polaris® products” that are associated with the mark. Therefore, whether or not the specimen is considered a display is of no consequence.

The applicant’s specimen is unacceptable as evidence of actual trademark use because it functions as advertising material. 37 C.F.R. §§2.56 and 2.88(b)(2), TMEP §§904.04, 904.05 and 904.07. Although the specimen submitted is a label shown on a window, the specimen label is not acceptable because, as it relates to the proposed mark, it functions as mere advertising material.

The applicant's specimen label functions as advertising material in that it tells the prospective purchaser about and promotes the sale of "other" products or goods, including those goods that are associated with the proposed mark. The specimen label does not cease to be advertising material merely because it also includes installation instructions related to a different mark and is shown on a window. Even if the specimen label was acceptable to show proper trademark usage for the mark POLARIS®, it does not make it acceptable for the proposed mark ENERGYWELD.

The applicant argues that "[t]he specimen label includes installation instructions for all Polaris window and patio doors and is not merely advertising material for the proposed mark." While the specimen label does include installation instructions for "POLARIS WINDOWS AND DOORS," those instructions are not for the "other fine Polaris® products" amongst which the proposed mark is mentioned. The applicant concedes that "[t]he registered trademark POLARIS referred to on the label is [its] house mark for its window and door line while the other trademarks shown on the label are secondary product marks." The specimen label only mentions the proposed mark ENERGYWELD in connection with "other fine Polaris® products" that the prospective purchaser is directed to "look for," and not in connection with the product upon which the label is shown.

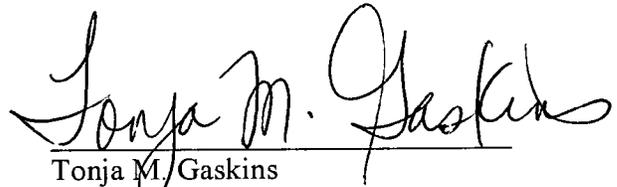
As the specimen clearly shows, the proposed mark ENERGYWELD is displayed at the bottom portion of the label below a line that separates it from the rest of the label with the POLARIS® windows and doors installation instructions. The bottom portion of the label specifically reads, "Look for these other fine Polaris® products . . ." and then lists the proposed mark in a litany of nineteen marks. The proposed mark is merely

identified as one of several marks associated with “other fine Polaris products” that the prospective purchaser is directed to “look for.” It is clear that the purpose of the directive is to tell the prospective purchaser about or promote the sale of “other” products and not the product upon which the label is actually displayed.

CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the final refusal for an unacceptable specimen be affirmed.

Respectfully submitted,



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POLARIS
TECHNOLOGIES
WINDOWS & DOORS

WINDOW/PATIO DOOR INSTALLATION INSTRUCTIONS

POLARIS® WINDOWS AND DOORS MUST BE STORED INSIDE.
STACK AS STRAIGHT AS POSSIBLE TO PREVENT BOWING.

1. Window must remain locked until installation is complete.
2. Caulk inside surface (face) of nail fin or entire exterior face of rough opening.
3. Set window/door frame plumb and square. Place a level on the sill and adjust the frame until it is perfectly level (this is most important for water resistance). DO NOT twist or bow frame. Leave adequate clearance (1/4" to 3/8") at head, allowing for header sag.
4. Use shims on jambs to keep unit evenly spaced from studs.
5. Block under sill to prevent sill from sagging, bowing, or dipping.
6. Screws are recommended to anchor window in place. Anchor at each corner, then every 12" to 16" using the pre-punched installation holes.
NOTE: IF NAILS ARE USED, CAUTION SHOULD BE TAKEN NOT TO DAMAGE THE WINDOW.
7. Fill interior voids between wood studs (or rough opening) and frame with batt type insulation such as rockwool or fiberglass to eliminate cold drafts.

8. Installation is now complete. Check window operation.

CAUTION: UNLESS SPECIFICALLY ORDERED, POLARIS® WINDOWS ARE NOT PROVIDED WITH SAFETY GLASS. IF BROKEN, THE GLASS COULD FRAGMENT CAUSING INJURY. MANY LAWS AND BUILDING CODES REQUIRE SAFETY GLASS IN LOCATIONS THAT ARE ADJACENT TO OR NEAR DOORS. POLARIS® WINDOWS ARE AVAILABLE WITH SAFETY GLASS. CONSULT YOUR BUILDER.

CLEANING INSTRUCTIONS: USE MILD SOAP AND WATER SOLUTION-NO BLEACH.

Look for these other fine
Polaris® products...