

This Opinion Is Not a  
Precedent of the TTAB

Mailed: June 5, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*In re TEK Group International*  
—

Application Serial No. 87722507  
—

Nathan Gugliotta of the Law Offices of Nathan Gugliotta, P.E., Esq., LPA,  
for TEK Group International.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Trademark Law Office 118,  
Michael W. Baird, Managing Attorney.

—  
Before Kuhlke, Bergsman and Coggins, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

TEK Group International (Applicant) filed an application to register on the  
Principal Register the mark ZEPOXY (in standard characters) for the goods listed  
below:

Oil and gas wellbore machine tools, namely, permanent  
composite zonal isolation tools for use in well fracturing, in  
Class 7; and

High temperature fiber reinforced thermoset resins for used [sic] in the manufacture of composite wellbore tools and composite wellbore tool components, in Class 17.<sup>1</sup>

On January 24, 2018, Applicant filed an Amendment to Allege Use claiming January 22, 2018, as Applicant's dates of first use anywhere and first in commerce for the goods in both classes. Applicant identified the specimen of use filed with the Amendment to Allege as a "tradeshow bro[c]hure distributed showing Applicant's use of the mark in commerce."<sup>2</sup> A copy of the specimen is reproduced below:



<sup>1</sup> Application Serial No. 87722507, filed December 15, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's claim of a bona fide intent to use its mark in commerce.

<sup>2</sup> The same specimen was submitted for each class.

On March 29, 2018, Applicant filed a second Amendment to Allege Use alleging January 6, 2018, as Applicant's dates of first use anywhere and first in commerce for the goods in both classes. Applicant identified the specimen of use filed with the second Amendment to Allege use as "Applicant's customer-facing quotation and offer for sale featuring Applicant's use of the mark in commerce."<sup>3</sup> A copy of the relevant portion of the specimen is reproduced below:



Tek Group International, Inc.

### Quotation

Quote To: [Redacted]

|               |                |          |             |
|---------------|----------------|----------|-------------|
| Quote Number: | 11750          | Contact: | [Redacted]  |
| Quote Date:   | 01/06/18       | Expires: | 01/06/19    |
| Customer:     | [Redacted]     | Inquiry: | [Redacted]  |
| Salesman:     | Chris Willison | Terms:   | Net 30 Days |
| Ship Via:     | Best Way       | Phone:   | [Redacted]  |
|               |                | FAX:     | [Redacted]  |

Thank you for the opportunity!

| Item | Part Number<br>Description   | Revision | Quantity | Price          |
|------|--|----------|----------|----------------|
| 1    | 10014801 / 10014802 MACHINED<br>5.5" 17-23# Frac Plug Mandrel<br>Filament Wound Zepoxy 8217 Hybrid Epoxy Material<br>CNC Machined to Print   |          | 10       | [Redacted] /EA |
|      |  |          | 50       | [Redacted] /EA |
|      |  |          | 100      | [Redacted] /EA |
|      |  |          | 500      | [Redacted] /EA |
| 2    | 10014801 / 10014802 MOLDED<br>5.5" 17-23# Frac Plug Mandrel<br>Filament Wound Zepoxy 8217 Hybrid Epoxy Material<br>Net Molded Utilizing ZCORE Technology   |          | 1        | [Redacted] /EA |
| 3    | 10014801 / 10014802 TOOLING<br>Compression Tooling to net mold 5.5" 17-23# Frac Plug Mandrel.<br>Tooling price of \$48,000.00 is per cavity.<br>Approximate capacity per cavity is 1000 units per month. |          | 1        | [Redacted] /EA |

<sup>3</sup> The same specimen was submitted for each class.

The Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127 and Trademark Rules 2.34(a)(1)(iv) and 2.56(a), 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a), because the specimens do not show the applied-for mark in use in commerce. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §§ 904, 904.07(a) (2018).

Section 45 of the Trademark Act states that a mark is 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, and
  - (B) the goods are sold or transported in commerce.

Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1) provides:

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 impracticable to place the mark on the goods or packaging for the goods.

*See also In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (“the test for an acceptable ... specimen, is simply that it must in some way evince that the mark is ‘associated’ with the goods and serves as an indicator of source”); *In re Marriott*, 459 F.2d 525, 173 USPQ 799, 800 (CCPA 1972) (“the menu is a display of appellant’s offering directly associated with appellant’s goods. It is from this word or pictorial depiction of the sandwich that the customer makes his selection, and his

selection is not indicated on the check by the specific ingredients of its composition but by the mark TEEN TWIST.”).

The TMEP explains further that a qualifying “display” will essentially comprise “point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices.” TMEP § 904.03(g); *see also In re Tsubaki, Inc.*, 109 USPQ2d 2002, 2003 (TTAB 2014).

Consistent with Section 45 of the Trademark Act, 15 U.S.C. § 1127, this TMEP section goes on to explain that “[f]olders, brochures, or other materials that describe goods and their characteristics or serve as **advertising** literature are not per se ‘displays’” and that “[i]n order to rely on such materials as specimens, an applicant must submit evidence of point-of-sale presentation.” (Emphasis added). The TMEP also explains that “[i]n appropriate cases, catalogs are acceptable specimens of trademark use,” but again qualifies this provision by noting that catalogs that do not “(1) include[] a picture or a sufficient textual description of the relevant goods; (2) show[] the mark in association with the goods; and (3) include[] the information necessary to order the goods” may constitute “mere advertising” material and thus not qualify. TMEP § 904.03(h). “[T]he 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.” *Id.* *See also In re Siny Corp.*, 920 F.3d 1331, 1337, 2019 WL 1549561 (Fed. Cir. 2019) (affirming rejection of “specimen [that] did not cross the line from mere advertising

to an acceptable display associated with the goods”); *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 available for license).

Applicant’s trade show brochure did not cross the line from mere advertising to an acceptable display associated with the goods because there is no information regarding how to place an order and, thus, it is not a point-of-sale display.<sup>4</sup>

Applicant contends that the “customer-facing quotation and offer for sale” (or invoice) is an acceptable specimen because it is impractical to affix the mark to the products or packaging for the products because the products are shipped in bulk.<sup>5</sup>

This is because the applied-for goods are resins for use in manufacture of wellbore tools and composite wellbore tool components in class 17. Specifically, this is the actual resin material that is used to make other tools. Indeed, it would be more than impractical to place the mark on this class 17 good — it would be impossible to do so. Further, the industrial nature of the industry in which these goods are distributed is much different to consumer goods. Indeed, it would be impractical to place the mark on any sort of industrial packaging because it is shipped in bulk, as contemplated by TMEP § 904.03(k).

---

<sup>4</sup> In other cases, the Board has found that the prominent display of the trademark on a trade-show booth where product literature is distributed and orders for the goods are taken is a display associated with the goods, *In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986), and that informational fliers or leaflets clearly depicting the mark and presented on the goods at trade show exhibits are acceptable displays associated with the goods. *In re Ancha Elec. Inc.*, 1 USPQ2d 1318 (TTAB 1986). In this application, unlike the *Shipley* and *Ancha Elec.* applications, there was no declaration or other corroborating material supporting, or explaining how, the brochures are point-of-sale displays.

<sup>55</sup> Applicant’s Brief, p. 3 (4 TTABVUE 4).

Further, the applied for goods in class 8 [sic], namely “oil and gas wellbore machine tools, namely, permanent composite zonal isolation tools for use in well fracturing,” are further of the type where affixing it to the goods, display, or packaging would be impractical. This is because the goods themselves are placed under ground, the packaging is industrial — not consumer — in nature and shipped in bulk, and due to the industrial nature of the channels of trade, displays associated with the goods are impractical and would be futile. Therefore, the applied-for goods in classes 8 [sic] and 17 are of the type contemplated by TMEP § 904.03(k), and as such the invoice specimen is sufficient to grant registration under the law.<sup>6</sup>

“[I]n rare circumstances it may be impracticable to place the mark on the goods or packaging for the goods if the goods are natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars. In such instances, an acceptable specimen might be an invoice, a bill of lading, or a shipping document that shows the mark for the goods.” TMEP § 904.03(k). In *In re Settec, Inc.*, 80 USPQ2d 1185 (TTAB 2006), the applicant asserted that placing the mark on the goods or on displays associated with the goods in the traditional manner was impracticable because the purpose of the goods was to provide digital media copy protection to media content providers, and placing the mark on the final product available to the ultimate end-user would impair the value of the goods, because the end-user would thereby be armed with an additional piece of the encryption puzzle. The Board rejected this contention, finding that there were a variety of ways in which applicant could use its mark in the traditional manner without making it available to the end-user.

---

<sup>6</sup> *Id.* at pp. 3-4 (4 TTABVUE 4-5).

Turning to Applicant's arguments regarding the propriety of its specimens, there is no actual proof in the record to support Applicant's statements. We have only Applicant's counsel's statements as to how Applicant sells its "permanent composite zonal isolation tools for use in well fracturing" and "resins for used [sic] in the manufacture of composite wellbore tools and composite wellbore tool components." *In re Simulations Publ'ns, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (where appellant argued that the magazines at issue deal with unrelated subject matter, the court held that "[s]tatements in a brief cannot take the place of evidence."); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298, 302 (CCPA 1974) (where patent claims were rejected for the insufficiency of disclosure under Section 112, the response of appellant was argument in lieu of evidence leading the court to hold that "argument of counsel cannot take the place of evidence lacking in the record."); *In re Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (disregarding outside counsel's conclusory unverified statements made without proper foundation regarding marketing of goods); *In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983) (applicant argued without corroborating evidence that its brochure would be recognized as an offer of services leading the Board to hold that "[u]nfortunately we have no evidence of record to this effect and assertions in briefs are normally not recognized as evidence"). *Compare In re Valenite Inc.*, 84 USPQ 1346, 1348 (TTAB 2007) (appellant submitted the declaration of its director of marketing who testified that appellant's customers regularly order its products by contacting the customer service department by telephone).

Taking counsel's assertions at face value, the explanation as to why it is impractical to place the mark on the products, packaging, or displays used in association with the goods is lacking detail. With respect to the Class 7 "permanent composite zonal isolation tools for use in well fracturing," other than that the tools are shipped in bulk, there is no explanation as to how the tools are shipped, why bulk shipping precludes the use of the mark on packaging or containers holding the tools, why the mark cannot be imprinted in the tools, or whether product literature featuring the mark is distributed at trade shows where the tools are sold.

Likewise, with respect to the "resins for used [sic] in the manufacture of composite wellbore tools and composite wellbore tool components," other than that the resins are shipped in bulk, there is no explanation as to how the resins are shipped, why bulk shipping precludes the use of mark on containers holding the resins, whether product literature featuring the mark is distributed at trade shows where the resins are sold, or whether there are instructions for employing the resins that display the mark.

To be clear, we are not substituting our knowledge of well fracturing tools and wellbore resins or their marketing for Applicant's knowledge. In this case, we simply have an uncorroborated, unsupported statement that the products are sold in bulk and that, therefore, it is impracticable to use the mark in a traditional manner. Because it is in only rare circumstances that the USPTO may accept nontraditional specimens where it is impracticable to put the mark on the goods, packaging for the goods, or displays used in association with the goods, we find that Applicant failed to

Serial No. 87722507

prove that is impracticable to place the mark on the goods, packaging for the goods, or displays used in association with the goods.

**Decision:** The refusal to register Applicant's mark on the ground that the specimens do not show the applied-for mark in use in commerce is affirmed.