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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mocon, Inc.

Serial No. 90673935

Michael Sherrill of Sherrill Law Offices, PLLC,
for Mocon, Inc.

Brittany Johnson, Trademark Examining Attorney, Law Office 126,
Andrew Lawrence, Managing Attorney.

Before Taylor, Bergsman and Lynch,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Mocon, Inc. ("Applicant") seeks registration on the Supplemental Register of the mark PERMWARE (in standard characters) for, as amended, "Downloadable software for managing permeation laboratory master data," in International Class 9.

The Trademark Examining Attorney finally refused registration on the Supplemental Register under Trademark Act Sections 1, 23, and 45, 15 U.S.C. §§ 1051, 1091, and 1127, on the ground that the specimen "failed to show the applied-for mark as actually used in commerce in connection with any of the goods identified

in the application." Examining Attorney's brief, unnumbered p. 1.[1] Applicant requested reconsideration of the Final Office Action, which was denied. Thereafter, Applicant appealed. We reverse the refusal to register.

I. Background

Before proceeding to the merits of the appeal, a review of the relevant prosecution history is in order. Application Serial No. 90673935 was filed on April 27, 2021, initially seeking registration on the Principal Register of the term PERMWARE under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's allegation of use of the mark anywhere and in commerce at least as early as November 24, 2020.

A first Office Action issued on December 24, 2021, in-part refusing registration under Sections 1 and 45, 15 U.S.C. §§ 1051, 1127, because the specimen (reproduced below) "does not show the applied-for mark as actually used in commerce in connection with any of the goods."[2] The Examining Attorney reasoned that Applicant's specimen "appears to be a mock-up created for the sole purpose of being

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[1] 6 TTABVUE 2. The application also was refused registration on the ground that the term PERMWARE is merely descriptive of the goods pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), but the refusal was withdrawn after Applicant amended its application to seek registration on the Supplemental Register.

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer.

References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

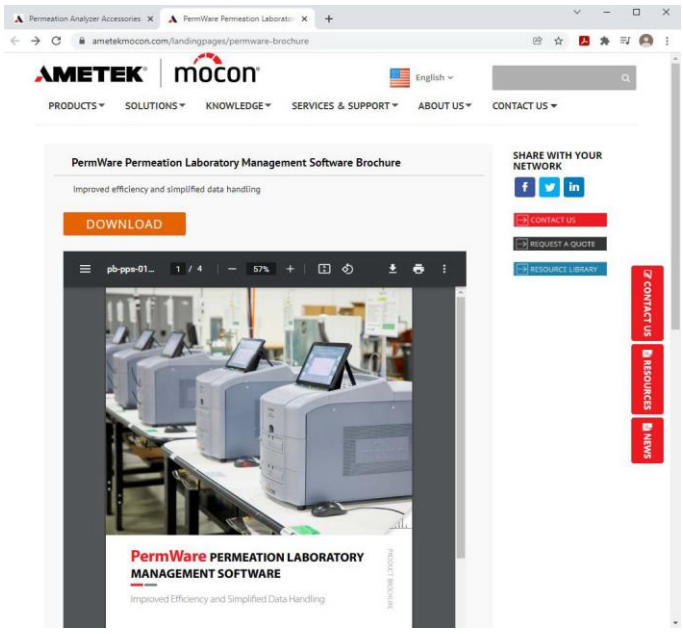
[2] December 24, 2021 Office Action, TSDR 4.

used as a specimen. There is no indication of what's on the flash drive or what it is used for."[3]

Applicant's original specimen (Specimen No. 1):

Applicant responded to the refusal in-part by submitting the substitute specimen shown below, taken from the landing page of its website at ametekmocon.com.[4] Applicant proffered no arguments in response to the initial specimen requirement, except to submit a substitute specimen.

Applicant's substitute specimen (Specimen No. 2):



[3] *Id.*

[4] Applicant January 28, 2022 Response, TSDR 7.

Citing Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.63(b); and TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §§ 904, 904.07, 1301.04(g)(i), the Examining Attorney, in her Office Action issued February 27, 2022, made final the refusal to register because the substitute specimen appears to be mere advertising and does not properly show the applied-for mark as actually used in commerce. The Examining Attorney specifically explains that "applicant submitted a screenshot of a webpage for downloading 'PermWare Permeation Laboratory Management Software Brochure'. Downloading the brochure for the software is insufficient to show use with the actual software because brochures are merely advertising material."[5]

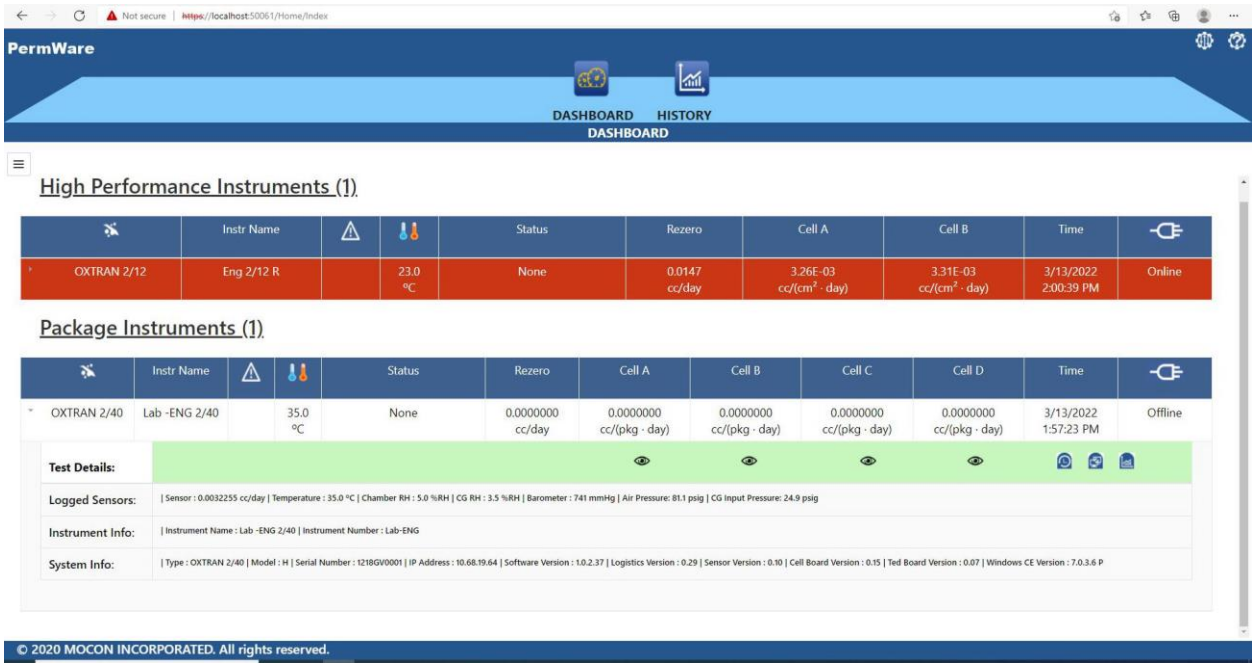
Applicant, on March 21, 2022, requested reconsideration of the Final Office Action, in-part submitting the specimen, shown below,[6] described in the Request for Reconsideration as "screenshot of software display screen," and in Applicant's brief as "a screen shot of a computer display screen projecting a page of the software bearing the PERMWARE mark."[7] Applicant again made no arguments in response to the requirement for an acceptable specimen, except to submit a second substitute specimen.

[5] February 27, 2022 Final Office Action, TSDR 2.

[6] Applicant's March 21, 2022 Request for Reconsideration, TSDR 6.

[7] 4 TTABVUE 3.

Applicant's second substitute specimen (Specimen No. 3):



The Examining Attorney, on April 12, 2022, maintained the requirement for an acceptable specimen, finding that Specimen No. 3 did not show the applied-for mark being used in connection with Applicant's goods.

Applicant then filed its appeal brief based solely on the specimen requirement as it pertains to Specimen 3. The appeal is fully briefed.

II. Specimen at Issue

As discussed above, Applicant submitted substitute specimens in response to the specimen requirements. Applicant did not argue, either during prosecution or in its brief, the requirement in connection with Specimen Nos. 1 and 2 and, further, indicated in its brief that "[t]he sole issue of appeal is whether the substitute specimen submitted by Applicant [on March 21, 2022] in support of registration of Applicant's PERMWARE mark shows the PERMWARE mark used in commerce in

connection with Applicant's listed goods." Applicant's brief pp. 2-3.[8] Because Applicant did not address Specimen Nos. 1 and 2, neither will we.

We turn then to Specimen No. 3, which as stated, consists of "a screen shot of a computer display screen projecting a page of the software bearing the PERMWARE mark," and consider whether it shows Applicant's PERMWARE mark used in commerce in connection with Applicant's "downloadable software for managing permeation laboratory master data."[9] *See In re Pitney Bowes*, 125 USPQ2d 1417, 1420 (TTAB 2018) ("[C]onsideration must be given not only to the information provided by the specimen itself, but also to any explanations offered by Applicant clarifying the nature, content, or context of use of the specimen that are consistent with what the specimen itself shows").

III. Discussion

As has been frequently stated, "[b]efore there can be registration, there must be a trademark." *In re Bose Corporation, d/b/a Interaudio Systems*, 546 F.2d 893, 896, 192 USPQ 213, 215 (CCPA 1978). The starting point for our analysis is Section 45 of the Trademark Act, as amended, where "trademark" is defined as "any word, name, symbol, or device, or any combination thereof used by a person ... to identify and

[8] 4 TTABVUE 3-4.

[9] The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed October 13, 2022) defines "permeation" as "the quality or state of being permeated." It defines "permeated" as "to diffuse through or penetrate something."

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of goods, even if that source is unknown." 15 U.S.C. 1127. This section further provides 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 if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce." *Id*. Thus, the mark must be used in such a manner that it would be readily perceived as identifying the specified goods and distinguishing a single source or origin for the goods. *See e.g., In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *1-2 (TTAB 2019) ("The key question is whether the asserted mark would be perceived as a source indicator for Applicant's [goods or] services."); *In re Aerospace Optics, Inc*., 78 USPQ2d 1861, 1862 (TTAB 2006) ("[T]he critical inquiry is whether the asserted mark would be perceived as a source indicator.").

The Examining Attorney maintains that Applicant failed to show the mark PERMWARE being used in commerce in connection with "downloadable software for managing permeation laboratory master data," specifically arguing that:

> applicant's substitute specimen filed on March 21, 2022, consists of a webpage showing the mark "PERMWARE" on the top left side of a display screen that includes an icon labeled "dashboard" and an icon labeled "history" in the center of the heading. Beneath the heading are charts of technical data, divided into two categories, "high performance instruments (1)" and "package instruments (1). The website does not mention what the software is used for nor does the website provide sufficient information to enable the user to download or purchase the software.

> Thus, the specimen fails to create an association between the mark and the goods.

Examining Attorney's brief.[10]

Citing *In re Settec, Inc.*, 80 USPQ2d 1185 (TTAB 2006) and TMEP § 904.03(e), Applicant argues that "[t]he substitute specimen proffered by Applicant is exactly what has long been accepted as a suitable specimen, a screen shot of a computer display screen projecting a page of the software bearing the trademark." Applicant's brief, p. 3.[11]

We agree. In *Settec*, the Board found "[i]t is not uncommon for a software provider to display its product marks or relevant corporate logos on computerized images created by distributed software, or on the website page where licensed users are given authorized access to the software product. In either of these cases, an applicant would simply submit to the Office a screen-print from the appropriate access screen." *In re Settec*, 80 USPQ2d at 1190. Further, TMEP § 904.03(e) explains that "[i]t is not necessary that purchasers see the mark prior to purchasing the goods, as long as the mark is applied to the goods or their containers, or to a display associated with the goods, and the goods are sold or transported in commerce." *See, e.g., In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (holding that stamping the mark after purchase of the goods, on a tag attached to the goods that are later transported in commerce, is sufficient use). Finally, as the Board made clear in *In re Minerva Associates, Inc.*, 125 USPQ2d 1634, 1639 (TTAB 2018) "[b]ecause software providers

[10] 7 TTABVUE 5.

[11] 4 TTABVUE 4.

have adopted the practice of applying trademarks that are visible only when the software programs are displayed on a screen, an acceptable specimen might be a photograph or screenshot of a computer screen displaying the identifying trademark while the computer program is in use."

In this case, because Applicant's mark appears prominently on the upper left corner of a screen shot from Applicant's downloadable software when the software is in use, we find that the substitute specimen (Specimen No. 3) shows the applied-for mark PERMWARE used in connection with the goods in Class 9, which would be readily perceived as a trademark identifying the source of those goods.

The Examining Attorney's objection to this specimen stems from her apparent misapprehension of the nature of Applicant's specimen. While Applicant's specimen is a screen shot taken from a computer display, it is not a webpage excerpt advertising the software which, as she correctly points out, would require sufficient information to enable the user to download or purchase the software. Instead, as explained by Applicant at the time it submitted Specimen No. 3 and in its briefing, Specimen No. 3 is a "screen shot of a computer display screen projecting an image created by the running of [Applicant's downloadable] PERMWARE software." Applicant's reply brief, p. 1.[12]

[12] 7 TTABVUE 2; March 21, 2022 Request for Reconsideration (TSDR 2, 3) ("Specimen Description" - "screenshot of software display screen").

We therefore conclude that Applicant's Specimen No. 3 is an appropriate specimen showing use in commerce of Applicant's PERMWARE mark on the identified "downloadable software for managing permeation laboratory master data."

Decision: The refusal to register the PERMWARE mark under Sections 1 and 45 of the Act is reversed.