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Filing date: **03/06/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78657648
Applicant	Corporate Express, Inc.
Applied for Mark	EVERYTHING FOR YOUR OFFICE. TO YOUR OFFICE.
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Submission	Appeal Brief
Attachments	Appeal Brief.pdf (4 pages)(531590 bytes)
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Date	03/06/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re the Application of:

Corporate Express, Inc.)
)
Serial No.: 78657648)
)
Filing Date: 6/24/2005)
)
Atty. File No.: 4742-98)

APPEAL BRIEF

Applicant appeals the decision of the Examining Attorney finally refusing registration on the basis that the Applicant is seeking registration of more than one mark. The Examining Attorney's opinion appears to be based upon the fact that although the drawing page shows the slogan, consisting of two sentences, "EVERYTHING FOR YOUR OFFICE. TO YOUR OFFICE", the specimen of use submitted with the application shows these two sentences separated.

TMEP Section 807.12(a) requires that "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods or services, as shown by the specimen. Here, the specimen shows the mark immediately above and below a photo of people working in an office. The mark is all in the same font and size. It is clear from the specimens that Applicant's services include the sale *and delivery* of office supplies and related products to customers. Thus, the entire slogan "EVERYTHING FOR YOUR OFFICE. TO YOUR OFFICE." *as a whole* suggests to the customer the nature of Applicant's retail services, which include a wide range of office supplies that may be delivered directly to the customer. When a consumer reviews the specimens, the consumer will not stop reading after EVERYTHING TO YOUR OFFICE. Rather, the consumer will also read the mark as a whole by reading the language under the photo as well.

Most importantly, *the mark does not even make sense when read as two separate marks*. Specifically, the second "mark" would be "TO YOUR OFFICE." which does not stand alone as a sensible phrase. Thus, Applicant believes that the commercial impression presented by the specimen is that the mark is EVERYTHING FOR YOUR OFFICE. TO YOUR OFFICE. Accordingly, the drawing is a substantially exact representation of the mark as shown by the specimen.

Finally, this is not a situation where Applicant has made any use of the terms the Examining Attorney alleges are two marks alone. In other cases, such as *In re Jordan Industries, Inc.*, 210 USPQ 158 (TTAB 1980), the Board refused registration of the mark "JORDAN JIF-LOK & Design" on the basis that JORDAN and JIF-LOK were two

separate trademarks. *Id.* at 160. In support of this refusal, the Board noted that the specimen itself showed use of JIF-LOK alone. *Id.* at 159. Applicant notes that unlike the *In re Jordan* case, in the present case, the Examiner has not shown any use by Applicant of EVERYTHING FOR YOUR OFFICE. alone and has not shown any use by Applicant of TO YOUR OFFICE. alone. Applicant submits that such evidence does not exist, since Applicant's mark does not consist of two separate marks. Similarly, in *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977), the Board refused registration of the mark "AUDI FOX & Design" on the basis that the Applicant was trying to register the two separate marks AUDI and "FOX & Design". *Id.* at 651. There was evidence in the record that "AUDI FOX & Design" was not used as a unitary mark anywhere, and the marks were typically used separately, since AUDI was Applicant's house mark and "FOX & Design" was a particular model name. *Id.* at 650. Here, the two phrases are always used together because there is only one mark.

Applicant also submitted additional samples of use of the mark that were not in use as of the filing date of the application, as supplemental evidence of use of the mark (copies of previously submitted evidence attached for convenience). These pages display two instances of Applicant's mark where there is no photo between portions of the mark. See *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (1992) where the applicant's product catalog showed additional use of the mark in support of registration.

In sum, the fact that Applicant's mark consists of two sentences does not mean that Applicant is seeking to register two marks. These two sentences only make sense together and are used together as shown in the specimen and in the supporting evidence of use. The commercial impression presented by the specimen is such that consumers will read the mark as EVERYTHING FOR YOUR OFFICE. TO YOUR OFFICE. based on the way this phrase appears in the same size and font and is set apart from the rest of the text. Under these circumstances, Applicant requests that the refusal of registration be withdrawn and the application be allowed to pass to registration.

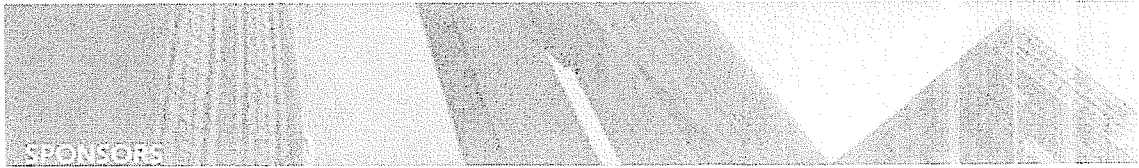
Respectfully submitted,

SHERIDAN ROSS P.C.

Date: 3/6/07

By: 
Sabrina C. Stavish

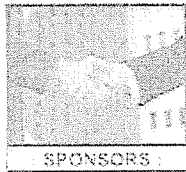
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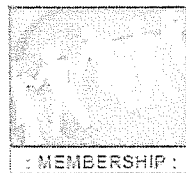
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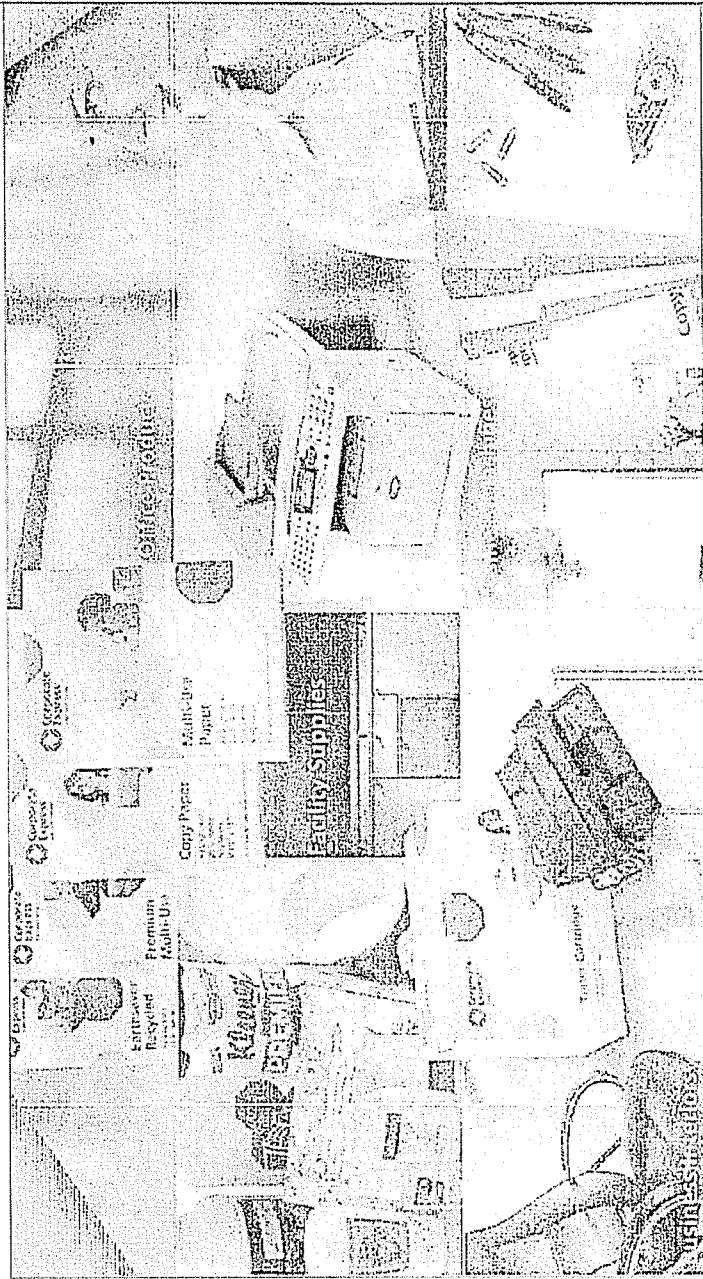
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