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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re U.S. Tsubaki, Inc.

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Serial No. 78698066

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James C. Wray, Esq. for U.S. Tsubaki, Inc.

Anthony M. Rinker, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

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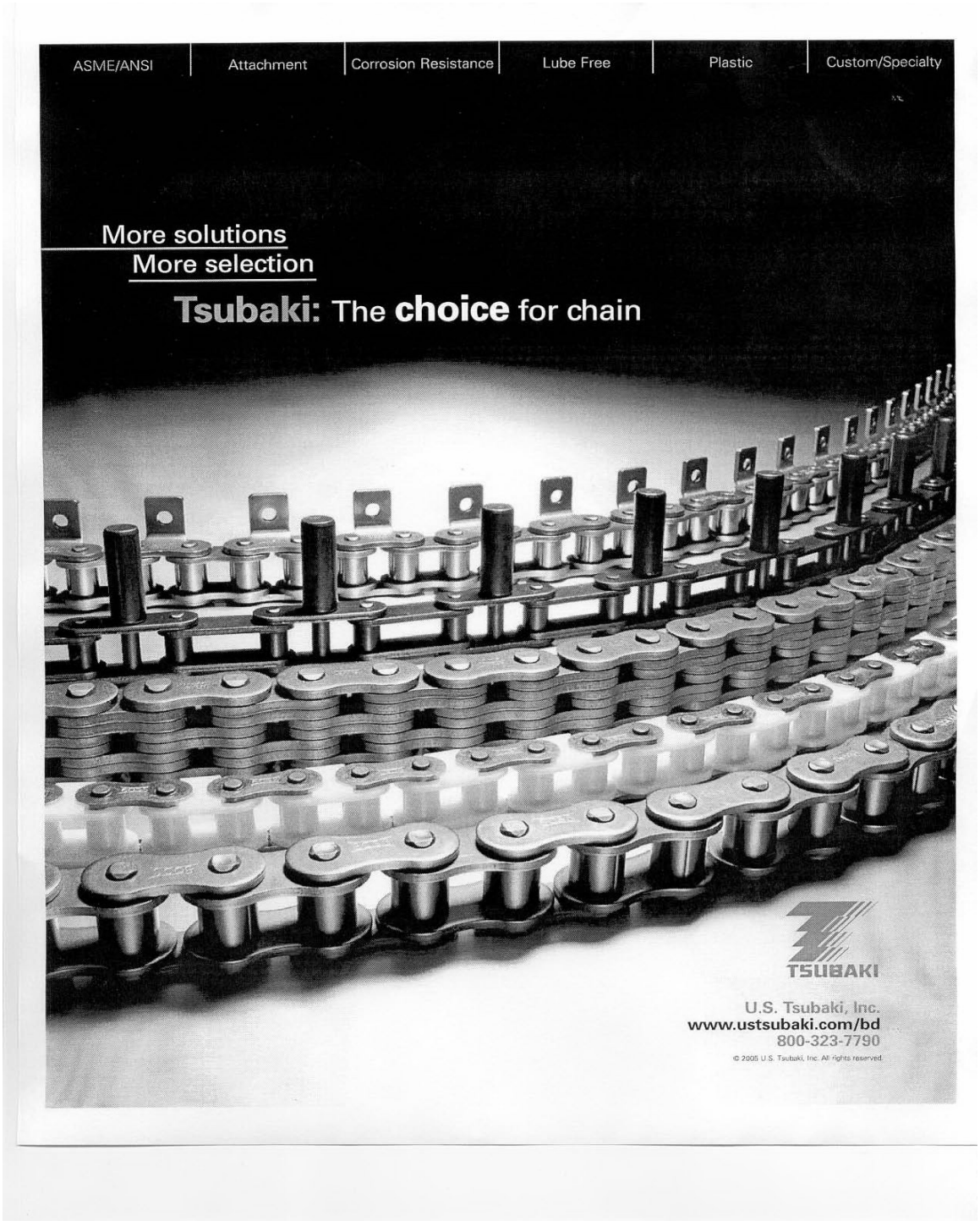
Before Grendel, Rogers and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

U.S. Tsubaki, Inc. filed a use based application to register the mark TSUBAKI: THE CHOICE FOR CHAIN, in standard character format, for goods ultimately identified as "machines and parts thereof, namely roller chain and engineering chain, drive chains, power transmission components and gearing for machines, namely, power transmission chains, sprockets, bushings, hubs, conveyor chains, top chains, and speed changers," in Class 7 (Serial No. 78698066). Applicant submitted an excerpt from a

catalog as its specimen of use. The specimen is set forth below.



The Trademark Examining Attorney refused registration on the ground that applicant's specimen does not show acceptable trademark use: that is, the page from applicant's catalog is not a display used in association with the goods.

Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127, defines "use in commerce" in relevant part as follows:

> For purposes of this Act, a mark shall be 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. . . .

In accordance therewith, Trademark Rule 2.56(b)(1) provides the following:

> 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 not possible to place the mark on the goods or packaging for the goods.

The determination of whether a specimen is merely advertising or a display associated with the goods is a

question of fact. *In re Shipley Co.*, 230 USPQ 691, 694 (TTAB 1986). A display used in association with the goods is essentially a point-of-sale display designed to catch the attention of purchasers as an inducement to consummate a sale. *In re Shipley Co.*, 230 USPQ at 694 ("A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location"); *In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979).

In accordance with case law, TMEP §904.03(g) (5th ed. 2007) provides the following guidance:

> Displays associated with the goods essentially comprise point-of-sale material, such as banners, shelf-talkers, window displays, menus and similar devices.
>
> These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. . . .
>
> In order to rely on such material as specimens, an applicant must submit evidence of point-of-sale presentation.

Specifically with respect to catalogs, the TMEP provides that a catalog or similar display associated with the goods may be an acceptable specimen of use under the following conditions:

1. The catalog includes a photograph or picture of the goods;

2. The catalog displays the mark near the photograph of the goods so that consumers associate the mark and the goods; and,

3. The catalog includes the information necessary to order the goods (*e.g.*, an order form, or a phone number, mailing address, or e-mail address for placing orders).

TMEP §904.03(h) (5th ed. 2007). "However, the 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 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 licensed).

The crucial factual issue in this case is whether applicant's specimen includes the information necessary to order applicant's chain, thus making it a point-of-sale display. In this regard, applicant contends that its

specimen is a display used in association with the goods for the following reason:

> Given the multitude of different types of chains and the need for customization to suit particular applications, some technical consultation may be necessary. As in In re Valenite (*In re Valenite Inc.*, 84 USPQ2d 1345 (TTAB 2007)) an order form would not be appropriate. Rather, customers know that orders are placed over the phone, where technical consultation can be provided to verify the correctness of a selected product. As in In re Valenite, detailed ordering instructions or solicitation are not required. Rather the website address and phone number themselves meet the requirement for including information necessary to order the goods.[1]

First, unlike the *Valenite* case, there is no evidence in the record regarding how applicant and its competitors sell chains or whether customers, in fact, "know that orders are placed over the phone."[2] In this case, we have only counsel's statements to this effect. *See In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni,* 219 USPQ 60, 70 (TTAB 1983) ("Unfortunately we have no evidence of record to this effect and assertions in briefs are normally not recognized as evidence").

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[1] Applicant's Supplemental Brief, p. 4.

[2] In *Valenite,* 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. *In re Valenite Inc.,* 84 USPQ2d at 1348.

Second, in this case, applicant's specimen does not contain the information necessary to order applicant's chains. In *Valenite, t*he Board found that appellant's webpage was an acceptable display used in association with the goods because it functioned as a point-of-sale display. The webpage contained links to appellant's "Technical Resource Center," including specification sheets, online calculators, and reference tables, as well as providing appellant's toll-free customer service telephone numbers. Accordingly, the Board found that appellant's webpage "provides an on-line catalog, technical information apparently intended to further the prospective purchaser's determination of which particular product to consider, an online calculator and both a link to, and phone number for, customer service information. Therefore, applicant's website provides the prospective purchaser with sufficient information that the customer can select a product and call customer service to confirm the correctness of the selection and place an order." *In re Valenite Inc.*, 84 USPQ2d at 1349-1350.

Finally, we find that applicant's catalog page is more akin to the fact sheet, catalog page, or brochures submitted as specimens by the appellant in *In re MediaShare Corp.*, 43 USPQ2d 1304. In *MediaShare,* the Board noted that

appellant's specimens lacked any purchasing information such as price or the conditions or terms on which appellant's software is licensed. Therefore, the inclusion of appellant's telephone number was not sufficient to convert the specimens from mere advertising to displays used in association with the goods just because the specimens included appellant's telephone number. *In re MediaShare Corp.*, 43 USPQ2d at 1306. In this case, applicant's specimen does not contain any information normally associated with ordering products via the telephone or the Internet. There is no sales form, no pricing information, no offers to accept orders, and no special instructions for placing orders anywhere on the specimen. Applicant is asking us to infer from the face of the specimen that it is common for customers to purchase applicant's chain through the telephone or through the Internet. At best, applicant's catalog page provides applicant's telephone number and domain name as information about applicant; the telephone number and domain name do not constitute a means to order applicant's chains by telephone or the Internet. In fact, applicant's website does not provide a means for ordering applicant's chain

online (or via telephone). Applicant's website directs consumers to applicant's distributors.[3]

After considering the specimen submitted by applicant, and the arguments of both the applicant and the Examining Attorney, we find that applicant's specimen is not a display associated with the goods, and therefore is not acceptable to show trademark use of applicant's mark.

Decision: The refusal to register is affirmed.

[3] December 9, 2006 Office Action.