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Subject: U.S. TRADEMARK APPLICATION NO. 86754400 - CASALANA - 13349 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86754400

MARK: CASALANA



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Siny Corp.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the final refusal to register the mark CASALANA on the ground that the specimens of record are not sufficient to show the mark used in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

STATEMENT OF FACTS

Applicant filed an application on September 11, 2015 seeking registration on the Principal Register of the mark CASALANA for use with “Knit pile fabric for use as a textile in the manufacture of outerwear, gloves, apparel, and accessories” in International Class 24.

On November 16, 2015, an Office action issued refusing registration of applicant’s mark because the web page advertising specimen was not an acceptable display associated with the goods under Section 1(a) of the Trademark Act, among other refusals and requirements.

On May 16, 2016, applicant responded with a substitute specimen showing the entirety of the previously submitted web page. The response resolved the other issues.

On June 16, 2016, a final action issued maintaining and making final the specimen refusal.

On December 16, 2016, applicant timely filed for appeal with the Trademark Trial and Appeal Board and simultaneously filed a request for reconsideration arguing that the specimen is an acceptable point of sale display or satisfies the requirements for an acceptable catalog specimen.

On January 3, 2017 the examining attorney denied the request for reconsideration.

Applicant filed its appeal brief on April 12, 2017, which was forwarded to the examining attorney on April 18, 2017.

ISSUE PRESENTED

The sole issue presented on appeal is whether the web page specimen of record shows the means to order the goods and is therefore acceptable to show applicant’s mark used in commerce with the applied-for goods under Section 1(a) of the Trademark Act.

ARGUMENT

APPLICANT’S WEB PAGE SPECIMEN IS MERELY ADVERTISING BECAUSE THE PAGE DOES NOT PROVIDE SUFFICIENT ORDERING INFORMATION

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods identified in the application. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Advertising materials are generally not acceptable as specimens to show use in commerce for goods. See *In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520, 1522 (TTAB 1993); TMEP §904.04(b), (c). 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. See TMEP §904.04(b).

1. Applicant's web page specimen does not provide sufficient ordering information to constitute a display associated with the sale of the goods.

A web page constitutes a display associated with the goods if it 1) contains a picture or textual description of the identified goods, 2) shows the mark in association with the goods, and 3) provides a means for ordering the identified goods. See *In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012); *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); *Lands' End v. Manbeck*, 797 F. Supp. 511, 514, 24 USPQ2d 1314, 1316 (E.D. Va. 1992); TMEP §904.03(i). In this case, applicant's specimen fails the third element.

For a web page to provide a means for ordering the goods, the page must either provide the means on the page itself, such as through a "shop online" or "add to cart" button or link, or through information contained on the page. See *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1378-79 (TTAB 2010); *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007). Telephone numbers or email addresses may be acceptable means to purchase if there are clear instructions for ordering, such as "call now to buy" or "e-mail your order." TMEP §904.03(i)(C)(2). Absent such instructions, a phone number or email address may be acceptable if 1) the web page contains sufficient product information to purchase the goods, 2)

the record contains an explanation or evidence clearly showing that the telephone number or e-mail address can be used for ordering the goods, rather than merely for obtaining information about the goods or the ordering process, or 3) the phone number or email address is prominently placed close to the goods to indicate it as a means of purchase. See *In re Valenite Inc.*, 84 USPQ2d 1346, 1349 (TTAB 2007); TMEP §904.03(i)(C)(2). Determining the sufficiency of the ordering information requires consideration of the entire web page for detailed information about the goods as well as the means for ordering the goods. TMEP §904.03(i)(C).

In this case, there are no clear instructions for purchasing the goods contained on the web page because there is no purchasing information on the webpage, indicating that the wording “For Sales Information” means to call or email to get more information about the goods. For example, the only information provided about the goods is that they are “The washable wool.” The specimen is void of relevant purchasing information about the goods, such as quantity, price, sizes, available colors or patterns, or shipping information. Moreover, applicant has not provided any evidence or explanation clearly showing that this form of information is common in the industry and is understood as information for ordering the goods rather than merely to obtain further information, especially given the lack of product information on the web page.

Finally, the placement of the phone number and email address and wording used in connection with the information creates ambiguity as to the purpose of the contact information. Specifically, the text and link “Click here to find out more about: how sliver knit pile fabrics are made” appears below the description of the goods with pictures on both sides. Below this wording and the pictures is the wording “Or, For More Information” in large bold colored font. Below that wording appears in smaller black font “For sales information: (608) 373-2955 yungd@montereymills.com.” The first wording and link indicates information about how the fabrics are made. The wording that follows indicating “Or, For More Information” and “For sales information” do not clearly indicate that the contact information below is

for the purpose of ordering the goods. The wording appears to indicate that the contact information is for obtaining information about the goods or the ordering process, especially since the web page has no relevant purchasing information about the products. A consumer using the phone number or email address is not prepared to order the goods because they do not have sufficient product information to make a purchasing decision. Thus, the contact information appears to be for obtaining the relevant product information necessary to make a purchasing decision and not for purchasing the goods.

Because the web page specimen is void of clear instructions for purchasing the goods, relevant purchasing information about the goods, evidence or explanations clearly showing the phone number and email address are used for purchasing the goods, and the placement of the number and email address does not clearly indicate the purpose is for ordering the goods, the phone number and email address do not constitute the means to purchase the goods.

Therefore, the web page specimen is merely advertising material because it does not contain the means to order the goods.

2. Applicant's arguments are not persuasive.

Applicant argues that the "commercial textile products sold to manufacturers" are not finished commercial products and thus require careful consideration as to the quantity, shipping, and technical specifications. Such information about the goods is necessary to make a purchasing decision, but the web page specimen is void of such product information. Moreover, applicant has provided no explanation or evidence showing why the information was not or could not be provided on the web page. Finally, applicant provided no evidence showing it is common in the fabric industry for goods to be sold in such a fashion where extensive discussion with a sales representative is required. Rather, it seems that such goods, which are not technologically complex, could easily be sold through a web page or at least the web page could provide sufficient product information.

Applicant argues that the phone number is sufficient to show the means to purchase the goods because the goods are specialized products requiring technical assistance in ordering. Applicant analogizes this case to that in *In re Valenite*, 84 USPQ2d 1346, 1346 (TTAB 2007), where the goods were tools for power-operated metal-cutting machines. The website specimen in *Valenite* featured information about technical training courses, including “Machining Principles and Basics of Cutting Tool Materials” and a link to a technical resource center. *Id.* at 1348-49. Applicant’s fabric goods are not technical goods akin to power-operated metal-cutting machines. Moreover, the website specimen does not contain information indicating the technical nature of the goods, such as the training courses and technical resource center in *Valenite*. Moreover, in *Valenite*, the applicant provided a signed declaration from the director of marketing stating that consumers did in fact use the phone number to purchase the goods. *Id.* at 1349. In this case, there is no such definitive statement that the goods are purchased by calling the phone number or emailing the address provided in the specimen. Thus, the specimen in this case does not include information indicating the technical complexity of the goods or show that the contact information is definitively used to purchase the goods.

Applicant argues that the specimen provides sufficient information to constitute the means to order the goods. As explained, the wording “for sales information” does not clearly indicate that the phone number and email address are used to purchase the goods because the webpage does not include any relevant purchasing information. As a result, the phone number and email address appear to be for obtaining additional product information or information about the sales process. Furthermore, the record does not include evidence that the goods can be purchased via the phone number and email address, and the contact information is at the bottom of the page away from the mark. Thus, the phone number and email address are not sufficient to show the means to purchase the goods.

Finally, applicant argues that the specimen is an acceptable catalog page. A catalog or similar display may be acceptable if it contains a picture or textual description of the goods, displays the mark,

and provides the necessary ordering information. *See Lands' End Inc. v. Manbeck*, 24 USPQ2d 1314, 1315 (E.D. Va. 1992). This argument also fails because the specimen lacks the necessary ordering information. The wording "For Sales Information" does not clearly indicate that the phone number and email address are for placing orders. The contact information appears to merely be the means to acquire more information about the goods and the ordering process because no relevant product or purchasing information is included on the webpage. Thus, contact information for acquiring more information alone is not sufficient ordering information.

CONCLUSION

Therefore, because applicant's specimen does not provide the sufficient ordering information, the specimen is merely advertising material and is not sufficient to show the mark in use in commerce for the applied-for goods. For the foregoing reasons, the refusal to register under Section 1(a) of the Trademark Act, 15 U.S.C. §1501(a), should be affirmed.

Respectfully submitted,

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