ESTTA Tracking number: **ESTTA852941**

Filing date: **10/18/2017**

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

Proceeding	86754400
Applicant	Siny Corp.
Applied for Mark	CASALANA
Correspondence Address	DANIEL E KATTMAN REINHART BOERNER VAN DEUREN SC 1000 N WATER ST STE 1900 MILWAUKEE, WI 53202-6648 UNITED STATES Email: tmadmin@reinhartlaw.com
Submission	Appeal to CAFC
Attachments	CASALANA Notice of Appeal ESTTA Filing.pdf(275742 bytes)
Filer's Name	Heidi R. Thole
Filer's email	tmadmin@reinhartlaw.com
Signature	/hrt/
Date	10/18/2017

Reinhart
Attorneys at Law

Reinhart Boerner Van Deuren s.c.
P.O. Box 2965
Milwaukee, WI 53201-2965

1000 North Water Street
Suite 1700
Milwaukee, WI 53202-3197

Telephone: 414-298-1000
Fax: 414-298-8097
Toll Free: 800-553-6215
reinhartlaw.com

October 17, 2017

Daniel E. Kattman
Direct Dial: 414-298-8185
dkattman@reinhartlaw.com

Director
United States Patent & Trademark Office
Office of the General Counsel
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir or Madam:

Re: Notice of Appeal In re: Siny Corp.
Application Serial No. 86/754,400

I enclose for filing a Notice of Appeal with respect to the decision of the Trademark Trial and Appeal Board, issued on August 18, 2017, concerning the captioned matter.

Yours very truly,

Daniel E. Kattman

37547588

Attachments

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Siny Corp.	)
Application No.: 86/754,400	)
Filed: September 11, 2015	)
Trademark: CASALANA	)

Attention: Mary Boney Denison
Commissioner for Trademarks

NOTICE OF APPEAL

Applicant, Siny Corp., hereby appeals to the United States Court of Appeals for the Federal Circuit from the Opinion and Order of the Trademark Trial and Appeal Board dated August 18, 2017, denying Applicant's registration on the Principal Register of the mark CASALANA in standard characters for "kn-it pile fabric made with wool for use as a textile in the manufacture of outerwear, gloves, apparel, and accessories" in International Class 024 (Exhibit A).

Dated: October 17, 2017

Respectfully Submitted,
Siny Corp., by its Counsel

REINHART BOERNER VAN DEUREN
Daniel E. Kattman
Heidi R. Thole
1000 N. Water St, Suite 2100
Milwaukee, WI 53202

CERTIFICATE OF SERVICE

I hereby certify that the accompanying cover letter and Notice of Appeal, both dated October 17, 2017, and copy of the decision being appealed, were sent via United States Express Mail on October 17, 2017, addressed as follows:

Director
United States Patent & Trademark Office
Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450.

I am advised that the United States Postal Service is expected to deliver the package on October 18, 2017.

I hereby also certify that the aforementioned documents and the requisite filing fee as required under Federal Circuit Rules 15(a)(1) and 52 and Trademark Rule 2.145(a)(2) were served approximately contemporaneously on the Clerk of Court for the United States Court of Appeals for the Federal Circuit.

Dated: October 17, 2017

By: REINHART, BOERNER, VAN DEUREN, s.c.
Attorneys for Siny Corp.

Daniel E. Kattman
Heidi R. Thole
1000 North Water Street, Suite 2100
Milwaukee, WI 53202

EXHIBIT A

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Mailed:
August 18, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Siny Corp.

Serial No. 86754400

Daniel E. Kattman and Heidi R. Thole of Reinhart Boerner Van Deuren, s.c. for Siny Corp.

Jacob Vigil, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Kuhlke, Lykos, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Siny Corp ("Applicant") filed an application to register on the Principal Register the mark CASALANA in standard characters for "Knit pile fabric made with wool for use as a textile in the manufacture of outerwear, gloves, apparel, and accessories," in International Class 24.[1] The Trademark Examining Attorney refused registration under §§ 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground

[1] Application Serial No. 86754400, filed on September 11, 2015 under Trademark Act § 1(a), 15 U.S.C. § 1051(a), on the basis of use of the mark in commerce, stating December 31, 2002 as the date of first use and first use in commerce.

that Applicant failed to submit a specimen of use showing proper use of the mark in commerce. When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. The case is fully briefed.

A mark is in use in commerce 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 Act § 45, 15 U.S.C. § 1127. Applicant submitted as evidence of use of its mark a printout of a web page from Applicant's website.[2] As this is not an example of use on the goods or on their containers, tags, or labels, Applicant contends that the web page constitutes a display associated with the goods. The USPTO, the Board, and the courts have required that displays associated with the goods, including online displays, must be "point of sale" displays. *Lands' End Inc. v. Manback*, 797 F. Supp. 511, 24 USPQ2d 1314, 1316 (E.D.Va. 1992) ("A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location. A point of sale location provides a customer with the opportunity to look to the displayed mark as a means of identifying and distinguishing the source of goods."). *See also In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1122 (Fed. Cir. 2009) (quoting *In re Ostberg*, 83 USPQ2d

[2] Applicant's response of May 16, 2016 at 6-7. Applicant had filed, with its original application, a shorter excerpt from the same website. In this decision, we discuss the substitute specimen which is more complete.

1220, 1222-23 (TTAB 2007) ("In [*Lands' End*], the determinative factor was that the mark was used at the point of sale.")). The Board has held:

> [T]o be more than mere advertising, a point-of-sale display associated with the goods must do more than simply promote the goods and induce a person to buy them; that is the purpose of advertising in general. The specimen must be *"calculated to consummate a sale."*

In re U.S. Tsubaki, Inc., 109 USPQ2d 2002, 2009 (TTAB 2014), *quoting In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979) (emphasis added).

The Examining Attorney's sole objection to the specimen of use is that it does not provide a means for ordering the identified goods. The Examining Attorney therefore characterizes the specimen as advertising material that does not constitute a display associated with the goods.[3] Applicant argues that its specimen of use must be considered in light of the fact that its goods are commercial textile products, not finished products, sold to manufacturers, rather than consumers; and that any purchase of the goods will require the assistance of a salesperson in order to carefully address the technical specifications of the goods, their quantity, and the details of shipping.[4] Applicant contends that in such a situation, in which "technical assistance is required in selecting the product or determining the product specifications," a display that includes a telephone number that will connect the purchaser with sales personnel "can constitute the requisite ability to order."[5]

[3] Examining Attorney's brief, 11 TTABVUE 4.

[4] Applicant's brief at 9-10, 9 TTABVUE 10-11.

[5] *Id.* at 10, 9 TTABVUE 11.

The determination of whether the proffered specimen is merely advertising or serves the function of a display associated with the goods is a question of fact. *In re U.S. Tsubaki, Inc.*, 109 USPQ2d at 2003, *citing In re Shipley Co.*, 230 USPQ 691, 694 (TTAB 1986). "Factually, we need to ask whether the purported point-of-sale display provides the potential purchaser with the information normally associated with ordering products of that kind." *In re Anpath Group Inc.*, 95 USPQ2d 1377, 1381 (TTAB 2010). The display should provide a "level of information … capable of allowing a consumer to consummate a physical order …" *Id.* at 1382.

Applicant's specimen of use, a web page, displays Applicant's mark CASALANA as one choice among eleven fabrics described as "Some Of Our Most Popular Fabrics." The mark appears beneath one of eleven product photographs, as follows:

The web page includes an explanation of the nature of Applicant's goods, which it characterizes as "Fabrics Made from Fiber." The explanation states that Applicant's goods are made according to the "sliver knitting process" which "locks individual fibers directly into a lightweight knit backing allowing each fiber to stand upright, free from the backing to form the soft pile on the face of the fabric." The explanation sets forth "Features and Benefits," as shown below:

- **Light Weight** Not twisted into dense yarns, pile's fibers along with the fine denier filament backing yarn, yield a fabric that seems nearly weightless for its volume.
- **Multi-season comfort** The billions of tiny air pockets created between pile's fibers act as tiny air conditioners to maintain an even temperature. The result is multi-season comfort.
- **Easy Care** With the exception of Glenoit Fabrics' artful faux fur styles, pile's non-shrink construction and select fibers make it washable.
- **Non-shrink** Because of the stability of its knit backing yarn, pile's shrinkage is virtually nonexistent. Though individual fibers may shrink slightly, there is no effect on the fabric itself.
- **Soft, Drapability** The flexibility of pile's filament knit backing yarns and lightweight loose fibers, delivers an appealing softness, drape and hand every time.
- **A nearly endless array of textures and patterns** Patterning from computerized jacquard knitting machines and expert finishing techniques make Glenoit Fabrics' totally unique.
- **Rich colors** Glenoit Fabrics' fibers are pre-dyed before construction (environmentally advantageous over yarn or fabric dying). They can then be blended for an exceptional depth of color and subtle variations within one fabric and pattern.

The web page includes an informational link shown as follows:

Click here to find out more about:

HOW SLIVER KNIT PILE FABRICS ARE MADE

Near the bottom of the web page is the following text, flush left:

Or, For More Information

For sales information:

(608) 373-2955

yungd@montereymills.com

For press information and materials:
birkhoffb@montereymills.com

For purposes of our analysis, we presume that the telephone number shown above will connect a prospective customer with sales personnel (although the Examining Attorney appears to be skeptical as to this point).[6]

As the Board stated in *Tsubacki*, "[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 U.S. Tsubaki, Inc.*, 109 USPQ2d at 2003, *citing In re Shipley Co.*, 230 USPQ at 694 (emphasis added). "A simple invitation to call applicant to get information — even to get quotes for placing orders — does not provide a means of ordering the product." *Id.* at 2005. In *Tsubacki*, the Board criticized the web page specimen because:

> After reviewing applicant's catalogs, prospective customers *are not yet at the point of purchase* and would need to contact applicant to obtain additional information. It is only after obtaining such information, which is not provided on the specimens, that the purchaser would be *in a position to make a purchasing decision*.
>
> The specimens simply do not contain adequate information for making a decision to purchase the goods and placing an order …

In re U.S. Tsubaki, 109 USPQ2d at 2009 (emphasis added). *See also In re Anpath Group Inc.*, 95 USPQ2d at 1381 ("Our hypothetical, potential customer, after reviewing applicant's specimen with its limited ordering information, is simply not yet at the point of purchase, and would contact applicant to obtain preliminary information necessary to order the goods; *it is only after obtaining such information,*

[6] Examining Attorney's brief, 11 TTABVUE 7.

which is not provided on the specimen, that the purchaser could actually place an order with applicant's sales office." (Emphasis added)).

Bearing in mind the foregoing guidance, on the present record we find it implausible that the business representative of a manufacturer would be prepared to place an order to purchase CASALANA brand fabric on the basis of the information set forth in Applicant's specimen of use. Notably, CASALANA brand fabric is featured alongside 10 other brands of Applicant's goods, and the only information to distinguish CASALANA from the others is the wording "The washable wool." Even this wording does not distinguish this product from the others, because the text of the webpage indicates that all Applicant's fabrics, with the exception of its faux fur fabrics, are washable. The photograph depicting CASALANA fabric is a generic photograph of a fold of fabric, and contains virtually no information about the specific qualities of the product. Thus, it would be impossible for a customer to make an informed decision to choose the CASALANA brand from among the other goods offered on the webpage.

There is other information regarding the nature and quality of Applicant's fabrics in general: they are made by the sliver knitting process; they are light in weight because the fibers are not twisted into yarns and the fabrics are made with "fine denier filament backing yarn"; they have non-shrink construction; they are pre-dyed before construction; they have "appealing softness, drape, and hand"; and they are available in "A nearly endless array of textures and patterns." Applicant offers "just

in time" production, with the implication that the goods will be made to order and specification.

Much information that we would consider essential to a purchasing decision is absent from Applicant's specimen. There is no information at all regarding the price, or even a range of prices, for the goods. There is no information regarding the weight or thickness of the fabric or the dimensions in which a bolt of the fabric would be available. As in *Anpath*, there is no information about the minimum quantities one may order, how one might pay for the products, or how the goods would be shipped. 95 USPQ2d at 1381. Considering the nature of the goods, it seems unlikely that Applicant's customers, who are manufacturers of "outerwear, gloves, apparel, and accessories," would purchase Applicant's fabric for incorporation into their goods without first inspecting a sample of the fabric. We find it implausible that a relevant customer would make such a purchase on the basis of the information disclosed in the specimen of use. Rather, customers would need a great deal more information about the CASALANA fabric before they would be prepared to purchase it.

This case is distinguishable from *In re Valenite, Inc*., 84 USPQ2d 1346 (TTAB 2007), in which a telephone number for a customer service representative, displayed on a web page, was the final step in the means provided for ordering the goods. In *Valenite*, the applicant provided a verified declaration from its director of marketing, confirming that the telephone numbers in question had in fact been used to place orders for the goods. Moreover, the applicant's webpage provided substantial technical information regarding the goods, including reference tables, material safety

data sheets, and an online calculator. When considered together with the director of marketing's statements, the Board was satisfied that customers had sufficient information to "select a product and call customer service to confirm the correctness of the selection and place an order." 84 USPQ2d at 1350.

We appreciate that the fact that Applicant's goods are industrial materials for use by the customer in manufacture indicates that the ultimate sale transaction may have to involve assistance from Applicant's sales personnel. Yet, while some details must be worked out by telephone, if virtually all important aspects of the transaction must be determined from information extraneous to the web page, then the web page is not a point of sale. Where the goods are technical and specialized in nature, and the applicant and examining attorney disagree as to whether a web page functions as a point of sale, the applicant would be well advised to provide the examining attorney with additional evidence and information regarding the manner in which purchases are actually made through the webpage. Attorney argument is not a substitute for reliable documentation of how sales actually are made, confirmation that actual sales have been consummated, and verified statements from knowledgeable personnel as to what happens and how. *See In re U.S. Tsubaki, Inc.*, 109 USPQ2d at 2007 ("where it is asserted that the nature of the goods and the consumers . . . require more involved means for ordering products, it is critical that the examining attorney be provided with *detailed information* about the means for ordering goods, and that such information be *corroborated by sufficient evidentiary support*." (emphasis added)).

As we have discussed above, we find that the webpage submitted as Applicant's specimen of use is not a point of sale display, and therefore that the webpage is not a display associated with the goods within the meaning of the Trademark Act.

Decision: The refusal to register is affirmed.

Lykos, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority's decision. In my view, Applicant's specimen of use constitutes a valid "point of sale" display for "[k]nit pile fabric made with wool for use as a textile in the manufacture of outerwear, gloves, apparel, and accessories" within the meaning of the Trademark Act. That is to say, Applicant's direct-to-consumer sale e-commerce web site provides a means for ordering the identified goods and sufficient information "calculated to consummate a sale." *See U.S. Tsubaki, Inc.*, 109 USPQ2d at 2009.

In particular, I disagree with the majority's finding that "on the present record we find it implausible that the business representative of a manufacturer would be prepared to place an order to purchase CASALANA brand fabric on the basis of the information set forth in Applicant's specimen of use." The product information on the specimen as summarized by the majority ("they are made by the sliver knitting process; they are light in weight because the fibers are not twisted into yarns and the fabrics are made with "fine denier filament backing yarn"; they have non-shrink construction; they are pre-dyed before construction; they have "appealing softness, drape, and hand"; and they are available in "A nearly endless array of textures and

patterns") seems sufficient to induce a purchase. Furthermore, as presented on the specimen, the telephone number is not merely informational but rather is preceded by the language "For Sales Information" thereby providing a mechanism for placing an order. *Compare In re Genitope Corp.,* 78 USPQ2d 1819, 1822 (TTAB 2006) ("[T]he company name, address and phone number that appears at the end of the web page indicates only location information about applicant; it does not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone."). Such language is not uncommon for direct-to-consumer sales e-commerce sites which is the type of website Applicant is using to sell its products.

Another consideration in the majority's decision is the lack of pricing information. Given the specific circumstances of this case, I do not think this is fatal. Applicant's goods as identified are not purchased by the average consumer but rather by manufacturers for use as a component in the production of outerwear, gloves and apparel. One could expect that under these circumstances the price would be negotiable depending on the quantity and quality of the fabric selected. Applicant is not marketing its commercial textiles to the average consumer from brick and mortar department stores or "big box" online retailers selling a wide variety of goods. Rather, Applicant is offering its products to a narrow niche of manufacturers from its own direct-to-consumer e-commerce website. In *Sones*, *supra*, the Federal Circuit cautioned the Board to avoid "bright-line" rules or "mandatory" requirements. In light of the increasing prevalence in the marketplace of direct-to-consumer e-commerce

sites, we need to keep this guidance in mind and adopt a flexible approach in evaluating whether a specimen shows "use in commerce."