

This Opinion is Not a
Precedent of the TTAB

Mailed: December 9, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re User First

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Serial No. 87231226

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Kenneth Linzer of Linzer Law Group PC,
for User First.

Jacob Vigil, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

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Before Taylor, Wolfson and Larkin,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

User First (“Applicant”) seeks registration on the Supplemental Register of the mark USER FIRST (in standard characters) for “Computer software, namely, software development tools for the creation of mobile internet applications and client interfaces” in International Class 9.

The Trademark Examining Attorney has finally refused registration of Applicant’s applied-for mark under Sections 1(a) and 45 of the Trademark Act, 15

U.S.C. §§ 1051(a), 1127, on the ground that the specimens of record do not show the mark used in commerce in connection with the identified software development tools.

Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Evidentiary Issue

We first address an evidentiary matter. In response to the Examining Attorney's brief, Applicant submitted the declaration of its office manager, Michael Berlin, attesting, in part, that "[t]he document entitled 'Certification Training Lab: Apps, KPIs, Dashboards and Charts from REST Data, SQL Server Data and Excel Reports' [Document] is the cover page of an instruction manual for individuals using Applicant's software goods,"¹ and a complete copy of the Document.²

Because the declaration and complete Document were not made of record until the filing of Applicant's reply to the Examining Attorney's brief, they are untimely and will be given no further consideration.³ *See* Trademark Rule 2.142(d), 37 C.F.R. § 142(d) ("The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of

¹ 10 TTABVUE 106. The TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

² *Id.* at 2-105.

³ If Applicant desired to introduce additional evidence, it could have requested suspension of the proceeding and remand of the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d).

appeal.”). *See also In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001) (“By attempting to introduce evidence with its reply brief, applicant has effectively shielded this material from review and response by the Examining Attorney.”).

II. Background

Before proceeding to the merits of the appeal, a review of the prosecution history is in order. Application Serial No. 87231226 was filed on November 9, 2016, initially seeking registration on the Principal Register of the wording USER FIRST, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). A first Office Action issued on February 17, 2017, refusing registration on the ground that the wording USER FIRST is merely descriptive of the goods pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Applicant responded to the refusal by filing an amendment to allege use (which was accepted on September 8, 2017), and amending its application to seek registration on the Supplemental Register.

The Examining Attorney issued a second Office Action refusing registration for failure to function as a trademark under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051-52, 1127, because Applicant’s specimen did not show trademark use of the applied-for mark, and requiring the submission of a substitute specimen under Sections 1(a) and 45 because the specimen filed with the amendment to allege use did not show use in commerce in connection with the identified goods.

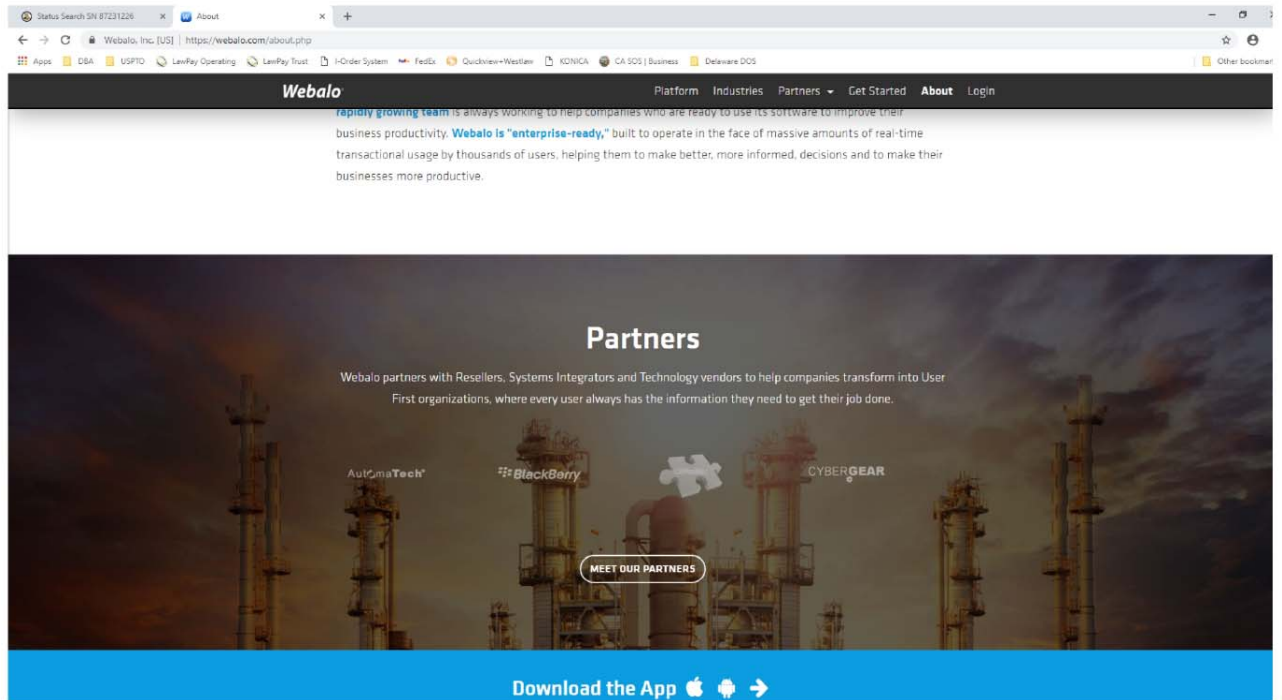
The original specimen is reproduced below:



In response, Applicant amended the application to its original intent to use basis, making the amendment to allege use moot.

The Examining Attorney then issued a third Office Action, withdrawing the failure to function refusal and the requirement for a substitute specimen, refusing registration on the Supplemental Register on the ground that the application was no longer eligible for Supplemental Register registration, and renewing the Section 2(e)(1) refusal.

Applicant responded by filing a second amendment to allege use, which was accepted on September 29, 2018, accompanied by a different specimen. The specimen is reproduced below:⁴



The Examining Attorney then issued a fourth and Final Office Action withdrawing the refusal regarding eligibility for registration on the Supplemental Register, noting that the 2(e)(1) refusal had been obviated, and reinstating and making final the refusal of registration for failure to function as a trademark under Sections 1, 2, and 45 because Applicant's specimen did not show trademark use of the applied-for mark, and the requirement for a substitute specimen under Sections 1(a)

⁴ The mark appears in the following statement: "Webalo Partners with Resellers, System Integrators and Technology vendors to help companies transform into User First organizations where every user always has the information they need to get their job done."

and 45 because the specimen filed with the second amendment to allege use did not show use of the applied-for mark in commerce in connection with the identified goods.

Applicant filed a notice of appeal and a “Request for Reconsideration after Final Action,” by which it submitted the substitute specimen shown below, described as “[a] scanned first page of a 103 page pdf instruction manual for the User First platform.”⁵



Webalo Certification Training Lab – KPIs, Dashboards and Charts
R54 Version 13817 (010318)

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In his denial of the request for reconsideration, the Examining Attorney withdrew the refusal for failure to function as a mark, but maintained the refusal based on the

⁵ March 21, 2019 Request for Reconsideration; TSDR 2.

requirement for a substitute specimen that clearly shows the mark used in connection with the identified software goods.

Applicant subsequently filed its appeal brief based solely on the specimen requirement as it pertains to the substitute specimen shown directly above, which was filed with its request for reconsideration. The appeal is fully briefed. We affirm.

III. Issue

The sole question before us is whether the first page of the “instruction manual for the USER FIRST Platform” is an acceptable specimen within the meaning of Sections 1 and 45 of the Trademark Act, demonstrating use in commerce of the applied-for mark USER FIRST in connection with the identified goods.

IV. Applicable Law

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a trademark is used in commerce when “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 ...” *See also* Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a), “an amendment to allege use under § 2.76 ... must ... include one specimen per class showing the mark as used on or in connection with the goods” Applicant submitted what it describes as the first page of a .pdf instruction manual as a specimen of use, and the Examining Attorney does not dispute that an instruction manual may be an appropriate specimen under Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1) (“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 impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.”). *See also, e.g., In re Ultraflight Inc.*, 221 USPQ 903, 906 (TTAB 1984) (The Board found that “the instruction manual [that is part of a kit for assembling the product] is as much a part of applicant’s goods as are the various parts that are used to build the gliders. Application of the mark to the manual of assembly instructions, then, must be considered affixation to the goods.”).

V. Discussion

Applicant has identified its current specimen as the first page of an instruction manual for its software goods, stating that it “contains the applied-for mark USER FIRST, prominently on the very top line of the document.” Applicant argues that “[t]he circumstances surrounding the present Application are in every meaningful way identical to those posed in *Ultraflight*,”⁶ such that its specimen adequately shows its mark used in commerce within the meaning of Sections 1 and 45 of the Lanham Act.

While recognizing that under *Ultraflight* instruction manuals can be acceptable specimens of use under certain circumstances, the Examining Attorney refuses to accept Applicant’s specimen because “the cover page is not clearly an instruction manual for downloadable software.”⁷ The Examining Attorney expounds that:

⁶ 7 TTABVUE 6.

⁷ 9 TTABVUE 6.

Although the specimen description states that the specimen is a cover page from an instruction manual, the text of the page indicates otherwise and creates ambiguity as to the nature of the specimen. The cover page is noticeably missing generic terms that would be expected to appear on an instruction manual, such as “manual,” “instructions,” or “user guide.” Rather, the page features the wording “Certification Training Lab: Apps, KPIs, Dashboards and Charts from REST Data, SQL Server Data and Excel Reports.” Printout data at the bottom of the page shows the wording “Webalo Certification Training Lab – KPIs, Dashboards and Charts.” The wording “Certification Training Lab” indicates education or training for the purpose of being certified in some discipline. This unusual wording does not indicate an instruction manual. Instead, the specimen appears to be training materials for a class or training program and not an instruction manual provided with the goods such that it functions as a part of the goods.⁸

We agree with the Examining Attorney and find that Applicant’s specimen does not clearly show Applicant’s applied-for mark used in connection with the identified “software development tools for the creation of mobile internet applications and client interfaces.” Although Applicant describes its specimen as being the cover page of an instruction manual for these goods, the text on the page does not reference these goods and, in fact, creates something of an ambiguity as to the nature of the specimen. Also, as pointed out by the Examining Attorney, the cover page does not include terms usually associated with an instruction manual, such as, “manual,” “instructions,” or “user guide.” While the use of these or other specific terms is not required before a document is recognized as an instruction manual, the wording “Certification Training Lab,” as presented on the proffered specimen, appears to refer to materials for an

⁸ 9 TTABVUE 5.

education or training program for which Applicant's specimen is the cover page, instead of an instruction manual that is integral to the use of, and functions as part of, Applicant's identified software development tools, as was contemplated by the Board in *Ultraflight*. Notably, the wording at the bottom of Applicant's specimen references "Webalo Certification Training Lab – KPI's Dashboards and Charts."

We are not persuaded by Applicant's contention that use of the wording "Certification Training Lab," as opposed to "instruction manual" or "user manual," does not substantially change the specimen's purpose as a manual for the goods. While we accept that an instruction manual may be called different things, it is doubtful that materials associated with the terminology "Certification Training Lab" would be recognized by consumers as manuals containing instructions on how to create mobile internet applications or client interfaces using software development tools such as provided by Applicant. Moreover, the record is devoid of evidence showing that Applicant's cover page specimen is from a manual provided contemporaneously with, and that functions as part of, the identified software goods.

Finally, the facts in this case are distinguishable from those in *Ultraflight*. In *Ultraflight*, the Board was presented with the cover page of a recognizable instruction manual that was integral to the operation of the Applicant's goods, and which was provided contemporaneously with the Applicant's goods. However, in this case and as discussed above, although Applicant's specimen is characterized as a cover page of an instruction manual for software goods sold by it, that fact is not discernable from a reading of the cover page itself. Nor is it clear from the face of the specimen that the

“manual” is integral to the use and operation of the identified software or that it is provided contemporaneously therewith such that it may be considered as part of the software goods themselves.

For the reasons indicated, we find that Applicant’s substitute specimen is unlikely to be recognized as a cover to an instruction manual for Applicant’s identified software goods, and that the substitute specimen thus does not show affixation of the mark to the goods identified as “computer software, namely, software development tools for the creation of mobile internet applications and client interfaces.” We therefore conclude that the substitute specimen of record is not adequate to support trademark use of the mark with the identified goods.⁹

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

⁹ As discussed above, we have excluded what Applicant’s “Reply Brief” describes as the “User First Manual,” 10 TTABVUE 1, because it was not timely submitted. We express no opinion regarding the sufficiency of the entire “User First Manual” as a specimen of use of the applied-for mark.