This Opinion is Not a Precedent of the TTAB

Mailed: October 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re E Z Products, Inc.

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Serial No. 87906813

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Kevin M. Hayes of Klarquist Sparkman, LLP,
for E Z Products, Inc.

Mark S. Tratos, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before Mermelstein, Goodman and Larkin,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

E Z Products, Inc. ("Applicant") seeks registration on the Principal Register of the mark SPEED EZ (in standard characters) for

> cleaning brushes for use on automobiles, motorcycles, boats and other vehicles; cleaning brushes for use on wheelchairs; cleaning brushes for use on bicycles in International Class 21.[1]

[1] Application Serial No. 87906813 was filed on May 3, 2018, based upon Applicant's assertion 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).

The Trademark Examining Attorney has refused registration of Applicant's mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that "the specimen submitted appeared to consist of a mockup of the applied-for mark on packaging for the Applicant's goods and did not show the applied-for mark in actual use in commerce." 10 TTABVUE 2.

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

I. Prosecution History

Before discussing the merits of the appeal, a summary of the prosecution history is in order. The involved application was originally filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). On December 4, 2019, after publication in the Official Gazette and issuance of a notice of allowance, Applicant submitted a Statement of Use accompanied by the specimen reprinted below:

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Applicant's brief is at 8 TTABVUE and the reply brief is at 11 TTABVUE; the Examining Attorney's brief is at 10 TTABVUE.

The Examining Attorney refused registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127, and 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a), on the ground that the specimen in International Class 21 consists "of a digitally altered image or a mock-up of the mark on the goods or their packaging and does not show the applied-for mark in actual use in commerce." January 28, 2020 Office Action at TSDR 1.

The Examining Attorney explained his basis for finding the specimen to be a mockup of a product label:

> Specifically, the wording "SPEED EZ" appears on a piece of paper that has been subsequently placed on an already existing label for the applicant's other goods. This piece of paper bearing the applied-for mark is not the same shade of white as the rest of the label, cuts off pictorial representations of bubbles on the already existing label, and shows the wording arranged vertically, when all other wording on the labels appears arranged horizontally. Therefore, it appears that the applicant

> has merely printed the applied-for mark on a piece of paper and attempted to attach it to its current product labels. Thus, the submitted specimen cannot be accepted.

Id. at TSDR 1.

The Examining Attorney suggested that Applicant submit a substitute specimen in response to the refusal, also making a request for information. *Id*. The information sought by the Examining Attorney included "information about and examples of how applicant's goods appear in the actual sales environment" to include "a representative sample of the name(s) of the stores and of photographs showing the goods for sale in the named stores, such as photographs of the sales displays or goods on shelves with the mark." *Id*. at TSDR 1.

In its May 27, 2020 Response to Office Action, Applicant provided further explanation about the nature of the specimen and asserted that the specimen complies with Section 45 of the Trademark Act as a label affixed to the tag that is attached to the goods:

> Specifically, the label containing the mark SPEED EZ is clearly on the tag that is affixed to the goods. The label is not a piece of paper, but an actual label that is affixed to the tag. There is no rule that says a label when affixed to the goods cannot cover other graphics (in this case the bubbles), nor is there a rule that says the wording has to be in the same font or match the arrangement of the other wording on the tag.

May 27, 2020 Response to Office Action at TSDR 1.

Applicant argued in its response that "[t]he specimen requirement has been met. ... no substitute specimen or declaration should be required because the specimen, as submitted, is appropriate." *Id*. at TSDR 1. Applicant also declined to provide a

response to the request for information, believing that its explanation relating to the specimen mooted the need for such a response. *Id.* at TSDR 1.

In his June 18, 2020 Office Action, the Examining Attorney made final the specimen refusal and the request for information, rejecting Applicant's explanation that the mark has been placed on a label which is affixed to a tag attached to Applicant's goods. The Examining Attorney took the position that the "packaging has been altered to include the mark" "by an [sic] subsequent label so as to include the applied-for mark." The examining explained his position as to why the specimen was a mockup and did not show actual use in commerce:

> The specimen shows the applied-for mark on a small, white piece of paper that has been either placed, taped or glued on a different label or tag, bearing a different mark for the goods identified by the applicant in Class 21. The small piece of paper has uneven sides and curved lines, which cover portions of design elements on the larger label or tag. Moreover, the smaller label creates shadows around all four edges of the label, clearly showing that the applied-for mark is not printed on the larger tag containing the wording EZDETAIL. Additionally, the applicant's use of the applied-for mark in connection with the cleaning brushes is wholly inconsistent with the use of similar marks on the rest of the label. Specifically, all of the wording on the labels is presented horizontally, including the other trademarks EZDETAIL, LITTLE EZ, GO EZ, BIG EZ, and EZ PRODUCTS. The only wording that is presented in an inconsistent manner when compared to the rest of label is the applied-for mark. All of this evidence indicates that the applied-for mark does not actually appear on the main tag that was provided by the applicant. Instead, the applied-for mark appears only on a piece of paper that has been laid on the tag.

After the specimen refusal and information requirement was made final, Applicant filed a request for reconsideration on December 18, 2020, providing answers to the Examining Attorney's information request. Applicant provided

photographs of the goods in the actual sales environment with the label and tags applied, identifying three locations where the goods are sold. December 18, 2020 Request for Reconsideration at TSDR 3, 4, 8. Applicant explained that it created the label for use in commerce, and not for submission as a specimen. *Id* at 2.

In response to the request for reconsideration, the Examining Attorney issued a "Notice of incomplete response to a final office action – additional time granted to resolve issues." January 13, 2021 Office Action at TSDR 1. The Examining Attorney found Applicant had satisfied the information requirement, but considered the photograph of the goods in actual commerce to be a substitute specimen that was lacking verification. The Examining Attorney provided Applicant time to provide the verification or submit a different substitute specimen with verification. *Id.* at TSDR 1.

When Applicant failed to respond to this action with a verification or another substitute specimen, the Examining Attorney denied reconsideration on March 18, 2021. The Examining Attorney explained:

> In this case, the specimen of record shows the applied-for mark on a small rectangular piece of paper that has been laid upon another label for similar goods. The applied-for mark and drawing of the goods below the applied-for mark are the only parts of the label arranged vertically and not horizontally. The larger label showing the EZDETAIL logo label shows multiple images of soap bubbles, which are covered by the mockup label used by the applicant, indicating that the applied-for mark has merely been placed upon a previously manufactured label. Noting the portion of the applicant's label that identifies the three kinds of cleaning brushes, the bubble designs are prevalent throughout the label. However, the small white piece of paper bearing the applied-for mark shows no bubble designs, indicating that the applied-for mark has been placed upon a previously manufactured label.
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> Moreover, the small piece of white paper is not cut with straight lines (noting the concave left edge) and shadows are noticeable on the left and bottom edges. This indicates that the small piece of white paper containing the applied-for mark has been separately made and placed on a previously manufactured label for the applicant's goods. The color of the brush (red) on the small white piece of paper does not match the color of the images of any of the other brushes shown on the larger label

> (blue). … Therefore, the specimen does not show actual use of the mark in commerce.

March 18, 2021 Denial of Reconsideration at TSDR 1.

II. Arguments

On appeal, Applicant argues that it "has more than proven that the goods have been shipped in commerce with mark affixed to the goods" by its explanation that the labels were affixed to the packaging (tags) and by the submission of the additional photographs of the goods in actual commerce. 8 TTABVUE 7; 11 TTABVUE 4. Applicant submits that its specimen complies with the requirements of Section 45 of the Trademark Act as a "label that is affixed to a tag containing the goods," and points out that there is no rule that the wording has to be same font, or match the arrangement of wording on the tag, or cannot cover graphics on the tag. 8 TTABVUE 7; 11 TTABVUE 3. Applicant also points out that it "clearly declared that the image was in use in commerce" and provided additional photographs, "significant additional information regarding use in commerce" and "detailed answers to the Examiner's inquiries" to show that the mark has been affixed to goods shipped in commerce. 8 TTABVUE 7; 11 TTABVUE 4.

The Examining Attorney rejects Applicant's position and argues that there "are several elements that indicate the specimen is a mockup." 8 TTABVUE 6. He points to the label being "stylistically incongruent" with the tag as the label does not include an image of the goods, and the label has different lettering than the other marks and goods identified on the tag, and provides no information about the goods nor instructions for use. 8 TTABVUE 6-7. The Examining Attorney also argues that the

submitted photographs of the tags affixed to the goods in commerce appear to be completely printed, rather than a label affixed to a tag, "indicating that the specimen of record was a mockup" because the label was made separately from the tag and "merely placed on a different tag." 8 TTABVUE 7, 8. The Examining Attorney references Section 904.03(a) of the Trademark Manual of Examining Procedure (TMEP), which states that a mark "reproduced on a plain white label adhered to the goods or printed packaging" can suggest that the label or tag is not actually in use in commerce. 8 TTABVUE 9. He submits that the "mere placement of a label in any manner on the Applicant's packaging does not necessarily show use of the applied-for mark in commerce." 8 TTABVUE 10.

III. Analysis

"[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 . . . and (B) the goods are sold or transported in commerce." Section 45 of the Trademark Act, 15 U.S.C. § 1127. Trademark Rule 2.56(b)(1), 37 CFR § 2.56(b)(1), which pertains to specimens for goods, provides in part that: "A trademark specimen must show use of the mark on the goods, on containers or packaging for the goods, on labels or tags affixed to the goods, or on a display associated with the goods." TMEP Section 904.04(a)(iii), which discusses "General Examination Considerations for Digitally Created/Altered or Mockup Specimens," instructs examining attorneys that "[i]f the applicant

satisfactorily responds to all requests for information and the original specimen does not contradict those responses, the specimen must be accepted."

Applicant has stated that it uses the mark in commerce and has provided a full explanation of how it uses the mark by affixing the label to tags for the goods. As pictured above, in the actual sales environment, the provided specimen is exactly how the mark is actually used in commerce. Thus, the submitted specimen and the photographs of actual use are consistent and do not contradict each other.

While the mark is not preprinted onto the tag, the fact that Applicant printed a label that it affixed to a preprinted tag is not prohibited nor does it make the specimen a mockup. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1847-48 (TTAB 2007) (temporary nature of specimens is not a characteristic that is "fatal" to registration). *See also In re Brown Jordan Co.* 219 USPQ 375, 376 (TTAB 1983) (the fact that mark is not stamped on tags affixed to the goods until after order is received is not prohibited).

In short, we conclude that the specimen of record submitted with the statement of use and supporting evidence of trademark use meets the statutory requirement for registration under Section 45 of the Trademark Act.

Decision: The Section 1 and 45 refusal to register Applicant's mark SPEED EZ is reversed.