

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 22
CEW

9/20/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Samick Music Corporation

Serial No. 75/063,066

Wendy K. Buskop of Buskop Law Group for applicant.

Lisa W. Rosaya, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Hairston, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

This case concerns an application by the Samick Music Corporation on the Principal Register for the mark DIGIPLAYER for "acoustic and electronic pianos and electronic musical keyboards."¹ Following publication of the mark for opposition and issuance of the notice of allowance, on January 1, 1997, applicant submitted a Statement of Use accompanied by specimens consisting of an

¹ Application No. 75/063,066, filed February 26, 1996, based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

advertisement. Following the Examining Attorney's refusal to register on the ground that the specimens did not evidence use of the mark on the goods, applicant submitted verified substitute specimens consisting of computer diskettes with the mark appearing on a label thereon.

The Examining Attorney has issued a final requirement for the submission of specimens showing use of the mark on or in connection with the goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not held.

We begin with a preliminary procedural matter. In the final paragraph of its appeal brief, applicant requested that, if the Board finds its specimens inadequate, applicant be given time to furnish adequate specimens or amend the declaration accompanying the specimens. In its order of June 18, 1999, the Board denied this request and informed applicant that any request for remand at this point must be supported by a showing of good cause or the consent of the Examining Attorney. Applicant then waited until the submission of its reply brief of August 30, 1999, to submit a request for remand along with the verified statement of an officer attesting to the use of the originally submitted specimen as a display associated with

the goods at trade shows since at least as early as January 1999. “[R]emand in an ex parte appeal is a matter of discretion with the Board, and the Board may refuse to remand for consideration of an amendment filed more than six months after the date of the action from which the appeal was taken” *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), Section 1205. Applicant has been on notice since April 15, 1998, the date of the first refusal based on the insufficiency of the specimens submitted with applicant’s Statement of Use, that the specimens have been considered to be advertisements by the Examining Attorney. It is not, as applicant argues, the Examining Attorney’s responsibility to guess whether these materials, which on their face are clearly advertisements, have also been used as displays associated with the goods. Instead of correcting what applicant now asserts is the Examining Attorney’s misunderstanding of the original specimens, applicant said nothing at the time and merely submitted substitute specimens. Applicant has not established good cause for remand at this time. Thus, its request for remand is denied and the declaration submitted with its reply brief has not been considered.

We now turn to the issue before us, whether the substitute specimens submitted by the applicant on August 10, 1998, are acceptable specimens of trademark use.²

The specimens are computer diskettes bearing labels upon which the mark appears as follows:

Applicant explains in its brief that the specimens are "copies of demo disks shipped with the Digiplayer pianos The demo disks demonstrate the operation of the pianos and are tantamount to an instruction manual." Applicant

² In its brief, applicant continues to argue that the originally submitted specimens are acceptable. In view of our finding above that we will not consider the declaration submitted with applicant's reply brief, we conclude that the specimens originally submitted are clearly merely advertisements. Although the goods are pictured in the advertisement, the mark does not appear on the goods, rather it appears in the advertising copy. As such, these advertisements are not acceptable specimens of trademark use of DIGIPLAYER on the identified goods. We consider the text of the advertisements in our opinion, *infra*, merely for the information conveyed therein about the nature of the goods.

contends that the demo disks "are an integral part of the product being sold, as would be an instruction manual."

The advertisement submitted with the Statement of Use refers to applicant's piano as "a leading edge digital piano"; that it "possesses all the general MIDI voices needed to reproduce the rhythm and accompaniment programs"; that it is "[c]apable of playing almost all currently available piano software"; and that "[a] full 8 Meg General MIDI Sound Engine by E-Mu, 16 bit Sampling, 32 note polyphony, 8-track Standard MIDI File Sequencer and a custom-made rhythm accompaniment section are all neatly tucked away in your choice of five different cabinet finishes." We take judicial notice of the definition of a MIDI file³ as follows:

Musical Instrument Digital Interface file. A set of instructions for a computer or synthesizer to play a certain musical composition. The MIDI file does not include actual sounds, but information on how to make the sounds. The MIDI instructions include the notes played, length of notes, instruments, volume, rhythm, etc.

Sections 1(a)(1)(C) and 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(a)(1)(C) and (d)(1), require the submission in an application of specimens of the mark "as used." Trademark Rule 2.56, 37 CFR 2.56, requires the submission

³ *Computer Currents High-Tech Dictionary* (1999); submitted by the Examining Attorney with her brief.

Serial No. 75/063,066

of "specimens of the trademark as used on or in connection with the goods in commerce." As applicant notes, the Board, in *In re Ultraflight Inc.*, 221 USPQ 903 (1984), made it clear that if printed matter included with goods functions as an integral part of the goods, such as a manual for assembling a kit for the product, placement of the mark on that printed matter constitutes use on the goods. Moreover, the Board concluded, in *In re Brown Jordan Co.*, 219 USPQ 375 (1983), that it is not necessary that purchasers see the mark for the goods before they purchase the goods.

From the information on the advertisement and applicant's explanation, it is clear that applicant's goods require software to operate; and that the software contained on the demo disk specimen is used to demonstrate the operation of the goods and is shipped with the goods. Clearly, these demo disks are an integral part of the goods themselves and, therefore, they constitute acceptable specimens of trademark use. It is an immaterial difference that the specimens are software rather than printed manuals.

Serial No. 75/063,066

Decision: The refusal on the ground that the specimens are unacceptable evidence of trademark use is reversed.

P. T. Hairston

C. E. Walters

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial and Appeal Board