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8/29/03  
Paper No. 32  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WebLink Wireless, Inc.

Serial No. 75/366,565

William A. Munck of Davis Munck, P.C. for WebLink Wireless, Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office 114 (Margaret K. Le, Managing Attorney).

Before Cissel, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

October 1, 1997, applicant filed the above-identified application to register the mark "PACKFAST" on the Principal Register for "data and voice communications services, namely, providing paging and voice messaging services and services related to the activation and use of message pagers and personal communication systems," in International Class 38. Applicant asserted that it had a

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bona fide intention to use the mark in commerce in connection with these services.

In addition to another informality, the original Examining Attorney<sup>1</sup> advised applicant that the recitation of services was unacceptably indefinite. Accordingly, applicant amended the recitation of services to read as follows: "data and voice communications services, namely, providing paging and voice messaging services, all in International Class 38."

On August 17, 2001, applicant filed a Statement of Use under Trademark Rule 2.88. The specimen of use submitted in conjunction with the Statement of Use is a printed advertisement. Applicant is identified at the top of the page, and three paragraphs appear beneath the heading "PackFAST!" Next to this text, illustrations of the three computer "screen shots" are shown with pictures of a "beeper" and two text-messaging devices beneath them. The text of the three paragraphs is shown below:

PackFAST! is one more way WebLink Wireless puts control into the hands of its customers. The administrator will no longer need to call an office to request messaging device delivery and activation for end users. Ordering devices has never been easier.

PackFAST! allows WebLink Wireless' customers to order wireless devices directly from our inventory

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<sup>1</sup> The Examining Attorney identified above was assigned to this application following the first Office Action.

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distribution center, directly from a PC. Each order is processed and can be shipped via next day airfreight (such as FedEx) either directly to employees or the Communications Administrator, fully activated and ready to use. With each order the account is automatically billed.

PackFAST! is a free computer program that permits a centralized administrator to dial directly into WebLink Wireless' provisioning system. As part of the ordering process PackFAST! gives the customer the ability to select the messaging device and assign a local toll-free number as well as select the desired coverage for each device.

The Examining Attorney held that this specimen does not show use of the mark in connection with the services identified in the application, as amended. He found that the specimen demonstrates that the mark is used to identify a free computer program that simplifies ordering goods from applicant, but that there is no indication that the mark is used to advertise or sell paging or voice messaging services. Citing Trademark Rules 2.56 and 2.88(b)(2), the Examining Attorney required applicant to submit a new specimen showing use of the mark used in connection with the sale or promotion of the services recited in the application, along with an affidavit or a declaration that the substitute specimen was in use in commerce prior to the expiration of the time allowed applicant for filing its statement of use.

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Additionally, the Examining Attorney noted that the mark on the drawing was displayed as "PACKFAST," whereas the specimens depict the mark as "PACKFAST!" Applicant was advised that unless the new specimen applicant needed to submit showing use of the mark in connection with the recited services showed the mark as "PACKFAST," applicant was required to submit a new drawing of the mark depicting it as "PACKFAST!"

Applicant did submit a substitute drawing which includes the exclamation point, but argued that the Examining Attorney's requirement for another specimen of use was not well founded. Applicant quoted from the text of its advertisement and concluded that the specimen of record clearly establishes applicant's use of the mark in connection with its paging and voice messaging services.

The Examining Attorney accepted the amended drawing, but continued and made final the requirement for a substitute specimen. Applicant timely filed a Notice of Appeal and an appeal brief. The Examining Attorney filed his brief on appeal and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

Trademark Rule 2.56 requires that "[a] service mark specimen must show the mark as actually used in the sale or advertising of the services." The sole issue on appeal is

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whether the specimen submitted by applicant demonstrates use of the mark in the sale or advertising of the paging and voice messaging services identified in the application.

The Examining Attorney takes the position that the mark identifies "a free computer program," i.e., software, which is used to order applicant's paging devices and services, and concludes that although "this product is tangentially related to the claimed services, it cannot be said that the proposed mark serves to indicate the source of any paging or voice messaging services. The specimen makes no mention of the claimed services in any context other than to promote Applicant's software as a tool to order such services and attendant devices." (Brief, p. 3).

The legal principle involved in this appeal is not disputed by either applicant or the Examining Attorney. In order to be evidence of use of the mark as a service mark, the specimen must show the mark used in a manner that would be perceived by potential purchasers as identifying applicant's services and indicating their source. The specimen must show the mark used in such a way that someone considering the specimen would associate the mark with the claimed services. In re Universal Oil Products Co., 476 F.2d 653, 177 USPQ 456 (CCPA 1973); and In re Johnson Controls, Inc. 33 USPQ2d 1318 (TTAB 1994). Applicant and

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the Examining Attorney simply disagree as to whether the specimen shows the mark used in such a way that a reasonable reader of it would understand the mark to identify the source of applicant's paging and voice messaging services, rather than only as a mark for the software used to order the services and the devices used in the rendering of the services.

Simply put, we agree with applicant that the specimen of record shows the mark used to identify the source of applicant's paging and voice messaging services. Although there can be no dispute but that the mark is specifically linked to applicant's ordering software, the specimens do show the mark used in association with the services which are rendered by means of the devices. In the first paragraph of the text, for example, in addition to showing the mark, applicant states that its customers no longer need to call an office to request delivery of messaging devices "and activation for end users." If the only thing applicant did was provide messaging devices, the mark would not be a service mark, but this language makes it clear that applicant not only provides the devices, it also activates them so that they can be used to receive messages. Once a pager is "activated," the service is being provided. This point is verified in the second

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paragraph, which states that after order processing and shipment, the devices arrive "fully activated and ready to use." The third paragraph of text in the advertisement notes that the customer is given the ability to select not just the particular messaging device, but also a local or toll-free number as well as the desired coverage for each device. The specimen thus makes it clear that applicant does more than simply supply the electronic devices; it provides the paging and messaging services which are rendered by means of such products. In view of the fact that the mark is clearly displayed in a manner which creates an association between the mark and the ordering and the provision of these services, the specimens meet the requirement of Rule 2.56, i.e., they show the service mark as actually used in the sale or advertising of the services. Accordingly, the requirement for a substitute specimen is not well taken.

DECISION: The requirement for a substitute specimen is reversed, and the application will proceed to publication in due course.