

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: 8/31/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hewlett-Packard Ltd., International Business Machines
Corporation, and Seagate Removable Storage Solutions LLC

Serial No. 75461855

M. Iris Hess of Ladas & Parry for applicants.

Michael H. Kazazian, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Walters and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by the above-named joint
applicants to register the mark LINEAR TAPE-OPEN for
"retail store services featuring computers, electronics,
and data processors; mail order catalog and telephone order
services featuring computers, electronics and data
processors" in International Class 35.¹

¹ Application Serial No. 75461855, filed April 3, 1998, based on
an allegation of a bona fide intention to use the mark in
commerce. Applicants subsequently filed a statement of use
setting forth dates of first use of August 20, 2000.

The examining attorney refused registration on the ground that applicants failed to submit acceptable specimens showing actual use of the mark in connection with the services recited in the application.

When the refusal was made final, applicants appealed. Applicants and the examining attorney filed briefs.² An oral hearing was not requested.

The application originally was filed in three International Classes, namely Classes 9, 16 and 42. The examining attorney indicated that certain terminology in the identification was indefinite, and an acceptable identification of goods in four Classes was suggested. Applicants filed an acceptable amendment to the identification, and the intent-to-use application subsequently was approved for publication in Classes 9, 16, 35 and 42. After publication without opposition, a notice of allowance issued. Applicants then submitted a statement of use together with specimens of use. The examining attorney accepted the Class 42 specimens, but found that

² Applicants submitted, for the first time with their appeal brief, certain third-party registrations in support of one of their arguments, namely that its on-line shopping services are analogous to a department within a retail outlet (exhibit D). The examining attorney objected to this evidence as untimely. The objection is sustained inasmuch as this evidence was untimely submitted. Trademark Rule 2.142(d). Accordingly, while we will consider the argument, the untimely evidence will not be considered.

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the specimens for Classes 9, 16 and 35 were unacceptable. Applicants submitted substitute specimens for these Classes, and the examining attorney found these specimens to be acceptable for Classes 9 and 16. When a request for reconsideration of the requirement as it pertained to Class 35 was denied, applicants requested a division of the application. Pursuant to this request, Classes 9, 16 and 42 were placed in a newly created "child" application, serial no. 75983433, and that application proceeded to mature into a registration. The services in Class 35 remained in the present "parent" application, and this appeal ensued. Thus, the only issue in this appeal is the acceptability of the specimens of use for the services identified in Class 35.

With respect to Class 35, applicants submitted a printout of the first page of a section of applicant IBM's on-line shopping catalog listing computer storage systems. The page shows prominent use of LINEAR TAPE-OPEN. When this specimen was found unacceptable by the examining attorney, applicants submitted substitute specimens which comprise a printout of two other pages from IBM's web site for selling the same computer storage systems. The first page shows prominent use of LINEAR TAPE-OPEN. This page includes a link to "My Account" which provides access to a

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"shopping cart" for the purchase of a variety of data storage products. Applicants also submitted, from the same web site, several additional linked pages needed for completing an on-line purchase of one of these data storage products.

Applicants contend that an on-line shopping service is analogous to a physical establishment, or a mail order service. Applicants argue that IBM's "web site shopping service bearing the mark LINEAR TAPE-OPEN is like a catalog with the opening page bearing the mark comprising the cover and the linking pages comprising the content of the catalog." (Brief, p. 5). As a secondary argument, applicants assert that their purported LINEAR TAPE-OPEN on-line shopping service is analogous to a department within the umbrella of a main store, e.g., the LINEAR TAPE-OPEN department for sales of computer storage systems within the main IBM store. Applicants point to the practice of retailers' using a separate service mark for a particular department within the retail outlet bearing the retailer's primary house mark. Further, applicants contend that a particular designation can function both as a trademark and as a service mark, and that "Applicant's mark can and does function as a service mark even though the same mark is also used by Applicant as a trademark for certain of its

goods also sold through such website." (Reply Brief, p. 4).

The examining attorney maintains that the specimens of record for the Class 35 services do not show use of the mark in connection with such services. According to the examining attorney, potential customers are unlikely to view the mark as identifying retail store, mail order catalog and telephone order services featuring computers, electronics and data processors; rather, consumers would perceive the mark as identifying a trademark for a product available for sale on applicants' web site. The examining attorney further argues as follows (Brief, p. 6):

[S]imply giving consumers the option to purchase a product online does not show proper service mark use in relation to retail and ordering services. This use is most similar to the sale of products on web sites such as Amazon.com or applicant's own IBM.com, wherein consumers can purchase a variety of products produced by others or by the applicant. Potential consumers would not view the name of the various products sold as identifying retail services, but rather simply as products they are able to purchase online.

Trademark Rule 2.56(a) provides, in part, that an application alleging use must include one specimen showing the mark as used on or in connection with the sale or advertising of the services in commerce. Trademark Rule

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2.56(b)(2) further specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...."

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. In re Monograms America Inc., 51 USPQ2d 1317 (TTAB 1999). It is not enough that the term alleged to constitute the mark be used in the sale or advertising; there must also be a direct association between the term and the services. In re Johnson Controls Inc., 33 USPQ2d 1318 (TTAB 1994); and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985). The mark must be used in such a manner that it would be readily perceived as identifying the source of such services. In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); In re Adair, 45 USPQ2d 1211 (TTAB 1997); and In re Metrotech, 33

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USPQ2d 1049 (Com'r Pats. 1993). See TMEP §1301.04 (3d ed. rev. 2003)

The issue, thus, is whether applicants are using LINEAR OPEN-TAPE as a mark to identify the source of their retail store services, and mail order catalog and telephone order services featuring computers, electronics and data processors. The determination of whether applicants' specimens show the mark LINEAR OPEN-TAPE in connection with the sale or advertising of these services necessarily requires a consideration of the specimens. As noted earlier, applicants' specimens are excerpts from IBM's website. The three main pages displaying the mark in the most prominent manner (these are the first pages of applicant's exhibits A, B and C) are reproduced below (other linked pages which allow completion of the sale are not shown).



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- Storage
 - StorageSmart
 - Linear Tape-Open
 - Products
 - How to buy
 - Technical support
 - News
 - Library
 - Contact tape drives

Linear Tape-Open

Lead story

When you want

- L**ots of Capacity
- T**ruly Reliable Backup
- O**verwhelming Performance
- L**ess cost per Gigabyte
- T**remendous Technology
- O**utrageous Scaleability

Linear Tape Open



**Think StorageSmart by IBM
Ultrium LTO Tape Drives**

The StorageSmart™ by IBM Linear Tape-Open family of storage solutions provide superior performance, exceptional reliability and around-the-world product support to give IBM's OEM, Distribution and Reseller customers the competitive edge they need to excel in their marketplace

Announcements

- New BakBone/IBM tape storage bundle offers mid-sized environment, speed, power, and ease of use.
- IBM to participate at the world's largest tradeshow, CeBit, March 22-28, 2001.
- Dantz Retrospect bundled with Ultrium LTO Tape Drives
- LTO - A New Robust Tape Standard
- IBM Announces Linear Tape-Open (LTO) Ultrium Product Offerings
- IBM first to market with tape storage breakthrough

Products

- Ultrium Tape L
- Ultrium Extern
- Ultrium Tape L
- Ultrium Scalab SL72
- Media

IBM to receive na for storage techn

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Select a country

Linear Tape-Open

LTO brings unprecedented levels of reliability, capacity and performance to scalable automation for open systems tape backup. Developed jointly by IBM, Hewlett-Packard and Seagate, LTO's open technology is ideal for a wide-range of open systems streaming data environments such as backup or archive. Powerful. Reliable. Interoperable. LTO delivers exceptional performance and availability at an economical price point.

IBM LTO Ultrium vs Super-DLT: Technology Comparison Performance Comparison

LTO and Linux a powerful combination - winner of a Artelia Power Award.

Products:

- [Ultrium E2 Drive](#)
- [Ultrium T2](#)
- [Ultrium S2 Library](#)
- [UltraScale Library](#)
- [LTO Ultrium](#)

Features

- High Capacity Cartridge - up to 200 GB of compressed data on a single cartridge
- Scalable - grows with your needs, across platform and operating systems
- High Sustained Data Transfer Rates - of up to 30 MB/second reduces backup and restore windows
- Compliant - multiple vendors' products conform to open specification
- Industry Acceptance - customers, leading tape drive, media, and automation companies endorse LTO Ultrium technology
- Investment Protection - four generation roadmap protects your investment today and in the future

Related links:

- Education
- Special Offers
- Tape Central Library

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Linear Tape-Open

LTO brings unprecedented levels of reliability, capacity and performance to scalable automation for open systems tape backup. Developed jointly by IBM, Hewlett-Packard and Seagate, LTO's open technology is ideal for a wide-range of open systems streaming data environments such as backup or archive. Powerful. Reliable. Interoperable. LTO delivers exceptional performance and availability at an economical price point.

IBM LTO Ultrium vs Super-DLT: Technology Comparison Performance Comparison

IBM's LTO Ultrium Tape Family has been awarded a CMP's Asia Computer Weekly (ACW) inaugural Readers' Choice Award

Products:

- [Ultrium External Tape Drive](#)
- [Ultrium Tape Autoloader](#)
- [Ultrium Scalable Tape Library](#)
- [UltraScalable Tape Library](#)
- [LTO Ultrium Media](#)

Features

- High Capacity Cartridge - up to 200 GB of compressed data on a single cartridge
- Scalable - grows with your needs, across platform and operating systems
- High Sustained Data Transfer Rates - of up to 30 MB/second reduces backup and restore windows
- Compliant - multiple vendors' products conform to open specification
- Industry Acceptance - customers, leading tape drive, media, and automation companies endorse LTO Ultrium technology
- Investment Protection - four generation roadmap protects your investment today and in the future

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Linux enabled products

The web pages appear to be typical of most on-line shopping sites. These pages show several commonplace

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features, such as a "My account" button, ordering instructions, a shopping cart and related links. As used in the specimens, the term LINEAR TAPE-OPEN most prominently appears near a picture of a computer storage product. Other uses of the term in the various web pages include "Linear Tape-Open family of storage solutions"; "IBM Announces Linear Tape-Open (LTO) Ultrium Product Offerings"; "Linear Tape-Open (LTO) Ultrium External Tape Drive"; "Media is interchangeable across all Linear Tape-Open Ultrium tape solutions"; "Includes a Linear Tape-Open Cartridge Memory (LTO-CM) chip"; and "Adheres to widely supported Linear Tape-Open (LTO) design specifications." The web pages include several more uses of the abbreviation "LTO," and a portion of one page includes the following: "Why IBM LTO? LTO is an open tape architecture developed by a consortium of three world-class storage products."

There is no question but that a mark may, under appropriate circumstances, function both as a trademark and as a service mark. The only restriction on the registration of the same term both as a trademark and a service mark is that the specimen filed in support of a service mark application must show the mark "used or displayed in the sale or advertising of services" as

distinguished from use on goods. In re Restonic Corp., 189 USPQ 248, 249 (TTAB 1976).

As used in the specimens, LINEAR TAPE-OPEN clearly gives the impression that it is a trademark for computer storage products, not for retail store, mail order catalog and telephone order services featuring such products, or even, as applicants argue, a department of such services. Whenever LINEAR TAPE-OPEN appears, the mark is used in connection with a product.³ Consumers viewing the mark as used in the specimens would clearly perceive LINEAR TAPE-OPEN as identifying the source of the computer storage products, rather than of any retail store, mail order catalog and telephone order services.

We likewise are not persuaded by applicants' contention that use of the mark in the specimens is analogous to a department (LINEAR TAPE-OPEN department) within a main store (IBM store).⁴ We agree with the examining attorney that the closest analogy to applicants' "store/department" argument is shown in the upper left-hand column of applicant IBM's web site. There, customers may view IBM as the "store name," and "Storage Solutions,"

³ The uses of the abbreviation of "LTO" in the same manner to identify a product reinforce the perception of LINEAR TAPE-OPEN as a trademark for goods rather than a service mark for services.

⁴ As indicated earlier, the evidence in support of this argument was untimely submitted.

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"Solution Centers," and "Storage Networking" as various "department" names. In no instance would LINEAR TAPE-OPEN be perceived as a "department" within the IBM store; rather, as indicated above, customers would view the mark as a source indicator for computer storage products.

Accordingly, we find that applicants have failed to submit specimens showing use of LINEAR OPEN-TAPE as a mark for the identified services in the present application.

Decision: The refusal of registration is affirmed.