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Mailed:
August 18, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bose Corporation

Serial No. 76515273

Charles Hieken of Fish & Richardson P.C. for Bose Corporation.

Lesley LaMothe, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Bucher, Grendel and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On May 19, 2003, Bose Corporation ("applicant") filed an intent-to-use application to register the mark ADAPTISENSE in standard-character form on the Principal Register for goods now identified as "headphones"[1] in International Class 9. After approval and publication of the application and issuance of the notice of allowance, applicant filed its statement of use.

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[1] At filing applicant identified the goods as "headsets" but later amended the identification as indicated.

The Examining Attorney found the specimen of use filed with the statement of use unacceptable and refused registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127. Ultimately the Examining Attorney issued a final refusal on the ground that, "the mark in the drawing does not match the mark referring to the goods in the specimen." Applicant then appealed. Both the applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.[2] For the reasons indicated below, we reverse.

Section 1 of The Trademark Act requires that an applicant submit "specimens or facsimiles of the mark as used in commerce." 15 U.S.C. § 1051. Trademark Act Section 45 provides further that a mark is "in use in commerce … 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 …" 15 U.S.C. § 1127. The Trademark Rules likewise specify, in pertinent part, that, "A trademark specimen is a label, tag or container for the goods, or a display associated with the goods." 37 C.F.R. § 2.56(b)(1).

[2] Applicant submitted evidence with its reply brief consisting of a publication entitled ALL ABOUT TRADEMARKS. We have not considered this evidence because it was not submitted before the filing of the appeal in accordance with 37 C.F.R. § 2.142(d).

Catalogs and the electronic equivalent of catalogs may be acceptable as specimens, provided they qualify as "displays associated with the goods" under cases, such as, Lands' End Inc. v. Manbeck, 797 F.Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992) and In re Dell Inc., 17 USPQ2d 1725 (TTAB 2004).

In this case, applicant filed copies of certain pages from its Internet website as a specimen; the pages display (1) a picture of applicant's headphones, (2) explanatory text quoted below, which includes the mark, and (3) functions which enable a visitor to place an electronic order for the goods. The Examining Attorney ultimately accepted the specimen as a display associated with the goods.

However, as we indicated above, the Examining Attorney issued a final refusal based on the specimen on the ground that "the mark in the drawing [did] not match the mark referring to the goods in the specimen." The Examining Attorney explained the refusal further in the final refusal:

> The applicant has submitted a page from its website in which the information displayed identifies the applied for mark ADAPTISENSE referring to a "technology" used in the performance of the goods (headsets)… The mark that is used as a trademark on the goods is AVIATION HEADSET X rather than ADAPTISENSE.

In her brief, the Examining Attorney explains further, "The term ADAPTISENSE does not specifically identify the headphones themselves but is used by the applicant in association with other statements describing the favorable features of the headphones."

As the Examining Attorney notes, we must look to the specimen in the particular case to determine whether the use qualifies as trademark use. In re Bose Corp., 546 F.2d 893, 192 USPQ 213 (CCPA 1976). The relevant text from the specimen, which appears immediately below the photo of the goods, reads as follows:

> Enjoy full-spectrum noise reduction, comfortable fit and clearer sound when you fly with the Bose® Aviation Headset X. Thanks to the proprietary TriPort® headset acoustic structure, this unique combination of benefits is available in one lightweight headset and with our AdaptiSense™ headset technology you can enjoy the performance of the Aviation Headset X …"

With regard to the Examining Attorney's statement that AVIATION HEADSET X is the mark which identifies the goods, applicant disputes the implied premise by stating, "it is settled that, 'There is no doubt that one product can bear more than one protectable trademark.' MCCARTHY ON TRADEMARKS § 7:2 and cases cited." And with regard to the Examining Attorney's statement that the mark refers to "a 'technology' used in the performance of the goods,"

applicant argues, “The contention that the mark ADAPTISENSE refers to a technology ignores the ordinary name of the goods ‘headsets’ immediately following the mark.”

We find applicant’s arguments persuasive. There is no doubt that more than one mark may be used to identify the source of the same product. As applicant points out here, its BOSE® mark, as well as the AVIATION HEADSET X mark, identifies the product in question in the specimen. Furthermore, we agree that the use of the mark ADPAPTISENSE here immediately before and as a modifier of “headset” with the ™ symbol indicates trademark use of ADAPTISENSE for “headsets” or “headphones.”

We also reject the Examining Attorney’s implication that the placement of ADAPTISENSE in this specimen is not sufficiently close to the photograph of the goods to associate the mark with the goods. The text where ADPAPTISENSE appears is immediately below the photo of the goods, and, as we noted, the name of the goods “headset” follows immediately after ADAPTISENSE in the text.

We conclude that the totality of the circumstances are such that the necessary association exists between the mark and the goods.

The Examining Attorney cites a number of cases in support of her position, but we find no support in those

cases for her position. See, e.g., In re Volvo Cars of North America Inc., 46 USPQ2d 1455 (TTAB 1998)(DRIVE SAFELY perceived as a safety admonition, not a trademark); In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992)(THINK GREEN perceived as environmental slogan, not a trademark).

The Examining Attorney's explanations for the refusal are more consistent with cases which hold that certain terms are not used as marks, or would not be perceived as marks, because the term identifies a "process" or, in this instance, a type of technology. See, e.g., In re Walker Research, Inc., 228 USPQ 691, 692 (TTAB 1986). Cf. In re Anchor Holdings LLC, 79 USPQ2d 1218 (TTAB 2006). For example, in the Walker Research case, the Board held that the mark SegMentor was not used as a service mark for market research and related services, but that it merely identified a computer program used in the rendering of the services. The use in question was in text in a promotional piece, as follows: "SegMentor – Integrated Software for Multi-Attribute Segmentation + Market Simulation." Walker Research, 228 USPQ at 692. The Board held that the SegMentor mark did not identify the market research service.

While this rationale appears to be the basis, at least in part, for the Examining Attorney's rejection of the

specimen here, we do not believe it applies. A designation may both identify a “process” or “technology” and function as a mark. In re Lativ Systems, Inc., 223 USPQ 1037, 1038 (TTAB 1984). In this instance, ADAPTISENSE may also identify the technology employed in the goods. Whether or not it also identifies the technology, we conclude that ADAPTISENSE, as used in this specimen, functions as a trademark for the goods.

In conclusion, after a careful review of the specimen in this case we conclude that the specimen demonstrates use of ADAPTISENSE as a trademark for headphones.

Decision: The refusal to register the mark for failure to provide a proper specimen of use is reversed.