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PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Concord Elevator Inc.

Serial No. 78337318

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Verna Beth Ririe, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney)

Before Seeherman, Bucher and Cataldo, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Concord Elevator Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register the
"circle and wave design," shown below, as a trademark for
"elevators and vertical and inclined wheelchair lifts for
buildings."¹

¹ Application Serial No. 78337318, filed December 5, 2003, and
asserting first use and first use in commerce as of November 1,
2001.



Registration has been refused on the basis that applicant has not submitted an acceptable specimen of use.

Both applicant and the Examining Attorney have filed appeal briefs.

A review of the application file shows that when applicant filed its use-based application, it omitted a specimen of use, submitting only a picture of the mark that was identical to the picture submitted as its drawing. The Examining Attorney, in the first Office action, required that applicant submit an acceptable specimen and support such specimen with a declaration stating that it was in use as of the filing date of the application. The Examining Attorney also advised applicant that it could amend the basis of its application, which was filed under Section

1(a) of the Trademark Act based on use in commerce, to intent-to-use.

In response, applicant filed a specimen, which has been referred to by the Examining Attorney as a "substitute specimen." Because this is the only specimen of record, we will use the term "specimen." This specimen consists of a four-page document that applicant initially described as a "catalog" but in its brief called a "sales brochure." The Examining Attorney found this brochure to be merely an advertisement, and therefore unacceptable as a specimen of use of the mark for the identified goods.

Trademark Rule 2.56 provides, in relevant part:

(a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.

(b) (1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines that a mark is 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, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.

It is applicant's position that its specimen is acceptable either as a display associated with the goods or because it is a document associated with the goods or their sale. Applicant asserts that "whether one labels the Brochure 'a display associated with the goods' or 'documents associated with the goods or their sale' is irrelevant." Brief, p. 5. However, the question is definitely relevant, as the language of the statute and the rules refer to two different circumstances. Specimens consisting of "documents associated with the goods or their sale" are acceptable only "if the nature of the goods makes such placement [on the goods or their containers or displays associated therewith] impracticable.

We turn first to a consideration of whether, because of the nature of applicant's goods, it would be impracticable to affix the mark to the goods themselves or their containers or displays associated with them. As noted, applicant's goods are elevators and vertical and inclined wheelchair lifts for buildings. The brochure

which applicant has submitted as a specimen shows that these items include vertical wheelchair platforms which can be used to lift a wheelchair from ground level to the front door of a home or building. Although applicant states that "the goods are bulky elevator products which are installed in buildings, and therefore it is impractical to place the mark on the goods themselves," brief, p. 5, applicant has not explained why it would be impractical to place a trademark on the goods.² On the contrary, there does not seem to be any inherent reason why a trademark could not be applied to such goods. In fact, the photographs of the goods in the brochure show that the "handicapped" symbol has been applied to them. It appears that a trademark could be applied just as easily. Thus, we do not consider the goods to be of such a nature that it is impractical to place the mark on them, and therefore the advertising

² Applicant's use of the word "bulky" suggests that applicant may be confusing the concept of a "bulky specimen" with the concept of the impracticality of affixation of a mark. Bulky specimens, as defined by Trademark Rule 2.56(d)(1) and (d)(2), are specimens that are larger than 8½ inches wide and 11.69 inches long, and are not flat. If a mark is used directly on the goods, and the goods are three-dimensional and/or larger than this size, the applicant may submit a photograph of the goods showing the mark. The mere fact that the actual goods cannot be submitted because that would result in a bulky specimen does not mean that it is impractical to affix a trademark to the goods.

brochure cannot be accepted as a "document associated with the goods or their sale."

We next address whether the specimen constitutes a display associated with the goods. Two pages of the four-page brochure are shown below:



The cover page (marked as "page 1" above) bears in large letters "Handilift" followed by the registration symbol, under which is the explanatory phrase "Vertical Wheelchair Platform Lift," below which is a large photograph of a wheelchair lift. At the bottom of the page the word CONCORD appears, with the applied-for design mark placed to the left of CONCORD. The words "ELEVATORS & LIFTS" are under CONCORD. At the left side of the cover page are

Ser No. 78337318

consists of a chart listing optional features, and listing technical aspects. Below this chart are the words "Authorized Dealer," but no dealer information is provided. The following paragraph appears on the left side of the page:

For more information about the Concord Handilift Vertical Wheelchair Platform Lift and other Concord products, visit our website at:
www.concordelevator.com

Below this paragraph is applicant's name, Concord Elevator Inc., and its address and telephone and fax numbers in Canada, as well as a toll-free (800) number.

The applied-for mark appears at the bottom of pages 3 and 4 in the same manner as on page 1.

As the Examining Attorney has pointed out, mere advertising, while acceptable as a specimen for services, is not acceptable to show use of a mark for goods. See *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997). Thus, the question is whether applicant's sales brochure can be considered to be not simply an advertisement, but a display associated with the goods. In *Lands' End Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992), the Court found specimen catalogs to be acceptable displays associated with the goods because "a customer can identify a listing and make a decision to purchase by filling out

the sales form and sending it in or by calling in a purchase by phone."

In the present case, however, the sales brochure cannot be used as a means of ordering the goods inasmuch as there are no prices nor an order form nor other means by which an order can be placed. The fact that applicant's name, address, telephone numbers and website address appear on the brochures is not sufficient. As the Board stated in *In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006), "the company name, address and phone number that appears at the end of the [specimen] web page indicates only location information about applicant; it does not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone." In this case, of course, the specimen is a brochure rather than a webpage, but the basic principle is the same. Merely providing address and telephone information on the brochure, does not make the brochure the equivalent of a sales or order form.

Applicant asserts that if one visits the website address that is listed on the brochure, the first link on that website tells the consumer "how to buy" and leads the consumer to further information and an authorized dealer.

We point out that the webpages have not been submitted as a specimen of use; thus, the question before us is not whether the website would be viewed as a means by which the goods can be ordered.³ The mere fact that the specimen brochure contains the website address does not make the brochure a display associated with the goods, any more than the listing of a mailing address or phone number does. One cannot use the specimen brochure as a means to order the product. In fact, the brochure advises that the web address is provided for consumers to obtain additional information about the product; it does not tell customers that they can order the goods by going to the website.

Because applicant has not shown that the nature of its goods make it impractical to apply the trademark to the goods, and because the specimen brochure does not constitute a display associated with the goods, the specimen is not acceptable to demonstrate use of the applied-for mark for the goods.

Decision: The refusal of registration is affirmed.

³ In any event, the webpages do not contain an order form, but merely a form by which one can submit one's contact information and areas of interest on a "Information Request & Dealer Locator" form in order to "obtain free information from Concord Elevator and locate an Authorized Concord Dealer in my area that will help me find the best product and most economical solution for my needs."