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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re U.S. Tsubaki, Inc.

Serial No. 78698066

James C. Wray, Esq. for U.S. Tsubaki, Inc.

Anthony M. Rinker, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Grendel, Rogers and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On July 18, 2008,[1] applicant, U.S. Tsubaki, Inc., filed a request for reconsideration of the Board's June 17, 2008 order affirming the refusal to register. Applicant had filed a use-based application to register the mark TSUBAKI: THE CHOICE FOR CHAIN, in standard character format, for goods ultimately identified as "machines and parts thereof, namely roller chain and engineering chain, drive chains, power transmission components and gearing for machines,

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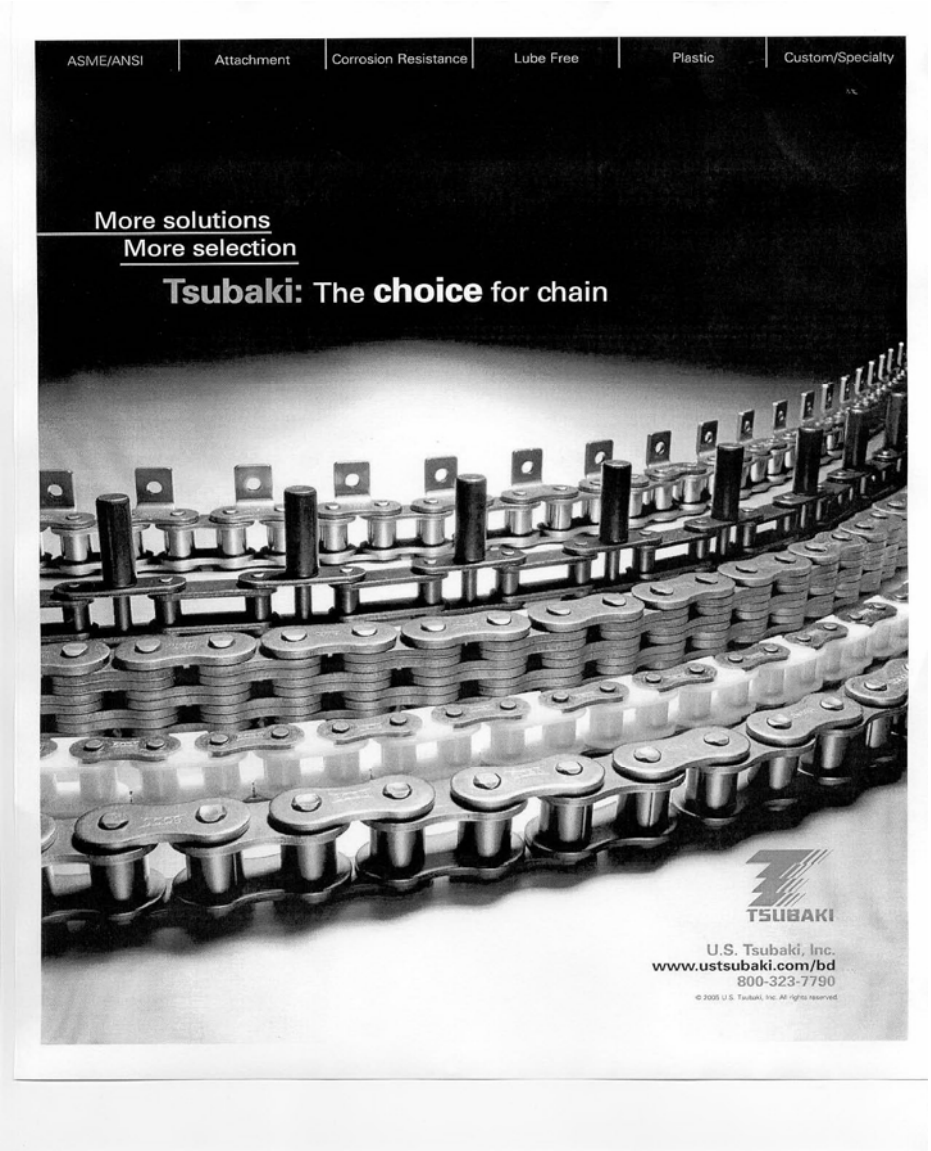
[1] Applicant's request for reconsideration is supported by a certificate of mailing dated July 17, 2008.

namely, power transmission chains, sprockets, bushings, hubs, conveyor chains, top chains, and speed changers," in Class 7 (Serial No. 78698066). As its specimen of use, applicant submitted an excerpt from its catalog. The specimen is set forth below.



The Trademark Examining Attorney refused registration on the ground that applicant's specimen does not show

acceptable trademark use: that is, the page from applicant's catalog is not a display used in association with the goods. The Board affirmed the refusal because applicant's specimen does not contain the information necessary to order applicant's chains, and therefore the catalog does not constitute a display used in association with the goods. We held that the specimen is not, in essence, a point-of-sale display.

In its request for reconsideration, applicant argues that the Board erred in its analysis by not considering the relevant public.

> To order chains, the web address and telephone number are all that the relevant public, skilled purchasers of chains, needs to know. The relevant public is not ordinary citizens who use chains in their vehicles and appliances and who purchase goods made, packaged, moved or transported with chains.[2]

Also, applicant argues that the Board's characterization as a display used in association with the goods as a point-of-sale display is "archaic" and incorrect because "[v]irtually all industrial products sales to purchasing agents for large companies are initiated via Internet or telephone communications," and therefore a telephone number or web address is sufficient information

[2] Request for reconsideration, p. 1.

to place an order.[3] Applicant argues that our holding in *In re Valenite Inc.,* 84 USPQ2d 1346 (TTAB 2007) is controlling:

> In view of the prevalence of online retailing and the fact applicant's goods are specialized industrial products … the applicant's "home" webpage constitutes a display associated with the goods.

In re Valenite Inc., 84 USPQ2d at 1350.

First, we did not ignore the fact that applicant's chains are a specialized, industrial product. We simply noted that applicant failed to present any evidence regarding how and to whom the sales of its products are made. Thus, there was no basis for us to infer that consumers would perceive applicant's catalog as anything other than advertising. In fact, we noted that the applicant in the *Valenite* case submitted a declaration by its marketing director explaining how orders were made, thus supporting its argument that the information presented in its webpage comprised a display used in association with the goods.

Second, we applied the three-part test set forth in the TMEP, and used in *Valenite,* to determine whether applicant's catalog page constitutes a display used in

[3] Request for reconsideration, p. 2.

association with the goods. The TMEP provides that a catalog or similar display associated with the goods may be an acceptable specimen of use under the following conditions:

1. The catalog includes a photograph or picture of the goods;
2. The catalog displays the mark near the photograph of the goods so that consumers associate the mark and the goods; and,
3. The catalog includes the information necessary to order the goods (*e.g.*, an order form, or a phone number, mailing address, or e-mail address for placing orders).

TMEP §904.03(h) (5th ed. 2007). In further explanation, the TMEP provides that "the mere inclusion of a phone number, Internet address and/or mailing address on an advertisement describing the product is not in itself sufficient to meet the criteria for a display associated with the goods. There must be an offer to accept orders or instructions on how to place an order." *Id.* *See also In re Valenite Inc.*, 84 UPSQ2d at 1348 (the website had links to "Service and Support," customer service, the "Technical Resource Center," as well as online calculators, and reference tables). Thus, *Valenite* does <u>not</u> hold that because on-line

and telephone sales make up a significant portion of trade, simply displaying a telephone number or domain name in an advertisement constitutes a display used in association with the goods.

Likewise, we decline to hold that merely presenting a telephone number and/or an Internet address in advertising, as shown in applicant's specimen of use, is sufficient to convert the advertisement into a display used in association with the goods no matter how common it is to sell products on-line or over the telephone. There must be something to invite or instruct the consumer to use the information in the advertisement to place an order (*i.e.*, a point-of-sale display). In this case, applicant's specimen is mere advertising.

Decision: Applicant's request for reconsideration is denied.