

The USPTO Trademark Trial and Appeal Board is on Board with On-line Commerce
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1. **Holding**

The USPTO Trademark Trial and Appeal Board (hereinafter “TTAB” or “Board”) has relaxed its requirements for allowing website pages to be used as trademark specimens.

In *In re Valenite, Inc.*, Serial No. 76482852, Trademark Trial and Appeal Board, 2007 TTAB LEXIS 71; 84 U.S.P.Q.2D (BNA) 1346, July 31, 2007, the TTAB decided that the specialized nature of applicant’s goods made it infeasible to sell the goods in a traditional online manner. The traditional online manner uses an online shopping cart. The Board concluded that the applicant’s web page information, which included a customer service phone number that provided technical information about the goods, and the ability of the applicant to accept purchase of goods ordered via telephone calls to that customer service number, constituted information necessary to complete a sale.

2. **Notation in Trademark Manual of Examining Procedure (TMEP)**

The TMEP has incorporated the holding in *Valenite* in TMEP 904.03(i), which now states that:

a web page containing a link to an online catalog, along with a toll free number and links to customer service and technical support, to be an acceptable specimen, where the goods were specialized industrial goods, and the record contained declaration evidence that purchase of the goods requires careful calculation and technical knowledge, and that the online phone numbers were in fact used to order the goods.

3. **Impact**

The holding in *Valenite* has four primary effects:

1. It allows applicants from anywhere in the world a greater opportunity to show use of a

trademark in commerce in the United States through use of a website.

2. An applicant or registrant may be able to claim an earlier priority date for a mark that is involved in an opposition or cancellation proceeding.

3. It allows applicants to save money by showing use of the mark in the United States earlier in the registration process; for example, at the time of application filing. This lessens the need to file an amendment to show use, a statement of use, or an extension of time to file a statement of use.

4. Applications will proceed to registration faster, because of less time waiting to obtain an acceptable specimen in order to show use of the mark in commerce.

4. **Prosecution Before the Examiner and the Board**

The examiner had refused registration of the mark, stating that it was “not associated with the goods, and the specimens do not contain sufficient ordering information as required under *Dell*.” The examiner also noted (Examining attorney’s appeal brief (citations omitted)):

However, the home page does not provide adequate ordering information so Internet customers can easily select and order the goods. There are no links to click on to select a good and place an order. Pricing information is not present. There are phone numbers and e-mail addresses listed on the home page. But the mere presence of a phone number or mailing address does not constitute sufficient information to order the goods.

Applying *Lands' End Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992), and *In re Dell, Inc.*, 71 USPQ2d 1725 (TTAB 2004), the Board held that the applicant’s web page contained sufficient information to order applicant’s goods, particularly since the goods were specialized industrial products: tools for power operated metal cutting machines, and the customers would need technical assistance prior to placing an order.

Specifically, the Board stated:

These are not products that can be ordered from a web page by clicking on an image of the product to add it to a shopping cart for checkout.... Further, the term 'customer service' itself is broad enough to encompass the service of allowing customers to order applicant's products by using the toll-free telephone numbers.

The Board concluded:

In the instant case, however, applicant's website, in addition to showing pictures of the goods, provides an on-line catalog, technical information apparently intended to further the prospective purchaser's determination of which particular product to consider, an online calculator and both a link to, and phone number for, customer service representatives. Therefore, applicant's website provides the prospective purchaser with sufficient information that the customer can select a product and call customer service to confirm the correctness of the selection and place an order.

5. **Author's Conclusion**

The holding in *Valenite* is a distinct change in the law in the US trademark office that expands the consideration of web pages as specimens to demonstrate use of a mark in commerce. In particular, the Board gives the applicant more latitude regarding associating a mark with goods and determining what constitutes sufficient ordering information for specialized goods.

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