

Specimen of Use

Applicant respectfully disagrees with the Examining Attorney's determination that "The specimen is not acceptable because it consists of advertising material for the goods," and requests reconsideration of same.

In its Statement of Use, Applicant submitted two specimens showing its THE BOX THAT'S REVOLUTIONIZING REMOTE SUPPORT trademark in use in connection with the claimed goods, which are as follows:

Computer hardware and software, namely, computer hardware and software for use in accessing, using and controlling remote computer systems and software; computer hardware and software for use in monitoring, diagnosing and troubleshooting remote computer systems and software; computer hardware and software for use in administering and auditing computer systems and software; computer hardware and software for use in delivering and deploying software applications and data over the Internet and/or to remote users; computer hardware and software for use in educating remote users concerning the use of computer software; computer hardware and software for use in installing and uninstalling computer software.

Trademark Rule 2.56(b)(1) provides 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) (emphasis added). Section 45 of the Trademark Act states, in pertinent part, that a mark is deemed to be in use in commerce on goods when "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 goods or their sale." 15 U.S.C. §1127 (emphasis added).

Here, the Examining Attorney has stated that the specimens submitted by Applicant both are merely "advertising material." Whether a specimen is advertising material or whether it is a "display associated with the goods" is a question of fact which must be determined in each case

based on the evidence in that particular case. *See In re Shipley Co.*, 230 USPQ 691 (TTAB 1986).

Applicant's specimens consist of copies of pages from Applicant's Web site. As an initial matter, the Board's precedents clearly establish that Web pages may constitute "displays associated with the goods" and thus serve as acceptable specimens of use. In *In re Dell Inc.*, the Board held that:

...a website page which displays a product, and provides a means of ordering the product, can constitute a "display associated with the goods," as long as the mark appears on the webpage in a manner in which the mark is associated with the goods. It is a well-recognized fact of current commercial life that many goods and services are offered for sale on-line, and that on-line sales make up a significant portion of trade.

In re Dell Inc., 71 USPQ2d 1725 (TTAB 2004). *See also In re Valenite Inc.*, 84 USPQ2d 1346 (TTAB 2007) (accepting Web page specimen and stating, "[I]n view of the prevalence of online retailing, and the fact applicant's goods are specialized industrial products, we conclude that applicant's 'home' webpage constitutes a display associated with the goods.")

Moreover, the Examining Attorney herself notes that "[O]ther types [of] specimens accepted for software are a screen shot of the software while in use and for downloadable software, the webpage where the software is downloaded showing the mark where it says 'click here to download.'" *Office Action*, May 23, 2008, p. 2.

In the instant case, Applicant's specimens are "displays associated with the goods" and thus are acceptable specimens. Applicant focuses here on the first of the two Web page specimens it has submitted.

Applicant's specimen shows its trademark THE BOX THAT'S REVOLUTIONIZING REMOTE SUPPORT prominently displayed alongside three photographs of Applicant's hardware goods and directly above a clickable button labeled "Free 7-Day Trial," which permits

consumers to download Applicant's software goods. Elsewhere on the same Web page, in close association with the mark, are clickable buttons labeled "Contact Us," "CONTACT," "Contact," "Free Trial -- Bomgar's Remote Support Software," and "Free Trial" -- in other words, the page in question both permits consumers to download Applicant's software goods directly and provides clear instructions as to how to order Applicant's hardware goods. As in the Dell case, Applicant's Web page is a page "which displays the product and provides a means of ordering the product." This Web page also is extremely similar to that analyzed by the Board in the Valenite case, which, in accepting a Web page specimen for goods, stated:

We find that the webpage satisfies the criteria set forth in Lands' End and Dell that the specimen (1) include a picture of the relevant goods, (2) show the mark sufficiently near the picture of the goods to associate the mark with the goods, and (3) contain the information necessary to order the goods.

Valenite, 84 USPQ2d 1346, 1353, citing Lands' End Inc. v. Manbeck, 24 USPQ 2d 1314 (E.D. Va. 1992).

Applicant's THE BOX THAT'S REVOLUTIONIZING REMOTE SUPPORT trademark thus is clearly and repeatedly "associated with" Applicant's computer hardware and software goods on the subject specimen. By any reasonable standard, Applicant's Web page specimen therefore qualifies as a "display associated with the goods," as defined in the pertinent statutes and in the Board's prior precedential decisions. Applicant thus requests approval of the Statement of Use and specimen.