This Opinion is Not a
Precedent of the TTAB

Hearing: November 21, 2024 Mailed: December 23, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re G4 2010, LLC

Serial No. 90281547

Jordan Chisek and Gina Durham of DLA Piper LLP
for G4 2010, LLC.

Chris Wolfsen, Trademark Examining Attorney, Law Office 129,
Pamela Y. Willis, Managing Attorney.

Before Heasley, Larkin, and Brock,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

I. Procedural History

Alleging an intent to use its proposed mark in commerce, Applicant G4 1010, LLC applied to register **PROMATCH** (in standard characters) for "drumsticks and percussion instruments" in International Class 15.[1] Following publication and

[1] Application Serial No. 90281547 was filed on Oct. 27, 2020, based on a declared intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

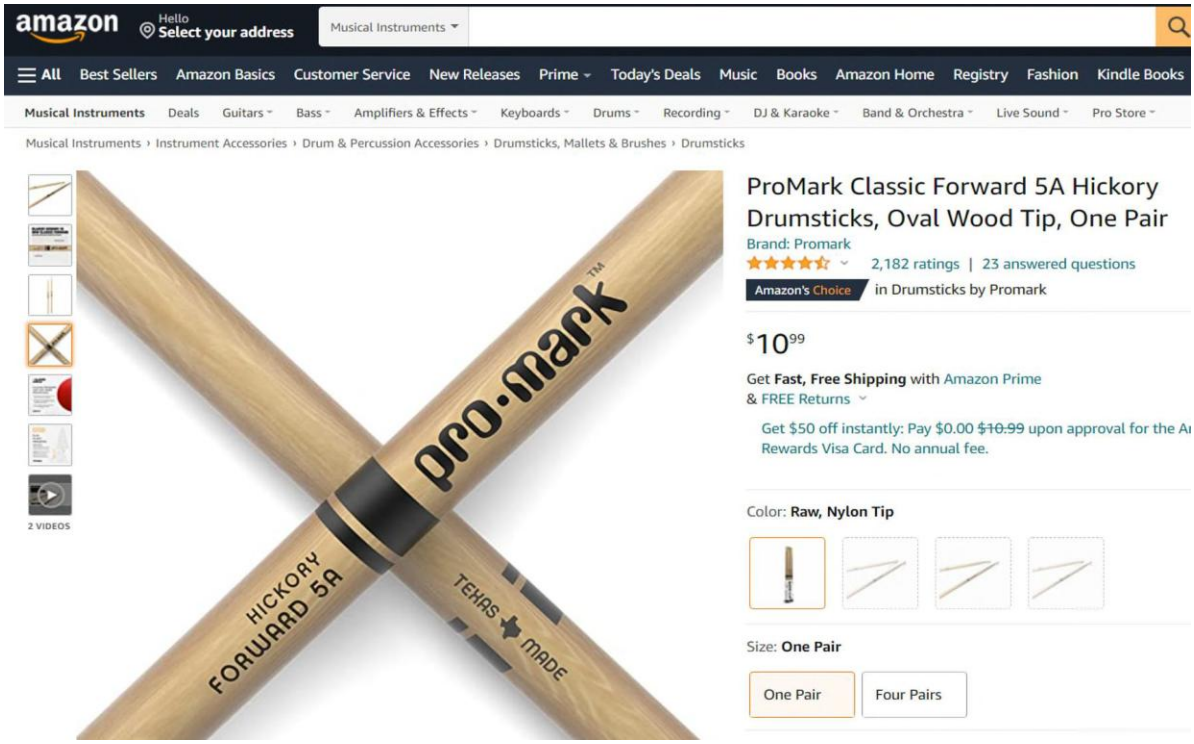
Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system and identify the documents by title, date, and page in the downloadable .pdf version. References to the briefs and other materials in the appeal record refer to the Board's TTABVUE online docketing system.

issuance of a notice of allowance, Applicant filed a statement of use accompanied by specimens, pertinent parts of which are displayed below.

From Applicant's website:



From a vendor's website:





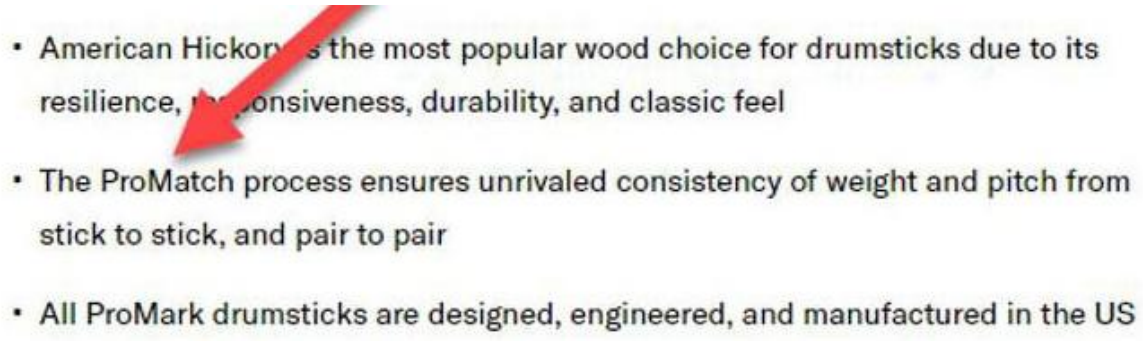
[2]

[2] June 27, 2022 specimens accompanying statement of use (arrow supplied by Applicant).

The Examining Attorney refused registration because, among other things, "the term appears to DESCRIBE how the goods are made…."[3]

Applicant responded with more specimens from its website, such as:





[4]

The Examining Attorney responded inter alia that:

> Registration is refused because the applied-for mark, as used on the specimen of record, merely identifies a process or system; it does not function as a trademark to indicate the source of applicant's goods and to identify and distinguish them from others. Trademark Act Sections 1, 2,

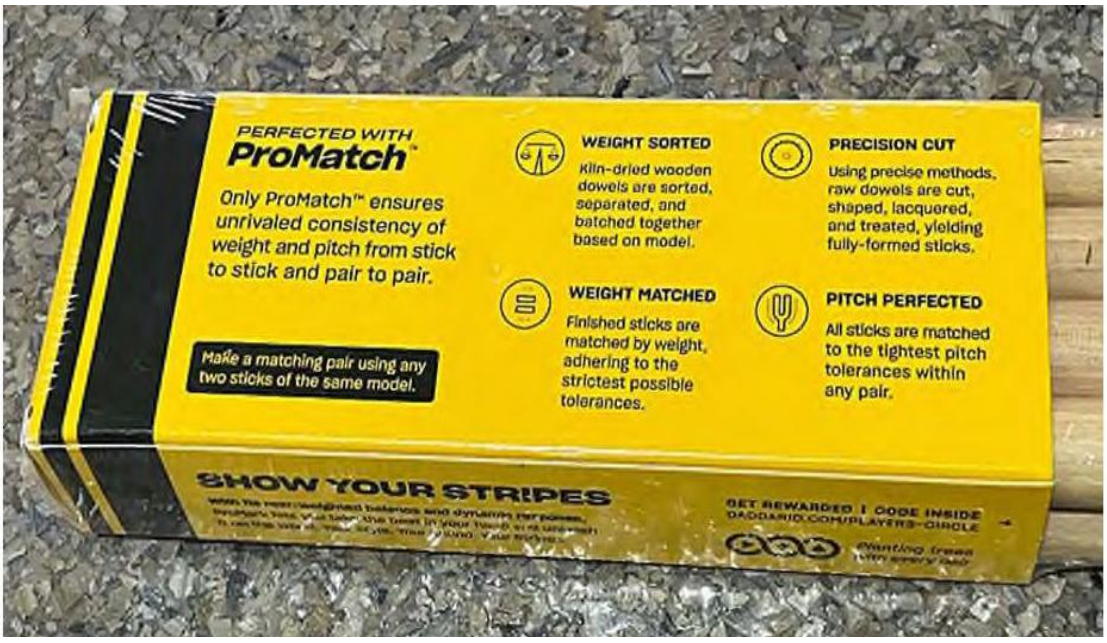
[3] Aug. 25, 2022 Office Action at 3 (capitalization supplied by the Examining Attorney).

[4] Specimens accompanying Feb. 27, 2023 Response to Office Action (arrow supplied by Applicant).

and 45, 15 U.S.C. §§ 1051-1052, 1127; *see In re Griffin Pollution Control Corp.*, 517 F.2d 1356, 1358-59, 186 USPQ 166, 167 (C.C.P.A. 1975); TMEP §§904.07(b), 1202.[5]

Applicant argued against the refusal, attaching a picture of the back of its drumstick packaging:

> The Examining Attorney has objected to the mark on the ground that [it] identifies a process and thus fails to function as a trademark. Applicant respectfully disagrees with the Examining Attorney's position. Applicant's PROMATCH mark is featured prominently, utilizes the ™ symbol, and is used in close proximity to the point of sale, as well as on the product packaging itself. All of these factors taken together will result in consumers recognizing PROMATCH as a source identifier for the mark. As shown below, a consumer viewing the package of drumsticks would have their eye immediately drawn to the wording "PROMATCH". The text is bolded, features the ™ symbol, and is in a larger size font [than] the remainder of the text. These are all factors that are relevant in considering whether or not a particular use constitutes trademark use.



[6]

[5] April 6, 2023 Office Action at 2.

[6] Oct. 6, 2023 Response to Office Action at 4.

The Examining Attorney nonetheless insisted that the applied-for mark, PROMATCH, as used on the specimens of record, merely identified a process or system:

> A process or system is only a way of doing something, and is not generally a tangible product. *Cf.* TMEP § 1301.02(e). An applied-for mark that identifies only a process, style, method, or system is therefore not registrable as a trademark.
> …
> In this case, the specimen shows the applied-for mark used solely to identify a process or system because applicant's substitute specimen of use, dated February 27, 2023, shows use of the marks PROMARK …for the identified goods in International Class 15 of "drum sticks and percussion instruments" but uses the applied-for term PROMATCH to discuss a process. The specimens of use state: "**The PROMATCH process ensures unrivaled consistency of weight and pitch from stick to stick, and pair to pair**" (emphasis added).[7]

The Examining Attorney added that Applicant's photo of the back of its drumstick packaging described the PROMATCH process:

> [A]pplicant's own website describes PROMATCH as "our multi-phase weight and pitch sorting **process**" (emphasis added). And third party websites also describe PROMATCH as a process—"each [drum] stick can be combined with each other from the [same] pack thanks to the PROMATCH **process**" (emphasis added). See attached website evidence.[8]

The Examining Attorney attached to this Office Action excerpts from Applicant's website, for example:

[7] Feb. 8, 2024 Office Action at 2 (emphasis supplied by the Examining Attorney, including italics in original).

[8] *Id*. at 3 (emphasis supplied by the Examining Attorney).

PERFECTED WITH ProMatch™

Every ProMark Drumstick has been perfected with ProMatch—our multi-phase weight and pitch sorting process. This ensures unrivaled consistency not only from stick to stick, but also from pair to pair.



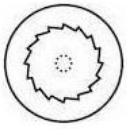




WEIGHT SORTED

Kiln-dried wooden dowels are sorted, separated, and batched together based on weight.

[9]



PRECISION CUT

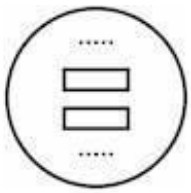
Using precise methods, raw dowels are cut, shaped, lacquered, and treated, yielding fully-formed sticks.



[10]

[9] *Id*. at 6.

[10] *Id*. at 7.

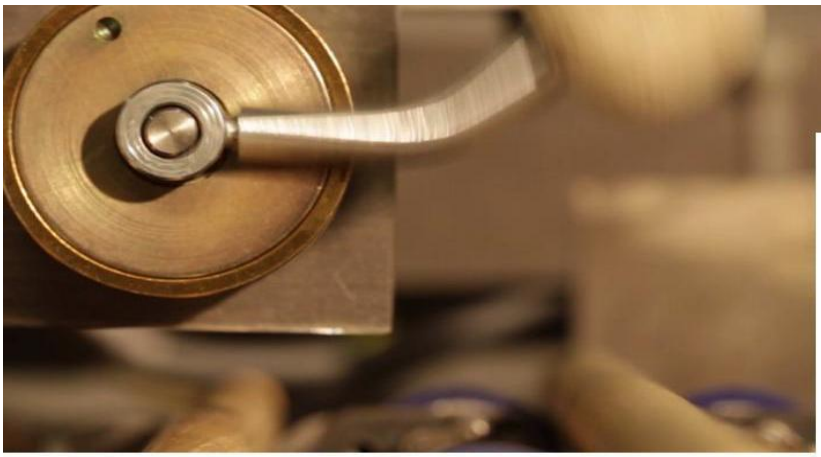




WEIGHT MATCHED

Finished sticks are matched by weight, adhering to the strictest possible tolerances.

11





PITCH PERFECTED

All sticks are matched to the tightest pitch tolerances within any pair.

12

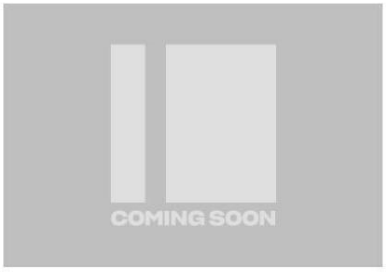
EXPLORE PROMARK'S DRUMSTICK LINEUP



PROMARK DRUMSTICKS



PROMARK CLASSIC DRUMSTICKS



PROMARK LIMITED DRUMSTICKS

13

[11] *Id*. at 8.

[12] *Id*.

[13] *Id*. at 9.

The Examining Attorney also attached pages from vendors' websites:



[14]



…

[14] BostonDrum.com, *id*. at 11.

The "ProMatch" process

To sort the sticks, ProMark uses the company's own, multi-stage weight and pitch process "ProMatch" to avoid excessive weight differences within a model series. In the "ProMatch" process, a decision is made as to what kind of model it should be at the end of production, before an embroidery blank becomes a finished stick. The stick blanks dried in the oven are first sorted by weight; then it is determined whether the blank will be a 7A, 5A, 5B or 2B stock, for example. This procedure prevents the described phenomenon of heavy 7A or light 2B specimens from occurring later. Since the blanks are already pre-sorted, not only are the sticks within a pair very close together, but also all pairs of the same stick type among themselves. The highlight is that, in principle, each stick can be combined with each other from the pack thanks to the "ProMatch" process.[15]

The Examining Attorney accordingly made the refusal final.

Applicant requested reconsideration, submitting specimens consisting of photographs of its packaged PROMARK drumsticks displayed on a shelf:



[16]

In addition to the PROMARK trademark displayed on the drumsticks and their

[15] DrummingNewsNetwork.com, *id*. at 13.

[16] April 2, 2024 Response to Office Action Request for Reconsideration at 8.

packaging, one side of the packaging displays: "PERFECTED WITH ProMatch™ Only ProMatch™ ensures unrivaled consistency of weight and pitch from stick to stick and pair to pair."

The Examining Attorney denied the request for reconsideration, and Applicant filed this appeal.

II. Applicable Law

"The Lanham Act provides for registration of a mark based on use of the mark in commerce." *In re Siny Corp.*, 920 F.3d 1331, 1335 (Fed. Cir. 2019), *quoted in In re Weiss*, 2024 WL 3617597, *2 (TTAB 2024).[17] Although Section 1(b) of the Trademark Act permits an applicant to begin the registration process having only a "bona fide intention" to use a mark in commerce, 15 U.S.C. § 1051(b), the Act ultimately requires the applicant "to show that the mark is being used in commerce before obtaining a registration on the mark." *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015). To this end, an applicant seeking a registration must, on filing a statement of use under Section 1(d), include one or more specimens showing the applied-for mark as actually used in connection with the goods identified in the application. 15 U.S.C. § 1051(d); Trademark Rules 2.56, 2.88, 37 C.F.R. §§ 2.56, 2.88. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 904.07(a) (Nov. 2024).

[17] As part of a Board pilot citation program on broadening acceptable forms of legal citation in Board cases, this opinion cites to Westlaw (WL) for precedential decisions of the Board. For decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals, this opinion cites to the Federal Reporter (e.g., F.2d, F.3d, or F.4th). This citation form thus adheres to the practice set forth in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 101.03 (2024). Practitioners should do likewise.

The predecessor to the Court of Appeals for the Federal Circuit explained the vital function served by specimens:

> An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark **with respect to the goods named in the application**.

In re Bose Corp., 546 F.2d 893, 897 (CCPA 1976) (emphasis added), *quoted in In re Fallon*, 2020 WL 6255423, *4 (TTAB 2020). A trademark, by definition, is used by its owner "to identify and distinguish his or her goods" and "to indicate the source of the goods...." 15 U.S.C. § 1127. These provisions "carry the necessary implication that a prerequisite to obtaining a trademark is that the subject matter to which it is applied must be goods." *In re Shareholders Data Corp*., 495 F.2d 1360, 1361 (CCPA 1974).

The specimen must show a direct association between the mark sought to be registered and the goods specified in the application. *In re Fallon*, 2020 WL 6255423, at *4; *In re Minerva Assocs., Inc*., 2018 WL 834314, *3 (TTAB 2018) ("Implicit in the definition of a trademark is a requirement that there be a direct association between the mark sought to be registered and the goods specified in the application….").

A specimen may fail to show such a direct association when it refers, not to the goods the applicant offers for sale, but to the process by which they were manufactured. "And what is a process? A process, inter alia, is a particular method or system of doing something, producing something or a system used in a manufacturing operation or other technical operation" *In re Stafford Printers, Inc*., 1967 WL 7638, *1 (TTAB 1967) (citing WEBSTER'S NEW INTERNATIONAL DIRECTORY,

3rd Ed., 1965). "A term that identifies only a process, style, method or system is not registrable as a [trade]mark." *In re HSB Solomon Assocs., LLC*, 2012 WL 1267901, *2 (TTAB 2012). *See also In re The Manual Woodworkers & Weavers Inc.,* 2008 WL 4233873, *4 (TTAB 2008) ("A term that merely designates a process, or is used only as the name of a process, is not registrable as a service mark [or trademark].").

For example, in *In re Griffin Pollution Control Corp*., 517 F.2d 1356 (CCPA 1975), the applicant sought to register a mark for a mixture of gases used to treat solid waste, but the Court found that the asserted mark was used to identify a process for producing the gases, rather than the gases themselves. It therefore affirmed the Board's conclusion that the asserted mark had not been used as a trademark for the identified goods. *Id.* at 1358-59, *cited in In re Shipley Co*., 1986 WL 83609, *2 (TTAB 1986). Similarly, in *Bose*, the specimens showed that the applied-for mark was used on Bose's loudspeaker-testing computer, not on the identified goods, "loudspeaker systems." The Court therefore concluded that "[t]he specimens which are of record fail to support, indeed they contradict, the use of [the applied-for mark] as a trademark with respect to loudspeaker systems for high-fidelity music reproduction, and the decision of the board [upholding the refusal to register] is, accordingly, affirmed." 546 F.2d at 897. *See also In re Fallon*, 2020 WL 6255423, at *4 (citing *Griffin* and *Bose*).

III. Analysis

The issue presented in this case is whether Applicant's specimens and related literature show **PROMATCH** used as a trademark for the "drum sticks and

percussion instruments" identified in the application, or solely as a term for the process by which they are manufactured.

Applicant "does not dispute that PROMATCH refers to a proprietary process for its drumsticks…."[18] It argues, however, that "a mark can function as both a trademark and refer to a process."[19] We agree that a term may identify both a process and the goods or services produced or rendered thereby; but whether it in fact does so "is determined by the specimens and other evidence of record in the application." *In re Osmotica Holdings Corp.*, 2010 WL 2513862, *3 (TTAB 2010); *see also In re DSM Pharms., Inc.*, 2008 WL 2385957, *2 (TTAB 2008); *In re Hughes Aircraft Co.*, 1984 WL 63035, *3 (TTAB 1984); *In re J.F. Pritchard & Co.*, 1979 WL 24828, *2 (TTAB 1979). We consider each specimen individually.

In this case, as the Examining Attorney correctly observes,[20] the first specimen, from Applicant's D'Addario.com website, shows the goods, drumsticks, offered for sale bearing the trademark **PROMARK**:

[18] Applicant's reply brief, 9 TTABVUE 8.

[19] Applicant's reply brief, 9 TTABVUE 8 (citing *In re Produits Chimiques Ugine Kuhlmann*, 1976 WL 20931 (TTAB 1976); and *In re Stafford Printers, Inc.*, 1967 WL 7638).

[20] Examining Attorney's brief, 8 TTABVUE 4.



The accompanying text expounds on the process by which the drumsticks are "perfected" via "a system used in a manufacturing operation or other technical operation," *Stafford*, 1967 WL 7638, at *1:

Perfected with **PROMATCH ™**

WEIGHT SORTED Wooden dowels are sorted, separated, and batched together based on weight.

PRECISION CUT Using precise methods, raw dowels are cut, shaped, lacquered, and treated, yielding fully-formed sticks.

WEIGHT MATCHED Finished sticks are matched into pairs by weight, adhering to the strictest possible tolerances.

> PITCH PERFECTED All sticks are matched to the tightest pitch tolerances within any pair.[21]

The vendors use PROMARK to identify the drumsticks and PROMATCH to identify their means of manufacture, suggesting how both vendors and purchasers will view PROMATCH:

> ProMark Release Four New Drumstick Bundles
>
> To sort the sticks, ProMark uses the company's own, multi-stage weight and pitch process 'Promatch' to avoid excessive weight differences withing a model series."[22]

With respect to its display of **PROMATCH** along with **PROMARK**, Applicant notes, "[p]roduct packaging will almost always feature more than one trademark…," and here, "[w]hen a consumer looks at the product packaging, the trademarks PROMARK and PROMATCH would stand out to consumers as source identifiers for the drumsticks that are inside the packaging."[23] The packaging in this case is shown below:

[21] June 27, 2022 specimen accompanying statement of use.

[22] DrummingNewsNetwork.com, Feb. 8, 2024 Office Action at 13.

[23] Applicant's reply brief, 9 TTABVUE 7-9 (citing *Amica Mutual Ins. Co. v. R. H. Cosms. Corp.,* 1979 WL 24882, *5 (TTAB 1979)).



[24]

One side of the packaging states, "Perfected with ProMatch™ Only ProMatch™ ensures unrivaled consistency of weight and pitch from stick to stick, and pair to pair."[25] This language describes the PROMATCH process; it does not frame PROMATCH as the source of the drumstick goods.

That packaging brings this case closer to precedents that had separate terms for a process and the trademark for goods produced by that process. In *In re Big Stone Canning Co.*, 1971 WL 16489 (TTAB 1971), for example, the applicant sought to register FLASH COOK, with a lightning flash design between the words, for canned vegetables. *Id.* at *1. Its specimens consisted of can tops showing "New" above FLASH COOK and "Process" directly below, as well as wrap-around labels bearing the trademark "BUTTER KERNEL." *Id.* The Board found that:

> As the mark is used on the containers for the goods it is apparent that it refers to a particular process rather than serves to identify the goods. The labels clearly indicate that the designation "BUTTER KERNEL" is intended and does serve as the indicator of source. And, while applicant

[24] April 2, 2024 Response to Office Action Request for Reconsideration at 8.

[25] Specimen accompanying Apr. 2, 2024 Request for Reconsideration at 8.

> contends that "FLASH COOK" suggests "better color and flavor", it is our opinion that said term indicates the process of cooking rather than other factors.

Id. The Board accordingly affirmed the refusal to register FLASH COOK. *Id.* at *2.

Similarly, in *Bose*, the Court found:

> [I]t is quite apparent that, in the specimens of record, only INTERAUDIO identifies the loudspeaker systems for high-fidelity music reproduction as originating with appellant and distinguishes such goods from those manufactured and sold by others. The mark SYNCOM merely relates to a speaker-testing computer. Only INTERAUDIO would be used by purchasers in asking for the loudspeaker systems set forth in appellant's application, and the mark SYNCOM neither serves as an indication of origin of such goods, nor serves any other valid trademark function with respect to such goods. SYNCOM is not used as a trademark with respect to such goods.

Bose, 546 F.2d at 897. Here, as there, the different terms, **PROMATCH** and **PROMARK**, point, respectively, to the process of production and the trademark for the product thereby produced.[26]

Applicant maintains that the term PROMATCH "is coined … and is not, to our knowledge, used by any other third parties in the industry to denote the level of quality that Applicant applies to the preparation and sale of drumsticks."[27] But

[26] Applicant contends that "the Examining Attorney's reliance on TMEP 1301.02(e) [which states that '[a] term that only identifies a process, style, method, system, or the like is not registrable as a service mark'] is misplaced because it is only applicable to service marks, which the applied-for mark is not." Applicant contends that "no such similar standard appears to apply to goods." Applicant's reply brief, 9 TTABVUE 3, 5. As *Griffin Pollution Control* and *Big Stone Canning* show, though, the "process" refusal is not limited to processes supporting services; it extends equally to processes for manufacturing identified goods. *See also Congoleum Corp. v. Armstrong Cork Co.,* 1983 WL 51969, *10 n. 13 (TTAB 1983) ("'inlaid color' serves no other purpose than that of indicating a process performed on the goods and consequently is not registrable under the Trademark Act because it is not, by definition, a trademark"). The Examining Attorney also cited TMEP § 904.07(b), which concerns, more generally, whether the specimens show the applied-for mark functioning as a mark.

[27] Applicant's main brief, 6 TTABVUE 8.

the issue is not whether the term is coined; it is whether the term, as presently used, points to the process by which the identified goods are produced, rather than the goods themselves.[28] For example, *Griffin Pollution Control* affirmed a "refusal to register the coined word OXINITE" because:

> Although OXINITE is defined as a mixture of gases, the treatment process is clearly emphasized. We believe that a purchaser viewing these descriptive materials would directly and distinctly associate OXINITE with a treatment process for municipal and industrial effluent water systems, and would not associate OXINITE with a mixture of gases.

Griffin Pollution Control, 517 F.2d at 1357. By the same token, we believe that purchasers viewing Applicant's current packaging and advertising would associate PROMATCH with the process used to enhance the PROMARK drumsticks' "level of quality."

Applicant further maintains that "[t]he PROMATCH trademark is displayed prominently in all bold letters, larger than any of the other text on the side panel, and both references to PROMATCH feature a ™ symbol."[29] But as the Examining Attorney correctly notes, this refusal turns on whether the applied-for mark identifies a process, not on its prominence on one side of the packaging.[30] And the mere "use of the letters 'TM' on a product does not make unregistrable matter into a trademark." *In re Remington Prods. Inc.*, 1987 WL 124304, *2 (TTAB 1987), *quoted in In re Empire Tech. Dev. LLC*, 2017 WL 3575874, *12 n.23 (TTAB 2017) (cleaned up).

[28] *See* Examining Attorney's brief, 8 TTABVUE 5.

[29] Applicant's reply brief, 9 TTABVUE 6; Applicant's main brief, 6 TTABVUE 7.

[30] Examining Attorney's brief, 8 TTABVUE 5.

IV. Conclusion

On this record, having considered all of the arguments and evidence, we find that **PROMATCH**, as used on the specimens of record, has not yet been used as a trademark for the "drum sticks and percussion instruments" identified in the application, but solely as a term for the process by which they are manufactured.

Decision: The refusal to register Applicant's applied-for mark is affirmed.