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Mailed:
Nov. 23, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Retail Royalty Company

Serial No. 77137764

Sarah Otte Graber and P. Andrew Blatt of Wood, Herron & Evans, L.L.P. for Retail Royalty Company.

Ira Goodsaid, Trademark Examining Attorney, Law Office 101 (Ronald Sussman, Managing Attorney).

Before Quinn, Grendel and Walsh, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark AERIE UNDIES IN A BUNCH (in standard character form) for services recited in the application as "retail store services and online retail store services featuring clothing and clothing accessories, footwear, headwear,

bags, purses, wallets, fragrances, cosmetics, and personal care products.”¹

The Trademark Examining Attorney has issued a final refusal to register applicant’s mark on the ground that applicant has failed to submit an acceptable specimen demonstrating use of the mark as a service mark. Trademark Act Sections, 1, 3 and 45, 15 U.S.C. §§1051, 1053 and 1127; Trademark Rules 2.88(b)(2) and 2.56(b)(2), 37 C.F.R. §§2.88(b)(2) and 2.56(b)(2).

Applicant has appealed the final refusal. For the reasons discussed below, we affirm the refusal to register.

The Trademark Act defines a “service mark” (in pertinent part) as “any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish the services of one person, including a unique service, from the services of others and

¹ Application Serial No. 77137764, filed on March 22, 2007. The application was filed on the basis of applicant’s asserted bona fide intent to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b). Applicant filed a Statement of Use on May 16, 2008. We note that applicant’s application originally also sought registration of the mark for Class 25 goods identified as “clothing and clothing accessories, namely, bathing suits, bathrobes, beachwear, belts, bottoms, hosiery, lounge wear, pants, shirts, tops, lingerie, sleepwear, underwear, footwear and headwear.” At applicant’s request during prosecution, Class 25 was divided out into a separate application, and the Class 25 registration (Reg. No. 3716886) was issued on November 24, 2009.

to indicate the source of the services, even if that source is unknown." Trademark Act Section 45.

To register a service mark, the applicant must submit a specimen of use which shows the mark as actually used in the sale or advertising of the services. Trademark Rules 2.88(b)(2) and 2.56(b)(2).

An asserted service mark will be found to function as a service mark only if purchasers will directly associate the asserted mark with the services in question. This "direct association" requirement is implicit in the statute's requirement that the asserted mark "identify and distinguish" the services. See *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); *In re Adair*, 45 USPQ2d 1211 (TTAB 1997).

To establish the requisite "direct association," it is not sufficient merely to show that the applicant in fact is rendering the services and is using the asserted mark in some manner in connection with or in the course of rendering and/or advertising the services. Rather, the asserted mark must be used specifically in such a manner that purchasers will directly associate the asserted mark with the services per se, i.e., they will use the mark to identify the services and will readily perceive and understand the asserted mark to be a source-indicator for

those services. See *In re Advertising and Marketing Development Inc.*, *supra*; *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); *In re Brown & Portillo Inc.*, 5 USPQ2d 1381 (TTAB 1987).

"As has often been stated, a term may serve as both a trademark and a service mark depending on how it is used as evidenced by the specimens of record." *In re Brown & Portillo Inc.*, *supra*, 5 USPQ2d 1381, 1382; see also *In re Adair*, *supra*; *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983).

To review, applicant seeks to register the mark AERIE UNDIES IN A BUNCH (in standard character form), for services recited in the application as "retail store services and online retail store services featuring clothing and clothing accessories, footwear, headwear, bags, purses, wallets, fragrances, cosmetics, and personal care products."

We first shall consider applicant's proffered specimen for its "retail store services ... featuring clothing ...," which we deem to be what are commonly referred to as "brick-and-mortar" retail store services. Afterward, and in the interest of completeness, we will consider applicant's separate specimen for its "...online retail store services featuring clothing...."

Applicant has submitted the photograph reproduced below as a specimen of its use of the mark in connection with its brick-and-mortar retail store services.



Although it is difficult to discern due to the poor quality of the photograph, the photograph is of the sales floor of a retail store in which various items of clothing are displayed for sale. The table in the lower-left corner of the photograph displays a selection of women's underwear. Next to the table displaying the underwear, there is a sign

on which the mark AERIE UNDIES IN A BUNCH appears, along with the price for the underwear.

We find that this sign displaying the mark next to the goods themselves is a point-of-sale "display associated with the goods," and that this photograph of the display sign likely would be an acceptable specimen of use in an application for registration of the mark as a trademark for the clothing goods themselves.

However, we find that the specimen is not acceptable as a service mark specimen because it fails to show that the asserted mark AERIE UNDIES IN A BUNCH also would be perceived as a service mark for applicant's retail store services, per se, and not merely as a trademark for the goods themselves.

We find that this case is closely analogous to the *In re Niagara Frontier Services, Inc.* and *In re Brown & Portillo Inc.* cases cited above.

In *Niagara Frontier Services*, the applicant sought to register the mark WE MAKE IT, YOU BAKE IT! for "supermarket grocery store services." One specimen was an advertisement which included the wording "Bakers Oven PIZZA We make it, You bake it. Hot in your Oven." Another specimen was a display sign in the grocery store which included the wording "Bakers Oven Real PIZZERIA STYLE PIZZA We Make

It...You Bake It! HAVE A TASTE." The Board found that the specimens did not suffice as evidence of service mark use, stating that "[i]n our view, the subject matter for registration, as used by applicant in the above examples, in no way serves to function as a service mark to identify and distinguish applicant's supermarket grocery store services. The term refers only to the pizza which may be purchased in applicant's store." 221 USPQ at 285.

In *Brown & Portillo*, the applicant sought to register the mark HEARTY BASKET for restaurant services. The specimens of use submitted by the applicant were menus which showed use of the mark to identify a particular combination of food products sold in the applicant's restaurant. The Board found that the mark served as a trademark to identify the food items offered by the restaurant, but that the mark failed to also function as a service mark for applicant's restaurant services. The Board stated: "... it does not logically follow that any arbitrary designation used in a menu to identify a particular food or beverage available in that restaurant also necessarily performs a service mark function to identify the restaurant services." 5 USPQ2d at 1383. The Board found that the mark as used on the specimen "identifies no service" but rather served only "to identify

an entrée available in the restaurant." *Id.* Also, the applicant had argued that its specimen was sufficient for its restaurant services because the specimen showed "that the goods delivered to the consumer are an integral part of those services and that it is impossible for a customer to purchase a particular tangible menu item so designated apart from the restaurant services rendered by applicant." The Board specifically rejected that argument.

Similarly in this case involving retail store services, we find that purchasers encountering the mark AERIE UNDIEN IN A BUNCH, as it appears (along with the price for the goods) on the display sign in the store next to applicant's underwear items, would perceive the mark only as a product mark identifying one of the various clothing items that applicant sells in its store, i.e., underwear or "undies." The mark by its nature and as it appears on these specimens specifically and directly refers to and identifies the goods themselves. Purchasers would not also directly understand and perceive the mark, as it appears on the display sign, to be a source-indicator for the retail store services themselves.

This is so, even though purchasers obviously are aware that applicant is rendering retail store services because they are in the store when they encounter the mark and can

purchase the goods bearing the mark while shopping in the store. A product mark or other designation displayed on a particular item in a retail store (e.g., on a label or tag affixed to the goods, or on a display associated with the goods) is not necessarily also a service mark for the retail store services themselves, merely by virtue of the fact that the mark is used and encountered in the store. See *In re Brown & Portillo Inc.*, *supra*. Such a generalized association in the purchaser's mind between the product mark and the retail store services does not suffice as the requisite "direct association" between the mark and the services which would make the asserted mark a service mark for the retail store services themselves.

Moreover, there is nothing inherent in the AERIE UNDIES IN A BUNCH mark itself that would lead purchasers to view the mark as anything but a product mark for applicant's underwear. Indeed, the mark's explicit reference to the goods ("undies") and its display on the sign with the price of the goods reinforce the obvious and immediate significance of the mark as solely a product mark. Applicant's asserted mark therefore is distinguishable from the third-party registered service marks for retail store services which applicant has made of

record.² Whether they are deemed to be primary marks or secondary marks, those third-party marks are more in the nature of advertising slogans and taglines which would be seen as referring to and identifying retail store services generally. They are not marks like applicant's mark which, as used on the display sign, explicitly and directly refers only to a particular item offered for sale in the retail store.

Again, not every product mark for a particular product in a retail store necessarily also functions as a service mark for the retail store services merely by virtue of the fact that the purchaser encounters the mark in the store and can purchase the goods bearing the mark in the store. In this case, we find that although the display sign depicted in applicant's specimen is a "display associated with the goods" and thus likely would be acceptable as evidence of use of the mark as a trademark for the underwear applicant is selling, it does not suffice as

² Applicant's third-party retail store service marks include marks such as: "SAVE MONEY. LIVE BETTER."; "GIVE YOUR GIFT"; "BUY THE MOST ... SAVE THE MOST!"; "UNBELIEVABLE DEALS 10 UNDER \$10"; "PRICES SO LOW YOU DON'T HAVE TO HOLD BACK"; "GET WHAT FITS"; "A BODY FOR EVERYBODY"; "FROM EVERYDAY TO RISQUE"; "JINGLE DEALS"; "EVERY HOME. EVERY BUDGET."; "FILL A TRUCK FOR A BUCK"; "THE WAY YOU FEEL IS ABOUT TO CHANGE"; "WHAT YOU SEE, IS WHAT YOU CAN GET"; "SURPRISE OF THE DAY"; "QUALITY PRODUCTS FOR NATURAL LIVING"; "GLORY FOR GIRLS"; and "WHERE THE PROS GET IT."

evidence of use of the mark as a service mark for applicant's retail store services, per se.

For these reasons, we find that applicant's photograph of the display sign bearing the AERIE UNDIES IN A BUNCH mark in its store is not an acceptable service mark specimen for applicant's retail store services, and we affirm the Trademark Examining Attorney's refusal to register applicant's mark on that basis.

We will turn next to a determination of whether applicant has submitted a specimen sufficient to demonstrate use of the asserted mark AERIE UNDIES IN A BUNCH as a service mark for the "online retail store services featuring clothing..." recited in applicant's application.

Initially, we find that "online retail store services" are a "service" for which a service mark may be registered. As the Board noted in *In re Dell*, 71 USPQ2d 1725, 1727 (TTAB 2004), "[i]t is a well-recognized fact of current commercial life that many goods and services are offered for sale online, and that online sales make up a significant portion of trade."

We further find that, as a general proposition, a webpage screenshot can be an acceptable type of service mark specimen for online retail store services. However,

whether a particular screenshot submitted as a specimen in a particular case is an acceptable service mark specimen depends on the facts of that case.

The legal principles discussed above regarding the sufficiency of a specimen as evidence of service mark usage in the brick-and-mortar retail store services context apply equally to the determination of the sufficiency of a specimen as evidence of service mark usage for online retail store services. The fact that the services are being advertised and/or rendered online by means of the Internet does not change the underlying analysis for determining the acceptability of a service mark specimen. *Cf. In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (in the context of trademark specimens for goods, the test for determining the acceptability of a webpage screenshot specimen is the same as that for any other specimen).

Thus, a service mark specimen for online retail store services must show that the mark is used in such a manner that it identifies and distinguishes the online retail store services themselves. That is, the specimen must show that purchasers would directly associate the mark with the online retail store services, *per se*, and that they would readily perceive and understand the mark to be a source-

indicator for those services, and not merely a product mark for the goods sold via the online retail store.

Applicant has submitted several screenshots from its website as its specimens of use for its application. The webpage screenshot depicted below is representative:

Keep AE e-mails coming? Cut and paste American Eagle Outfitters (AE) (aerial.ae.com) into your address book or safe (if new)

aerie
BY AMERICAN EAGLE
aerie.com

all your favorite
aerie undies
in a bunch
6 for \$20
shop now

everything aerie...
our undie guide, bra guide, and spring look book [take a peek](#)

wish list | store locator | ae gifts | international shipping

save on softness
get \$5 off
all aerie cotton bras
[shop hannah bras](#) | [shop sarah bras](#)

At the top left of the screenshot appears the word "aerie" in large stylized lettering, under which appear in smaller lettering the words "BY AMERICAN EAGLE" and "aerie.com". In the center of the screenshot, to the left of a photograph of models wearing underwear, appears the wording "aerie undies in a bunch" above the wording "6 for \$20." This is directly above a link saying "shop now," which is above a photograph of several pairs of women's underwear. At the bottom of the screenshot are additional links which include "wish list," "store locator," "ae gifts," and "international shipping."

This screenshot specimen (which, again, is representative of applicant's other screenshot specimens) is a "display associated with the goods" which likely would suffice as a specimen of trademark use in an application to register the mark as a trademark for applicant's goods. *See In re Sones, supra; In re Dell, supra.*

However, we find that the specimen is not an acceptable service mark specimen showing use of the asserted mark AERIE UNDIES IN A BUNCH for applicant's online retail store services. We find that purchasers encountering the mark as it appears on the screenshot specimen (in conjunction with a photograph of the goods and the price for the goods) would perceive the mark only as a

product mark identifying one of the various clothing items that applicant sells in its online retail store, i.e., women's underwear or "undies." The mark by its nature and as it appears on these specimens specifically and directly refers to and identifies only the goods themselves.

Purchasers would not also directly understand and perceive the mark, as it appears on the screenshot, to be a source-indicator for the retail store services themselves.

This is so, even though purchasers obviously are aware that applicant is rendering online retail store services because they have accessed applicant's website when they encounter the mark in connection with the goods and can purchase the goods bearing the mark while shopping on the website. Such a generalized association in the purchaser's mind between the product mark and the online retail store services does not suffice as the requisite "direct association" between the mark and the services which would make the asserted mark a service mark for the online retail store services themselves.

Contrary to applicant's argument that in this case "the context is the Internet," the fact that these retail store services are offered online rather than in brick-and-mortar stores does not change the standard and analysis for determining whether the mark is used as a service mark for

retail store services. The standard is the same, regardless of the venue in which or the manner by which the retail services are offered. *Cf. In re Sones, supra.*

As discussed above, applicant's sign in its brick-and-mortar store displaying the mark in connection with applicant's underwear products does not suffice as a service mark specimen for applicant's brick-and-mortar retail store services, *per se*. Similarly and for the same reasons, we find in this case that applicant's screenshot "display associated with the goods" does not suffice as a service mark specimen for applicant's online retail store services, *per se*.

Accordingly, we find that applicant has failed to submit an acceptable specimen establishing that the asserted mark AERIE UNDIES IN A BUNCH functions as a service mark in connection with applicant's recited Class 35 services, whether its brick-and-mortar retail store services or its online retail store services. We have carefully considered all of applicant's arguments to the contrary (including those not specifically discussed in this opinion), but we are not persuaded by them.

Decision: The refusal to register is affirmed.