

From: Hayes, Gina

Sent: 11/6/2014 10:22:07 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77684321 - BEST FOR BABY - N/A - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 77684321.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77684321 MARK: BEST FOR BABY	
CORRESPONDENT ADDRESS: MELISSA S DILLENBECK DRINKER BIDDLE & REATH LLP 191 NORTH WACKER DRIVE STE 3700 CHICAGO, IL 60606	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Johnson & Johnson	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS:	

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's final refusal to register the mark BEST FOR BABY on the Principal Register, on the grounds that the specimens submitted do not show acceptable use of the proposed mark for the goods identified, in accordance with Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a).

FACTS

On March 5, 2009, the applicant, Johnson & Johnson, ("the applicant"), filed an application to register the proposed mark BEST FOR BABY on the Principal Register for "toiletries, namely, baby shampoo, baby bath skin cleansers and washes, baby cleansing wipes, baby lotion, baby shampoo and conditioner, baby oil and hair detanglers".

On June 30, 2009, the proposed mark was published for opposition.

On September 22, 2009, a Notice of Allowance was issued.

On September 21, 2012, after five extensions, the applicant filed a Statement of Use. The identification of goods was changed to "toiletries, namely, baby bath skin cleansers and washes, and baby lotion".

On October 11, 2012, the examining attorney issued an action refusing the specimen submitted and requiring a substitute specimen in accordance with Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), on the grounds that the specimens do not show use of the mark in connection with the goods.

On March 22, 2013, the applicant responded, arguing that the specimens are used as displays associated with the goods.

On April 6, 2013, the examining attorney issued a non-final action, on the grounds that the proposed mark fails to function as a mark under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127. On October 3, 2013, the applicant responded arguing that the specimens are used as a display associated with the goods.

On October 21, 2013, the examining attorney withdrew the failure to function refusal and issued a final action, on the grounds that the specimens submitted do not show acceptable use of the proposed mark on or in connection with “toiletries, namely, baby bath skin cleansers and washes, and baby lotion”. On April 21, 2014, the applicant filed its notice of appeal and Request for Reconsideration.

On July 16, 2014, the examining attorney denied the Request for Reconsideration and continued the final action.

On September 15, 2014, the applicant filed its brief and requested an oral hearing.

ISSUE

The sole issue for consideration on appeal is whether the applicant’s specimens present acceptable use of the applied-for mark on the goods, namely, toiletries, namely, baby bath skin cleansers and washes,

and baby lotion in accordance with Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a).

ARGUMENT

APPLICANT'S SPECIMENS ARE MERELY ADVERTISING MATERIAL, NOT POINT OF SALE DISPLAY

Applicant's specimens consists of coupons bearing the proposed mark, a picture of the goods, and the amount of the discount along with the name of the store where the consumer can use the coupon to receive the allotted discount. Displays associated with the goods essentially comprise point-of-sale material and must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Close physical association between the mark and the goods is not required, the terms of the Lanham Act are met if the mark is placed in any manner on the displays associated with the goods. See TMEP §904.03(g). Prior case law can serve as a guide for what constitutes a display associated with the goods and how to distinguish it from mere advertising.

In *Lands' End Inc.*, the trademark "KETCH" appeared prominently in large bold lettering on the display of purses in the Lands' End catalog in a manner which closely associated the term with the purses. And, an order form and telephone number was also provided in the catalog so that a customer could make a decision to purchase an item "straight from the identification in the catalogue." *Lands' End, Inc. v. Manbeck*, 797 F. Supp. 511, 514 (E.D. Va 1992). Lands' End would deliver the item shortly after receiving the order from the customer, the court therefore, deemed the catalog to be more than mere

advertising, because a customer could identify a product in the catalog and make a decision to purchase it by filling out the sales form and sending it in or by calling in a purchase by phone. For these reasons, the catalog specimen in *Lands' End* was an acceptable display associated with the goods.

Unlike *Lands' End*, in the applicant's case, the specimens do not offer a customer a means to purchase the goods. There is no telephone number or anything on the coupon that would allow a customer to consummate a purchase. For this reason alone, applicant's specimens are advertising material and not acceptable as specimens for goods. The function of applicant's coupons is merely to tell the prospective purchasers about the goods, or to promote the sale of the goods, which is unacceptable to support trademark use.

Applicant's display must be related to the sale of the goods such that an association of the two is inevitable. For example, in *In re Shipley Co. Inc.*, the Trademark Examiner's the refusal to register the mark "SHIPLEY IMAGINATIVE SOLUTIONS," for "chemicals for use in the fabrication of printed circuit boards" was reversed by the Trademark Trial and Appeal Board. The Board determined that a purchaser, upon seeing literature describing applicant's chemicals for use in the fabrication of printed circuit boards and being provided with the opportunity to buy these products at the trade show booths would, associate the mark that is prominently displayed on that booth with the goods. In *Shipley*, the court stated "[a]ttempting to draw the line of demarcation between mere advertising and a display associated with the goods is, as this case makes clear, a difficult task. In this case, we find that applicant's use falls on the 'display associated with the goods' side of the line rather than the 'advertising' side of the line, in view of the fact that the use of the mark is at a point-of-sale location. Those purchasing applicant's chemicals would look to the mark as prominently displayed on the trade show booth as a means of identifying and distinguishing the source of the chemicals offered for sale and/or purchased at those booths." *In re Shipley Co. Inc.*, 230 USPQ 691, 694 (TTAB 1986)

In this case, drawing the “line of demarcation” with applicant’s coupons, it is clear that the coupon fails to meet the test of a display associated with the goods as set out by case law that requires applicant to provide evidence of how its coupons are used as a display. Applicant has failed to do this; there is no invitation to order the goods as set out in Lands’ End. In fact, there is no means of ordering from applicant’s coupon at all. Applicant’s specimens are mere advertising material specifically designed to get people to buy applicant’s product from a third party.

THE SPECIMENS SUBMITTED DO NOT SHOW PROPER USE OF THE PROPOSED MARK ON “TOILETRIES, NAMELY, BABY BATH SKIN CLEANSERS AND WASHES, AND BABY LOTION,” IN ACCORDANCE WITH TRADEMARK ACT SECTIONS 1 AND 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a).

The proposed mark, BEST FOR BABY, is only used on applicant’s point-of-purchase coupons and not on or in connection with the applicant’s goods as required by the Trademark Act. The criteria for establishing whether a mark is in proper use on goods in commerce is set out in 15 USC § 1127, which states:

For purposes of this Act, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) 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 the goods or their sale, and
(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in

the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Applicant argues that its coupons are used in commerce as “displays associated” with the goods. However, applicant’s specimens are unacceptable as displays associated with the goods, because they do not meet the criteria set out in 15 USC §1127 above, nor do they meet the exception set out in 37 C.F.R. 2.56 providing that the “[o]ffice may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.” In this case, it is presumed that it is not impracticable for the applicant to place the mark BEST FOR BABY on containers for the goods.

The Trademark Manual of Examining Procedure (“TMEP”) Section 904.03(g), which covers displays as specimens, states in part:

A display must be associated directly with the goods offered for sale. It must bear the trademark prominently. However, it is not necessary that the display be in close proximity to the goods. *See In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands’ End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992). Displays associated with the goods essentially comprise point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices.

These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, the display must prominently display the trademark in question and associate it with, or relate it to, the goods. *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007); *In re Morganroth*, 208 USPQ 284 (TTAB 1980) (purported mark was so obfuscated on the specimen that it was not likely to make any impression on the reader). The display must be related to the sale of the

goods such that an association of the two is inevitable. *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979).

The cases noted above, in particular, *In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992), and *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979) clearly support the fact that a display associated with the goods must (1) include a picture or a sufficient textual description of the relevant goods; (2) show the mark in association with the goods; and (3) include 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). In other words, for a display to be acceptable as a specimen for goods, it must show the proposed mark in connection with the sale of the goods identified, so that it is inevitable for a consumer to associate the mark with the sale of the goods.

In this case, applicant's coupons are not associated with its products in such a way that consumers associate the mark BEST FOR BABY with the goods. Applicant argues, "a coupon is designed to act as a direct inducement to make a sale. That is, in fact the only point of a coupon. It serves no other purpose. Thus, a point-of-sale coupon is exactly the type of specimen that should be accepted as evidence of use." (Applicant's Brief, page 2). On the contrary, the applicant's coupons are distributed to customers at checkout as simply an automatic byproduct of the purchase experience. The coupons are not shelf talkers; there is no association with the goods in such a way that consumers would associate the mark with the goods. TMEP § 904.03(g) requires applicants to submit evidence of a display:

Folders, brochures, or other materials that describe goods and their characteristics or serve as advertising literature are not per se "displays." *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990). In order to rely on such materials as specimens, an applicant must submit evidence of

point-of-sale presentation. Such evidence must consist of more than an applicant's statement that copies of the material were distributed at sales presentations or tradeshows. A mere statement that advertising and promotional materials are used in connection with sales presentations is not sufficient, in and of itself, to transform advertising and promotional materials into displays used in association with the goods. *Osterberg*, 83 USPQ2d 1220, 1224 ("Applicant's declaration lacks sufficient detail to transform the web page from advertising into a display used in association with the goods. For example, there is no discussion regarding how the applicant used the web page at sales presentations to make an association between the mark and the products or whether consumers, in fact, associated the mark with the products. The use of advertising material in connection with the sales of a product does not ipso facto make it a display used in association with the goods sufficient to support technical trademark use for registration.")

It is therefore the examiner's contention that applicant's specimens do not constitute a "display associated directly with the goods offered for sale" within the meaning of *In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972) or *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

The distinction between the instant case and *In re Marriott Corp.*, is that in *Marriott* customers would see the mark on the menu, select the item by printing on a form or calling for the item by name, and presenting it to the waitress as an order. In *Marriott*, the United States Court of Appeals for the Federal Circuit reasoned that:

"in both the table and curb service, appellant's menu, with the instant mark thereon, indicates ingredients which compose the TEEN TWIST sandwich and also frequently has a small illustration of the sandwich. In either form, we think that the menu is a display of appellant's offering directly associated with appellant's goods. It is from this word or pictorial depiction of the sandwich that the customer makes his selection, and his selection is not indicated on the check by the specific ingredients of its composition

but by the mark TEEN TWIST. The fact that after the order is taken it is a short period of time until that order is translated into a sandwich delivered to the customer does not militate against the efficacy of the mark's association with the goods." *In re Marriott Corp.*, 59 C.C.P.A. 1055, 1057 (C.C.P.A. 1972).

In the case at bar, unlike *In re Marriott Corp.*, there is no means of ordering the goods from the applicant, thus, no invitation from the applicant. The scenario with applicant's coupon is vastly different from a restaurant experience where the customer identifies the product on the menu, calls for it by name (orders it) and has a waitress bring the food to him for consummation. In the applicant's case, there is no action by the applicant to fulfill the order. The applicant has not created a display associated with the goods, because the applicant does not fulfill the order – third parties do. In so doing, the applicant has merely provided an advertisement for the goods, which is not acceptable to show proper use of the mark in connection with the goods.

As the applicant indicates on page 2 of the response dated April 21, 2014, "the coupon must be paired with the goods and surrendered at the time of check out – the point of sale where the consumer purchases the item". The applicant suggests that the point of sale is at the check-out counter where the consumer purchases the item. But, there is no display associated with the goods at the check-out counter. Having the customer hold the product in hand or place it on the conveyor belt for purchase is not a display associated with the goods. In this case, pairing the coupon with the goods is only possible after the customer completes his/her purchase at the check-out counter. Applicant concedes that the coupon "indeed is actually dispensed to the consumer at the point-of-sale itself." (Applicant's Brief, page 1). The coupons are advertising materials and should a potential consumer decide to purchase the goods after the coupon has been delivered to the consumer by the third party grocer, the purchase would come at a time in the future, because there no way to order or purchase the product from the

coupon. The coupons are promotional items from the applicant (manufacturer) to entice customers to buy their product from a third party – the very definition of advertising.

A point-of-sale display means that the goods are on display where the mark would appear next to the product or in some proximity. This could be accomplished with applicant's coupons if the coupons were situated in such a way that the goods and the coupons are next to each other or in "direct association". Along the same lines, if applicant's coupons were used as a hangtag coupon next to the goods on the grocery shelf or in close proximity so that when the consumer grabs the product, he could also grab a coupon at the same time directly associating the proposed mark with the goods. This is not the case in the subject application. Applicant has submitted no evidence that the goods are on display where the mark would appear next to the product or in some proximity. There is no Point of Sale display in applicant's case.

Applicant's coupons do not provide the means for ordering or purchasing the goods as required in *Lands' End, Inc.*, rather, the coupons provide marketing information about the product and offer a discount on the product's purchase price. The purchase price is not obtained from the coupon, nor do the coupons provide instructions on where the products are located or how to purchase the products.

In *Lands' End, Inc.*, the court reasoned that:

"The trademark statute does not require that the mark be affixed or have "close physical association" to the goods. The terms of the statute are met if the mark is placed in any manner on a "display associated" with the goods. *Id.* In re Marriott, 59 C.C.P.A. 1055, 459 F.2d 525, 526 (C.C.P.A. 1972). Specimens are invalid for registration purposes only if they constitute mere advertising. See In re Shipley Co., 230 U.S.P.Q. 691, 694 (T.T.A.B. 1986). A "line of demarcation" should be drawn

between mere advertising and a display associated with the goods. *Lands' End, Inc. v. Manbeck*, 797 F. Supp. 511, 513 (E.D. Va. 1992).

The court went on to say "the determination of whether a specimen is mere advertising or a display associated with the goods is a factual question amenable to proof. *Shipley*, 230 U.S.P.Q. at 694. A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location. A point of sale location provides a customer with the opportunity to look to the displayed mark as a means of identifying and distinguishing the source of goods." *Id.* at 514. The court determined the catalogue to be more than "mere advertising," because "a customer can identify a listing and make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone. A customer can easily associate the product with the word 'KETCH' in the display. The mark and the accompanying description also distinguish the product from others." *Lands' End, Inc. v. Manbeck*, 797 F. Supp. 511, 514 (E.D. Va. 1992). Here, the applicant's coupons are unlike the Lands' End catalog in that a customer cannot make a decision to purchase by filling out the coupon, sending the coupon to Johnson & Johnson or using the coupon to call in a purchase by phone. Nor, can the consumer order the product from either of the store shown on the coupons.

It is applicant's contention that the specimens meet the test set out in *In re Dell*, 71 U.S.P.Q.2d 1725 (T.T.A.B. 2004). The Board in *Dell* stated that an examining attorney should accept any "catalog or similar specimen as a display associated with the goods, provided: 1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods. Applicant argues the coupon "meets each of these requirements: It includes an image of the relevant goods, it shows the mark BEST FOR BABY near the images of the goods, and specifically lists the retailer where the items can be purchased, as well as the amount of the discount available at the time of purchase". (Applicant's brief,

page 5). The apparent problem is that the coupon does not present information necessary to order the goods, because unlike catalogs, a consumer cannot purchase goods from a coupon. Therefore, applicant's argument is without merit.

Applicant's specimens are not like a catalog, and they are even less like a trade show booth; yet, applicant argues that its specimens are akin to the specimens in *In re Shipley Co.*, 230 U.S.P.Q. 691 (T.T.A.B. 1986), where the specimen showing a mark at a trade show booth was acceptable as a display associated with the goods. Although the goods were chemicals, and therefore not present at the tradeshow, the Board determined that the tradeshow booth functioned as a sales counter for the chemicals being sold at the booth. Unlike in *In re Shipley*, the instant case, there is no tradeshow booth in applicant's scenario. Applicant does not have a sales counter from which the baby bath skin cleansers and washes, and baby lotion can be purchased at Winn Dixie or Lowe's Foods (the establishments noted on the coupons). Consumers cannot order from applicant at all, because there is no contact information to order the goods from applicant. This is what the case law contemplates – not a manufacturer sending consumers to third parties. Applicant has provided no point of sale display evidence at all, and the fact that the coupons are not shelf talkers is significant in drawing the conclusion that they are mere advertising.

For the aforementioned reasons, the specimens provided do not show proper use of the mark in connection with the goods identified in the application.

CONCLUSION

The Board is urged to affirm the decision of the trademark examiner finding the specimens unacceptable as a point-of-sale display associated with the goods and that they therefore, fail to show the applied-for mark in use in commerce.

Respectfully submitted,

/Gina Hayes/

Trademark Examining Attorney

U.S. Patent & Trademark Office

Law Office 103

571-272-9407

gina.hayes@uspto.gov

Michael Hamilton

Managing Attorney

Law Office 103