

This Opinion is not a
Precedent of the TTAB

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Mailed: September 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Johnson & Johnson

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Remand Order

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Serial No. 77684321

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Melissa S. Dillenbeck and Darren S. Carr of Drinker Biddle & Reath LLP,
for Johnson & Johnson.

Gina Hayes, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

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Before Taylor, Mermelstein and Greenbaum,
Administrative Trademark Judges.

By the Board:

Johnson & Johnson (“Applicant”) seeks registration on the Principal Register of the mark BEST FOR BABY (in standard characters) for, as amended, “toiletries, namely baby bath skin cleansers and washes, and baby lotion.”

The Trademark Examining Attorney finally refused registration of Applicant’s mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. § 1051 and 1127, on

the ground that the specimen of use is unacceptable to show use of the mark in commerce with the identified goods.¹

The mark appears on the specimen of record as follows:



Applicant appealed to this Board. Both Applicant and the Examining Attorney filed briefs and both appeared at an oral hearing on July 15, 2015.

Upon consideration by the Board, we find *sua sponte* that a remand is in order. Trademark Rule 2.142(f)(1) provides that if, during an appeal from a refusal of registration, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may suspend the appeal and remand the application to the Examining Attorney for further examination to be completed within thirty days.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an

¹ During prosecution, the Examining Attorney also asserted as a ground for refusal that the applied-for mark, as used on the specimen of record, does not function as a trademark to indicate the source of the goods under Trademark Act Sections 1, 2 and 45; 15 U.S.C §§ 1051, 1052 and 1127. This particular ground was not repeated at briefing, but rather appears to have been subsumed by the specimen refusal.

immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Moreover, the Federal Circuit has stated, “[m]arks that are merely laudatory and descriptive of the alleged merit of a product are also regarded as being descriptive. ... Self-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods.” *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir.) quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:17 (4th ed. 1996) (internal quotations omitted). Thus, registration is properly refused when a term is held to be merely laudatory as applied to particular goods. *See, e.g., In re Boston Beer, supra* (finding THE BEST BEER IN AMERICA highly laudatory and descriptive as applied to beer and ale); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (finding BEST and PREMIER in mark BEST! SUPPORTPLUS PREMIER merely descriptive of computer consultation and support services and thus subject to disclaimer); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (finding AMERICA'S BEST POPCORN! and AMERICA'S FAVORITE POPCORN! descriptive of “popped popcorn”).

It appears that the applied-for mark BEST FOR BABY may be laudatorily descriptive under Trademark Act Section 2(e)(1). Accordingly, the application is remanded to the Examining Attorney for further examination in view of the

discussion above. This further examination should be completed within thirty days. Trademark Rule 2.142(f)(1). The attention of Applicant and the Examining Attorney is directed to TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1209.01 (2015) (“Remand – Upon Board’s Own Initiative”), and the pertinent remainder of Trademark Rule 2.142(f):

(2) If the further examination does not result in an additional ground for refusal of registration, the examiner shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.

(3) If the further examination does result in an additional ground for refusal of registration, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. If the ground for refusal is made final, the examiner shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

(4) If the supplemental brief of the appellant is filed, the examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

(5) ...[A]n oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.

On remand the Examining Attorney may not make a requirement or refuse registration on a new ground not specified in this order. Nor may the Examining

Attorney or Applicant submit any additional evidence relating to the Sections 1 and 45 ground.

In view of the above, the appeal is suspended.