

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 21, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Factory Direct, Inc.

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Serial No. 77764096

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Mary M. Lee of Mary M. Lee, P.C., for Factory Direct, Inc.

Linda A. Powell, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Bucher, Grendel and Gorowitz,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Factory Direct, Inc. (“applicant”) seeks registration on the Principal Register of the mark **SLEEP BETTER, LIVE BETTER** (*in standard character format*) for “sleep products, namely, mattresses, spring mattresses, box springs and mattress foundations,” in International Class 20.¹

On January 12, 2011, applicant filed a statement of use along with the requisite specimens of use. While applicant argues these photographs show displays associated with the goods, the examining attorney contends that these are not valid to demonstrate trademark usage for the goods identified in the

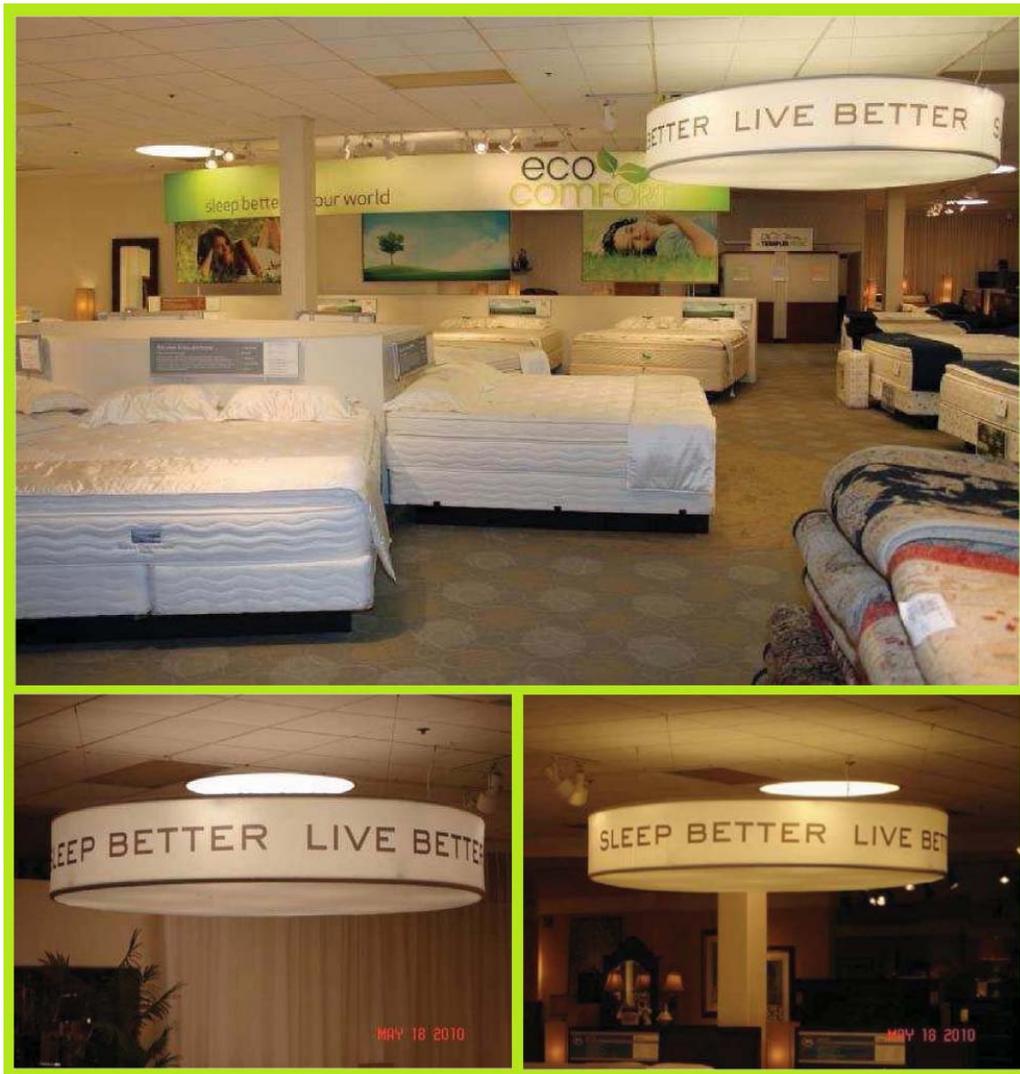
¹ Application Serial No. 77764096 was filed on June 19, 2009, based upon applicant’s claim of a *bona fide* intention to use the mark in commerce.

application, citing to Trademark Act Sections 1 and 45 and the relevant Trademark Rules, 15 U.S.C. §§ 1051 & 1127, and 37 C.F.R §§ 2.56(a) & 2.88(b)(2).

When the refusal was made final, applicant appealed to this Board.

We affirm the refusal to register.

The specimen shows the slogan **SLEEP BETTER, LIVE BETTER** displayed on large, circular, illuminated signage suspended from the showroom ceiling:



Beneath the sign on the showroom floor are a variety of sleep products, including mattresses and foundations having marks such as **Tempur-Pedic**, **Serta** and **Sealy**.

It is the position of the examining attorney that our controlling statute and rules create a clear distinction between trademarks (used in connection with products) and service marks (used in connection with services), and that our case law discusses these respective types of specimens as having different purposes. In the use-based trademark registration system of the United States, the specimens offer the best insight that the examining attorney has into how applicant's practices, as alleged under oath, match up with what he or she knows to be industry norms. Given the nature of this alleged mark and its placement some distance away from the goods, the examining attorney argues that this slogan is not associated with the goods as would be banners, shelf-talkers and other point of purchase displays. Hence, the examining attorney contends that while the slogan on this signage may well function as a service mark for retail store services featuring sleep products (such as mattresses and mattress foundations), it is not an acceptable specimen for trademark usage described as a point of sale display associated with the goods.

On this critical issue, we agree with the examining attorney. Wishing does not a trademark make. From the viewpoint of the first-time shopper in the Factory Direct store as photographed, it is "Factory Direct" that is responsible for the quality of the retail shopping experience. This large store signage having the slogan **SLEEP BETTER, LIVE BETTER** contains something between advertising verbiage and an

identifying tagline that applicant wants to plant in the minds of Factory Direct consumers.²

However, as the prospective consumer flops down on the floor model to determine the quality and comfort of the innerspring mattress, it is the **Serta**, **Sealy** or **Tempur-Pedic** label on the mattress the customer will be eyeing when making a determination about the quality of the product. By contrast, the prospective consumer will *not* understand the suspended slogan to be a mark identifying the source of that mattress. Moreover, applicant does not argue anywhere in the prosecution of this application that the applied-for mark appears *on or in close proximity to* any of the goods for which registration is sought.

Accordingly, we agree with the examining attorney that this large suspended sign in the middle of the store displaying the slogan **SLEEP BETTER, LIVE BETTER** is not a display associated with the goods for the named sleep products. With specimens as with other visual cues, “we know it when we see it,” and on this question of fact, we have no doubt that applicant’s specimens fail to depict acceptable displays associated with these goods.

Decision: The refusal to register applicant’s mark is hereby affirmed.

² We should add that in response to applicant’s arguments, we are not suggesting that a mark cannot function as both a trademark and a service mark, given appropriate specimens in support of each, nor are we suggesting that a product label cannot bear more than one mark without diminishing the identifying function of each.