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N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77980412

MARK: PLAQUE-ZAPPER



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Gulf Coast Nutritionals, Inc.

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## EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark "PLAQUE-ZAPPER" on the ground that it fails to provide evidence of the applied-for mark in use in commerce for the goods recited in International Class 31. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b). *See* 37 C.F.R. §2.64(a).

### STATEMENT OF FACTS

On January 8, 2008, applicant Gulf Coast Nutritionals, Inc., filed original (parent) U.S. Trademark Application Serial No. 77366701, seeking registration of the proposed mark, PLAQUE-ZAPPER, based on an intent to use for goods in International Class 31.

On April 16, 2008, the trademark examining attorney issued an Office Action requiring an amendment to the original identification of goods and payment of additional fees for any classes added to the application. On September 19, 2008, applicant responded by amending the identification of goods in International Class 31, and adding International Classes 1, 3, 5 and 21, including the payment of fees for those added classes. On December 24, 2008, a Notice of Publication issued with a publication date of January 13, 2009. On April 7, 2009, a Notice of Allowance issued.

The applicant filed a First Request for Extension of Time to File Statement of Use on September 30, 2009, and a Notice of Approval of Extension Request #1 was issued on October 15, 2009. On April 5, 2010, the applicant filed a Second Request for Extension of Time to File Statement of Use, and a Notice of Approval of Extension Request #2 was issued on April 10, 2010. The applicant filed a Request to Divide on July 8, 2010, but an Office Action was issued denying that Request to Divide as untimely on July 15, 2010. On August 23, 2010, the applicant filed a Statement of Use deleting International Classes 1 and 21, and also a Request to Divide. On September 16, 2010, the Office issued a Notice of Divisional Request Completed, specifying that the parent application would contain the International Class 3 (intent to use) goods, and the newly created child application, SN 77980412, would contain International Classes 5 and 31.

The Statement of Use for the new child application, SN 77980412, (this application), was sent to the examining attorney for review. The specimen filed in the

Statement of Use was the same for both International Classes 5 and 31. After reviewing the Statement of Use, the trademark attorney issued a non-final Office action on October 13, 2010, accepting the specimen for the medicated goods in International Class 5, but refusing the *same* specimen for the food goods in International Class 31. On April 13, 2011, the applicant responded with arguments against the specimen refusal, but the arguments were unpersuasive because the specimen was for a dental treatment for pets and not “*pet treats, pet food and pet beverages,*” as recited in International Class 31. On April 28, 2011, the examining attorney issued a final refusal of the specimen for International Class 31. The applicant concurrently filed a Request for Reconsideration and a Notice of Appeal with the Trademark Trial and Appeal Board on October 28, 2011. On December 8, 2011, the examining attorney issued a denial of the Request for Reconsideration because the applicant did not present any new issues or arguments, and returned the application to the Board to resume the instant appeal.

On December 9, 2011, the applicant filed a Request to Divide Application, and the goods in International Class 5 were divided into the newly created child application, SN 77982918, [incorrectly noted in Applicant’s Brief as 77928918], as noted in the Notice of Divisional Request Completed, which issued on January 18, 2012. The goods in International Class 31 remained in the instant application SN 77980412, and on December 14, 2011, the appeal was resumed in an Order from the Board. Applicant filed its Appeal Brief on February 10, 2012. The application was forwarded to the examining attorney for a brief in accordance with Trademark Rule 2.142(b) on the same date.

## ISSUE

The sole issue on appeal is whether or not the proposed mark fails to function as a mark under Sections 1 and 45 of the Trademark Act because the specimen filed with the Statement of Use on August 23, 2010, is not acceptable to show use of the mark with the goods recited in International Class 31.

## ARGUMENT

THE PROPOSED MARK FAILS TO FUNCTION AS A MARK UNDER SECTIONS 1 AND 45 OF THE TRADEMARK ACT BECAUSE THE SPECIMEN IS UNACCEPTABLE TO SHOW USE OF THE MARK WITH THE GOODS RECITED IN THE APPLICATION.

In the instant case, it is the applicant's contention that one specimen supports use of the mark on goods in more than one class. Although a combined, multi-class application, requires that there be one specimen showing use of the mark for each class, 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.56(a) and 2.86(b), it is also true that one specimen can be acceptable to support use of the mark for goods recited in more than one class. TMEP §904.01(b). *See In re International Salt Company*, 166 USPQ 215 (TTAB 1970). However, as the Board stated in *In re International Salt Company*, "specimens filed in any particular class should reflect use of the mark in connection with the product for the use set forth in the application." *Id.* at 216. The Board also considered a situation where a specimen may identify a singular purpose or use that is contradictory to the recitation of

goods for which the applicant asserts the specimen shows use of the mark. In this situation, the Board indicated that the examining attorney should inquire about any contradictions of this nature before approving the application. *Id.* In this case, the single specimen submitted by the applicant supports use of the proposed mark with the International Class 5 goods that have since been allowed in the divided child application, SN 77982918 (*medicated pet dental products, namely, dental treats, and rinses and pharmaceutical products for animal dental care; ingestible pet dental products, namely, ingestible multi-vitamins and liquids for dental care*), but does not support use of the proposed mark with the goods in International Class 31 that remain in this application (*Pet products, namely, edible pet treats, pet food and pet beverages*).

Specifically, the specimen filed in the statement of use of August 23, 2011, which was exactly the same for both International Classes 5 and 31, appears to be some type of dental product which consists of a powder that can be mixed with water or wet cat or dog food. The applicant describes the specimen in the statement of use as “packaging for the goods.” The specimen consists of multiple views of one box, which provides the following information:

FRONT: For Small to Medium Pets; BREATH-LESS FIZZY PLAQUE-ZAPPER Patent Pending; Odorless · Colorless · Tasteless; Will Not Change Pet’s Drinking or Eating Habits; Pets Do All the Work... You Don’t!; EMPTY CONTENTS INTO PET’S DRINKING WATER; 30 pouches

LEFT SIDE: BREATH-LESS FIZZY PLAQUE-ZAPPER Patent Pending; *Plaque-Zapper* contains naturally available enzymes that are activated by mouth

saliva. As your pets drink from their water bowl Ark's *Plaque-Zapper*...Zaps harmful mouth bacteria and our clinically tested enzymes stop plaque from sticking to teeth. **Warnings:** For Dogs & Cats. Keep out of reach of children and other animals. In case of accidental overdose contact a health professional immediately. **Storage:** Refrigeration not necessary. Cool dry location. MADE IN USA

**TOP:** For Small to Medium Pets; BREATH-LESS FIZZY PLAQUE-ZAPPER Patent Pending; **ENDS**...Hand brushing, wipes, sprays, gels, paste and jumpy animals. **GOODBYE**...Plaque, tartar, bad breath and stained teeth. **HELLO**...Pet's Healthy Teeth and Sweet Breath. ARK NATURALS.

**BACK:** BREATH-LESS FIZZY PLAQUE-ZAPPER Patent Pending; Vet Recommended & Formulated; **Product Facts:** For use by Dogs & Cats. Recommended to support dental health and control plaque, tartar and bad breath. **Recommended Use:** Empty packet in bowl of fresh water. **Therapeutic:** 2x daily for 4-6 weeks. **Maintenance:** Use 1x daily – 3x per week. **Fizz lasts 3-5 seconds. Enzymes remain active for 6-8 hours. For Cats Who Don't Drink Water From a Bowl:** Empty packet onto cat's wet food. Effective on its own or it can be combined with *Breath-Less Brushless-Toothpaste*. Results within 4-6 weeks of continual use.

**RIGHT SIDE:** BREATH-LESS FIZZY PLAQUE-ZAPPER Patent Pending; ALL NATURAL; **Active Ingredients:** A proprietary formula 100mg: Lysozyme, Glucosidase, Amylase, Papain, Amyloglucosidase, Peptizyme, Lactoferrin. **Inactive Ingredients:** Maltodextrin, Citric Acid, Sodium Bicarbonate. **NO** Anthium Dioxide, Chlorine Peroxide, Chlorine Dioxide. **Yeast Free. Wheat Free. Corn Free. Cautions:** If animal's condition worsens or does not improve, stop product administration and consult your veterinarian.

**BOTTOM:** **About Ark Naturals and Our Ingredients:** Our ingredients and manufacturing processes are natural, human quality and are GMP (good manufacturing practices) compliant. *Breath-Less Plaque-Zapper* is manufactured in the USA in FDA/OTC facilities. Proud members of the NPA, APPMA and NASC. **www.arknaturals.com; Questions:** Contact us or visit us on the web for information about Ark's full line of pet products.

There is no mention on the packaging submitted by the applicant that the goods are “pet treats,” “pet food” or “pet beverages.” But as argued by the applicant, there is no requirement that the packaging specifically use the word “treat” to describe the applicant’s goods. So the examining attorney agrees that the exclusion of the term “treat” on the packaging is not fatal. However, consumers must be able to identify that the proposed mark would be associated in some way with the recited goods. TMEP §904. In other words, the applicant is given latitude to identify their goods and classify them in the appropriate international class accordingly, but the specimen submitted must support the identification provided by the applicant for their goods, and specifically, show use of the mark for those identified goods. This prevents the applicant from over-reaching their trademark protection by arbitrarily reciting goods and asserting that a particular specimen supports use of those goods for more than one international class, even when the specimen suggests a contradictory use, or supports use with one class but not all of the classes of goods recited in the application. Therefore, a determination must be made herein as to whether consumers would make any connection between the mark as used on the specimen, and the recited *pet treats, pet food and pet beverages* in International Class 31.

In the instant case, not only does the specimen omit the term “treat,” but the specimen does not ever specifically identify what the goods are. One might argue that

this supports the applicant's arguments that the specimen can be used to support both the International Class 5 and 31 goods. However, the examining attorney believes that the packaging suggests a contradictory use. The packaging does state that the goods are "[r]ecommended to support dental health and control plaque, tartar and bad breath." *See* Specimens, BACK of box, Page 2. The packaging also states that the powder may be mixed into the pet's water or sprinkled on wet cat food. *See* Specimens, FRONT & BACK of box, Pages 1 & 2, respectively. Based on this description, the goods may be added to water or food, but this does not magically transform the goods into a "food or beverage," or by analogy, a "treat." In fact, the remainder of this brief focuses on whether the use of the mark is supported for "*pet treats*," as the applicant has not challenged the assertion by the examining attorney that the specimen shows use of the mark for "*pet food*" or "*pet beverages*."

The definition of "treat" from the record is "anything that affords particular pleasure or enjoyment." [www.dictionary.reference.com/browse/treat](http://www.dictionary.reference.com/browse/treat) (attached to Applicant's Response of 4/13/11). Although there are other possible definitions of the term "treat," this definition makes the most sense with the facts of the instant case. The specimen packaging specifically touts that the goods are "Odorless · Colorless · Tasteless" and "Will Not Change Pet's Drinking or Eating Habits." *See* Specimens, FRONT of box, Page 1. The examining attorney has repeatedly argued that something that is odorless, colorless and tasteless cannot be considered a "treat." It is unperceivable that anyone, including a pet, could receive "particular pleasure or enjoyment" from

something that they cannot smell, see or taste. The whole point of the goods packaged in the box shown on the specimen is that the animal will not know that anything has been added to their food or water – or as stated on the specimen, they “will not change pet’s drinking or eating habits.” *See* Specimens, FRONT of box, Page 1. In sharp contrast, the claims made on the specimen do support use of the mark with the goods recited in International Class 5, which were divided into child application, Serial No. 77982918<sup>1</sup>, and have now been allowed for registration.

In addition to the evidence supporting this refusal, common sense must be used in the analysis of the specimen, and the examining attorney reiterates the assertion that there is nothing on the specimen that would suggest to a consumer that the goods are a “treat.” Simply calling the powdered dental goods by another name, i.e., “pet treats,” without any support or indication on the packaging that this is the case, does not transform the dental powder into another good. In other words, the specimen and evidence plainly show that the goods are a form of dental hygiene powder that can only be classified in International Class 5. These same goods cannot be wedged into an additional International Class 31 merely by calling it a “pet treat” in the application, when the specimen does not provide any support for this additional use of the goods.

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<sup>1</sup> *Medicated pet dental products, namely, dental treats, and rinses and pharmaceutical products for animal dental care; ingestible pet dental products, namely, ingestible multi-vitamins and liquids for dental care*

The applicant argues that the examining attorney erred because the dictionary definition of “treat” selected by the applicant, one of several definitions included in the evidence submitted by them (Applicant’s Response, 4/13/11), establishes that the goods are a “treat.” The definition selected by the applicant defines “treat” as “entertainment, food, drink, etc., given by way of compliment or as an expression of friendly regard.” [www.dictionary.reference.com/browse/treat](http://www.dictionary.reference.com/browse/treat). As discussed in the final Office action issued on April 28, 2011, it appears that the applicant may have been confusing the term “compliment” (“give something to somebody: to give somebody a gift as a sign of respect or honor”) with the term “complement” (“one of two: either of two things that form a unit”) in this definition. [www.encyclopedia.com](http://www.encyclopedia.com) (*see* definitions attached to Final Office Action of 4/28/11). In the definition provided by the applicant, the term “compliment” is referring to the food or drink being a gift, e.g., free. Thus, the definition selected by the applicant provides no support for a finding that the specimen is a “treat,” and in fact, does not make any sense at all related to the goods at issue.

The applicant further argues in their Brief that “[o]ne could spend a half an hour looking at nothing but dictionary definitions of the term ‘treat’ and every single one of them would describe exactly what is inside Applicant’s previously submitted packaging. Indeed, many pets consider Applicant’s product to be a treat.” Applicant’s Brief, Page 5. However, the applicant has not provided any additional definitions of the term “treat” that would support this very broad assertion. It is not conceivable that “every single [definition could] describe exactly what is inside” the applicant’s packaging. There are

many more definitions of “treat” included in the dictionary excerpt provided by the applicant alone, and none of them would appear to “describe exactly what is inside” the applicant’s packaging. The applicant goes on to argue that “[i]n all known sources for definitions of words, the definition of ‘treat’ supports the Applicant’s position herein every single time a definition appears.” Applicant’s Brief, Page 10. Yet again, the applicant has not provided any definition for “treat” other than the one source previously submitted with their response on April 13, 2011. It is not clear how the applicant can make such a broad-sweeping statement without any evidence to back it up. Moreover, the applicant argues later in their Brief that the examining attorney has not satisfied the burden of proof for showing that the goods are not a treat, but the applicant itself makes the claim that “many pets consider Applicant’s product to be a treat,” Applicant’s Brief, Page 5, and this claim is completely unsupported by the applicant (how would anyone even know this?), and the applicant is the party that would have access to the resources required to support such a claim, if that were even possible.

As discussed in the denial of the request for reconsideration, issued on December 8, 2011, “pet treats” are typically edible goods that do have flavor, and are usually given to a pet as a reward for good performance or to encourage certain desired behaviors during pet training. Contrary to the applicant’s assertions that this description of “pet treats” is conjecture by the examining attorney, this assertion is supported by the descriptions of “pet treats” provided in the attachments to that request for reconsideration. For example:

ONLY NATURAL PET STORE:

Healthy, High Quality Pet Treats

All natural and healthy treats for cat and dogs available in variety of chews, biscuits, bones, crunches and moist goodies.

ENTIRELY PETS:

DELICIOUS TREATS!

Pet Treats can help keep your dog or cat happy and healthy. Playing not only is fun but gives both you and your pet great exercise. You can also show you care by rewarding good behavior with **pet treats** like Joint Treats, Greenies, and Trim Treats. Yummy treats are great for training your pet as well. Pick up some treats for your furry friend today.

*See attachments to Request for Reconsideration Denied, 12/8/11, Pages 2 and 11.*

In that same denial of request for reconsideration, the examining attorney provided evidence that on websites offering the applicant's products for sale, the goods shown in the packaging submitted in this application, are listed under departments and categories of goods that are not "Pet Treats." For example, the applicant's goods were found in the "Grooming/Hygiene" department on the "Only Natural Pet" website, and in the "Dental Products" or "Dental Additives" departments on the "Entirely Pets" website.

*See attachments to Request for Reconsideration Denied, 12/8/11, Pages 7 and 16.*

Moreover, neither the applicant's goods nor anything similar in nature to the applicant's powdered goods in the instant application, were found in the "Pet Treats" departments of either of these websites. *Id.* at pages 2-6, 9-15. The examining attorney does not dispute

that an owner may give their pet a treat for many different reasons, and not only those stated above. Rather, the examining attorney is merely attempting to provide context to what would be considered a “pet treat” in the pet products industry.

The applicant presents a new argument in their brief that the fact that the goods are “fizzy,” as stated on the specimen, prove that the goods are a treat because “many pets like the feel of fizz on their tongues when they are consuming something.” Applicant’s Brief, Page 7. The applicant further reasons that because pets consume it, it must be a treat – “Pets don’t lie.” No, “pets don’t lie” because they can’t communicate with us. Moreover, the applicant does not provide any support for any of these assertions, and as pointed out several times by the examining attorney, how would one go about determining the truth of this assertion? Even if the applicant could prove somehow that an animal would consider something fizzy a treat (it seems it is equally possible that an animal would have an adverse reaction to something fizzing in their face), the packaging states that the fizz only lasts 3-5 seconds, which is not very long and very unlikely to even be experienced by the animal unless the owner pours the powder in while the animal is right there ready to take a drink. Therefore, the mere fact that the goods are fizzy, without any further evidence to shed light on an animal’s actual response to the fizz, does not prove that the goods are “treats.”

The applicant's additional argument that a dog will consider the goods a treat because of the beneficial results of consumption: "better oral hygiene, be[ing] healthier, [and] liv[ing] longer," is similarly unpersuasive for the same reason – there is no evidentiary basis for how a pet would understand the benefits. Finally, the applicant states that the dictionary definition of record identifies that "the ultimate arbiter of whether the product is a pet treat, is the pet." Applicant's Brief, Page 9. And further asserts that "[t]he party wishing to challenge that needs to submit evidence going to the heart of the matter." *Id.* It is not clear what the applicant means, and the examining attorney does not see anything in the dictionary evidence that would support this assertion by the applicant.

As with all of the above assertions, the applicant could have chosen to provide declaration evidence from owners of pets that have used the applicant's product, indicating how their pet responds to receiving the product for consumption, and possibly, how the owner would classify the goods shown in the applicant's specimen. The applicant is best suited to collect this type of evidence to support their case as they have more resources at their disposal, but the applicant has not submitted any evidence of this type, or any other type for that matter. The USPTO does not have the resources or ability to collect that type of evidence.

The applicant spends a good deal of energy asserting that the examining attorney has made arguments and findings without sufficient evidentiary support, and repeatedly states that the examining attorney should have provided evidence of a nature that is simply not available to the examining attorney, e.g.,

“[T]here is no evidence whatsoever that a single human buyer ever considered the product *not* to be a treat.” Applicant’s Brief, Page 6;

“[T]he ultimate arbiter of whether the product is a pet treat, is the pet. The party wishing to challenge that needs to submit evidence going to the heart of the matter. The Examining attorney has submitted no evidence of any acceptable kind.” Applicant’s Brief, Page 9.

The examining attorney takes issue with these attacks on the credibility of the evidence of record. In fact, other than one dictionary excerpt provided by the applicant, the examining attorney is the only party that has provided outside evidence to the record. A review of the record clearly shows that the examining attorney has provided evidentiary support that the goods sold in the packaging shown in the specimen are not “*pet treats*” in the sense of the common usage of that term in the marketplace.

Additionally, the examining attorney has provided a specific discussion as to why the wording on the packaging does not support any common sense connection between the goods for which that packaging is used and the “*pet treats*” recited in the instant application. The examining attorney has also provided a relevant definition of the term “treat” and explained why the packaging does not support use of the mark with goods of

the type that would be considered a “treat” under that definition. Finally, the examining attorney has provided evidence of treatment of the applicant’s goods in the marketplace, and specifically the goods shown in the specimen packaging. That evidence shows that the applicant’s goods have been categorized as “Dental Products,” “Dental Additives,” and “Grooming/Hygiene” products. When a search was conducted of those same websites in the “Pet Treats” departments, not only were the goods named on the applicant’s specimen missing from that department, but there did not appear to be any other goods that were similar in nature, e.g., powder in any form, let alone an “odorless, colorless, tasteless” powder. Therefore, the assertions and arguments made by the examining attorney herein have all been supported by evidence and explanatory discussion, and are not made without basis, as the applicant would have the Board believe. Moreover, the examining attorney has not used anything other than the plain English language meaning throughout this appeal brief, and as supported by the evidence.

As a final consideration to support the examining attorney’s refusal of the specimen for International Class 31, the facts in the instant case are highly similar to those in the recently decided case before the Trademark Trial and Appeal Board, *In re Jakks Pacific, Inc.*, Serial No. 77404047 (TTAB March 14, 2012) [not precedential]. To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the serial number specified. The Trademark Trial and Appeal Board has stated that decisions designated as not precedential are not binding upon the Board but may be cited for whatever persuasive value they might have. TBMP §101.03; TMEP §705.05. In this

non-precedential case, the Board held that the specimen of record therein supported use of the proposed mark, BIONICAM, on “toy microscopes” recited in International Class 28, but not for ordinary “microscopes” recited in International Class 9. The Board looked at the packaging provided by the applicant in that case, and also printouts from various online sources wherein the applicant’s goods were categorized by those retail websites as “Toys.” Based on all of the evidence therein, the Board determined that the goods were toys, and not the more scientific goods that would be “microscopes” in International Class 9. In the *Jakks Pacific* case, the relationship between the goods at issue was much closer than the instant case, and the packaging even mentioned the goods at issue, “microscopes,” in that case. Even so, the Board still held that the packaging was clearly for “toy microscopes,” and could not be used to expand trademark protection for an additional class by reciting those goods in a different way, e.g., “microscopes.” Similarly, in the instant case, the packaging for the applicant’s goods does not support use for “treats” for all the reasons discussed above, and the internet evidence shows that the applicant’s goods would be classified as something other than “pet treats.” Therefore, although the *In re Jakks Pacific, Inc.*, case cannot be used as binding precedent, it does provide very relevant guidance to the case at issue since the facts are so highly similar.

Since the specimen does not show use of the mark for anything other than the *pet dental products* recited in International Class 5, the specimen cannot show use of the mark in commerce as a trademark for the goods in International Class 31. Trademark Act

Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a).

### CONCLUSION

For the foregoing reasons, the specimen of record does not show use of the mark with “*pet treats, pet food and pet beverages,*” recited in International Class 31. Therefore, the examining attorney requests that the Trademark Trial and Appeal Board affirm the refusal to register on the basis of Sections 1 and 45 of the Trademark Act, 15 U.S.C. §1051, 1127.

Respectfully submitted,

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