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OF THE TTAB

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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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Serial No. 85286071

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Darren S. Cahr, Melissa S. Dillenbeck and Nathan A. Pollard of Drinker Biddle & Reath LLP for Johnson & Johnson.

Matthew J. McDowell, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Zervas, Cataldo and Wellington, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Johnson & Johnson ("Applicant") seeks registration on the Principal Register of the mark EARNING TRUST WITH EVERY BOTTLE (in standard character form) for "Facial and skin cleansers; facial and body washes; soaps; shampoos; body lotions" in International Class 3. The application, which was filed on April 5, 2011, was originally based on an asserted bona fide intention to use the mark in commerce. It was approved by the Examining Attorney, published for opposition, and eventually a notice of allowance issued. Applicant then filed a Statement of Use, alleging first use and first use in commerce on September 20, 2012, and the

Examining Attorney issued an Office action in which he found the specimen submitted in support of the Statement of Use to be unacceptable. The Examining Attorney made the refusal to register final pursuant to Sections 1 and 45 of the Trademark Act of 1946, 15 U.S.C. §§ 1051 and 1127, on the ground that applicant failed to submit a specimen showing proper trademark use.

After the refusal was made final, Applicant filed a Request for Reconsideration and an appeal of the Examining Attorney's refusal under Section 1 and 45. The Board remanded the application to the Examining Attorney for consideration of the Request for Reconsideration. After the Examining Attorney denied the Request for Reconsideration, the Board resumed the appeal and both Applicant and the Examining Attorney filed briefs. An oral hearing was held on February 25, 2015.

The sole issue in this appeal is whether the specimen submitted by applicant on October 19, 2012 with its Statement of Use is an acceptable specimen to show use of the mark in connection with the identified goods.

Applicable Law

Section 1 of the Trademark Act establishes that the owner of a trademark used in commerce may apply to register the trademark on the Principal Register by filing a written application and specimens of the mark as it is used in commerce. Section 45 of the Trademark Act states that a mark is deemed to be in use in commerce

> (1) on goods when—
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> (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.

"Section 45 of the Trademark Act does not define the term 'displays associated therewith,' and … the Board must make a case-by-case determination of whether a particular use asserted to be a 'display' is adequate to demonstrate use in commerce." *In re Shipley Co. Inc.*, 230 USPQ 691, 692 (TTAB 1986). It is well established that mere advertising is invalid as a specimen for registration purposes. *See Powermatics, Inc. v. Globe Roofing Products Co., Inc.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965) (mere advertising and documentary use of a notation apart from the goods do not constitute technical trademark use).

Many of the recently reported cases concern webpages as specimens; in this case we have a different type of specimen – a coupon. Applicant states its coupon functions as a point-of-sale display which is provided to the customer at the cash register where he or she is shopping, and that the coupon may be redeemed in the same store.[1] The specimen, submitted by Applicant with its October 19, 2012 Statement of Use, is reproduced below:

[1] Applicant's Brief at 4, 3 TTABVUE 5.

The coupon states that seventy-five cents may be saved "on any JOHNSON'S Baby Wash or Lotion product" and depicts two bottles of the goods, with the mark juxtaposed beside the bottles.

The Trademark Examining Attorney contends that the coupon is not acceptable to show use of the mark in connection with the goods because it is merely advertising material and not a display associated with the goods.

In *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2003 (TTAB 2014), the Board commented on when point of sale displays function as a proper specimen:

> [The Federal Circuit,] [o]ur primary reviewing court has instructed that the Trademark Act "specifies no particular requirements to demonstrate source or origin; for displays, the mark must simply be 'associated' with the goods." [*In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1122 (Fed. Cir. 2009)], citing *In re Marriott*, 459 F.2d 525, 173 USPQ 799 (CCPA 1972). However, the court, in the context of reviewing a Board determination that a webpage specimen did not qualify as a display associated with goods, also stated that a relevant consideration was whether the webpage specimen had "a 'point of sale

> nature.'" *Sones*, 93 USPQ2d at 1124 (citing *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992)). The determination of whether a proffered catalog specimen is merely advertising or serves the function of a display associated with the goods is a question of fact. *In re Shipley Co.*, 230 USPQ 691, 694 (TTAB 1986). A display used in association with the goods is essentially a point-of-sale display designed to catch the attention of purchasers as an inducement to consummate a sale. *Id.* at 694 ("A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location").

Thus, in determining whether the coupon is mere advertising or a point of sale display, we look to whether the coupon has a "point of sale nature," and if it is designed to catch the attention of the purchasers as an inducement to consummate a sale."

Prior decisions have what explored under what circumstances a display is a "point of sale," induced to consummate a sale. In *Lands' End Inc. v. Manback*, 797 F.Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992), the court considered a product offered in a catalogue, and stated that "[a] crucial factor in the analysis is if the use of an alleged mark is at a point of sale location." *Id.* The court noted the following characteristics of the catalogue

> The catalogues display the merchandise that is offered for sale, with descriptions and pictures designed to make a sale to a customer. The pictures and words describing the goods are supplemented by specifications and options from which the customer can choose. These options include the various prices, colors, and sizes of the product. An order form and telephone number is also provided so that a customer can make a decision to purchase an item straight from the identification in the catalogue.

Id.

According to the court, the catalogue functions as a display associated with the goods because upon viewing the picture of the product and corresponding description of the product with the options and ordering information mentioned above, the customer could make a decision to purchase by filling out the sales form and sending it in or by calling in a purchase by phone. The court concluded, "The point of sale nature of this display, when combined with the prominent display of the alleged mark with the product, leads this court to conclude that this mark constitutes a display associated with the goods." *Id.*

In re Anpath Group Inc., 95 USPQ2d 1377 (TTAB 2010), is significant in light of what the Board found lacking in a pamphlet and a flyer submitted as specimens of use. In determining which side of the "'line of demarcation' … [the specimens fall] between mere advertising materials, which have been found unacceptable as specimens showing use of a mark for goods, and point-of-purchase promotional materials which have been found acceptable as a display associated with the goods," *id.* at 1380, the Board considered, "the many characteristics of the *Land's End* catalogue (e.g., detailed descriptions and pictures having trademarks displayed prominently nearby, specifications and options, prices, colors, sizes, a detailed order form, etc.) … ." *Id.* at 1381. In connection with the flyer, the Board noted:

> [A] generous portion of the text is devoted to touting the benefits of these goods. What is missing is a sales form, or ordering information anywhere on the specimen. In point of fact, the potential purchaser has no actual information about the minimum quantities of applicant's goods one may order, how much the goods cost, how one might pay for the products, how the large containers of liquid would be shipped, etc. *MediaShare Corp.*, 43 USPQ2d at 1306-07. Our hypothetical, potential customer, after reviewing applicant's specimen with its limited

> ordering information, is simply not yet at the point of purchase, and would contact applicant to obtain preliminary information necessary to order the goods; it is only after obtaining such information, which is not provided on the specimen, that the purchaser could actually place an order with applicant's sales office.

Id. The Board contrasted the specimen with what a consumer will experience when shopping in a local brick-and-mortar retail store, similar to a grocery or drug store where Applicant's goods are offered for sale:

> Contrast the limited nature of the information available to this prospective customer upon reviewing applicant's specimen with the ordinary consumer walking down the aisle of the local brick-and-mortar retail store. In terms of information and interaction with the product, the in-store consumer has probably been able to do some product comparisons, has handled the goods, had the opportunity to learn the details from packaging, labeling and/or a shelf-talker, before asking questions of the clerk at the checkout register.

Id. The Board considered more than just the fact that the product was available on a shelf in the store, and considered the interaction of the customer with the cashier.

In *In re Shipley Co*., 230 USPQ at 694, the Board reversed a refusal to accept a specimen consisting of a photograph of a booth in a technical trade show. A declaration filed in support of the specimen stated that "sales personnel are at the booth at all times during the show promoting and selling Shipley's products, and though products are not always in close proximity to the booth, point of sale materials such as product literature, banners, displays, etc., are at the booths and … the display of the identified trademark at the booth is intended to catch the attention of purchasers and prospective purchasers as an inducement to consummate the sale of chemicals for use in the fabrication of printed circuit

boards." *Id.* at 692. The Board considered the actual sales conditions presented by the booths:

> The … declaration, when fairly read, establishes that applicant's trade show booths are more than sites for the distribution of advertising literature; these booths are also sales counters for applicant's products, including the chemicals for use in fabrication of printed circuit boards. Applicant made of record, at the request of the Examining Attorney, samples of its product literature. … A purchaser, upon seeing such 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, we think, associate the mark that is prominently displayed on that booth with such goods. Thus, we find applicant's mark, as shown in the photographs submitted as specimens, is used on a display associated with the goods.

Id. at 693-94.

Turning now to Applicant's arguments, Applicant maintains that its coupon "can only be used at the point-of-sale" and "is designed to act as a direct inducement to make a sale … it serves no other purpose."[2] Applicant explains the purchasing process for the corresponding goods using a coupon:

> Applicant's point-of-sale coupon is associated directly with the goods offered for sale. The specimens at issue are coupons available at the store itself, generated and provided to the customer at the cash register. Any argument that the specimen coupons are not available at the point-of-sale is negated by the fact that the coupons are actually provided to the consumer in the very store in which they can be redeemed – at the point-of-sale. One could feasibly receive the coupon after purchase and immediate step back into the store and purchase the product discounted by the coupon. And the coupon is designed to be used as part of the purchasing process itself – it is the instrument through which a purchase is induced. It is difficult to imagine a more direct connection to the purchasing process than a point-of-sale coupon.[3]

[2] Applicant's Brief at 2, 3 TTABVUE 3.
[3] Applicant's Brief at 4, 3 TTABVUE 5.

Indeed, the coupon includes an image of Applicant's goods and shows the applied-for mark next to such goods. The coupon also identifies the retailer where the goods can be purchased and is dispensed to the customer in the very store where the goods are located and offered for sale. Similar to the sales personnel at the booth in *Shipley*, the cashier or other store personnel is directly available in the event there are questions regarding pricing or product quantities or location in the store, as these details are not identified on the coupon. In fact, it is the *cashier* who hands the coupon to the customer, and the *cashier*, by presenting the coupon to the customer, begins the association the mark with the goods.[4] Thus, the information found lacking in the *Anpath* specimen and which is not evident from the coupon, is readily obtainable by the customer in the present case because the customer is in the very store where the goods are sold with personnel who can assist the customer with any questions due to the limited information on the coupon (such as pricing). Certainly, if the customer is enticed by the product and the amount of the discount noted on the coupon, he or she may turn around and pick up the product for which the coupon is intended and return to the cashier with the product and make the purchase.

The Examining Attorney points out that prior to the customer being handed the coupon, the goods reflected on the coupon were not in the customer's grocery cart, and when the customer is handed the coupon, he or she has purchased other goods and is ready to depart from the store. Although the Examining Attorney disagrees,

[4] It appears from the specimens that the mark is not being used on the applied-for goods, but is intended to promote customer affiliation with such goods.

Applicant maintains that even in these circumstances, there are customers who, when presented with the coupon, will examine the coupon and go back to the shelves of the store, pick up the product featured in the coupon and proceed to purchase the product. We have no reason to dispute Applicant's representation as to the purchasing habits of customers who are presented with coupons at checkout.

A temporal separation exists between the receipt of the coupon (where the mark appears) from the cashier and the completion of the purchase of the goods in the store, in the point-of-sale scenario described by Applicant. In *In re Hydron*, 51 USPQ2d 1531 (TTAB 1999), the Board discussed the temporal separation between when the mark appeared in a half-hour infomercial and when the instructions for ordering the involved goods later appeared in the infomercial. Over two minutes passed between the presentation of the mark in connection with the goods and the instructions for ordering the goods. The Board did not find that the separation in time extinguished the point-of-sale characteristics of the specimen but stated, "[t]he information on how to order the goods is also given within a reasonable time of when the mark and the goods are shown." *Id*. at 1534. The Board added, "[t]hat the ordering information is not shown in direct proximity to when the mark and the goods are shown does not detract from the fact that sequentially depicting the mark and the goods creates an association between the two in the mind of a person watching the video." In the present case, the coupon depicts the mark with the goods, and the goods may be purchased in the same location where the purchaser is when presented with the coupon. The temporal separation between the customer

receiving the coupon and then perceiving the mark on the coupon, and the purchase of the corresponding goods reflected on the coupon, does not preclude the use of the coupon presented in the store as a display associated with the goods. Thus, in the same sense that an infomercial functions as a point-of-purchase display in *Hydron*, the coupon presented to the customer in the very store where the goods are located depicting the mark next to a representation of the goods, albeit at a time when the purchaser has purchased other goods, functions as a point-of-purchase display.[5]

In our view, the customer will associate the mark with the goods once presented with the coupon that contains the mark and a depiction of the goods by the cashier, in the very store in which the goods are offered for sale. Because the coupon is dispensed when the customer is in the store, and prior to his or her departure from the store, the coupon is intended to consummate a sale.

Decision: The refusal to register Applicant's mark under Sections 1 and 45 of the Trademark Act is reversed.

[5] In addition, the purchasing process presented by Applicant's coupon is not too dissimilar from that involving a catalog, such as the *Land's End* catalog, where the catalog is received in the mail and at some later time, picked up and reviewed, resulting in a sale.