This Opinion is Not a Precedent of the TTAB

Mailed: June 4, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Wholesale & Retail Distribution, Inc.

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Serial No. 86586432

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Barry L. Haley and Kristina M. Dimaggio of Malin Haley Dimaggio & Bowen, P.A., for Wholesale & Retail Distribution, Inc.

Toby E. Bulloff, Trademark Examining Attorney, Law Office 119, J. Brett Golden, Managing Attorney.

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Before Lykos, Adlin and Coggins, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Wholesale & Retail Distribution, Inc. ("Applicant") seeks to register on the Principal Register the mark OXZGEN in standard characters for goods ultimately identified as "[n]on-metal dosing caps for bottles; non-metal dispensing caps for containers" in International Class 20.[1] Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark under Trademark Act

[1] Application Serial No. 86586432, filed April 3, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant's specimens fail to show the applied-for mark in use in commerce in connection with any of the goods specified in the statement of use.

By way of background, Applicant originally applied to register its mark for two classes of goods: the International Class 20 goods identified above and "non-alcoholic beverages, namely, sports drinks; energy drinks; isotonic drinks; hypertonic drinks; and hypotonic drinks" in International Class 32. In the initial Office Action dated July 13, 2015, the Examining Attorney refused registration of the mark for the International Class 32 goods under Trademark Act Sections 2(e)(1), 15 U.S.C. § 1052(e)(1) and 2(a), 15 U.S.C. § 1052(a). In response, Applicant deleted the International Class 32 goods from the application, thereby rendering the refusals moot. The application was then approved for publication solely for the goods listed in International Class 20. Following issuance of a notice of allowance, on September 1, 2016, Applicant submitted a statement of use and two specimens for International Class 20 described as "product[s] displaying the mark." The specimens are reprinted below:


RELAX
OXYGEN
.COM
65ml/2.2Fl oz

The Examining Attorney found both specimens unacceptable on the ground that they did not show use of Applicant's mark in connection with the goods because "the mark appears on the bottles but not the caps themselves; nor is the mark shown with caps sold separately as stand-alone goods." October 19, 2016 Office Action at 1. Applicant was given the opportunity to submit a "verified substitute specimen" but instead argued against the refusal:

> Applicant's specimen is a picture of the mark OXZGEN on the bottle/container which is used in connection with its non-metal dosing/dispensing caps. Here, the mark is shown in use in commerce because it is prominently featured on normal commercial packaging for Applicant's goods. *See* TMEP Section 904.03(c). In this case, the mark shown on the bottle/container is normal packaging for Applicant's dosing caps which dispense liquid into the container. Such is the normal "mode of use" for Applicant's "non-metal dosing caps for bottles, non-metal dispensing caps for containers." Moreover, the mark on the container also functions as a label or tag since it would be impractical to put the mark on the actual dispensing cap.

April 19, 2017 Response to Office Action. Unconvinced, the Examining Attorney issued a final refusal:

> [T]he applied-for mark looks to be the brand of the beverage (deleted from the Statement of Use), offering different flavors under its subbrands of "RELAX" and "ENERGY." There is nothing directing consumers to a special kind of cap or dosing mechanism under any name. In fact, as shown, the cap looks like any other basic beverage cap and a consumer would not perceive this to be a special feature of the bottle or an item sold on its own for use with other kinds of bottles or containers.

May 11, 2017 Final Office Action at 1. Applicant then filed a notice of appeal, which is now briefed.

On appeal, Applicant reiterates the arguments made during prosecution, adding that the "non-metal caps are sold together with the bottles for beverages;" that "[t]he dispensing caps are attached to the bottles in order to serve the purpose of dispensing the liquid or powder into the beverage;" and that "it is practical to place the mark on the bottle instead of the cap itself because consumers can readily see the trademark in large capital letters on the container/packaging." Brief, pp. 2-3; 4 TTABVUE 6-7.

After careful consideration of Applicant's specimens and Applicant's reasons why the mark cannot be affixed to the goods, we agree with the Examining Attorney that the specimens fail to show use of OXZGEN as a trademark for any of the goods identified in the statement of use.

A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods specified in the statement of use. Trademark Act §§ 1 and 45, 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.56(a), 2.88(b)(2). Section 1(d)(1) of the Trademark Act, 15 U.S.C. § 1051(d)(1), requires that the applicant file a "specimen" or facsimile "of the mark as used in commerce." Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a), amplifies that an applicant filing an intent-to-use application must file "one specimen . . . showing the mark as used in commerce on or in connection with the goods or services." Section 45 of the Trademark Act, 15 U.S.C. § 1127, 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
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> (B) the goods are sold or transported in commerce.

Consistent therewith, the Office may accept another document related to the goods or their sale when it is impracticable to place the mark on the goods, packaging for the goods, or associated displays. Trademark Rules 2.56(b)(1) and (2), 37 C.F.R. §§ 2.56(b)(1) and (2). *See also In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) ("the test for an acceptable … specimen, is simply that it must in some way

evince that the mark is 'associated' with the goods and serves as an indicator of source"). In interpreting the meaning of impracticability as set forth in the statute, Section 904.03(k) of the TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") makes clear that an applicant's mere assertion of impracticability does not suffice; rather, the record must indicate that the goods are, in fact, of such a nature that affixation of the mark in the typical manner is not possible:

> The USPTO 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, or displays associated with the goods. … This provision is not intended as a general alternative to submitting labels, tags, containers, or displays associated with the goods; it applies only to situations when the nature of the goods makes use on these items impracticable. For example, in rare circumstances it may be impracticable to place the mark on the goods or packaging for the goods if the goods are natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars. In such instances, an acceptable specimen might be an invoice, a bill of lading, or a shipping document that shows the mark for the goods.

Applicant's Class 20 goods are in no way analogous to "natural gas, grain that is sold in bulk, or chemicals that are transported only in tanker cars." *Id.* We agree with the Examining Attorney that Applicant's applied-for mark as displayed on both specimens is being used as a trademark to identify the International Class 32 beverages deleted from the application, not the "[n]on-metal dosing caps for bottles; non-metal dispensing caps for containers" in International Class 20 identified in the statement of use. The dosing and dispensing caps are an integral component of the bottles in which the beverages are sold, and as Applicant has confirmed, the caps are

not sold separately. In other words, consumers are purchasing Applicant's beverages, not the dispensing and dosing caps.

In sum, Applicant's specimens on their face fail to show use in commerce of the mark OXZGEN for any of the goods identified in the statement of use.

Decision: The refusal to register is affirmed.