

<p>This Opinion is Not a Precedent of the TTAB</p>

Hearing: July 11, 2018

Mailed: July 18, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Midwestern Pet Foods, Inc.

Serial No. 86702878

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LLP for Midwestern Pet Foods, Inc.

Aaron Rosenthal,¹ Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Taylor, Lykos and Hightower,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Midwestern Pet Foods, Inc. (“Applicant”) seeks to register on the Principal
Register the mark EARTHBORED REBORN in standard characters for “pet food” in
International Class 31.² Applicant has appealed the Trademark Examining

¹ Mr. Rosenthal is the author of the Office’s appeal brief and represented the Office at the oral hearing held on July 11, 2018. The prosecution of this application was handled by Trademark Examining Attorney Nicole Nguyen of Law Office 107.

² Application Serial No. 86702878, filed July 23, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Attorney's final refusal to register the mark under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127, on the following two grounds: (1) that the mark in the drawing is not a substantially exact representation of the mark as used on either the original or substitute specimen, and (2) that Applicant's original specimen and substitute specimen each fail to show the applied-for mark used in connection with the identified goods.

I. Background

Before discussing the merits of the appeal, a summary of the prosecution history is in order. The involved application was originally filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use in commerce. After publication in the *Official Gazette* and issuance of a notice of allowance, on August 22, 2016, Applicant submitted a Statement of Use accompanied by the following specimen, consisting of a "[s]creenshot of Applicant's website featuring the mark used in direct connection with the goods included in International Class 31 outlined in the Application."³

³ During oral argument, counsel for Applicant informed the Board that the screenshot was an incomplete depiction of Applicant's website and requested that the Board take judicial notice of the entirety of Applicant's website. The Board denied Applicant's request, explaining that Board practice does not include taking judicial notice of business-to-consumer e-commerce websites. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1208.04 (June 2018) and cases cited therein. In general, the taking of judicial notice is reserved for reference materials such as dictionary definitions, encyclopedia entries, and census data. See *id.* The Board added that once an appeal has been filed, the proper way to seek to add evidence to the record is to file a written request with the Board to suspend the appeal and remand the application for further examination. See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); see also TBMP § 1207.02 and cases cited therein. The Board's denial at the hearing prompted Applicant's attorney to request during rebuttal that the application be remanded in order to make the evidence of record. The Board denied this request as improper insofar as it was not in writing. In any event, even if Applicant formally filed a request for remand, the Board would have denied the request for lack of good cause



The Trademark Examining Attorney refused registration on grounds that the mark in the drawing is not a substantially exact representation of the mark as used on the specimen, and that the specimen fails to show the applied-for mark used in connection with the identified goods. In explaining why the drawing was not a substantially exact representation of the mark on the specimen, the Examining Attorney observed:

[T]he drawing displays the mark as “EARTHBORN REBORN”. However, the specimen displays the mark as “EARTHBORN HOLISTIC” inside of a circular design with the wording “REBORN” below, and overlapping with the

given the late stage in the appeal process and the fact that the evidence was previously available. *See, e.g., In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (request for remand denied for failure to show good cause so late in the appeal); *In re Central Sprinkler Co.*, 49 USPQ 1194, 1195 n.2 (TTAB 1998) (request for remand to make third-party registrations of record denied because such evidence was previously available).

circle; in addition, there appears to be further wording above “REBORN” that is not legible in the screenshot.

September 15, 2016 Office Action. The Examining Attorney advised Applicant that amending the mark in the drawing to conform to the mark on the specimen would be a material alteration and would not be accepted, because the difference between the mark in the specimen and the drawing is significant and each mark creates a different commercial impression. As to the second ground for refusal, that the specimen does not show the applied-for mark in use in commerce in connection with the goods, the Examining Attorney pointed out that the identified goods consist of “pet food,” and that “the specimen shows a box for recycling; there is no reference to pet food in the specimen.” *Id.* The Examining Attorney also advised Applicant of the types of specimens that would be acceptable:

Examples of specimens for goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. *See* TMEP §§ 904.03 et seq. Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. TMEP § 904.03(i).

Id.

On March 15, 2017, Applicant responded to the refusal, essentially arguing that the presentation of the terms EARTHBORN and REBORN in relatively larger size font is such that they constitute a substantially exact representation of the mark depicted on the drawing page, and that the use of the mark on a recycling container constitutes an acceptable point-of-sale display as ancillary services to the goods. Unconvinced, the Examining Attorney issued a final refusal on May 1, 2017.

In an effort to traverse the final refusal, on November 1, 2017 Applicant filed a Request for Reconsideration and submitted the following substitute specimen consisting of an advertisement, which as Applicant describes “contains an image of Applicant’s recycling bin, which features the prominent wording “EARTHORN REBORN,” abutting images of Applicant’s pet food (contained in bags).”

Bettering the
ENVIRONMENT
for the Future

100% Recyclable Packaging
Through our Earthborn ReBorn™ recycling program and TerraCycle® our bags are now 100% recyclable!

Trees Planted Worldwide
Purchase Earthborn Holistic® products & send in your UPC codes to plant trees in areas affected by deforestation all around the world.

UPCs FOR TREES

Earthborn Holistic

Holistic Food For Pets

- Grain & Gluten-Free Formulas
- Dry & Moist Pet Foods, Dry & Semi-Moist Dog Treats
- Wholesome, Antioxidant-Rich Vegetables and Fruits in Every Bite
- 4th Generation, Family-Owned Company
- Dry Pet Food Made in the USA

earthbornholisticpetfood.com

The advertisement features a Weimaraner dog looking up at a tree. A recycling bin with the Earthborn ReBorn logo is visible. Various Earthborn Holistic pet food products are shown at the bottom. The text promotes environmental benefits like 100% recyclable packaging and trees planted worldwide through the UPCs for Trees program.

Applicant also submitted the declaration of Warren Hill, Applicant's Chief Commercial Officer (hereinafter referred to as the "Hill Declaration"), stating in pertinent part:

3. Applicant's EARTHBORN REBORN program allows purchasers of Applicant's pet food to recycle their used/empty pet food bags by depositing the bags in our EARTHBORN REBORN bins at participating retail locations.
4. The substitute specimen features an image of Applicant's recycling bin with the mark EARTHBORN REBORN appearing next to the images of Applicant's pet food (contained in bags). Above these images, the collateral includes, in part, the statement: "Through our EARTHBORN REBORN recycling program and TerraCycle®, our bags are now 100% recyclable!" The EARTHBORN REBORN mark is thus being used in clear association with Applicant's pet food, offering an environmentally-friendly way to recycle the packaging of the same pet food.
5. Applicant's bins and any associated recycling services are ancillary to our pet food and are used to promote the sale of such pet food. Consequently, our EARTHBORN REBORN mark is ultimately recognized by consumers as a source identifier for our pet food. Indeed, our consumers readily understand that Applicant does not offer recycling services for sale, but instead offers pet food that is offered for sale in recyclable packaging.
6. Furthermore, our recycling bins featuring the EARTHBORN REBORN mark are located in the same retail locations where our pet food is sold, thus encouraging our customers to buy our pet food and recycle our bags. The recycling bins therefore effectively operate as point-of-sale displays that serve to further strengthen our customers' association of the EARTHBORN REBORN mark with our pet food.

November 1, 2017 Request for Reconsideration. The Examining Attorney denied the Request for Reconsideration on November 20, 2017, reiterating the same reasons

above for refusal, but also adding that to the extent that Applicant submits the advertisement constitutes a point-of-sale display, the substitute specimen is not acceptable:

[T]he use of the mark on a recycling container fails to be an acceptable point-of-sale display in that the display is not so related to the sale of the goods that such an association between the two is inevitable. TMEP § 904.03(g). In this case, applicant has not shown the recycling display in the sales environment, so it cannot be determined whether it properly functions as a point-of-sale display. While applicant argues that the displays are placed in the same retail locations where applicant's pet food is sold, this is unpersuasive in demonstrating that the specimen shows an acceptable point of sale display.

The application was then returned to the Board for resumption of the appeal.⁴

II. Whether the mark as it appears in the specimens is a substantially exact representation of the mark in the drawing?

We direct our attention to the first ground for refusal. The “drawing depicts the mark sought to be registered.” Trademark Rule 2.52, 37 C.F.R. § 2.52. As such,

[i]n an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

Trademark Rule 2.51(b), 37 C.F.R. § 2.51(b). Case law interpretation of this rule

⁴ In arguing against the refusal, Applicant in its appeal brief focused on the substitute specimen. However, in response to questioning at oral argument, counsel for Applicant requested that the Board consider both the original and substitute specimen. Thus, in order to render a complete opinion, we have considered both specimens.

provides that “[a]n applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression.” *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1316 (TTAB 2011) (citing *In re 1175854 Ontario Ltd.*, 81 USPQ2d 1446 (TTAB 2006)). In other words, “the mark as actually used must not be so entwined (physically or conceptually) with other material that it is not separable from it in the mind of the consumer.” *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1123 (TTAB 2008) (quoting *In re Chem. Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988)).

In this appeal, the mark as displayed in the drawing is comprised solely of two words, EARTHBORN REBORN (standard characters) in that order with no design elements. At oral argument, the Examining Attorney conceded that the applied-for mark was a substantially exact representation of the mark as depicted on the substitute specimen within the phrase “Through our EARTHBORN REBORN™ recycling program and TerraCycle®, our bags are now 100% recyclable!” We agree that this wording in the substitute specimen is a substantially exact representation of the drawing.

However, as to the original specimen, the Examining Attorney adheres to the refusal, arguing that

... the mark appearing on the recycling bin in the specimen does not match the drawing, because the additional wording between the terms “EARTHBORN” and “REBORN” creates a different commercial impression—in particular, the impression on the specimen is of “EARTHBORN HOLISTIC” as one phrase, with “REBORN” as a totally separate phrase. There is a significant physical separation between the terms

“EARTH BORN” and “REBORN”, such that they cannot be viewed as a single mark, or as a substantially exact representation of the mark in the drawing.

10 TTABVue 5. Applicant in turn asserts that because the terms EARTH BORN and REBORN, while not next to each other, are displayed in a font size far greater than the remaining wording, the consumer’s attention is immediately drawn to both of these terms, thereby presenting a separate and distinct commercial impression.

We find that the drawing of the mark is not a substantially exact representation of the mark as it appears on the original specimen of use because as actually used, prospective consumers will not perceive the terms EARTH BORN REBORN as separable from the remaining literal and design elements. On the original specimen the word immediately after EARTH BORN is not REBORN as depicted in the drawing but is instead the word HOLISTIC. “EARTH BORN HOLISTIC” is displayed inside of a circular design above, not congruent with, the word REBORN. “EARTH BORN HOLISTIC” also appears as the tail end of the phrase LOVE YOUR PET, LOVE YOUR PLANT. Thus, the word EARTH BORN is “entwined” both physically and conceptually with the word HOLISTIC. *See In re Yale Sportswear Corp.*, 88 USPQ2d at 1123. For these reasons, the terms EARTH BORN and REBORN as used on the specimens do not engender a separate commercial impression apart from the remaining elements. The fact that the words EARTH BORN and REBORN appear in larger size lettering fails to mitigate these deficiencies. We therefore find that with regard to the original specimen of record, Applicant’s drawing of the mark is not a substantially exact representation of the mark as used in commerce.

III. Whether the original specimen and substitute specimen each fail to show the applied-for mark used in connection with the identified goods?

Turning now to the second ground for refusal, 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.” *See also* Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a) (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.”). A mark is in use in commerce on goods when:

(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, ...

Trademark Act Section 45, 15 U.S.C. § 1127. Insofar as this appeal does not present an example of use on the goods or on their containers, tags, or labels, the issue before us with whether the original or substitute specimen constitutes a display associated with the goods. Displays associated with the goods, including online displays, must be “point of sale” displays. *Lands’ End Inc. v. Manback*, 797 F. Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992) (“A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location. A point of sale location provides a customer with the opportunity to look to the displayed mark as a means of identifying and distinguishing the source of goods.”); *see also In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1122 (Fed. Cir. 2009) (quoting *In re Osterberg*, 83 USPQ2d 1220, 1222-23 (TTAB

2007) (“In [*Lands’ End*], the determinative factor was that the mark was used at the point of sale.”)). The Board has held:

[T]o be more than mere advertising, a point-of-sale display associated with the goods must do more than simply promote the goods and induce a person to buy them; that is the purpose of advertising in general. The specimen must be “calculated to consummate a sale.”

In re U.S. Tsubaki, Inc., 109 USPQ2d 2002, 2009 (TTAB 2014) (quoting *In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979)). The determination of whether the proffered specimen is merely advertising or serves the function of a display associated with the goods is a question of fact. *In re U.S. Tsubaki, Inc.*, 109 USPQ2d at 2003 (citing *In re Shipley Co.*, 230 USPQ 691, 694 (TTAB 1986)). “Factually, we need to ask whether the purported point-of-sale display provides the potential purchaser with the information normally associated with ordering products of that kind.” *In re Anpath Group Inc.*, 95 USPQ2d 1377, 1381 (TTAB 2010). The display should provide a “level of information ... capable of allowing a consumer to consummate a physical order ...” *Id.* at 1382. Acceptable print display specimens are point-of-sale materials such as banners, shelf-talkers (a printed card or sign affixed to a store shelf to call a buyer’s attention to a particular product displayed on that shelf), and window displays, which are designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. TMEP § 904.03(g); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d at 2003 (citing *In re Shipley Co.*, 230 USPQ at 694). Brochures and other advertising material may be acceptable specimens as print displays only if sufficient evidence, such as a photograph of a trade show booth, is provided showing how such specimens are used in an actual display featuring the

goods and the print advertising material together. *See In re Ancha Elecs., Inc.*, 1 USPQ2d 1318, 1319-20 (TTAB 1986); TMEP § 904.03(g). Otherwise, such materials are generally considered mere advertising and are not acceptable as specimens for showing use in commerce for goods, as in the present case. *See In re Kohr Bros.*, 121 USPQ2d 1793, 1794 (TTAB 2017) (quoting *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1379 (TTAB 2010)); TMEP § 904.04(b).

At oral argument, Applicant urged the Board to consider the original specimen as an acceptable display associated with the goods. As noted above, Applicant's original specimen consists of an excerpt from Applicant's website. Applicant contended that the "Learn More" and "Find a Dealer" tabs provided a means of ordering Applicant's pet food. A web page that displays a product can constitute a "display associated with the goods" if it: (1) contains a picture or textual description of the identified goods; (2) shows the mark in association with the goods; and (3) provides a means for ordering the identified goods. *See In re Sones*, 93 USPQ2d at 1123; *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012); *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); *Lands' End*, 24 USPQ2d at 1316; *see also* TMEP § 904.03(i). The mark must also be displayed on the web page in a manner in which customers will recognize it as a mark. *See In re Morganroth*, 208 USPQ 284, 287-88 (TTAB 1980); *In re Osterberg*, 83 USPQ2d at 1223 (finding that CONDOMTOY CONDOM was not displayed so prominently on web page specimen that consumers would recognize it as a trademark for condoms). Based on the record before us, we cannot conclude that Applicant's web page excerpt meets these requirements. In other words, the web page does not contain

a picture or textual description of pet food; it does not show the mark EARTHBORN REBORN in association with pet food; and it does not provide a recognizable means for the consumer to order pet food. The only product displayed on the specimen is a recycling bin. For these reasons, the original specimen of use fails to qualify as a point of sale display associated with the goods.

Having determined that Applicant's original specimen does not constitute a display associated with the goods, we now consider whether the substitute specimen meets this standard. In its brief, Applicant refers to the substitute specimen as a flyer. Applicant maintains that the flyer clearly shows Applicant's EARTHBORN REBORN mark in use in connection with the promotion and sale of Applicant's pet food thereby qualifying as a point of sale display. Relying primarily on the Hill Declaration, Applicant argues that the flyers are located in the same retail stores where Applicant's pet food is sold under the mark EARTHBORN HOLISTIC; that they are distributed to consumers with the purchase of Applicant's EARTHBORN HOLISTIC pet food; and that the flyers are designed to appeal to eco-minded consumers and foster brand loyalty by encouraging consumers to purchase Applicant's EARTHBORN HOLISTIC pet food sold in recyclable bags. In Applicant's view, consumers understand that Applicant does not offer recycling services but rather pet food sold in recyclable packaging, and that any associated recycling services are ancillary to the Applicant's EARTHBORN HOLISTIC branded pet food.

Of course, as Applicant points out, an advertising flyer can constitute a point of sale display. However, in this particular instance, it does not. Applicant has failed to

provide sufficient evidence showing a direct connection between its applied-for mark EARTHBORN REBORN with pet food. As shown on the specimen, EARTHBORN REBORN functions as a source identifier for a recycling program, not pet food: “Through our EARTHBORN REBORN recycling program and TerraCycle®, our bags are now 100% recyclable!” In the absence of photographic evidence, or a more detailed explanation in affidavit or declaration form of how the flyer is used in conjunction with the marketing and sale of Applicant’s pet food in retail locations, the Hill Declaration, standing alone, fails to show how Applicant’s advertising flyer constitutes a point of sale display featuring pet food under the proposed mark. Without further information, we cannot conclude that the specimen is “calculated” to induce a sale of pet food. *See In re U.S. Tsubaki, Inc.*, 109 USPQ2d at 2009. As the Examining Attorney points out in his brief, the substitute specimen shows EARTHBORN HOLISTIC, not EARTHBORN REBORN, as a source indicator for pet food. All the record evidence points to Applicant offering a recycling program service, not pet food, under the applied-for mark. For the foregoing reasons, Applicant’s substitute specimen fails to show the applied-for mark used in connection with the identified goods.

Decision: The refusal to register the original specimen of record on the ground that the drawing of the mark is not a substantially exact representation of the mark as used in commerce is affirmed; this refusal however is reversed as to the substitute specimen.

The refusal to register is affirmed on the ground that Applicant's original and substitute specimen fails to show the applied-for mark used in connection with the identified goods.