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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ther-A-Pedic Associates, Inc.

Serial No. 86983542

Joseph Agostino of Greenberg Traurig, LLP,
for Ther-A-Pedic Associates, Inc.

David I, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

Before Mermelstein, Wolfson, and Lynch,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

I. Background

Ther-A-Pedic Associates, Inc. ("Applicant") seeks registration on the Principal Register of the standard character mark THERAFIT for goods ultimately amended to:

"Bed sheets" in International Class 24.[1]

Applicant initially based the application on its allegation of a bona fide intent to use the mark in commerce on "Fitted fabric furniture covers; fitted furniture covers not of fabric" in International Class 20 and "Mattress pads and bed sheets" in International Class 24. After the notice of allowance issued, Applicant filed a Request to Divide the application to specify that the mark was in use on "bed sheets" in Class 24, but that "fitted fabric furniture covers; fitted furniture covers not of fabric" in Class 20 and "mattress pads" in Class 24 "remained under Section 1(b)."[2]

Applicant filed a Statement of Use and submitted a specimen depicting the mark as used in connection with "bed sheets" for Class 24. Applicant described the specimen as "packaging containing Applicant's goods."[3] The specimen, below, shows the mark in the middle of the packaging, referring to the mark in the phrase "with THERAFIT technology":

[1] Application Serial No. 86983542 was filed February 17, 2016, based on Applicant's assertion of a bona fide intent to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

[2] The application was divided on January 24, 2018. The child application, Serial No. 86910278, was abandoned on August 26, 2019 for failure to file a timely statement of use or extension request.

[3] 4 TTABVUE 5.

The Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the specimen does not show Applicant's mark in use in connection with the goods specified in the statement of use.[4] The Examining Attorney explained that "the mark is used to describe a technology that is featured in the sheets not for the sheets themselves."[5] Applicant responded that the mark "clearly refers to the finished bed sheets

[4] March 2, 2018 Office Action at 1.

[5] *Id.*

themselves, and not solely to any components that can be disassociated with the sheets or components that are sold separately from the sheets."[6]

Applicant appealed, and the appeal is fully briefed. We affirm.

II. Applicable Law

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a trademark is used in commerce when "it is placed in any manner on the goods or their containers or the displays associated therewith ...." *See also* Trademark Rule 2.56(b)(2), 37 C.F.R. § 2.56(b)(1). "An application initially based on Trademark Act Section 1(b) must, upon the filing of ... a statement of use under Section 1(d), include one specimen showing the applied-for mark in use in commerce, on or in connection with those goods or services identified in the application...." *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d 1056, 1062 (TTAB 2016). Applicant submitted a photograph of a package for the goods as a specimen of use, and the Examining Attorney does not dispute that a package may be an appropriate specimen under Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1) ("A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods.").[7]

The Examining Attorney bases the refusal to register on the manner in which the THERAFIT mark is used on the package, framing the issue on appeal as a failure to show use of the mark in commerce. To make this determination, we look to the

[6] August 8, 2008 Response at 3.

[7] The Examining Attorney "is not objecting to the nature of the specimen, which very clearly shows product packaging for a cotton sateen sheet set." 6 TTABVUE 6.

specimens or other evidence of record[8] showing whether the proposed mark is directly associated with the identified goods and serves as an indicator of source. A specimen "must in some way evince that the mark is 'associated' with the goods and serves as an indicator of source." *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009); *see also In re Universal Oil Prods. Co.,* 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) (term must have "direct association" with applied-for services); *In re Safariland Hunting Corp.,* 24 USPQ2d 1380, 1381 (TTAB 1992) (specimen must show "direct association" with goods). "The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public." *In re Eagle Crest Inc.,* 96 USPQ2d 1227, 1229 (TTAB 2010) (citations omitted); *see also In re Aerospace Optics, Inc.,* 78 USPQ2d 1861, 1862 (TTAB 2006) ("The mere fact that a designation appears on the specimen of record does not make it a trademark…. A critical element in determining whether matter sought to be registered as a trademark is the impression the matter makes on the relevant public."). In order for Applicant's mark to function as a trademark for Applicant's goods, Applicant's mark must be associated with the goods and signify to purchasers the source of the goods sold or offered for sale.

[8] Applicant submitted a copy of pages from its website for the first time with its brief. The record in an application should be complete prior to the filing of an appeal. Accordingly, we sustain the Examining Attorney's objection to the evidence and exclude it as untimely. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d).

III. Analysis of Specimen Refusal

The Examining Attorney argues that the mark as used on Applicant's specimen identifies "a particular technology that is featured on or in the manufacturing of the sheets and not for the sheets themselves."[9] The Examining Attorney notes that the mark appears between the words "with" and "technology," thereby creating the impression that the mark describes a feature or component of the goods, and not the goods themselves.

Applicant, on the other hand, argues that consumers would view the mark as identifying finished bed sheets that include "extra-wide jacquard elastic" that is built into the sheets.

The specimen shows the wording: "THERAPEDIC 450 THREAD COUNT 100% COTTON SATEEN SHEET SET WITH THERAFIT TECHNOLOGY." We find that the relative size and placement of the wording gives the impression that the THERAPEDIC mark, which appears with the registration symbol, identifies the sheet set as a whole. By contrast, the relatively smaller size and placement of the proposed mark contribute to it being perceived as identifying the elastic feature of the sheets, rather than the sheets themselves. This impression is furthered by the design element shown with the FIT portion of the proposed mark, 

, which is suggestive of the elasticized corners of fitted sheets. Although Applicant is correct

[9] 6 TTABVUE 5.

that because the elastic cannot be "disassociated"[10] from the fitted sheets, the goods belong in Class 24 (the class of the finished product[11]), that does not compel the conclusion that the mark identifies the finished product and not the elastic "technology." Classification is assigned according to the goods as identified in the application, and is not indicative of whether the specimen shows use of the designation as a trademark for the identified goods. Use of the mark within the phrase "with THERAFIT technology" supports a finding that consumers who encounter the mark will perceive it as referring to the elastic feature of the bed sheets, and not the finished bed sheets themselves. The mark will be perceived as identifying the elastic component of the bed sheets and not the overall finished sheets without regard to any of their particular features.

IV. Conclusion

Applicant's specimen does not demonstrate use of the mark in a manner that creates in the minds of potential consumers a direct association between the mark and the identified goods. That is, consumers viewing the proposed mark in the specimen will not directly associate the proposed mark with the involved goods such that it would indicate the source of the goods.

Decision: The refusal to register Applicant's mark THERAFIT is affirmed.

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[10] 4 TTABVUE 6.

[11] *See* TMEP § 1402.05(a) ("Components or ingredients sold as part of a finished product are classified in the class of the finished product, since the components or ingredients have been incorporated into other finished goods.").