

This Opinion Is Not a
Precedent of the TTAB

Mailed: March 18, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Mansell

Serial No. 87220151

Jerry C. Harris, Jr. of Wick Phillips Gould & Martin, LLP
for John Mansell.

Esther A. Belenker, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Taylor, Lynch, and English
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

John Mansell (“Applicant”) seeks registration on the Principal Register of the mark 20/20 IN 2020 in standard characters¹ for “Advertising, marketing and

¹ Application Serial No. 87220151 was filed October 29, 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).

promotion services in the field of ophthalmology; Advertising, marketing and promotion services in the field of optometry” in International Class 35.

Applicant initially based the application on his allegation of a bona fide intent to use the mark in commerce. After the notice of allowance issued, Applicant filed a statement of use with the following specimen described as “Digital photographs of the mark being used to advertise ophthalmology and optometry related services in a physician’s waiting room.”²



² July 24, 2017 Statement of Use at 2-3.



The Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant's specimen appeared to be an advertisement for his own goods or services, and therefore is not a registrable service for the benefit of others, and on the ground that the specimen "appears to consist of a digitally altered image or a mock-up ... for future use in commerce."³ The Examining Attorney also required information about the specimen and Applicant's services, and requested documentation of sales of the services.

The response submitted and signed by Applicant's attorney stated that Applicant is a pain management specialist, not an ophthalmologist or optometrist, and is compensated by providers of such services for patient referrals. According to Applicant, the signage bearing the mark prompts Applicant's patients to inquire, "provid[ing] Applicant with an opportunity to advertise the ophthalmological or

³ August 18, 2017 Office Action at 1.

optometric services of physicians for whom he has agreed to provide such services.”⁴ Applicant denied that the specimen was a mock-up, noting that the sign was on public display in Applicant’s clinic. Applicant responded to the information requirements, except for the documents, which Applicant contended were confidential.

In the next Office Action, the Examining Attorney maintained the refusal under Sections 1 and 45 on the ground that the specimen does not show Applicant’s mark in use in connection with the recited services because it contains “nothing to indicate that the applicant advertises or promotes the ophthalmology or optometry services of others.”⁵

Applicant appealed, but also requested reconsideration, so the case was remanded.⁶ In the request for reconsideration,⁷ Applicant questioned the propriety of a final action, given the underlying shift in rationale for the refusal. Applicant further contended that although the specimen includes no explicit reference to the services, consumers nonetheless could infer the nature of the services from the context (use with an eyeglasses design) and significance of the mark (20/20 in relation to vision), and would make an association.

The Examining Attorney maintained the refusal that the specimen does not show use of the mark in connection with the services. According to the Examining Attorney:

The specimen shows the mark, and lists the applicant’s name, the name of the applicant’s practice, which is a pain

⁴ February 16, 2018 Response to Office Action at 3.

⁵ March 5, 2018 Office Action at 1.

⁶ 2 TTABVUE.

⁷ 4 TTABVUE.

clinic, and the applicant's address. The specimen does not create a direct association between the mark, and the services of advertising, marketing or promotion of ophthalmology and optometry services of others. Since the context or environment in which the specimen appears is a pain clinic, there is no logical reason a patient of the applicant's pain clinic would surmise that the applicant is advertising the services of ophthalmologists and optometrists. Especially since the applicant's name, address, and the name of the clinic also appear on the specimen, there is nothing to tell the public that this specimen somehow is promoting the services of an ophthalmologist or optometrist. Having the applicant's name and reference to his pain clinic on a sign purporting to advertising ophthalmological and optometric services is incongruous and does not make sense. While the picture of the eyeglasses and the reference to "20/20" suggest vision, there is nothing to suggest that the applicant is engaged in advertising and promoting other doctors' services. If the specimen said something like "Ask me to recommend a good ophthalmologist or optometrist," or "Looking for a good ophthalmologist or optometrist?" or "Ask us how," then it would show some association between the mark and the claimed services. The specimen of record does not show this.⁸

Applicant responded that a direct association between the mark and the advertising services would be made because "a patient would know that it is in a pain clinic; the patient would know that it was not in an optometrist's or ophthalmologist's office and, being aware of its environment, the patient would necessarily and logically know that the provided specimen was Applicant's advertising of the optometry and ophthalmology services of others."⁹ However, the Examining Attorney remained unpersuaded, and maintained the refusal, based on her earlier reasoning.¹⁰

⁸ December 14, 2018 Office Action at 1.

⁹ June 12, 2019 Response to Office Action at 1.

¹⁰ 6 TTABVue.

Applicant filed another request for reconsideration, pointing to TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1301.04(f) (Oct. 2018) to argue that the reference to “20/20” with an eyeglasses design sufficiently refers to the field of use and the signage is unmistakably advertising.¹¹

The Examining Attorney again denied the request for reconsideration based on her earlier reasoning, and pointed to two registrations owned by Applicant for the marks, 2020 IS THE YEAR TO SEE CLEAR and 2020, THE YEAR TO SEE CLEAR for similar services to those at issue in this case. She alleged that, in contrast to the specimen in this case, the supporting specimens for those registered marks included wording that “show[ed] a logical connection between the mark shown on the specimen and the services, such as “Ask us how,” or “We can refer you to the proper eye care professional. Dr. Mansell is compensated by an eye care professional for this advertisement.”¹²

The appeal resumed, and has been briefed.¹³

As explained below, we affirm the refusal to register because we find the specimen does not show use of the mark in connection with the recited advertising services.

¹¹ 10 TTABVUE.

¹² 12 TTABVUE 6. While in TSDR the Office Action denying reconsideration includes as attachments copies of Applicant’s registrations, it does not include copies of the specimens on which the Examining Attorney relies.

¹³ Applicant already had submitted his Brief (5 TTABVUE) before the case was remanded for consideration of the request for reconsideration, resulting in further prosecution. Once the appeal was resumed almost two years later, the Board afforded Applicant the opportunity to file a supplemental brief, 13 TTABVUE, but he did not do so.

II. Use of the Mark for the Services

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a service mark is used in commerce “when it is used or displayed in the sale or advertising of services.” *See also* Trademark Rule 2.56(b)(2), 37 C.F.R. § 2.56(b)(2) (“A service mark specimen must show the mark as used in the sale or advertising of the services”). Such use may be established by: (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed as a service mark in advertising the services, which encompasses marketing and promotional materials. *In re WAY Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016) (citing *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316-17 (TTAB 1992) (an acceptable specimen need not explicitly refer to the services if it “show[s] use of the mark in the rendering, i.e., sale, of the services”)); *In re Red Robin Enters.*, 222 USPQ 911, 914 (TTAB 1984) (stating that “rendition” of services is properly viewed as an element of the “sale” of services).

Applicant has clarified in his Brief that his specimen is the first type – showing the mark in the course of rendering the services.¹⁴ While a rendering-type specimen need not explicitly refer to the services, it still must show “some direct association between the offer of services and the mark sought to be registered therefor.” *In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). A specimen is deficient if it shows only the mark with no reference to, or association with, the services. *In re Adair*, 45 USPQ2d 1211, 1214-15 (TTAB 1997); *In re Duratech Indus.*

¹⁴ 5 TTABVue at 10-11.

Inc., 13 USPQ2d 2052, 2054 (TTAB 1989). In order for the rendering-type specimen to establish the requisite direct link between the mark and the services, “there must be something which creates in the mind of the purchaser an association between the mark and the service activity.” *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994). We make this inquiry from the perception of the user or consumer of the services. *See In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016). We must decide whether use of the mark “sufficiently creates in the minds of purchasers an association between the mark” and the applied-for services. *Id.* (quoting *In re Ancor Holdings LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006)).

We find that consumers would not associate 20/20 IN 2020 with advertising services for others in the field of ophthalmology or optometry based on Applicant’s



use of the mark in his specimen, . It fails as a rendering-type specimen, because it does not convey that any service is being advertised for others.

Applicant argues that because he does not provide ophthalmology and optometry services, consumers “would recognize that the Applicant is advertising

ophthalmology and optometry services that must be provided by another.”¹⁵ He contends in his Brief:

The ordinary observer would recognize that “20/20” has commonly-recognized significance in the fields of ophthalmology and optometry, particularly, in reference to visual acuity (i.e., clarity of vision). Likewise, the ordinary observer would recognize that “2020” is suggestive of “20/20” and, thus, is suggestive of the fields of ophthalmology and optometry. Taken in concert with the representation of eyeglasses appearing in the specimen, the observer would easily infer a reference to ophthalmology and optometry and, thus, that the services being advertised are ophthalmology and optometry services.¹⁶

However, the inferences Applicant seeks to impute to consumers are too much of a reach. *See WAY Media*, 118 USPQ2d at 1701 (photo of “radio broadcast booth environment” does not suffice to show use in rendering radio broadcasting services). Even in the context of the display of the sign in Applicant’s pain clinic office, the sign simply does not associate 20/20 IN 2020 with advertising services provided for the benefit of others. While the eyeglasses design and reference to 20/20 certainly suggest something associated with vision, exactly what the sign promotes remains a mystery. Given the accompanying name and contact information, we find that consumers probably would view it as an advertisement for Dr. Mansell and his practice. Consumers could derive the impression that Dr. Mansell offers some type of vision-related goods, such as eyeglasses, or vision-related services, such as treatments that improve sight. Alternatively, consumers could perceive the mark as a general slogan

¹⁵ 5 TTABVUE 12.

¹⁶ 5 TTABVUE 11-12.

for Dr. Mansell's office or his pain management services. In this regard, we take judicial notice of the second definition of "20/20" in the Merriam-Webster Dictionary, "marked by facilely accurate discernment, judgment, or assessment// hindsight is twenty-twenty,"¹⁷ such that consumers could perceive the mark as an indication that in 2020, they would consider treatment by Dr. Mansell to reflect good judgment. Ultimately, even consumers who are Dr. Mansell's patients visiting his office would not associate this mark with advertising services for others. The specimen, even as displayed in the setting shown in the photograph, gives no indication that the mark appears in the course of advertising for others. *See Johnson Controls*, 33 USPQ2d at 1320 ("There would be no reason for any reasonable person to suspect that a custom manufacturing service is being identified by the mark as it is used on these labels.").

Decision: We affirm the refusal to register.

¹⁷ Merriam-webster.com entry for "twenty-twenty" or "20/20," accessed March 18, 2021. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).