

This Opinion is Not a
Precedent of the TTAB

Mailed: May 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Peak Valley Pure Water, LLC

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Serial No. 87686193

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Ludomir A. Budzyn of Budzyn IP Law LLC for Peak Valley Pure Water, LLC

Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Greenbaum, Dunn, and Allard,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Peak Valley Pure Water, LLC (Applicant) filed an application seeking registration of the mark PVPW (standard characters) on the Principal Register for services amended to “water supplying, namely, delivery of bottled water to homes, offices and stores” in International Class 39.¹ The Trademark Examining Attorney refused

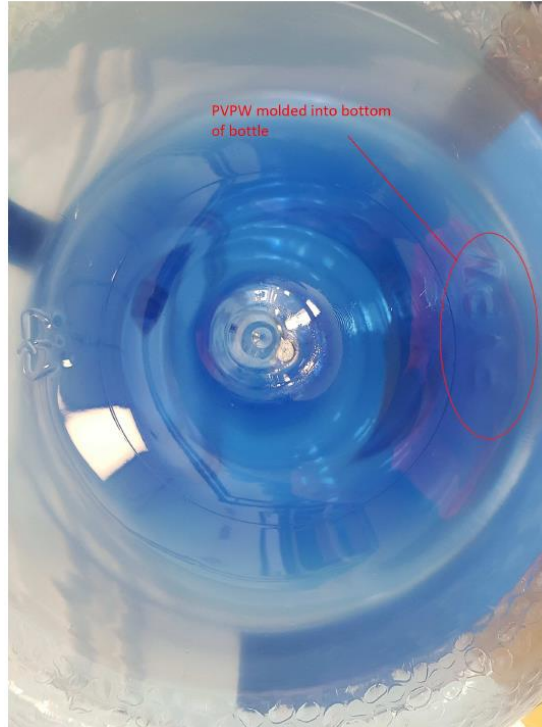
¹ Application Serial No. 87686193 filed November 15, 2017 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging October 2017 as its dates of first use anywhere and in commerce. As set forth in the decision, the application basis changed to intent to use, but the dates of use alleged in the statement of use were the same dates as alleged in the original application based on use.

registration of Applicant's mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant failed to provide a specimen which shows the mark in use in commerce in connection with the services. Applicant appealed and filed a request for reconsideration which was denied. The appeal is fully briefed. We affirm the refusal.

I. Relevant Chronology

Applicant's original services were described as "water supplying," and the application described the specimen as "photograph of product."² The original specimen which shows PVPW molded into the bottom of the bottle, is depicted below:

² November 15, 2017 Application, TSDR 1-3. The Trademark Status and Document Retrieval (TSDR) and TTABVUE citations refer to the two locations on the USPTO website where the appeal record and briefs can be found, namely the Trademark database for the involved application and the Board's electronic docket. All citations to the TSDR database are to the downloadable .pdf version of the documents.



Applicant's Original Specimen

In response to the refusal that the original specimen failed to show the mark with the identified services, Applicant stated “Applicant does not sell bottles of water, but rather picks up empty bottles and replaces them with full bottles in supplying water,” and the mark “PVPW molded into Applicant’s bottle shows use of the Applicant Mark during the rendering of Applicant’s water supplying service.”³ The Examining Attorney issued a final refusal which distinguished water delivery services from water supply services (such as provided by a water utility), and found that the specimen remained deficient.⁴

Applicant filed a request for reconsideration which amended the application’s

³ September 7, 2018 Response 3.

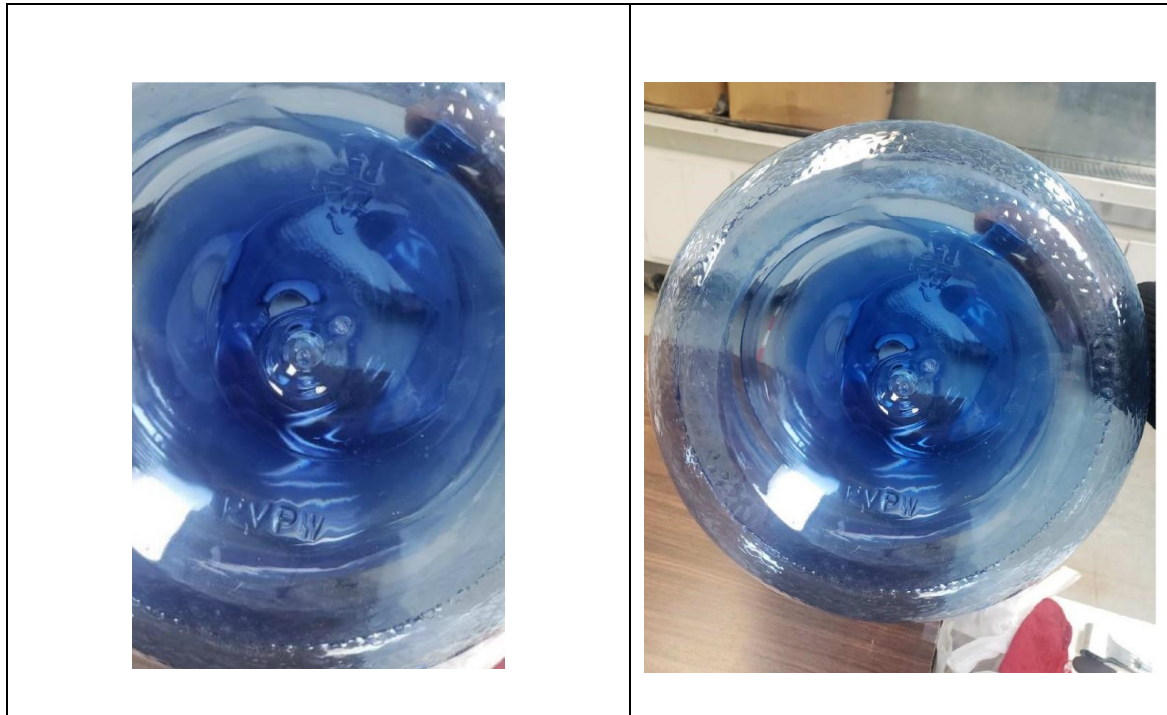
⁴ October 9, 2018 Office Action 2.

basis from use to bona fide intent to use the mark under Trademark Act Section 1(b) and amended the services to “water supplying, namely, bottled water delivery services.”⁵ The amendment to the basis was accepted, and the services were amended once more to “water supplying, namely, delivery of bottled water to homes, offices and stores.”⁶ The application was approved for publication and published for opposition.

The notice of allowance of the application issued August 13, 2019 and required Applicant to file a statement of use, or to seek a timely extension of time in which to do so. Trademark Act Section 1(d), 15 U.S.C. 1051(d). Applicant did not seek an extension, making February 13, 2020 the deadline to meet the requirements for the statement of use. *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1525 (TTAB 2016). Applicant filed its Statement of Use on February 13, 2020 alleging October 2017 as its dates of first use, and describing the accompanying specimen which shows PVPW molded into the bottom of the bottle, as “photographs of product.”

⁵ April 8, 2019 Request for Reconsideration 1.

⁶ April 12, 2019 Examiner’s Amendment. There was a subsequent amendment to clarify Applicant’s entity as a limited liability company. May 6, 2019 Examiner’s Amendment.



Applicant's Specimens Accompanying Statement of Use⁷

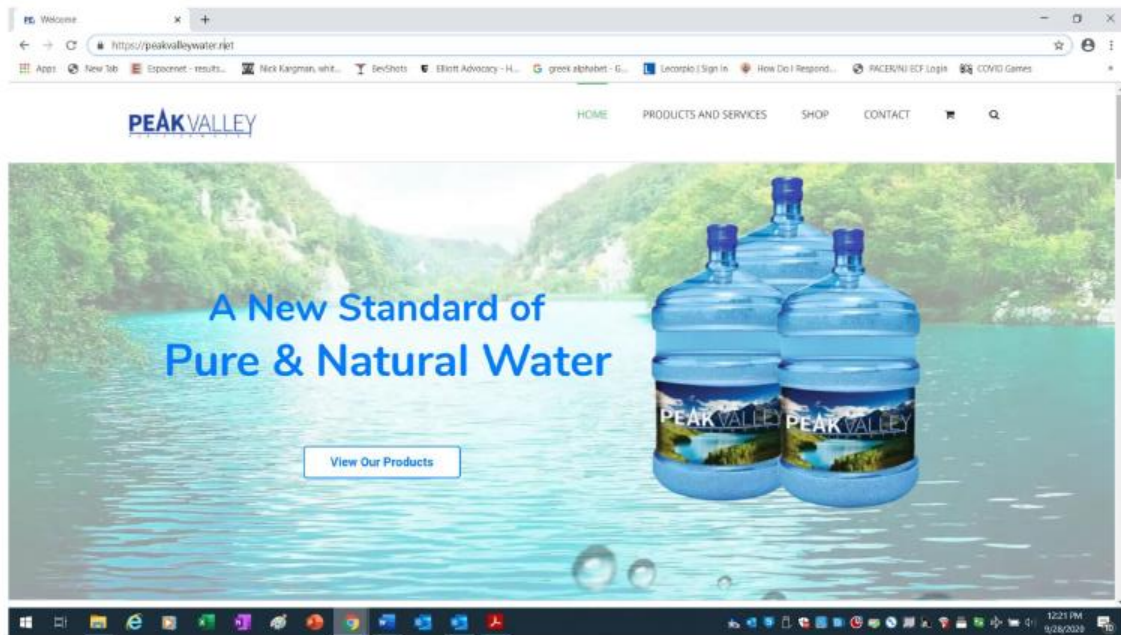
Registration was refused because “specimens for services must show a direct association between the mark and the services” and “the specimen depicts use of the mark on goods, namely, bottled water and does not show use of the marks in the sale, advertising or rendering of the delivery services specified.”⁸ In response, Applicant contended that the appearance of the mark on the water bottles show the mark “in the rendering of Applicant’s water delivery services.”⁹ Applicant also submitted excerpts from its website “showing the bottles used by Applicant and the offering of

⁷ February 13, 2020 Statement of Use Specimens.

⁸ March 29, 2020 Office Action.

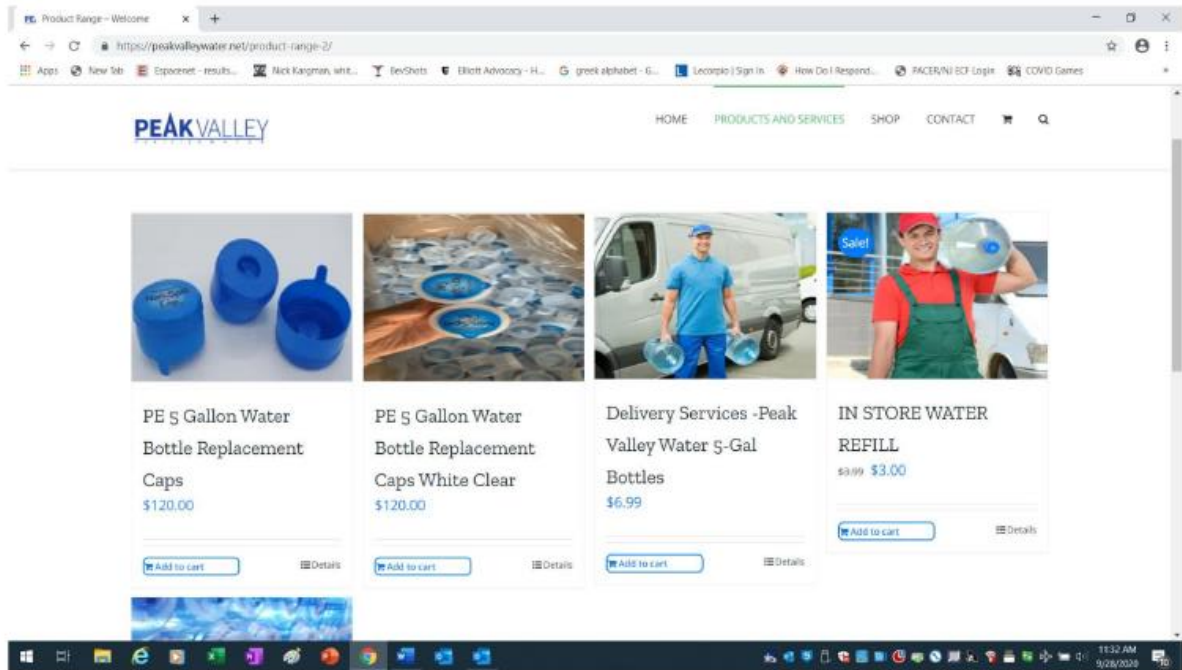
⁹ September 28, 2020 Response, TSDR 6.

its water delivery services” both of which display PEAK VALLEY as a mark and not PVPW:



Applicant's webpage showing bottled water¹⁰

¹⁰ Id.



Applicant's webpage showing water delivery service¹¹

The Examining Attorney issued a final refusal because neither the original nor the substitute specimens show the applied-for mark as actually used in commerce, explaining that the mark on the bottles does not show the requisite direct association between the mark and the services, and the advertising of the water delivery services on the website does not include the mark.¹²

Applicant filed a request for reconsideration arguing that water dispensers which are not connected to a water supply depend upon delivery of bottled water, and within that context, that the use of the mark on the bottles, and the use of the bottles to deliver the water, provides the necessary direct association between the mark and the services so that the mark on the bottles constitutes an acceptable specimen for

¹¹ Id.

¹² October 23, 2020 Office Action.

the water delivery services.¹³ Applicant supports its argument with a Wikipedia article on water dispensers and a Google image search for “water delivery service” which produced images of the same type of bottles used by Applicant:

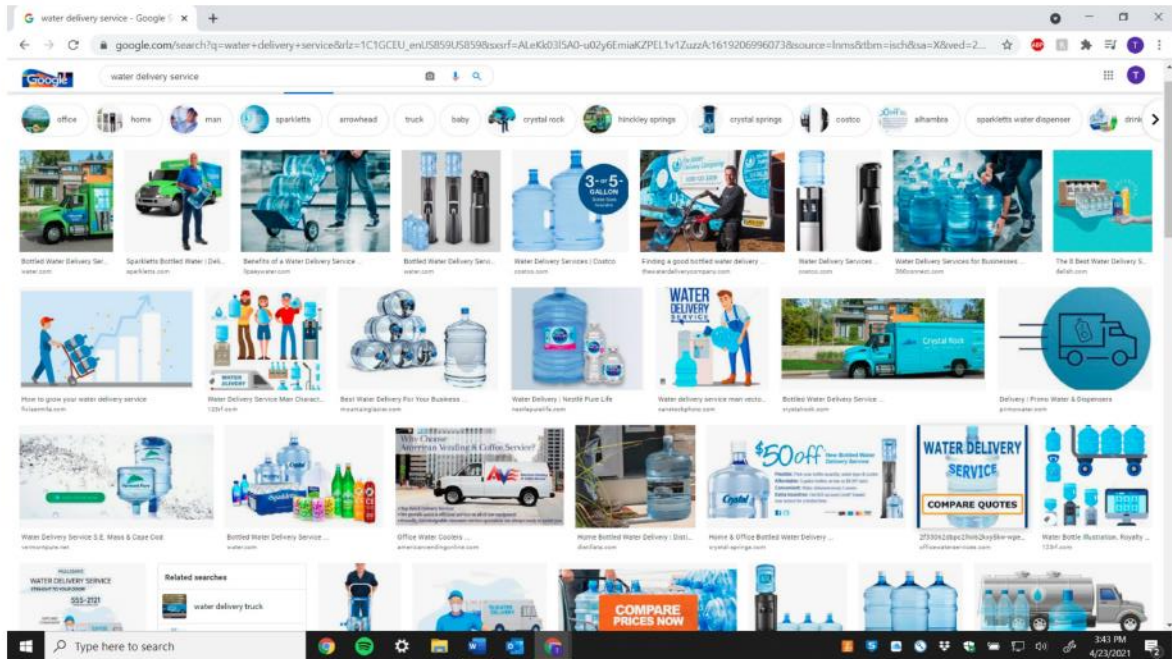


Bottled water dispenser

Excerpt from Wikipedia article on water dispensers showing bottled water¹⁴

¹³ April 23, 2021 Request for Reconsideration .

¹⁴ Id. at 23.



Google image search results for "water delivery service"¹⁵

In her denial of the request for reconsideration, the Examining Attorney acknowledged Applicant's supplemental materials and related argument but did not find them persuasive.¹⁶ In addition to finding that the mark molded on the bottles would be visible to the consumer only "after purchase, delivery and installation of the purchased bottled water in the water dispensing unit," the Examining Attorney cited evidence that Applicant's website offers blue water bottles for sale, finding the mark on the bottles will not be perceived as a source indicator for delivery services but for bottles:¹⁷

¹⁵ Id. at 32.

¹⁶ June 3, 2021 Office Action.

¹⁷ Id. at 3.



PET Plastic 5 Gallon BPA FREE (EMPTY) Bottles

\$6.59

- This product is BPA FREE,
- The bottle has NOT caps and holds a capacity of 5 gallons and is sized with dimensions: 10.75"-11.25" Diam. x 19.5"-20.0" Height. Includes a 53-55mm

Add to cart

Applicant's webpage for purchase of water bottles¹⁸

The Examining Attorney also supplemented the record evidence that Applicant's website uses the mark PEAK VALLEY (and not the mark PVPW) in connection with its delivery services:



Delivery Services -Peak Valley Water 5-Gal Bottles

\$6.99

PLEASE NOTE : If you do not have empty jugs or bottles for exchange your need to select (ONE) PET Plastic 5 Gallon BPA FREE (EMPTY) Bottles per each 5-Gallon Bottle that you want to get delivered (only for first time) or if you do not have empty bottles for exchange (this is just Refundable a deposit on the plastic Bottles

Applicant's webpage for water delivery service¹⁹

The Examining Attorney found that the water delivery industry does not typically mold marks on the bottom of water bottles to indicate the source of the water delivery service, but uses a "combination of verbiage in advertising materials, labeled bottles,

¹⁸ Id. at 5.

¹⁹ Id. at 8.

water dispensing units, uniforms and other indicia that create in the minds of consumers, a source identifying association between mark and services.”²⁰



Water bottle advertising Fontis water delivery service²¹



Webpage advertising Fontis water delivery services²²

²⁰ Id.

²¹ Id. at 16.

²² Id. at 18.



bulk water? Choosing the best option.

Thanks to their efficiency and lightweight packaging, single-serve bottles have proven a convenient and popular refreshment option for hydration on the go. The trade-off? Less water stored compared to its larger cousins.

On the other hand, our 3- and 5-gallon bottles have a much greater storage capacity, thanks to their larger size. Made of a strong polycarbonate plastic, the bottles are cleaned, sanitized and reused up to fifty times.

[Shop](#)

Water bottle advertising Crystal Spring water delivery service²³

water delivery service from Crystal Springs®?

In a word, convenience. Whether it's a 25-lb. case of .5-liter bottles or a 5-gallon returnable bottle, carrying your own bottled water can be a major workout. Let our friendly Route Sales Representatives (RSRs) save you the hustle by bringing the great taste of Crystal Springs® bottled water right to your door! You can count on your RSR to deliver the products you love to your home or office.

[Shop](#)



Webpage, truck, and uniform advertising Crystal Spring water delivery service²⁴

²³ Id. at 22.

²⁴ Id. at 21.



Water bottles advertising Deer Park water delivery services²⁵

Get up to \$50 OFF + FREE DELIVERY on your first recurring order. [See Details](#)

Bottled Water Delivery Service in Your Area

(800) 220-8286

Available Brands
[Deer Park](#)

Water Dispensers
[Water Dispensers](#)

[Order Online](#)

[Shop Water Dispensers](#)



Webpage advertising Deer Park water delivery services²⁶

²⁵ Id. at 25.

²⁶ Id. at 24.



Water bottles advertising Endless Waters water delivery service²⁷



Truck advertising Endless Waters water delivery service²⁸

²⁷ Id. at 32.

²⁸ Id. at 32.



LEARN MORE

Get purified bottled water delivered to your home or office from a local water company!

Maryland's own Endless Waters delivers the highest-quality bottled water.

water passes through a rigorous, 10-stage filtration process, resulting in water that is virtually free from all impurities.

family the purest bottled water in Maryland, Northern Virginia and Washington, DC. Call Endless Waters today to start delivery!



Bottled Water Delivery

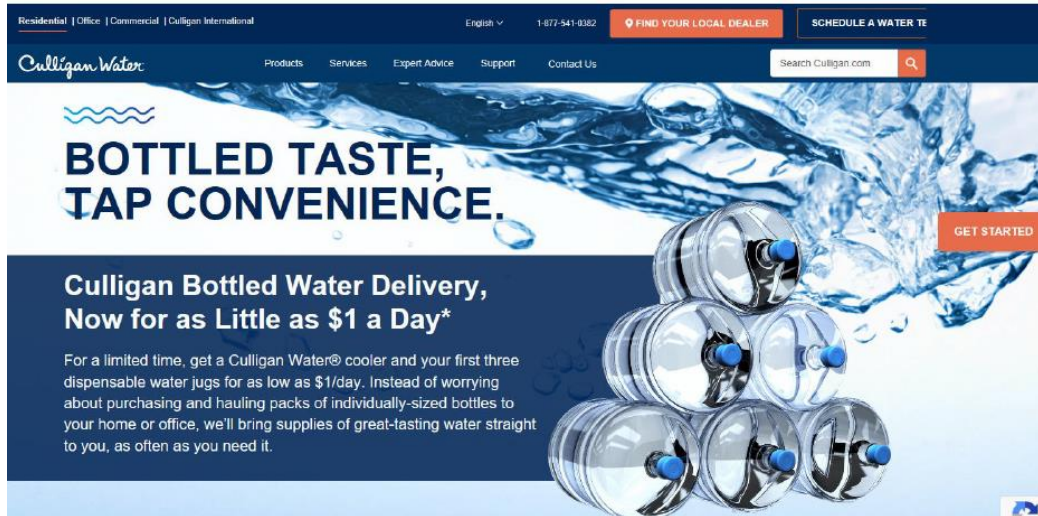
Webpage advertising Endless Waters water delivery service²⁹



Water bottle advertising Culligan water delivery service³⁰

²⁹ Id. at 31.

³⁰ Id. at 37.



Webpage advertising Culligan water delivery service³¹

More specifically, the Examining Attorney found that the record supported a finding that marks used in connection with water delivery services typically appear on the bottles in which the water is delivered, but did not support a finding that it is typical practice to use a mark molded on the bottom of a water bottle, and so found Applicant's specimen did not provide the necessary direct association between the mark and the services.

II. Applicable Law

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." The specimen must show the mark used in a manner that creates in the minds of potential consumers a direct association between the mark and the services. *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (CCPA 1973) ("The minimum requirement is some direct association between the offer of services and the mark

³¹ Id. at 36.

sought to be registered therefor.”); *see also In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614, 620, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) (“The ‘direct association’ test does not create an additional or more stringent requirement for registration; it is implicit in the statutory definition of ‘a mark used * * * to identify and distinguish the services of one person * * * from the services of others and to indicate the source of the services.’”). “The ultimate question here is this: whether purchasers would perceive [Applicant’s] mark[] to identify [the services listed in the application].” *In re JobDiva, Inc.*, 843 F.3d 836, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016).³²

Because industry use may vary or evolve, an applicant may supplement its specimen with an explanation or evidence of industry custom which makes clear why purchasers would perceive the mark on the specimen as identifying the service. *See In re JobDiva, Inc.*, 121 USPQ2d at 1125 (“JobDiva’s CEO had testified that JobDiva’s software actually performs personnel placement and recruitment services.”); *In re Pitney Bowes, Inc.*, 125 USPQ2d 1417, 1419 (TTAB 2018) (“While the Examining Attorney reasonably found the specimen unclear as to whether Applicant, rather than a third party, provides the services, Applicant’s explanation of the specimen and how Applicant provides the outsourced mailing services referenced on the specimen resolved the ambiguity”). Of course, an explanation cannot excuse failure to use the mark in connection with the identified services, and must be consistent with what

³² We reject Applicant’s argument (11 TTABVUE 13-14) that the Examining Attorney’s use of the words “sufficient nexus” applied the wrong test in her denial of the request for reconsideration. The Examining Attorney plainly and repeatedly referred to the required “direct association” and was not barred from using alternate wording to explain the concept.

the specimen itself shows. Id.; *see also In re The Cardio Group, LLC*, 2019 USPQ2d 227232 (TTAB 2019) (“Applicant’s explanation fails to clarify that the specimens show Applicant rendering a retail store service of any type or persuade us that there is an association between THE CARDIO GROUP and design and retail store services.”).

III. Analysis

Here, we address whether, as the statute requires, Applicant uses its mark “in the sale or advertising of services.” Applicant contends that its mark PVPW is used in the sale of the water delivery service because the mark appears on the bottom of the bottle in which the water is delivered and, as shown by the evidence of record, “consumers associate ‘water delivery service’ with the same type of clear, bluish plastic, multi-gallon bottles as those used by Appellant and seen in the Specimens.”³³ Applicant contends that because the bottles may be “stored and transported on [their] side” and “may be inverted during use” with water dispensers, there is a direct association between the mark and the services.³⁴

We disagree. We can and do agree with the separate propositions that an acceptable specimen may display the mark while the services are rendered, and that goods used in performance of the services may display the mark and serve as an acceptable specimen. We further agree that, with respect to the water delivery services at issue in this case, the record demonstrates that the water bottles used in

³³ 11 TTABVUE 9.

³⁴ 11 TTABVUE 11.

performance of the water delivery services display the mark for the water delivery services. However, we disagree that the consumer of Applicant's water delivery services will encounter Applicant's bottles as shown below, in which the image on the left does not show the mark presumably molded on the bottom, and find that the molded PVPW indicates the source of the water delivery services.



Applicant urged us to consider the context of industry use and consumer understanding when considering its use of the PVPW mark and we have done so. We consider the following contextual facts relevant to the perception of the molded PVPW mark in connection with Applicant's water delivery services: Applicant's business involves not just water delivery but the sale of the same bottles used in delivery. Applicant's bottles display prominent PEAK VALLEY labels and its website advertises "Delivery Services Peak Valley Water 5 gal. bottles." Competitors in the water delivery industry display their marks on prominent water bottle labels and their website advertisements. There is no evidence that the mark is perceptible to the prospective consumer when the water bottles are being delivered. There is no evidence that consumers perceive, or even encounter, molded marks on the bottom of

water bottles as indicators of source for water delivery services using the bottles. Based on these facts, we agree that the PWPV mark does not have a direct association with water delivery services.

We disagree that the two cases cited by Applicant dictate acceptance of the specimens. In the case of *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986), the mark for services renting chain-link fences comprised “alternately colored strands of wire arranged vertically in the fencing as installed at a location requested by a customer,” and the Board found “that the specimens submitted by applicant show applicant’s fencing, bearing the mark, as the fencing stands around a customer’s property quietly generating income for applicant; that hence the specimens show use of applicant’s mark in the sale of applicant’s rental services, i.e., as it is displayed in the rendering of the services.” *Eagle Fence Rentals* at 230. In the case of *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984), the mark for entertainment services, namely personal appearances, clowning, antics, dance routines and charity benefits comprised a design of a bird costume, and the Board found “In essence, the specimen portrays a form of use of the service mark as an animate pictorial ‘sign.’” *Red Robin* at 914. In both cases, the mark was readily discerned by the customer for the services as the services were being performed. The uses in the cited cases are not comparable to Applicant’s molding its mark on the bottom of water bottles to indicate the source of water delivery services.

As stated, industry use may vary or evolve. We are not finding that bottles with a mark molded on the bottom cannot serve as specimens for water delivery services.

On this record and in the absence of any evidence that the prospective consumer would encounter the PVPW mark on the bottom of the bottle and perceive PVPW as indicating the source of the water delivery service, we find that Applicant's bottles with a mark molded on the bottom have no direct association with Applicant's water delivery services, and so are not acceptable specimens.

IV. Decision

The refusal to register Applicant's mark PWPV for "water supplying, namely, delivery of bottled water to homes, offices and stores" under Sections 1 and 45 of the Trademark Act for failure to submit an acceptable specimen of use is affirmed.