Mailed: December 16, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Elba, Inc.

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Serial No. 77424767

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Molly B. Markley of Young Basile Hanlon & Macfarlane PC for Elba, Inc.

Christopher L. Buongiorno, Trademark Examining Attorney, Law Office 102 (Karen Strzyz, Managing Attorney).

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Before Quinn, Holtzman and Cataldo, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Elba, Inc. to register on the Principal Register the mark FORMULATING HEALTH in standard characters for

> contract and custom manufacturing in the fields of personal care and pharmaceutical products and manufacture of personal care and pharmaceutical products to the order and/or specification of others

in International Class 40.[1]

[1] Application Serial No. 77424767 was filed on March 18, 2008, based on applicant's allegation of a bona fide intent to use the

Upon applicant's submission of a statement of use, the trademark examining attorney issued an Office action on July 8, 2009 refusing registration under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053 and 1127, on the ground that the proposed mark, as used on the specimen of record, fails to identify and distinguish applicant's services from similar services of others or indicate their source. Applicant's specimen, identified as a screenshot from applicant's Internet webpage advertising its services, is reproduced below. The wording appearing on applicant's specimen inside the green "bubble" reads as follows:

> A legacy of excellence.
> Elba Laboratories can trace its roots back nearly 150 years to 1866 with a rich heritage as The Mark Allen Company, a personal care products manufacturer. Today, Elba Laboratories provides exceptional products and services that meet or exceed regulatory, contractual, and partner standards. We do this by combining innovative formulations, unique and versatile designs, strict production standards and time-tested marketing expertise. Elba Laboratories creates products with high perceived values and excellent sell-through performance.
> E Elba Laboratories *formulating health*[2]

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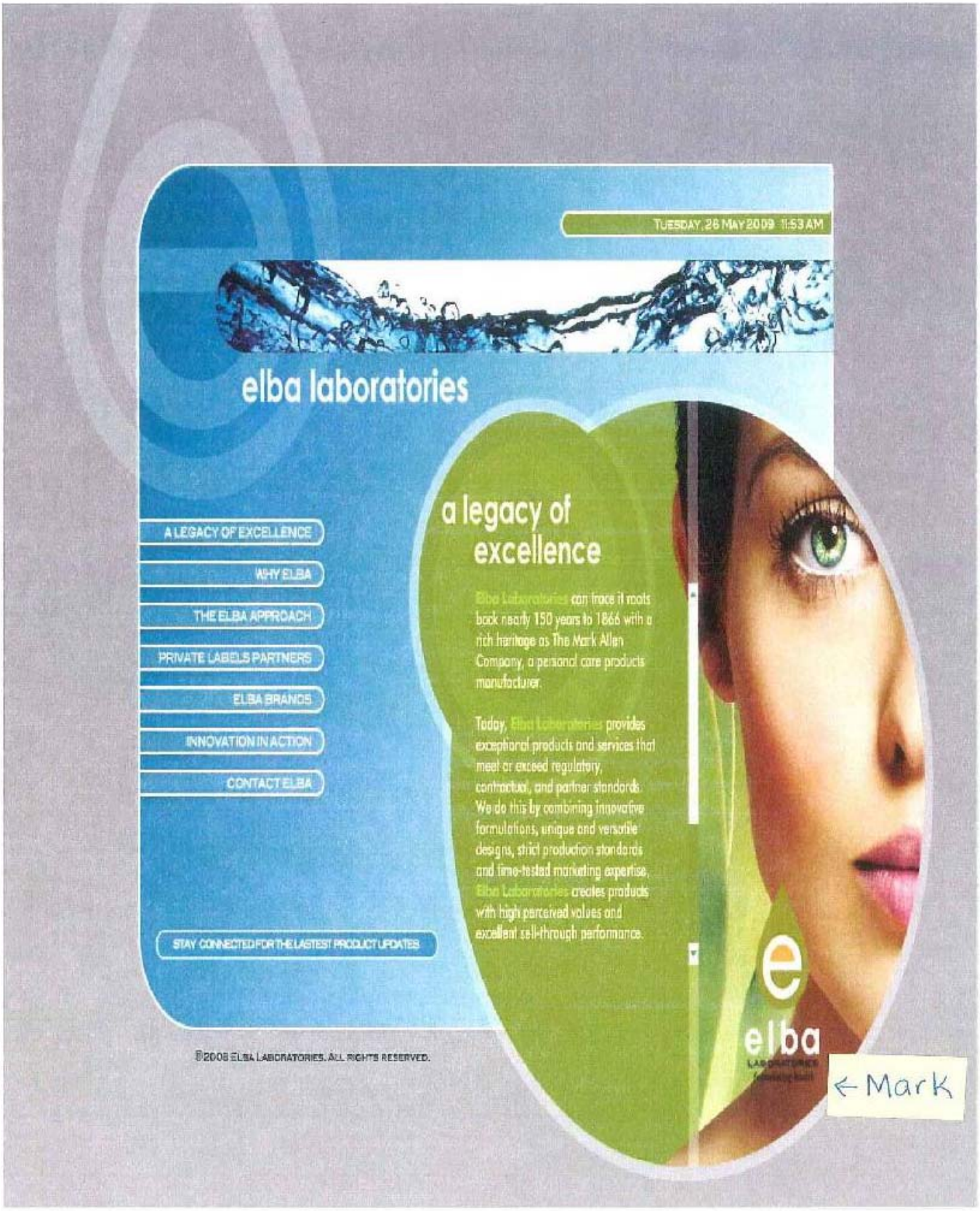
mark in commerce under Section 1(b) of the Trademark Act. In response to the examining attorney's requirement, applicant disclaimed HEALTH apart from the mark as shown. Subsequent to publication, applicant filed a statement of use asserting January 2008 as a date of first use of the mark anywhere and in commerce.

[2] Applicant's specimen of use, submitted on May 26, 2009.


TUESDAY, 26 MAY 2009 11:53 AM
elba laboratories
A LEGACY OF EXCELLENCE
WHY ELBA
THE ELBA APPROACH
PRIVATE LABELS PARTNERS
ELBA BRANDS
INNOVATION IN ACTION
CONTACT ELBA
STAY CONNECTED FOR THE LASTEST PRODUCT UPDATES
a legacy of excellence
Elba Laboratories can trace it roots back nearly 150 years to 1866 with a rich heritage as The Mark Allen Company, a personal care products manufacturer.
Today, Elba Laboratories provides exceptional products and services that meet or exceed regulatory, contractual, and partner standards. We do this by combining innovative formulations, unique and versatile designs, strict production standards and time-tested marketing expertise. Elba Laboratories creates products with high perceived values and excellent sell-through performance.
©2008 ELBA LABORATORIES. ALL RIGHTS RESERVED.
elba
← Mark

In its January 8, 2010 response, applicant submitted arguments in support of registration and also submitted as further evidence of use "a picture of an Elba Laboratories product label that uses the FORMULATING HEALTH mark."[3] Applicant's evidence is reproduced below:

Drug Facts

Active Ingredients	**Purpose**
Petrolatum 67%	Skin Protectant
Zinc Oxide 9.6%	Anti-irritation

Uses For temporary relief of chapped skin, diaper rash

Warnings

■ **For External Use Only.** ■ When using this product do not get into eyes. ■ **Stop use and ask doctor if** condition worsens or symptoms last more than 7 days or clear up and occur again in a few days.
■ **Keep out of reach of children.**
■ **If swallowed, get medical help or contact Poison Control Center right away.**

Directions Apply as needed. Gently message or apply liberally to unbroken skin.

Other Information Store at Room temperature (59-86°F)

Inactive Ingredients Lanolin, White Beeswax, Zinc Stearate, Castor Oil, Balsam of Peru, Calamine.

Made & Distributed in the USA by:
ELBA LABORATORIES, INC. ***Formulating Health***™
www.diaprex.com • Questions: 1-248-288-6098

In his January 25, 2010 Office action, the examining

[3] Applicant's January 8, 2010 communication, p. 1.

attorney noted that above evidence submitted by applicant was unacceptable as a substitute specimen of use because (1) it does not show use of the mark in connection with services, but rather is a label for an end product; and (2) it is not verified with an affidavit or declaration as provided by Trademark Rule 2.20. In its July 26, 2010 response, applicant presented additional arguments in favor of registration. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

Applicant asserts that its mark is used on its Internet homepage which advertises all of applicant's services. Applicant argues that the FORMULATING HEALTH mark, as it appears on its original specimen of use, appears in a different font from the rest of the text on the webpage; is physically separate from both the text describing its services and applicant's company logo appearing on the webpage; and is presented in such a manner as would be perceived as a service mark used in connection with its services. Applicant further argues that its "substitute specimen is further evidence of the mark used as a source identifier. This example is additional

evidence that the slogan is consistently used as a source identifier."[4]

The examining attorney maintains that the specimen submitted with the original statement of use displays the FORMULATING HEALTH mark in such small characters that "it is extremely difficult to discern where the mark appears on the specimen."[5] The examining attorney further maintains that he does not dispute that the original specimen displays the mark separate from the text appearing thereon, however, "the wording in the proposed mark appears in such a nondescript manner whereby it cannot be easily seen or read to serve as a source identifier for the services."[6] The examining attorney argues that, as a result, "the proposed mark as it appears on the web page specimen, does not show the wording 'formulating health' functioning as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services."[7]

With regard to the product label subsequently submitted by applicant, the examining attorney contends that, by applicant's own admission, "the purpose of the

[4] Applicant's brief, p. 4.
[5] Examining attorney's brief, unnumbered p. 3.
[6] Id.
[7] Id.

product label specimen is to promote [applicant's] own goods and not promote services rendered for others;"[8] that the label does not reference the recited services; and that, as a result, the label fails to show use of the mark as a service mark.

Product Label

We turn first to the product label submitted by applicant to show that the FORMULATING HEALTH mark "is also used on labels advertising products made and distributed by Elba Laboratories."[9] We observe initially that it is not clear from the record of this case whether applicant submitted the product label as a substitute specimen or merely as "additional evidence" of use in support of the original specimen. In that regard, we note that applicant did not indicate that the product label was a substitute specimen when it was first submitted. *See generally* TMEP §904.05 (8th ed. 2011) and authorities cited therein. Nor did applicant submit an affidavit or declaration in support thereof under Trademark Rule 2.20, even after this deficiency was noted by the examining attorney in his January 25, 2010 Office action.

[8] Id. at 4.
[9] Applicant's January 8, 2010 communication.

We find, therefore, that to the extent the above product label was ever intended to serve as a substitute specimen, it was not properly submitted as such and consequently will be given no consideration as a specimen of use.[10]

Original Specimen Submitted with Statement of Use

We turn then to the screenshot from applicant's Internet website, submitted as a specimen with its statement of use. Trademark Rule 2.88 provides, in part, that a statement of use must include one specimen showing how the applicant actually uses the mark in commerce. *See* 37 C.F.R. §2.88(b)(2). Trademark Rule 2.56(b)(2) specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." See 37 C.F.R. §2.56(b)(2). Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." See 15 U.S.C. §1127.

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must

[10] We note, in any event, that even if we were to consider the product label as a specimen, such labels generally are not sufficient to support use of a mark as a service mark.

be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. *See In re Monograms America Inc.*, 51 USPQ 1317 (TTAB 1999). It is not enough that the term alleged to constitute the mark be used in sale or advertising; there must also be a direct association between the term and the services. *See In re Compagnie Nationale Air France*, 265 F.2d 938, 121 USPQ 460 (CCPA 1959); *In re Johnson Controls Inc.*, 33 USPQ2d 1318 (TTAB 1994); and *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985). *See also In re Adair*, 45 USPQ2d 1211 (TTAB 1997). The mark must be used in such a manner that it would be readily perceived as identifying the source of such services. *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614 2 USPQ2d 2010 (Fed. Cir. 1987); and *In re Metrotech*, 33 USPQ2d 1049 (Com'r Pats. 1993). *See also* TMEP §1301.04 (8th ed. 2011). Thus, the issue before us is whether the specimen of record creates a direct association between applicant's FORMULATING HEALTH mark and the services specified in the application.

In this case, we first find that the specimen submitted by applicant with its application displays its FORMULATING HEALTH mark, albeit in small characters.

Inasmuch as applicant applied for its mark in standard character form, the mark as it appears in stylized form in its specimen of use is considered to agree with the mark as it appears in its drawing. *See* Trademark Rule 2.52(a); 37 C.F.R. §2.52(a). *See also* TMEP §807.03(e).

Regarding the size of the mark, in *In re Singer Mfg. Co.*, 255 F.2d 939, 118 USPQ 310, 312 (CCPA 1958) the predecessor to our primary reviewing court stated as follows:

> We are unable to agree with the Assistant Commissioner that appellant's labels, because of their relatively small size, 'can hardly make a commercial impression.' No authority is cited, and none has been found, to the effect that a trademark use requires a display of a design of any particular size or degree of prominence. The important question is not how readily the mark will be noticed, but whether, when it is noticed, it will be understood as indicating origin of the goods.

Similarly, in the case before us there is no requirement that applicant display the mark FORMULATING HEALTH in any particular size or degree of prominence on its website specimen.

Inasmuch as the applied-for mark is present on applicant's specimen, we must next determine whether it will be understood as indicating the source of applicant's recited services. *Id.* As noted above, Trademark Rule 2.56(b)(2) provides that "[a] service mark specimen must

show the mark as actually used in the sale or advertising of the services." When appropriate, the Board has been fairly flexible in accepting service mark specimens. *See In re Ralph Mantia Inc.*, 54 USPQ2d 1284 (TTAB 2000); and *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992).

In this case, we find that applicant's specimen is an advertisement for the identified services and that the advertisement shows the requisite direct association between the mark and the activities described therewith. *Cf. In re Adair, supra*; and *In re Johnson Controls, Inc., supra*. Specifically, the specimen indicates in a paragraph to the left and above the FORMULATING HEALTH mark that applicant provides products and services in the field of personal care "that meet or exceed regulatory, contractual, and partner standards." Further, the blue text to the left of this information on applicant's website specimen refers to applicant's "Private Label Partners" from which we may infer that it manufactures such products for others. As a result, applicant's specimen creates a direct association between the FORMULATING HEALTH mark and applicant's recited services. We note in addition that the examining attorney does not argue that applicant's website specimen fails to create such an association with its services. Thus, we conclude that the specimen of record is adequate to support

the use of the mark in connection with the identified services.

Decision: The refusal to register on the ground that applicant's mark, as used on its specimen of record, fails to identify and distinguish applicant's services from similar services of others or indicate their source is reversed.