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Subject: U.S. TRADEMARK APPLICATION NO. 85369372 - FOOD FOR FEET -
T56742US00 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85369372

MARK: FOOD FOR FEET



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APPLICANT: Zinpro Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:

T56742US00

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant appeals two final refusals regarding the acceptability of the proffered specimens for the proposed mark FOOD FOR FEET because (1) the specimens do not show use of FOOD FOR FEET in connection with any of the identified retail store services and (2) the specimens do not show use of the applied-for FOOD FOR FEET mark in use in commerce as a service mark for the identified retail store services, both refusals pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.64(a); TMEP §§904, 904.07(a).

STATEMENT OF FACTS

The applicant filed a use based application on July 12, 2011. The examining attorney discussed the application issues with the applicant's attorney and subsequently issued an examiner's amendment/priority action regarding the identification and specimen on

August 31, 2011. The applicant responded on October 26, 2011. The examining attorney issued a non-final action on November 15, 2011, because the amended identification in the October 26, 2011, response was beyond the scope of the original identification. The applicant submitted a November 30, 2011, response which sought to amend the identification, but did not address the specimen issues. The examining attorney issued a final action regarding the identification and specimen issues on December 16, 2011, as the amended identification was not acceptable and the outstanding specimen issues had not been resolved. The applicant submitted a request for reconsideration on May 24, 2012, that ignored the specimen issues, but amended the identification. The examining attorney denied the request for reconsideration on June 14, 2012, as the identification amendment was unacceptable. The applicant instituted the current appeal on June 18, 2012. The Trademark Trial and Appeal Board (TTAB) remanded the application to the examining attorney for consideration of another identification amendment on July 24, 2012. The examining attorney accepted the identification amendment but denied the request for reconsideration on August 13, 2012, because of the outstanding specimen issues. The specimen issues are the issues on appeal.

ISSUES ON APPEAL

1. Do the specimens show use of the proposed mark FOOD FOR FEET in connection with any of the retail store services featuring mineral supplements to promote healthy feet and/or legs of livestock and poultry where the specimens show use of FOOD FOR FEET as part of advertising copy in a magazine advertisement, or in flyers and information sheets promoting the applicant's goods, but that make no direct association between FOOD FOR FEET and the stated retail store services?
2. Do the specimens show the proposed mark FOOD FOR FEET in use in commerce as a service mark for the identified retail store services?

ARGUMENT

1. THE SPECIMENS DO NOT SHOW USE OF THE PROPOSED MARK FOOD FOR FEET IN CONNECTION WITH ANY OF THE APPLICANT'S RETAIL STORE SERVICES.

The specimens are not acceptable because they do not show the applied-for mark FOOD FOR FEET used in connection with any of the retail store services listed in the identification. An application for registration under §1(a) of the Trademark Act must include one specimen for each class, showing use of the mark on or in connection with the goods, or in the sale or advertising of the services, in commerce. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv) and 2.56(a); TMEP §904.

To show service mark usage, the specimen must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services listed in the identification and indicating their source. *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not identify franchising services); TMEP §1301.04(a).

A service mark specimen consisting of advertising or promotional materials generally must show a direct association between the mark and the services for which registration is sought. *See In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973); *In re HSB Solomon Assocs.*, 102 USPQ2d 1269, 1274 (TTAB 2012);

TMEP §1301.04(b). While the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)); see *In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

The specimens submitted with the application on July 12, 2011, are described by the applicant in the original application as a “scanned image of front and back of magazine.” Additionally, the applicant submitted substitute specimens with its October 26, 2011, response that are described by the applicant as:

“ . . . flyers or information sheets that are provided by Zinpro Corporation to its distributors and actual potential customers that show FOOD FOR FEET *and are intended to promote the primary benefit of use of the Zinpro products there described*, and to help the animal owner and potential customer decide if he is in need of the FEET FIRST programs recommended products, such as AVAILA SOW.”

October 26, 2011, response at TICRS page 2; emphasis added.

The applicant further states that “. . . [t]he whole purpose of the flyers is promote and assist our retail sales services to customers.” October 26, 2011, response at TICRS page 3; emphasis added.

In other words, the applicant is not using the proposed mark to indicate the source of any retail *store* services, if in fact the applicant actually has a retail store, but to assist the applicant in the sale of the goods it produces, e.g., the applicant gives the flyer to the

distributor who gives it to the retail customer in order for the retail customer to determine whether the applicant's goods are suitable.

None of the specimens submitted show any direct association between the stated retail *store* services featuring mineral supplements to promote healthy feet and/or legs of livestock and poultry and the proposed mark FOOD FOR FEET. *See* July 12, 2011, application at TICRS pages 3 and 4; October 26, 2011, response at TICRS pages 4-9.

The applicant's own statements confirm this fact, as the applicant states that the wording is being used to promote its *products*, but is not being used to indicate the source of the retail store services listed in the application. There is not a single reference in any of the specimens that makes a direct association between the proposed mark and the listed retail store services. In other words, the proposed mark FOOD FOR FEET is being used as advertising copy in various promotional advertisements, flyers, and information sheets to promote the sale of the applicant's goods, but FOOD FOR FEET is not being used as a service mark that indicates the source of the retail store services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

The applicant is under the mistaken belief that because the applicant uses the proposed mark FOOD FOR FEET in advertising and promotional materials for the goods that it sells that this fact shows use of the mark as a service mark that indicates the source of the listed retail store services. However, the applicant's contention is directly contradicted by well settled case law. A specimen that shows only the mark, with no reference to the

identified services (such as in the instant case), does not show service mark usage. *In re wTe Corp.*, 87 USPQ2d 1536 (TTAB 2008) (specimen comprising a packaging label affixed to boxes being mailed to customers, on which the proposed mark was used as part of a return address, held unacceptable because it did not show a connection between the mark and the services); *In re Adair*, 45 USPQ2d 1211 (TTAB 1997) (tags affixed to decorated Christmas tree that bear the mark “TREE ARTS CO. and design” and the applicant’s location, but make no reference to services, fail to show use for “design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees”); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994) (labels affixed to packaging of valves do not show use of mark for custom manufacture of valves); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (bumper stickers showing only the mark do not show use to identify “association services, namely, promoting the interests of individuals who censor the practice of drinking and driving”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (cutouts showing mark with no reference to the services held unacceptable for automotive service center); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (iron-on transfer clothing patches in the form and shape of a cartoon animal mark, distributed as free promotional items to restaurant customers at counters, held insufficient to identify restaurant services); TMEP §1301.04(b).

It does not matter if the applicant’s sales representatives use the advertising, flyers, and information sheets to assist in making the sale of the applicant’s goods, because FOOD FOR FEET as used on the specimen makes no reference at all to the retail *store* services.

Furthermore, the manner of potential use as a sales aid in the flyers and information sheets makes no association between FOOD FOR FEET and the retail *store* services in the application; giving the flyer or information sheet to a distributor for use as a sales aid does not show that the applicant has a retail store and certainly does not show use of the proposed mark to indicate that the applicant is the source of the listed retail store services. As shown by a review of the specimens, there is no mention, of any sort, of the stated retail store services listed in the specimens. Consequently, none of the specimens show use of the proposed FOOD FOR FEET mark as a service mark for the applicant's retail store services. TMEP §1301.04(b).

2. THE SPECIMENS DO NOT SHOW THE PROPOSED MARK FOOD FOR FEET IN USE IN COMMERCE AS A SERVICE MARK FOR THE IDENTIFIED RETAIL STORE SERVICES.

The specimens do not show use of the applied-for mark in use in commerce as a service mark for the identified mail order and on-line retail store services under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.64(a); TMEP §§904, 904.07(a). The applicant's specimens make no mention of the retail store services listed in the application. The specimens of record do not show that the retail store services are actually performed under the proposed FOOD FOR FEET mark. As a result, the specimens do not show use of FOOD FOR FEET as a service mark for the applicant's retail store services.

CONCLUSION

The specimens are not acceptable because they do not show the applied-for FOOD FOR FEET mark used in connection with any of the applicant's retail store services featuring mineral supplements to promote healthy feet and/or legs of livestock and poultry. None of the specimens show use of FOOD FOR FEET in a manner that would be perceived by potential purchasers as identifying the applicant's retail store services and indicating their source because there is no direct association between the proposed mark and the applicant's retail store services in the specimens. Simply listing the proposed mark in advertising copy, flyers, and information sheets used in the sale of the applicant's goods does not show the required direct association between the proposed FOOD FOR FEET and the listed retail store services. Moreover, the applicant has not provided evidence of use of the applied for mark in commerce for the stated retail store services. Therefore, the examining attorney respectfully requests that the Trademark Trial and Appeal Board affirm both refusals.

Respectfully submitted,

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