Hearing: May 17, 2022 Mailed: June 24, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Layla Sleep, Inc.

Serial No. 88359361

Walter B. Welsh of Welsh IP Law LLC,
for Layla Sleep, Inc.

Monica R. Reid, Trademark Examining Attorney, Law Office 126,
Andrew Lawrence, Managing Attorney.

Before Shaw, Coggins, and Dunn,
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Layla Sleep, Inc. ("Applicant") seeks registration on the Principal Register of the mark FLIPPABLE FIRMNESS in standard characters for "online retail store services featuring bed frames, foundations, mattresses, pillows, toppers, and bed sheets" in International Class 35.[1] Applicant appeals the Trademark Examining Attorney's final refusal to register the mark under Trademark Act Sections 1 and 45, 15 U.S.C.

[1] Application Serial No. 88359361. FLIPPABLE is disclaimed. The application as filed also identified goods in Class 20; but, those goods were divided out to a new (child) application, Serial No. 88981478, and are not at issue in this appeal.

§§ 1051 and 1127, on the ground that Applicant's specimens fail to show the mark in use in commerce in connection with the identified services.

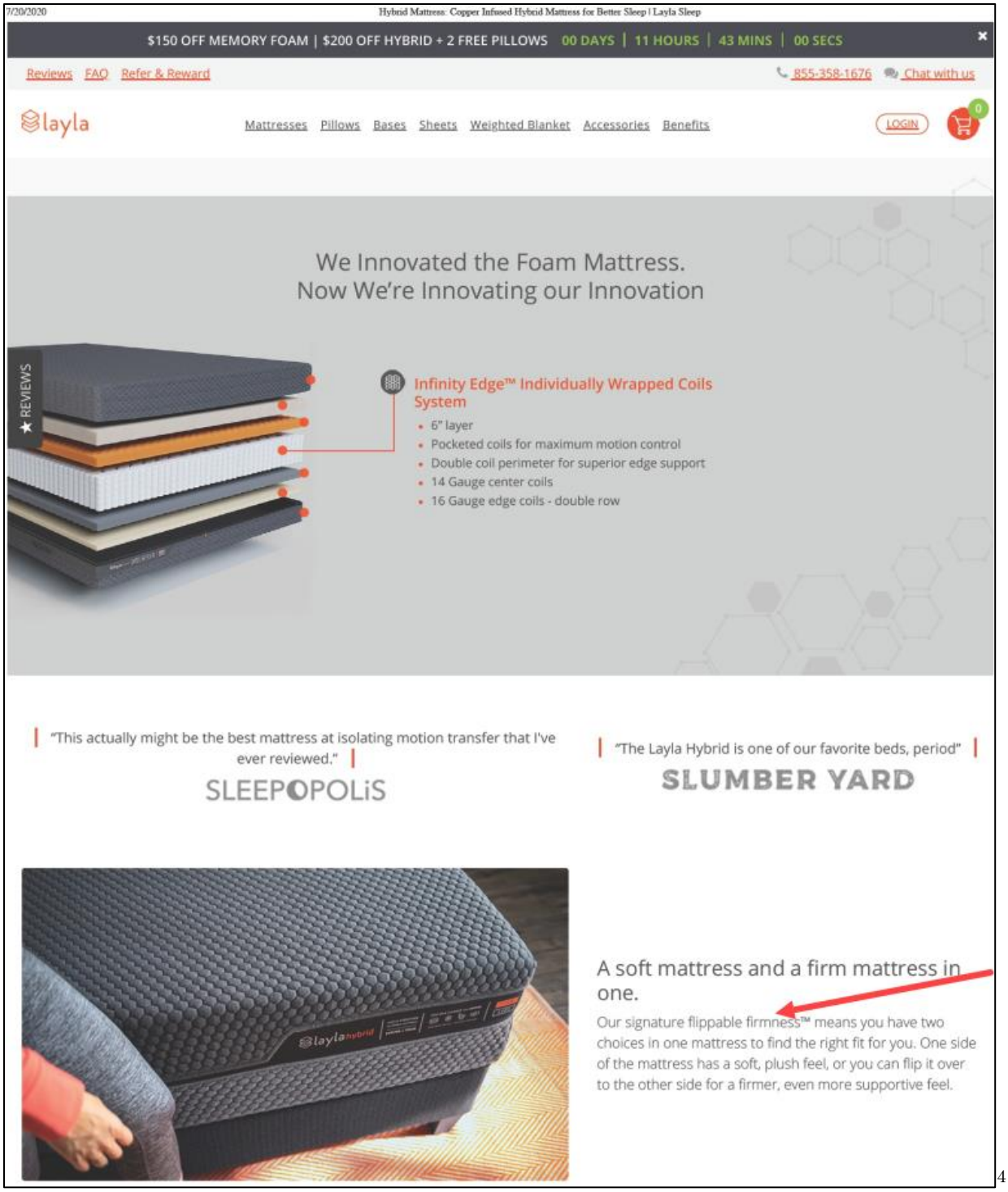
I. Relevant Prosecution History

Applicant filed the subject application on March 27, 2019, based on its declared intention to use the mark FLIPPABLE FIRMNESS in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. § 1051(b). A notice of allowance issued on October 15, 2019. After obtaining an extension of time, Applicant filed a Statement of Use on July 20, 2020, alleging that it had used FLIPPABLE FIRMNESS in commerce in connection with its online retail store services at least as early as April 30, 2020.[2]

As specimens of use for the identified services, Applicant attached what it described as "screen captures of online retail store" and directed the Office to "see second page."[3] Of the nine screen captures submitted, the term FLIPPABLE FIRMNESS is visible only on the second page, as Applicant indicated. The second page is reproduced below (with added red arrow pointing to the location of the proposed mark).

[2] April 30, 2020 Statement of Use at 2. Citations to the prosecution record refer to the .pdf version of the TSDR system.

[3] *Id.* at 3.



[4]

[4] *Id.* at 17; and July 20, 2020 Specimen at 11.

The Examining Attorney found the specimens unacceptable because they did not show a direct association between the mark and the services, and explained that because the proposed mark appeared only within one of the various paragraphs discussing the features of a mattress, the mark appeared to reference only the mattress and not retail store services featuring mattresses.[5] The Examining Attorney accordingly refused registration of the proposed mark under Trademark Act Sections 1 and 45.

In response to the Office Action, Applicant maintained that its specimen was acceptable and argued that a consumer viewing the specimen would link the mark with a retail store selling mattresses because the mattresses in question are available exclusively online.[6]

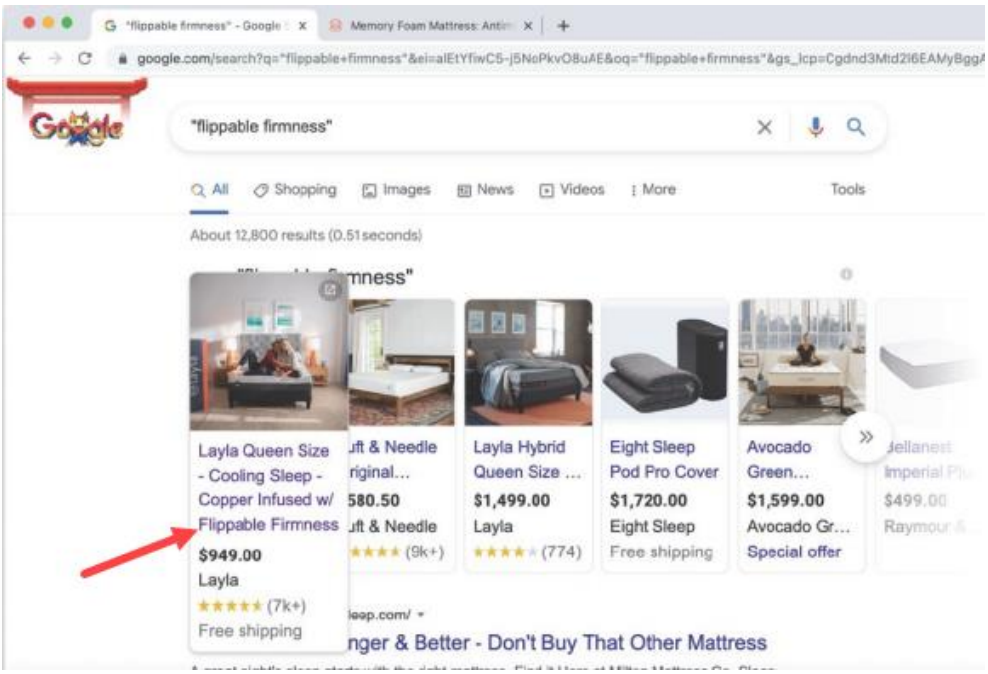
The Examining Attorney did not accede to Applicant's position, found that the specimens fell short of demonstrating use of the proposed mark in commerce in connection with online retail store services, and argued that because the sole place the mark appeared on the specimen was within a description of the qualities of a mattress, consumers would make a direct association only between the proposed mark and the mattress, not an association between the mark and online retail store services featuring that mattress. The Examining Attorney accordingly made final the refusal to register.[7]

[5] August 20, 2020 Office Action at 2.

[6] February 22, 2021 Response to Office Action at 5.

[7] March 1, 2021 Office Action at 2, 3.

In its Request for Reconsideration (filed concurrently with its appeal[8]), Applicant maintained that its original specimen was sufficient,[9] and submitted, in the alternative, three substitute specimens which we reproduce below (with added red arrows pointing to the location of the proposed mark).[10] Applicant explained that (1) the first substitute is a screenshot captured on a desktop computer displaying a Google Display Ad sponsored by Applicant and linking to Applicant's online retail store, (2) the second substitute is a screenshot captured on an iPhone displaying a Google Display Ad sponsored by Applicant and linking to Applicant's online retail store, and (3) the third substitute is a screenshot captured on an iPhone and shows ad copy from Applicant's laylasleep.com webpage.[11]



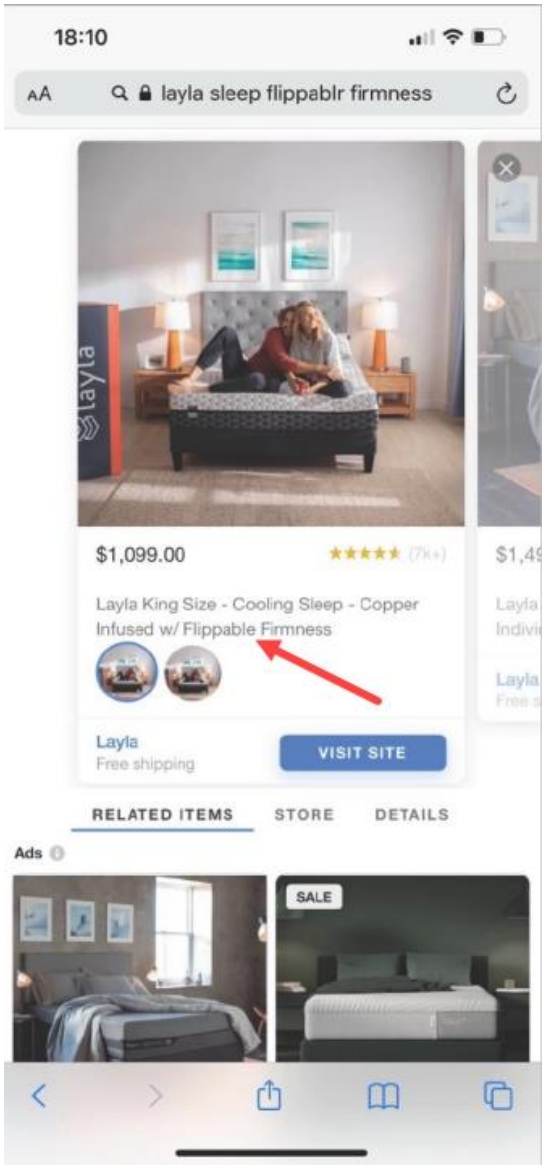
[1st: ad on desktop]

[8] 1 TTABVUE. Citations to the briefs in the appeal record refer to the TTABVUE system.

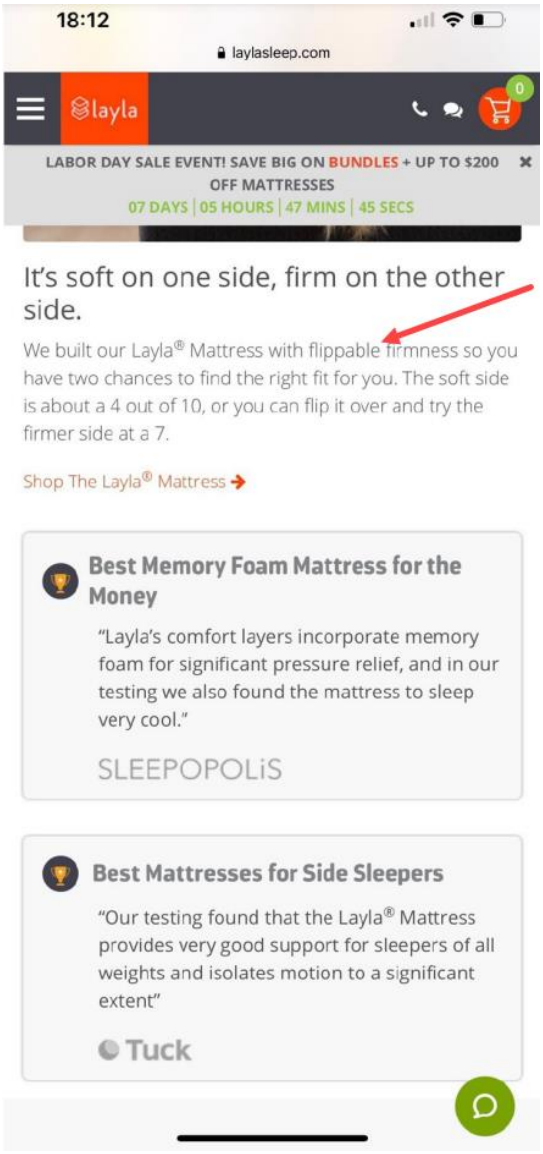
[9] September 1, 2021 Request for Reconsideration at 11.

[10] *Id.* at 11, 81-83.

[11] *Id.* at 19, 20; and September 2, 2021 Specimen at 2-4.



[2nd: ad on iPhone]



[3rd: laylasleep.com on iPhone]

Applicant also submitted from the TESS database print outs of third-party registrations for services including what Applicant summarizes as "online retail services featuring mattresses," along with a specimen allegedly supporting registration of those services for each registration.[12]

[12] September 1, 2021 Request for Reconsideration at 16-19, 52-78.

After the Examining Attorney denied the request for reconsideration, the appeal was resumed and fully briefed. We affirm the refusal to register.

II. Evidentiary Issue

The Examining Attorney objects to a declaration, with accompanying exhibit, attached to Applicant's appeal brief as untimely because it was not submitted prior to the appeal.[13] Applicant acknowledges that it "submitted a declaration of its executive in connection with the [a]ppeal," and argues that "[t]he purpose of the declaration is to provide background information and further context regarding significant use of the sponsored ads by the Applicant."[14]

Because the declaration was not previously submitted, the Examining Attorney's objection is sustained and the declaration will not be considered. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018) (Evidence "submitted with Applicant's appeal brief that Applicant did not previously submit during prosecution is untimely and will not be considered."), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019)). *See also* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) ("The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal."); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.01 (2022).

[13] 8 TTABVUE 3-4 (objection), 6 TTABVUE 20-23 (declaration with exhibit).

[14] 9 TTABVUE 3.

III. Arguments on Appeal

The Examining Attorney argues that because the original specimen "depicts the product page for a mattress, and the sole place the [proposed mark] appears is under the product within the various paragraphs discussing the features and the product," a consumer "would view the . . . [proposed mark] as a feature of the mattress and not as a source identifier for online retail store services."[15] She posits that "[a] mark for retail-store services is customarily located at the top [of the] web page, separated from the relevant goods by the website navigation tabs," and that Applicant's "[m]erely placing the mark [anywhere] on a website does not automatically mean the mark is used for the site as a whole."[16]

Applicant argues that its original specimen "includes the mark on a website for selling mattresses and related bedding products," and explains that while the specimen comprises several "PDF print outs from the relevant portions of its webpage," it would be a mistake "to mechanically evaluate" the print outs because "the browser software invariably renders the graphics and text in a different format" than as they appear on the specimens.[17] Applicant posits that to correctly evaluate "the specimen, one must consider how it is perceived by the consumer" who will view the website "on a phone screen, tablet, or computer browser" and through a "field of view [that] is much narrower than the PDF" generated when the web page was

[15] 8 TTABVUE 5.

[16] *Id.*

[17] 6 TTABVUE 12.

captured for submission to the Office.[18] Applicant concludes that "[a]s a result" of the narrower field of view, "the use of the mark becomes much more prominent."[19]

Applicant explains that "an Add[-]to[-]Cart button for the type of mattress is continuously available at the top of the page regardless of the scrolling of the consumer. Thus, when a consumer view[s] the mark in the content of the live specimen, the add[-]to[-]cart button and other shop buttons are immediately available, forming a direction association in the mind of the consumer between the mark and the services."[20] Applicant believes that "consumers would perceive the mark used in the [original] specimen as identifying the Applicant's service for selling online retail services featuring mattresses because this is what Layla does. Since being founded in 2016, Layla is exclusively an online retailer of mattresses and associated products."[21]

The Examining Attorney argues that first and second (i.e., Google Display Ad[22]) substitute specimens demonstrate "that the online retail store services are provided by 'Layla'," while the proposed mark FLIPPABLE FIRMNESS is used only "to refer

[18] *Id.*

[19] *Id.*

[20] *Id.* at 14.

[21] *Id.*

[22] Despite the Examining Attorney's characterization of the first and second substitute specimens as "Google search results," September 22, 2021 Reconsideration Letter at 1, and "screenshots of results from a Google search," 8 TTABVUE 8, we understand these specimens are sponsored advertisements displayed above Google search results. *See* September 1, 2021 Request for Reconsideration at 5 (identifying the specimens as "advertisement[s]" from "Google.com"), 81-82 ("[s]creenshot[s] from Google.com . . . show[ing] an advertisement"); 6 TTABVUE 9-10; 9 TTABVUE 3.

to a touted feature of a . . . mattress product."[23] Similarly, for the third (i.e., laylasleep.com) substitute specimen, she points out that "the wording 'Layla' is displayed prominently at the top of the webpage."[24]

Applicant argues that the first and second substitute specimens prominently display the proposed mark in a "link to Layla's online retail store that the user can access by simply clicking on the sponsored ad."[25] Applicant theorizes that, "[a]t a minimum, the potential customer has some base level of knowledge regarding how such advertisements function[]. Namely, that selecting the displayed link in a sponsor ad will navigate the browser to a website offering online retail store services."[26] Similarly, Applicant notes that the second substitute specimen "includes a button titled VISIT SITE" which "[a] potential customer understands . . . refers to an online retail store."[27] Applicant argues that in the second substitute, "[t]here is nothing in the advertisement limiting the term FLIPPABLE FIRMNESS to mattresses. Instead, a potential consumer could logically conclude from the image of a mattress on a bed frame that the online retail store features a variety of bedding related products, including bed frames, foundations, mattresses, pillows, toppers, and bed sheets." [28]

[23] 8 TTABVUE 8.

[24] *Id.* at 9.

[25] 6 TTABVUE 10.

[26] *Id.* at 11.

[27] *Id.*

[28] *Id.*

Applicant concludes that any doubt about the specimens should be resolved in its favor.

IV. 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." An acceptable specimen of use 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). *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 of the services, including use in the performance or rendering of the services, or in the advertising of the services. The specimen must show a direct association between the mark and the services."). While the specimen "need not explicitly refer to those services in order to establish the requisite direct association 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 WAY Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016) (quoting *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)). *See also In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016). Additionally, if a "specimen shows use of the mark in connection with goods rather than the identified services, the specimen must be refused for failure to show service-mark use in commerce in connection with the identified services." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1301.04(g)(i) (July 2021); *see also* TMEP § 1301.04(d) (same).

"To determine whether a mark is used in connection with the services described in the [application], a key consideration is the perception of the user." *JobDiva*, 121 USPQ at 1126 (citation omitted). The question in this appeal is whether the evidence of Applicant's use of its proposed mark FLIPPABLE FIRMNESS creates an association between that mark and Applicant's online retail store services. *Id*.

An applicant may explain the nature of the mark's use or the way the services are advertised or rendered. *See In re Pitney Bowes, Inc.,* 125 USPQ2d 1417, 1419 (TTAB 2018) (while examining attorney reasonably found the specimen unclear, applicant's explanation of the specimen and how applicant provides the services referenced on the specimen resolved the ambiguity); *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992) (finding specimens acceptable based, in part, on applicant's explanation that the specimens showed the mark as it appeared on a computer terminal in the course of rendering the services); TMEP § 1301.04(f)(ii). Applicant has done so here, explaining multiple times the nature of its mark, nature of its specimens, and nature of its services. Applicant has also explained its potential consumers' understanding of advertising links generally and Applicant's online-only retail store services specifically. *See* TMEP § 1301.04(f)(ii) (noting that "direct association may be indicated by the context or environment in which the services are rendered, or may be inferred based on the consumer's general knowledge of how certain services are provided or from the consumer's prior experience in receiving the services." (citing *Metriplex,* 23 USPQ2d at 1316; *WAY Media,* 118 USPQ2d at 1698)). Of course, an explanation cannot excuse failure to use the mark in connection with the identified

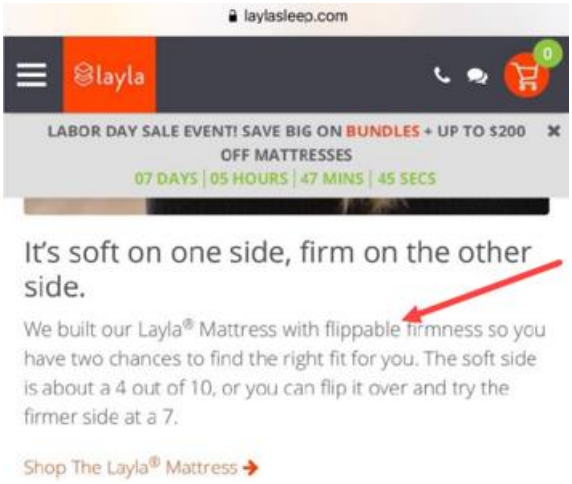
services, and must be consistent with what the specimen itself shows. *See, e.g., In re Cardio Grp., LLC*, 2019 USPQ2d 227232, *3 (TTAB 2019) ("Applicant's explanation fails to clarify that the specimens show Applicant rendering a retail store service of any type or persuade us that there is an association between [the mark] and retail store services.").

There is no rule that a mark for online retail store services must be located at the top of a web page. However, for advertisement specimens, "[i]n order to create the required 'direct association,' the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source." *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

Whether a mark sought to be registered as a service mark has been used "to identify" the services specified in the application is a question of fact to be determined on the basis of the specimens submitted by the applicant, together with any other evidence of record. *In re Adair*, 45 USPQ2d 1211, 1214 (TTAB 1997). Upon review of all of the specimens and all of Applicant's explanations and arguments, we find that none of specimens creates the required direct association between the mark FLIPPABLE FIRMNESS and online retail store services.

On the original specimen and third substitute specimen (each from Applicant's laylasleep.com website) the mark appears only within a short paragraph describing features of Applicant's mattress. The original, with a portion excerpted below,

explains to a consumer that Applicant's "signature flippable firmness™ means you have two choices in one mattress to find the right fit for you. One side of the mattress has a soft, plush feel, or you can flip it over to the other side for a firmer, even more supportive feel."[29] Similarly, the third substitute, with a portion excerpted below,



explains to a consumer that "We built our Layla® Mattress with flippable firmness so you have two chances to find the right fit for you. The soft side is about 4 out of 10, or you can flip it over and try the firmer side at a 7."[30]

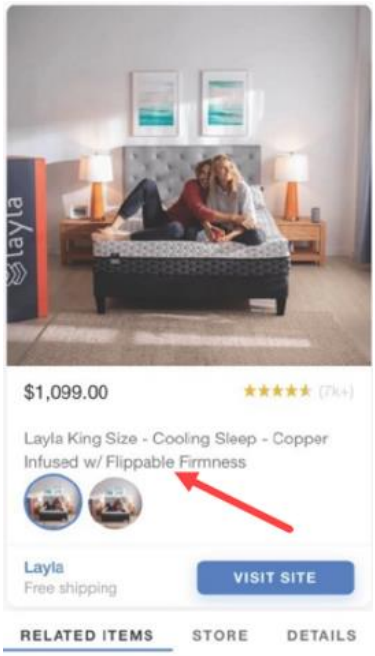
The above excerpts demonstrate the mark's appearance and location in context within Applicant's website. The original specimen shows the mark within a

[29] July 20, 2020 Specimen at 11.

[30] September 1, 2021 Specimen at 4.

paragraph immediately under larger text (i.e., "A soft mattress and a firm mattress in one.") and immediately next to an image of a mattress which, presumably, is Applicant's soft-and-firm mattress-in-one. The third substitute similarly shows the mark within a paragraph immediately under larger text (i.e., "It's soft on one side, firm on the other side.") that itself is under an unidentifiable image scrolled almost entirely off the screen.

The first and second substitute specimens, with a portion of each respectively excerpted below,



also show the mark in informational text under an image that includes, inter alia, a mattress. The text indicates that a Layla queen- or king-sized mattress features "– Cooling Sleep –" and is "Copper Infused w/ Flippable Firmness."

We find that in each specimen, whether the website or Google Display Ad, the term FLIPPABLE FIRMNESS refers to a feature of a mattress as opposed to a

FLIPPABLE FIRMNESS activity or service of selling mattresses. Our finding is supported by the surrounding text. The web pages advertise the advantages of a FLIPPABLE FIRMNESS mattress – that is, a mattress a consumer can flip to obtain different levels of firmness or support – and the Google Display Ads list it as a feature. In each of the substitute specimens, the mark is preceded by "with" (or it's abbreviation[31]).

There is nothing on any specimen that refers to, or even suggests, that there is such a thing as a FLIPPABLE FIRMNESS online retail store service. We recognize that the first substitute specimen includes an interactive link leading to Applicant's website, the second substitute specimen contains a "visit site" button, and the third substitute specimen contains an add-to-cart button (presumably as does the original specimen based on Applicant's explanation of what happens when a consumer scrolls the webpage). However, none of the specimens creates the required direct association between FLIPPABLE FIRMNESS and online retail store services.[32] Instead, the mark simply promotes Applicant's goods by describing a feature thereof. On each

[31] "W/" is an abbreviation for "with" which means "characterized by or having: *a person with initiative*." Dictionary.com, based upon THE RANDOM HOUSE UNABRIDGED DICTIONARY (2022). The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *See, e.g., In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018). We so exercise our discretion in this case.

[32] From the multiple placements of "Layla" in each of the Google Display Ads (i.e., as a prop in the photograph, in the name of the mattress sizes, and above the indication of free shipping), a consumer is more likely to perceive "Layla" as the source of the retail services – not "Flippable Firmness" as the source. However, because the issue is not before us, we make no determination whether such specimens would be sufficient to support registration of the mark LAYLA for online retail store services.

specimen the proposed mark is used merely in connection with goods used in the performance of the services.[33]

Finally, after noting that each case must be decided on its own merits and criticizing the Examining Attorney for introducing third-party websites to demonstrate customary placement of online retail service marks, Applicant provided in support of its argument that retail marks do not always appear on the top of webpages, printouts of specimens presumably from the USPTO database file histories of eight third-party registrations for different marks that also identify online retail services featuring mattresses.[34] Apart from the fact that the specimens of use at issue in those cases are different from those provided by Applicant in this case and thus do not establish any industry standard for the provision of specimens in such cases, it is well-settled that the prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Board. *See In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). As Applicant itself argued and recognized,[35] each case is decided on its own facts, and each mark stands on its own merits.

On the record before us, we find that none of Applicant's specimens shows the proposed mark used in a manner that creates in the minds of potential consumers a

[33] Indeed, the Examining Attorney found the original specimen sufficient to support registration of the Class 20 mattresses which were divided out after the refusal to register the Class 35 services was made final.

[34] March 1, 2021 Office Action at 2-3, 5-11 (third-party websites); September 1, 2021 Request for Reconsideration at 16-19, 52-78 (criticism, third-party specimens).

[35] September 1, 2021 Request for Reconsideration at 16.

direct association between the mark FLIPPABLE FIRMNESS and the recited online retail store services. *Universal Oil*, 177 USPQ at 457 ("The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor."); *see also In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614, 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 online retail services listed in the application]." *JobDiva*, 121 USPQ2d at 1126. Based on the specimens before us, we find that they would not.

V. Decision

The refusal to register Applicant's mark FLIPPABLE FIRMNESS is affirmed.