

STATEMENT IN RESPONSE TO OFFICE ACTION
U.S. TRADEMARK APPLICATION NO. 88299678 – LILA GRACE
ISSUE/MAILING DATE: 11/8/2019

APPLICANT'S SPECIMENT ACCURATELY REFLECTS THE APPLIED TO TRADEMARK.

Relevant Facts

- Applicant owns the following registrations and trademark filings:

Word Mark **LILA GRACE**
Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Antibacterial soap; Bar soap; Hand lotions; Hand soaps; Reeds and scented oils sold as a unit for use in room scent diffusers. FIRST USE: 20110523. FIRST USE IN COMMERCE: 20110523

Registration Number 4214519

International Registration Number 1254750

Registration Date September 25, 2012

Word Mark **LILA GRACE**
Goods and Services IC 021. US 002 013 023 029 030 033 040 050. G & S: Bath products, namely, loofah sponges. FIRST USE: 20130915. FIRST USE IN COMMERCE: 20130915

Registration Number 5789738

Registration Date June 25, 2019

Word Mark **LILA GRACE**
Goods and Services IC 025. US 022 039. G & S: Bathrobes. FIRST USE: 20140902. FIRST USE IN COMMERCE: 20140902

Registration Number 4731637

Registration Date May 5, 2015

Word Mark **LILA GRACE**
Goods and Services IC 021. US 002 013 023 029 030 033 040 050. G & S: Drinking cups; drinking cups sold with lids therefor; mugs. FIRST USE: 20130913. FIRST USE IN COMMERCE: 20130913

Registration Number 5699009

Registration Date March 12, 2019

Word Mark LILA GRACE
Goods and Services IC 016. US 002 005 022 023 029 037 038 050. G & S: Agendas; Notepads; Photo albums; Stationery; Blank journals. FIRST USE: 20181123. FIRST USE IN COMMERCE: 20181123
Registration Number 5752522
Registration Date May 14, 2019

Word Mark LILA GRACE
Goods and Services IC 016. US 002 005 022 023 029 037 038 050. G & S: Blank journals; Brag books. FIRST USE: 20091012. FIRST USE IN COMMERCE: 20091012
Registration Number 3878858
International Registration Number 1239502
Registration Date November 23, 2010

Word Mark LILA GRACE
Goods and Services IC 004. US 001 006 015. G & S: Candles. FIRST USE: 20190204. FIRST USE IN COMMERCE: 20190204
Serial Number 87795982
Filing Date February 13, 2018
Published for Opposition July 10, 2018
Registration Number 5852488

Word Mark LILA GRACE
Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Body oils; Body scrub; Bubble bath; Cosmetics; Shower gel; Non-medicated bath salts; Non-medicated skin care preparation, namely, body mist. FIRST USE: 20120110. FIRST USE IN COMMERCE: 20120110
Serial Number 88109937
Filing Date September 9, 2018
Published for Opposition January 22, 2019
Registration Number 5841082

Word Mark LILA GRACE
Goods and Services IC 025. US 022 039. G & S: Slippers. FIRST USE: 20150503. FIRST USE IN COMMERCE: 20150503
Serial Number 88040520
Filing Date July 17, 2018

Published for Opposition March 5, 2019

Registration Number 5846797

Word Mark **LILA GRACE**

Goods and Services IC 025. US 022 039. G & S: Sleep masks. FIRST USE: 20190204. FIRST USE IN COMMERCE: 20190204

Serial Number 88110882

Filing Date September 10, 2018

Published for Opposition March 5, 2019

Registration Number 5846925

EXAMINING ATTORNEY'S REASON FOR REFUSAL

Registration Refused – Unacceptable Specimen of Use

Registration is refused because the specimen does not show the mark in the drawing in use in commerce in International Class 3, which is required in the statement of use. 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), 1301.04(g)(i). The mark appearing on the specimen and in the drawing must match; that is, the mark in the drawing “must be a substantially exact representation of the mark” on the specimen. See 37 C.F.R. §2.51(b); TMEP §807.12(a).

In this case, the specimen displays the mark as “LILAGRACE”. However, the drawing displays the mark as “LILA GRACE”. The mark on the specimen does not match the mark in the drawing because the terms “LILA” and “GRACE” are depicted as a single, compound term with no space separating the terms, while the mark drawing depicts the terms as two separate terms. Applicant has thus failed to provide the required evidence of use of the mark in commerce. See TMEP §807.12(a).

REPLY TO REFUSAL

A. APPLICANT'S USE OF THE MARK LILA GRACE AS PROVIDED TO THE USPTO IN SUPPORT OF THE APPLICATION FOR REGISTRATION FULLY COMPLIES WITH TRADEMARK ACT SECTIONS 1 AND 45, 15 U.S.C. §§1051-1052, 1127; 37 C.F.R. §§2.34(A)(1)(IV), 2.56(A); TMEP §§904, 904.07(a), 1301.04(g)(i)

Trademark Act Section 1(a)(1), 15 U.S.C. § 1051(a)(1), requires an applicant to submit specimens of its mark as used. See also Trademark Rules 2.34(a)(1)(iv), 37 C.F.R. § 2.34(a)(1)(iv), and 2.56(a), 37 C.F.R. § 2.56(a) (“An application under section 1(a) of the Act . . . must [] include one specimen per class showing the mark as used on or in connection with the goods or services.”). An applicant also is required to submit a drawing, which “must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). “[T]he determination of whether a mark shown in the drawing is a substantially exact representation of the mark shown on the specimen is ‘assuredly a subjective one.’” *In re wTe Corp.*, 87 USPQ2d 1536, 1539 (TTAB 2008) (quoting *In re R.J. Reynolds Tobacco Co.*, 222 USPQ 552, 552 (TTAB 1984)). Indeed, “each case presents its own unique circumstances and requires a judgment as to that particular designation.” *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1146, 1448 (TTAB 2006).

Under the Board's precedent, a drawing displaying only a "minor alteration" of the mark that "does not create a new and different mark creating a different commercial impression" from the matter shown in the specimens is acceptable. *In re Schechter Bros. Modular Corp.*, 182 USPQ 694, 695 (TTAB 1974); see also *In re Frankish Enters. Ltd.*, 113 USPQ2d 1964, 1974 (TTAB 2015) (quoting *Schechter*). See *In Re Cynthia Dumas*, No. 87345342, 2018 WL 4489516, at *2-3 (Aug. 24, 2018)

In Schechter Brothers Modular Corporation filed an application on December 23, 1970 to register for rain spouts, rain gutters and roof edgings and accessories of prefabricated metal the following:



The specimens filed with the application show the following:



The examiner held that the mark as sought to be registered is a mutilation of the mark as shown on the specimens; that to separate the shadow image of the word portion from the remainder of the mark creates a separate commercial impression than as actually used; and that a new drawing or new specimens in accordance with the drawing of the mark be presented. Applicant did not file a new drawing or new specimens and the request for registration was refused and made final. Applicant appealed. It is applicant's position that the subject matter of the application does not in any way destroy the commercial impression engendered by the total composite mark shown in its specimens. Applicant submits that the impression created by the mark as shown in its specimens is essentially what it is attempting to register in that the omission of the shadow image of the word portion does not obliterate or destroy the mark. The TTAB agreed with the Applicant. See *In Re Schechter Bros. Modular Corp.*, 182 U.S.P.Q. (BNA) ¶ 694 (T.T.A.B. Apr. 22, 1974).

Here, Applicant filed for registration of the standard character mark LILA GRACE, in Class 3 for Body oils; Body scrub; Bubble bath; Cosmetics; Shower gel; Non-medicated bath salts; Non-medicated skin care preparation, namely, body mist. Applicant submitted the following pictures of products it sells showing use of the mark:



The mark is displayed on the packaging as follows:



While there is admittedly no space between LILA and GRACE, the use of different fonts gives the commercial impression that the words are separated. To that end, it is noteworthy that the Applicant owns the following registrations for LILA GRACE (see attached) ALL of which relied upon submitted specimens that showed the mark used exactly as in the present application:

- Reg. No. 5,789,738, CLASS 21: Bath products, namely, loofah sponges
- Reg. No. 5,752,522, CLASS 16: Agendas; Notepads; Photo albums; Stationery; Blank journals
- Reg. No. 5,699,009, CLASS 21: Drinking cups; drinking cups sold with lids therefor; mugs
- Reg. No. 4,731,637, CLASS 25: Bathrobes

Reg. No. 4,214,519, CLASS 3: Antibacterial Soap; Bar Soap; Hand Lotions; Hand Soaps; Reeds and Scented Oils Sold as a Unit for Use in Room Scent Diffusers
Reg. No. 3,878,858, CLASS 16: Blank Journals; Brag Books
Reg. No. 5,852,488, CLASS 4: Candles
Reg. No. 5,841,082, CLASS 3: Body oils; Body scrub; Bubble bath; Cosmetics; Shower gel; Non-medicated bath salts; Non-medicated skin care preparation, namely, body mist.
Reg. No. 5,846,797, CLASS 25: Slippers
Reg. No. 5846925, CLASS 25: Sleep masks

There must be determination whether the mark as shown in the drawing is a substantially exact representation of the mark shown in the specimens, that is, if they “are basically the same marks creating the same impressions.” *In re Schechter Bros. Modular Corp.*, 182 USPQ 694, 695 (TTAB 1974). “[E]ach case presents its own unique circumstances and requires a judgment as to that particular designation.” *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446, 1448 (TTAB 2006); see *In Re Herschend Adventure Holdings, LLC*, No. 87562135, 2019 WL 646096, at *4 (Jan. 15, 2019). While the neither the Trademark Examining Attorney nor the Board are bound to approve for registration an Applicant's mark based solely upon the registration of other assertedly similar marks ... having unique evidentiary records.” *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); see also *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits ... Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.”). *In Re Starbucks Corp.*, No. 85792872, 2019 WL 646085, at *7 (Jan. 17, 2019). However, each of those cases did not deal with the same applicant and the same mark at issue.

For the reasons stated, the submitted specimen should be accepted as demonstrating use in commerce of the applied for mark.