

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Johnson & Johnson :  
Serial No.: 87/458,905 :  
Mark: NEUTROGENA : Won T. Oh  
Filing Date: May 22, 2017 : Examining Attorney  
Our Ref: J&J 1904524 : Law Office 114

**RESPONSE TO OFFICE ACTION**

This is in response to the Office Action mailed on December 4, 2018.

Applicant’s specimen of use has been rejected based on the contention that it does not show the mark in the drawing in use in commerce. Specifically, the Office action states that “the specimen displays the mark as ‘NEUTROGENA SKIN360’” but the “drawing displays the mark as ‘NEUTROGENA’”.

Applicant respectfully disagrees and submits that the mark on the specimen and substitute specimens attached herein match the mark in the drawing. However, in order to advance prosecution, Applicant has submitted substitute specimens demonstrating use of the mark and submits that these should be accepted by the Office.

The substitute specimens comprise the following two images:

Substitute Specimen #1



Substitute Specimen #2



These substitute specimens attached herein support the notion that NEUTROGENA is separable from the phrase NEUTROGENA SKIN360 and consequently, support registration of NEUTROGENA. The first substitute specimen, which is Applicant's webpage describing the mobile application and how it works, shows Applicant's mark NEUTROGENA and on a separate line than SKIN 360, which appears below Applicant's mark. The second substitute specimen, which is from Applicant's mobile application, shows Applicant's mark NEUTROGENA separately, in a different font, size and style than SKIN360.

These uses show use of the mark in connection with the goods in the application. In these, NEUTROGENA is separated from other elements, either by showing this term alone on a different line or by showing this in a different font and stylization of wording. The impression to consumers is clear that NEUTROGENA functions alone as a mark for the named goods.

The specimens show the manner in which the mark is seen by the public, and consumer impression is paramount as that is the determining factor in accepting specimens. T.M.E.P. Section 904. In this respect, the impression created clearly supports registration of NEUTROGENA. Applicant's NEUTROGENA mark is *very* well known to consumers and the public at large. Founded in 1930, Neutrogena's long line of skin care, hair care and cosmetics products are distributed in more than 70 countries. With a recorded revenue of US\$16 billion in 2010 and dozens of A-list celebrity-endorsements throughout the years, including Nicole Kidman, Jennifer Garner, Kristen Bell and Kerry Washington, Neutrogena is a hugely popular brand for men and women of all ages. **See Exhibit A.** The NEUTROGENA brand's popularity in the beauty industry is further evident by Applicant's ownership of nine trademark registrations and one trademark application for the NEUTROGENA mark in connection with Class 3 goods, which does not even include the dozens and dozens of marks Applicant owns for NEUTROGENA-formative marks in

this sector. **See Exhibit B.** Evidently, therefore, Applicant's NEUTROGENA mark is a standalone brand and consumer perception views NEUTROGENA as a separable element on the specimens and in the phrase NEUTROGENA SKIN360.

The fact that consumer perception views NEUTROGENA as a separable element can be further evidenced with the media coverage of the mobile application launch, the subject goods of the trademark application. Multiple sources wrote about the product launch by referring to the mobile application as the NEUTROGENA app since this is the household brand recognized by consumers worldwide. **See Exhibits C-F.** Not only do media sources refer to Applicant's product simply as the NEUTROGENA app, but a Google search for "neutrogena app" results in the top hits being those of Applicant's subject product and said media channels. **See Exhibit G.**

As such, the specimens support use of NEUTROGENA in commerce for the named goods and the appearance of the additional term SKIN360 does not change this impression, nor does it serve to make the specimens, and especially the substitute specimens, not match the mark as applied for.

### **CONCLUSION**

For all of the foregoing reasons, Applicant's mark should be entitled to register. Applicant therefore respectfully requests that the refusal of registration be withdrawn and that its application be approved for publication.