

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: September 21, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Mastronardi Produce, Ltd.

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Serial No. 77322943

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Kurt Koenig of Koenig & Associates for Mastronardi Produce, Ltd.

Shaila E. Settles, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Quinn, Cataldo and Wolfson,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Mastronardi Produce, Ltd. filed an application, as amended, to register in standard characters the mark MEDLEY on the Supplemental Register for "fresh, raw and unprocessed tomatoes, fresh tomatoes; raw tomatoes; unprocessed tomatoes; fresh, raw and unprocessed vegetables" in International Class 31.<sup>1</sup>

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<sup>1</sup> Application Serial No. 77322943 was filed on November 6, 2007, on the Principal Register, based upon applicant's assertion of a bona fide intent to use the mark in commerce. Applicant subsequently filed an allegation of use asserting April 17, 2009

The trademark examining attorney has refused registration on the Supplemental Register on the ground that the mark as it appears in the drawing is not a substantially exact representation of the mark as it appears on the specimen submitted with the allegation of use.<sup>2</sup> When the requirement was made final, applicant appealed. Applicant and the examining attorney filed main briefs on the issue under appeal and applicant filed a reply brief.

The specimen submitted in connection with the Class 31 goods is reproduced below.



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as a date of first use of the mark in commerce, and amended the application to seek registration on the Supplemental Register.<sup>2</sup> As noted in the Board's October 15, 2010 order clarifying the issue on appeal, various other matters were raised during prosecution of the involved application but subsequently were resolved or withdrawn.

It is well-settled that an applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. See *Institut National des Appellations D'Origine v. Vintners International Co. Inc.* 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); and *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). If the portion of the mark sought to be registered does not create a separate and distinct commercial impression, the result is an impermissible mutilation of the mark as used. See, e.g. *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

As noted by our primary reviewing Court in *Chemical Dynamics, supra* at 1829, quoting 1 J. T. McCarthy, *Trademarks and Unfair Competition* §19:17 (2d ed. 1984), the issue of mutilation "all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself." In making these determinations, we are mindful of the fact that in an application under Section 1 of the Trademark Act, the applicant has some latitude in selecting the mark it wants to register. TMEP §807.12(d) (7th ed.

October 2010).

In this case, we agree with the examining attorney that the mark as it appears on the specimen for applicant's goods consists of the words GOURMET MEDLEY. We are not persuaded that the term MEDLEY in applicant's specimen creates a commercial impression and thus a trademark that is separate and distinct from the term GOURMET. *Cf. Institut National des Appellations D'Origine, supra.* Rather, the terms GOURMET and MEDLEY appear next to one another approximately the same size in highly similar font in such a manner as to create the impression of the single mark GOURMET MEDLEY. We are not persuaded by applicant's argument that because "the word GOURMET is obviously devoid of any source-indicating significance and would require a disclaimer if it were to be included,"<sup>3</sup> individuals encountering the specimen for its goods will recognize that its mark consists only of MEDLEY. First, applicant's assertions regarding the source-indicating ability of the term GOURMET are not supported by evidence. More importantly, the disclaimer of matter in a mark does not have the effect of removing the matter from the mark. *See Bordon, Inc. v. W.R. Grace & Co., 180 USPQ 157 (TTAB 1973).*

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<sup>3</sup> Applicant's brief, unnumbered p. 3.

On the contrary, regardless of the significance of the term GOURMET as applied to applicant's goods, individuals viewing the specimen for applicant's goods will see that the mark consists of the unitary phrase GOURMET MEDLEY. In a similar fashion, the slight differences in font and capitalization between the two terms comprising the mark do not suffice to create a separate and distinct commercial impression in the term MEDLEY such that it would be perceived as a mark, particularly inasmuch as it is immediately preceded by GOURMET in the specimen of use submitted by applicant. The proximity of these terms to one another in applicant's specimen and the manner in which they are displayed creates a single commercial impression in the mark GOURMET MEDLEY.

In short, the mark as it is displayed in applicant's drawing omits a salient feature of the mark as it is used by applicant on the specimen for its goods, namely, the term GOURMET. As a result, the drawing of the mark is an impermissible mutilation of the mark as used on or in connection with the goods. See *In re Miller Sports Inc.*, *supra*.

In view of the foregoing, we find that the mark shown in the drawing is a mutilation of the mark as shown on applicant's specimen for its goods.

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Decision: The refusal to register on the ground that the mark in applicant's drawing does not match the mark as displayed on the specimen submitted with applicant's allegation of use is affirmed.