

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

Mailed: May 18, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cutting Edge Beverages, LLC

Serial No. 77420157

Mark G. Kachigian of Head, Johnson & Kachigian for Cutting Edge Beverages, LLC.

Andrew Rhim, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Bucher, Kuhlke and Walsh, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Cutting Edge Beverages, LLC has filed an application to register, on the Principal Register, the mark shown below, for goods ultimately identified as "soft drinks, namely, carbonated and non-carbonated soft drinks" in International Class 32.



The application includes the following description of the mark: The mark consists of the Universal prohibition symbol, a circle with a diagonal line going from the upper left to the lower right of the inside of the circle.

The application was filed on March 12, 2008, based upon an allegation of an intention to use the mark in commerce. 15 U.S.C. §1051(b). On March 15, 2009, applicant filed a statement of use accompanied by a specimen of use. Upon examination of the statement of use, the examining attorney refused registration of the mark on the ground that the mark shown in the drawing does not agree with the use of the mark on the specimen. In view of the differences between the mark sought to be registered and the mark shown in the specimen, the examining attorney required that applicant submit a substitute specimen properly showing the mark as used. In addition, the examining attorney stated that applicant may not submit an amended drawing to conform to the display of the mark on the specimen because the character of the mark would be materially altered.

When the refusal was made final, applicant appealed. We affirm the refusal to register.

The sole issue before us is whether the mark, as it appears in the drawing in the application, is a substantially exact representation of the mark as used on the specimen.¹ Trademark Rule 2.51(b).

The mark as it appears on applicant's specimen is reproduced below.



The examining attorney argues that:

...the wording shown on the specimen is physically connected to the universal prohibition symbol. The word CRASH is prominently displayed in large letters in the center of the universal prohibition symbol - this word in fact appears on top of the diagonal slash of the universal prohibition symbol, partially obscuring some of the diagonal slash. The wording ENERGY and SCIENCE appears within the physical space of the universal prohibition symbol and the word CRASH is centered on top of the universal prohibition symbol; therefore, the wording is an integral element of the mark as shown on the specimen.

¹ The examining attorney did not issue a refusal under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127 for failure to function as a mark.

The removal of this wording would alter the commercial impression of the mark. The display of the design and wording as shown on the applicant's specimen supports the conclusion that the universal prohibition symbol is not a separable element that makes a distinct and separate commercial impression apart from the wording on the specimen, but rather the universal prohibition symbol is so intermingled with the wording as to create a single and unitary commercial impression.

Br. p. 3.

Further, the examining attorney asserts that consumers regularly encounter the universal prohibition symbol shown together with accompanying wording and, therefore, would likely view the design and wording on applicant's specimen as integral parts of a unitary mark. Br. p. 4. In support of this position, the examining attorney submitted excerpts from web pages describing the use of the universal prohibition symbol with accompanying wording, as follows.

The no symbol... is a circle with a diagonal line through it ... surrounding a pictogram used to indicate something is not permitted. ...the "prohibition sign" has been so widely used in advertising and promotions that now any variation of the design flipped left or right or varied in hue is considered acceptable and recognized by the general public as a symbol of prohibition...

www.wikipedia.org/wiki/No_symbol.

The examining attorney concludes that:

...the applicant's drawing of the universal prohibition symbol conveys a commercial impression of a symbol that could have various different meanings in relation to the goods, such

as something is not permitted or merely a circle with a diagonal line. ...however, ... the display of the word CRASH over the diagonal slash of the universal prohibition symbol on the specimen conveys the commercial impression of goods where the consumer does not "crash" or does not get tired or fatigued. This commercial impression is reinforced by use of the word ENERGY on the specimen and the appearance of the additional wording "LONG LASTING" and "EXTENDS ENDURANCE" shown beneath the mark on the specimen. Without this wording, the mark shown on the applicant's drawing certainly conveys a different commercial impression.

Br. p. 5.

In traversing the refusal, it is applicant's contention that the mark as shown in the drawing creates a separate and distinct commercial impression apart from the wording. Applicant argues that:

...the extraneous material on the specimen that the Examining Attorney includes in his interpretation of the mark shown on the specimen is not in fact part of the mark because the extraneous material is merely indicative of the variety of the soft drink bearing the mark, and the universal prohibition symbol shown on the specimen makes a separate commercial impression apart from the extraneous material. ...

...the Applicant has elected not to include the words "energy crash science" in its trademark. This is within the Applicant's discretion because the universal prohibition symbol makes a separate and distinct commercial impression apart from the variety designation "energy crash science." The distinction between the brand associated with the universal prohibition symbol and the variety "energy crash science" is relayed to the consumer by the fact that the brand symbol is substantially larger than "energy crash science." Thus, the consumer would recognize the universal

prohibition symbol as the trademark for the drink, with "energy crash science" merely indicating the characteristics of the variety of drink. The universal prohibition symbol mark is not so entwined, either physically or conceptually, with the variety "energy crash science" that it is not separable from it in the mind of the consumer. The universal prohibition symbol presents a separate and distinct commercial impression apart from the variety "energy crash science," and therefore the Applicant should be able to register the universal prohibition symbol as its trademark, pursuant to TMEP Section 807.12(d) and substantial case law.

Br. pp. 4-8.

Trademark Rule 2.51(b) provides that "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods..." 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.*, 939 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

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the mark as used. As noted by our primary reviewing Court, 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 [and] the portion sought to be registered...performs the trademark function of identifying the source of the merchandise to the customers." Chemical Dynamics, 5 USPQ2d at 1829, quoting 1 J.T. McCarthy, Trademarks and Unfair Competition 909 (2d ed. 1984). We must decide each case on the unique facts of the particular case. In re Pharmavite LLC, 91 USPQ2d 1778, 1781 (TTAB 2009).

We agree with the examining attorney that the design shown in the drawing does not create a separate commercial impression apart from the wording as displayed on the specimen. Given the ubiquitous use of the universal prohibition symbol in conjunction with wording or another design to convey the meaning "NO," as to a particular thing, and due to the presentation of the mark encompassing the wording with the word CRASH superimposed over the diagonal slash, consumers would perceive the display on the specimen as a unitary message NO CRASH or NO ENERGY CRASH SCIENCE and not merely the design without meaning or meaning only "NO." The design element here is not simply a background or carrier, but is also an integral part of the

message conveyed by the combination of the design and wording. Thus, it is "not a background design in the usual sense." *Pharmavite*, 91 USPQ2d at 1781. As in *Pharmavite*, the issue here is whether "the alleged mark in applicant's drawing creates a distinct commercial impression separate and apart from the words and designs appearing on the bottles, not whether various elements can be separated in any physical sense." *Id.* Here, the words are "essential to the commercial impression" of the universal prohibition symbol. *Id.* See also *In re Yale Sportswear Corp.*, 88 USPQ2d 1121 (TTAB 2008) (standard character mark UPPER 90 different in connotation, pronunciation and appearance from UPPER 90° because degree symbol substantially changes overall impression of the mark).

Accordingly, we find that the universal prohibition design does not create a separate and distinct commercial impression, at a minimum, apart from the word "CRASH."

In view of the foregoing, we find that the mark shown on the drawing is not a substantially exact representation of the mark shown on the specimen.

Decision: The refusal to register is affirmed.