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PRECEDENT OF THE TTAB

Mailed: May 2, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Frito-Lay North America, Inc.

Serial No. 78555200

Joseph J. Ferretti, Esq. for Frito-Lay North America, Inc.

Christopher L. Buongiorno, Trademark Examining Attorney,
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Before Quinn, Walters and Wellington, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark LAY'S GET YOUR SMILE ON, in standard character
form, for "potato-based snack foods, namely, potato chips
and potato crisps," in International Class 29.¹

¹ Serial No. 78555200, filed January 27, 2005, based on an
allegation of a bona fide intention to use the mark in commerce.
Trademark Act Section 1(b), 15 U.S.C. §1051(b). On June 21,
2006, applicant filed a statement of use alleging first use and
use in commerce as of January 1, 2005, and a specimen of use.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark in the drawing is not a substantially exact representation of the mark as it appears on the specimen of record. See Trademark Act Section , 15 U.S.C. §1051. The appeal is fully briefed. After careful consideration of the evidence and arguments of record, we reverse the refusal to register.

The specimen of record is shown below:



The portion of the applied-for mark consisting of LAY'S in a circle, as shown on the back of the package above and as a separate mark on the front of the package above, includes the symbol ® to the lower right of the red banner. The portion of the applied-for mark consisting of GET YOUR

SMILE ON!, as shown on the back of the package above, includes the symbol TM immediately following the phrase and exclamation mark.

The examining attorney argues that the applied-for mark actually consists of two marks, LAY'S and GET YOUR SMILE ON! and, as such, cannot be the subject of a single application. He references applicant's Registration No. 3152119, for the mark shown below for the same goods and with the same specimen as herein, as evidence that applicant recognizes this application contains two separate marks. The examining attorney states "[t]he specimen shows a portion of the standard character mark within design elements" and "[i]n essence, applicant's filing of two applications for marks with identical wording but one mark containing a portion of the mark within design elements and the other mark simply a standard character mark affirms that the refusal is sound." (Office Action, March 21, 2007.)



Applicant argues that the applied-for mark is a single registrable composite mark. Applicant acknowledges that

this composite mark includes its house mark, but contends that the components appear as a single mark in close proximity to one another. Applicant notes that it owns several registrations for standard character composite marks, including, for example, LAY'S SENSATIONS (Registration No. 3105055), BAKED LAYS (Registration No. 2158860), and LAY'S WOW! (Registration No. 2219090). The specimens of use submitted in each of the applications consist of snack food packaging and the marks appear on the packaging with the house mark LAY'S in proximity to the additional word in each mark.

There is no question that an application must be limited to one mark. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.52; and see *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999), and authority cited therein. If, based on the specimen of use, matter included in the drawing of a mark is not part of the mark, such matter must be deleted from the mark in the drawing, as long as the deletion does not materially alter the mark. See *In re Sazerac Co., Inc.* 136 USPQ 607 (TTAB 1963) (design mark including words TORADO TEQUILA - manner of display of TEQUILA on specimen of use is distinctly different from that of TORADO, which emphasizes their disunity, thus, applied-for matter is not composite mark).

The question in this case is whether the applied-for mark is a registrable unitary composite mark engendering a unique and distinct commercial impression. See *In re Walker-Home Petroleum, Inc.*, 229 USPQ 773 (TTAB 1985). Applicant cites to cases involving mutilation; however, the issue in this case is the converse of the situation where the applied-for mark is missing integral subject matter as shown on the specimen and, thus, the applied-for mark is deemed to be a mutilation of the mark as used.

The issue is resolved by comparing the specimens to the drawing and our analysis is necessarily subjective. See *In re Jordon Industries, Inc.*, 210 USPQ 158 (TTAB 1980) citing *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977). The specimens of use presumably show how the average purchaser will encounter the mark under normal marketing conditions and, as such, the specimens are suggestive of the reaction of the average purchaser to this display of the mark. See *In re Magic Muffler Service, Inc.*, 184 USPQ 125 (TTAB 1974).

There is no limitation on the number of trademarks that may appear on a specimen and serve to identify the source of the product. See *McCarthy on Trademarks and Unfair Competition*, §7.6 (2008). Likewise, there is no prohibition against components of a mark being registered

separately and in combination with other elements as long as the elements of the applied-for mark do not appear on the specimen of use in such a manner that these elements would be perceived as constituting multiple marks, i.e., separate commercial impressions. The word LAY'S in the circular design with banner appears separately on the front of the packaging and it is clearly applicant's house mark. However, our analysis does not end with this observation. On the back of the packaging, the LAY'S design appears immediately above the phrase GET YOUR SMILE ON!. The phrase is curved up at the ends like a smile and it both follows the contour of the circular LAY'S design and it is in close proximity thereto. Therefore, we conclude that the commercial impression fostered by applicant on the specimen of use is that of a single unitary mark.

Contrary to the examining attorney's contention, the fact that applicant has registered the same mark in the design format shown on the specimen of use is irrelevant to a determination of whether the elements of the applied-for mark comprise a single mark. Nor is this a situation where the manner of use of the mark on the specimens includes an essential element that cannot be produced by the use of standard characters.

Decision: The refusal to register is reversed.