

This Opinion is Not a
Precedent of the TTAB

Hearing: November 30, 2021

Mailed: March 17, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Nittany Corporation
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Serial No. 88439889
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Timothy D. Pecsénye of Blank Rome LLP,
for Nittany Corporation.

Elaine Xu, Trademark Examining Attorney, Law Office 128,
Travis Wheatley, Managing Attorney.

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Before Shaw, Kuczma, and Dunn,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Nittany Corporation (Applicant) seeks registration on the Principal Register of the mark WEGE (in standard characters) for “beer” in International Class 32.¹

¹ Application Serial No. 88439889 filed May 21, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

Citations to the examination record are to the downloadable .pdf version of the documents in the USPTO’s online Trademark Status and Document Retrieval system (TSDR). Citations to TTABVUE are to the Board’s public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

The application states that the English translation of the word “WEGE” in the mark is “ways,” and claims ownership of Registration Nos. 2527187, 2230831, and 1493363 for the mark WEGE in standard characters, stylized form, and with a pretzel design, all for “snack foods, namely, pretzels.”

The Trademark Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. § 1051 and 1127, on the ground that the required specimen failed to show the applied-for mark in use in commerce with the goods.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Relevant Chronology

The notice of allowance of the application issued November 19, 2019 and required Applicant to file a statement of use, or to seek an extension of time to do so, within six months. Trademark Act Section 1(d), 15 U.S.C. 1051(d). Applicant did not seek an extension, making May 19, 2020 the deadline to meet the requirements for the statement of use. *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1525 (TTAB 2016). Applicant filed its Statement of Use on November 26, 2019 alleging June 28, 2019 as its dates of first use, and describing the accompanying specimen as an “Image of applicant’s product packaging showing the mark used in direct connection with the goods outlined in class 32.”

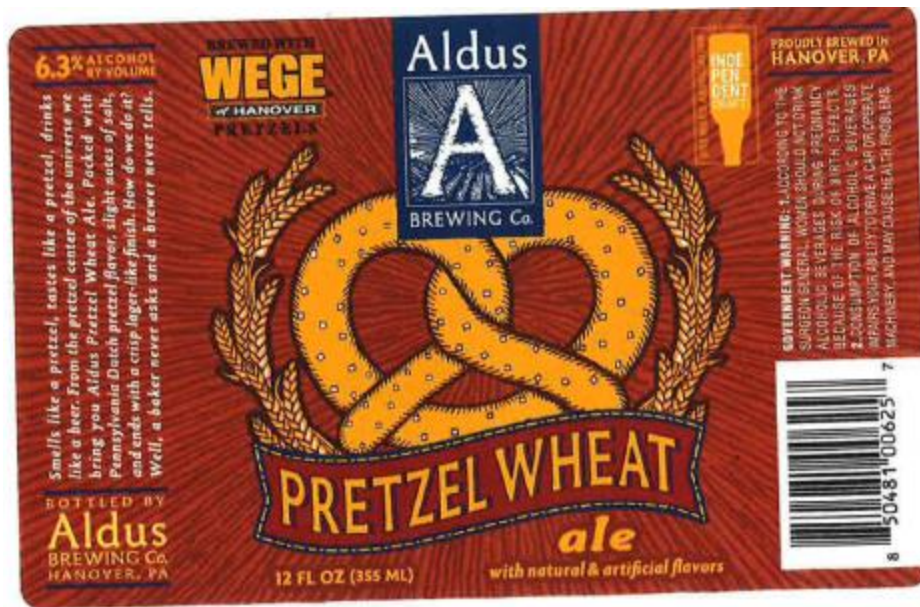


Figure 1 Applicant's November 26, 2019 specimen of use



Figure 2 Enlarged view of mark on Applicant's November 26, 2019 specimen of use

On December 9, 2019, the Examining Attorney informed Applicant by email that the specimen appears to show that Applicant is making pretzels for beer, and not beer, and recommended that the goods be amended to read “pretzels sold as an integral brewed ingredient of beer.” On the same day, following Applicant’s response declining to approve the recommended amendment, the Examining Attorney issued

an Office Action refusing registration for failure to submit the required specimen showing the mark in use in commerce with “beer.”

On June 9, 2020, Applicant filed a response which contended that the initial specimen was acceptable and also submitted a substitute specimen described as “a photograph of beer showing the WEGE mark appearing on beer bottle labels and product packaging.”²



² The response included a declaration that the substitute specimen was in use in commerce prior to expiration of the filing deadline for filing a Statement of Use.

There is no dispute that Applicant only uses the mark WEGE on beer as part of the phrase “BREWED WITH WEGE OF HANOVER PRETZELS.”

II. Requirements for Specimens of Use

Section 45 of the Trademark Act, 15 U.S.C. § 1127, states that a mark is deemed to be in use in commerce:

(1) on goods when

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce.

The classic function of a trademark is to point out distinctively the origin of the goods to which it is attached. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976). The specimens in a trademark application function to verify trademark use, demonstrating that “the asserted mark has been used *as a trademark* with respect to the goods named in the application.” *Id.* at 216 (*emphasis* in original). *See also Eastman Kodak v. Bell & Howell*, 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993) (examination of either a use-based application or an application amended to allege use must address “whether the mark, as displayed in the specimens or facsimiles, functions as a mark”) (quoting legislative history in S. Rep. No. 515, 100th Cong., 2d Sess. 32 (1988)).

The presence of the proposed mark on the goods may create an acceptable specimen as to form, but if the use of the proposed mark on the goods fails to demonstrate the required trademark use, the specimen fails in its purpose. *In re*

Fallon, 2020 USPQ2d 11249 *5 (TTAB 2020) (“We agree with the Examining Attorney that Applicant did not make a sufficient ‘reference to the liner or highlight it in some manner where prospective customers would unquestionably associate the wording THERMAL MATRIX with [the] liner.’”); *In re Minerva Assocs., Inc.*, 125 USPQ2d 1634, 1639 (TTAB 2018) (“The mere fact that a designation appears on the specimens of record does not make it a trademark.”). *See also In re Pa. Fashion Factory, Inc.*, 588 F.2d 1343, 200 USPQ 140, 141 (CCPA 1978) (“the mere fact that appellant’s goods are placed in bags (bearing the words sought to be registered) during a particular phase of the transportation process does not, ipso facto, establish trademark usage of those words.”). In affirming a refusal of registration on the ground that the proposed mark, which appeared on the goods sold in commerce, did not function as a trademark for the goods, the predecessor of the Court of Appeals for the Federal Circuit held:

The question is may a trader in wrappers register as a trade-mark for wrappers a device [the proposed mark BUTTER KRUST] which is obviously intended for one particular article of trade and on its face refers to the article within the wrapper rather than to the wrapper itself? While no exact precedent has been found, this question must be answered in the negative. The meaning of a trade-mark, like a reputation, grows out of the opinions of others and not the opinion or intent of the owner. The ultimate consumer is the man who buys the bread, and he would never suppose this mark to refer to the wrapper.

In re Dobeckmum Co., 148 F2d 106, 65 USPQ 39, 39 (CCPA 1945) quoting *Ex parte Adams*, 1918 C.D. 53, 255 O.G. 609 (Comm’r Pat. 1918). *See also In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (“[T]he test for an acceptable website-based specimen, just as any other specimen, is simply that it must in some way evince that the mark is ‘associated’ with the goods and serves as an indicator of source.”).

Whether the prospective purchaser of the goods will perceive a term on the goods as the trademark indicating the source of the goods will vary with the circumstances, including whether more than one term appears on the goods. *In re Walker Process Equip. Inc.*, 233 F.2d 329, 110 USPQ 41, 43 (CCPA 1956) (“While it may be that two or more distinct trade-marks may be applied simultaneously to the same goods, that is clearly not the usual practice, and where, as here, the most prominent feature of a label is a word which is unquestionably a trade-mark, the natural inference would be that the remaining words on the label are not to be considered a trade-mark.”). While there is no bar to multiple marks appearing on goods, the multiple marks may not serve the same source-indicating function to the prospective consumer. *See Amica Mutual Ins. Co. v. R. H. Cosmetics Corp.*, 204 USPQ 155, 161 (TTAB 1979) (“It is well established that a product can bear more than one trademark, that each trademark may perform a different function for consumers and recipients of the product, and that each can be registered providing the mark as used, creates a separate and distinct impression in and of itself and serves to identify and distinguish the product as it is encountered by consumers in the normal marketing milieu for such goods.”).

More specifically, multiple terms on the goods may not indicate multiple marks but a trade name and a trademark. *Walker Process*, 110 USPQ at 43 (finding that term is a trade name and not a trademark supported by presence of a second term acting as a trademark and “the addition of the address of Walker Process Equipment Inc. [which] suggests that the name of the corporation is not being used as a trademark.”). Multiple terms on the goods also may indicate a house mark and a product

mark. *Amica Mutual*, 204 USPQ at 161 (“The usual situation in which this principle [of multiple registrable marks] has normally been applied ... involves a house mark which normally serves to identify the source of the product, per se, and a product mark which serves to identify a particular product within a line of merchandise normally associated with and distinguished by the house mark.”).

In addition, multiple marks on the goods may indicate the source of different goods and services. *See In re Bose*, 192 USPQ at 216 (“[I]t is quite apparent that, in the specimens of record, only INTERAUDIO identifies the loudspeaker systems for high-fidelity music reproduction as originating with appellant and distinguishes such goods from those manufactured and sold by others. The mark SYNCOM merely relates to a speaker-testing computer.”); *In re Supply Guys, Inc.*, 86 USPQ2d 1488, 1493 (TTAB 2008) (“Here, we note that the term LEADING EDGE TONERS is used [on Applicant’s webpage] in phrases where other trademarks, which appear to be owned by third parties, are used to identify the toners and other goods. The mere fact that applicant is a retailer selling products of others does not by itself establish that applicant’s mark, which may function as its trade name or service mark, necessarily also functions as a trademark for the goods applicant sells.”); *Safe-T Pacific Co. v. Nabisco, Inc.*, 204 USPQ 307, 315 (TTAB 1979) (“The principle can be extended one step further to allow the inclusion on the product of the distributor’s trademark and trade name along with the manufacturer’s trademark so long as the effect thereof upon customers and prospective customers is not to confuse them as to the source of the goods or to obliterate the distinction between the distributor and the

manufacturer which is necessary to give validity and vitality to this concept”); *Yard-Man, Inc. v. Getz Exterminators, Inc.*, 157 USPQ 100, 107 (TTAB 1968) (“It is quite apparent from this record that Yard-Man did not abandon the mark ‘YARD-MAN’ during this period, and it is likewise clear that as a result of Yard-Man’s efforts to maintain its identity as the manufacturer of the goods that the purchasing public was in no way deceived, confused, or misled by the association of ‘CRAFTSMAN’ and ‘YARD-MAN’ or ‘A Product of Yard-Man, Inc.’, they recognized ‘CRAFTSMAN’ as the mark of the merchant and ‘YARD-MAN’ as the mark of the manufacturer.”).

In sum, the common use of multiple terms on the goods requires careful consideration of how those terms will be perceived by the prospective consumer of the goods. Demonstrating a technical trademark use by affixing a term to the goods in and of itself does not serve the essential specimen purpose of verifying use of the mark by showing that the mark “has been used as a trademark with respect to the goods named in the application.” *Bose* at 216. The “basic consideration” is whether the mark as used conveys to consumers “the purpose of the mark, namely whether it indicates the source to be the manufacturer or the merchandiser or distributor of the goods.” *Amica Mutual*, 204 USPQ at 161.

The consideration of multiple terms on a trademark specimen does not alter if the use is termed “co-branding.” Because it was raised by Applicant at oral argument, we briefly address a current term for the use of multiple marks on goods or services to designate marketing by multiple sources. The term “co-brand” is defined as “to market or issue (something, such as a credit card) in conjunction with another

company so that the product bears the name of both.”³ There is nothing in the definition which suggests that the multiple marks appearing on co-branded goods all function to indicate a single source for the goods, rather than functioning to indicate multiple sources for the advertisement. In fact, Applicant’s brief⁴ confirms that co-branding is a marketing tool, asserting that “the well known” WEGE mark “is being used as an enticement to consumers to purchase the product offered in connection therewith,” in this case, beer.

While the concepts are related because trademarks are used in co-branding, a trademark has one owner and is used to designate source, and co-branding by definition is created by multiple parties and is used to market goods or services. While the use of multiple marks also may indicate that the parties have joined to create the goods,⁵ this is not always the case.

To the contrary, the practice of co-branding may reflect multiple purposes or relationships between the owners of the different marks, such as a merger, a license, or a single marketing campaign using different marks to indicate the source of different goods and services. *See AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, *6 (TTAB 2020) (“In 2007, Opposer started a co-branding campaign that

³ Merriam-Webster.com Dictionary, <https://www.merriam-webster.com/dictionary/co-brand>. Accessed 17 Mar. 2022. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

⁴ 8 TTABVUE 10-11.

⁵ *See Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2021 USPQ2d 1069 *10 (Fed. Cir. 2021) (“Between early 2012 and 2016, the parties sold two co-branded kits, manufactured by BBS based on Brewery’s recipes, which “prominently featured both parties’ marks.”).

displayed both the Cingular and AT&T names and logos to educate the American public that Cingular and AT&T were, due to several mergers, now all part of the same company.”);⁶ *The North Face Apparel Corp. v. Sanyang Indus. Co., Ltd.*, 116 USPQ2d 1217, 1231 (TTAB 2015) (“Mr. Munro testified that ‘in the past’ Opposer licensed its marks to General Motors for a sport utility vehicle which was co-branded as ‘The North Face edition of a Chevrolet Trailblazer’”);⁷ *Nat’l Pork Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1487 (TTAB 2010) (“As an example of added synergy, both retailers and food manufacturers have participated with opposers in co-branded advertising campaigns that promote the mark THE OTHER WHITE MEAT in conjunction with their own products and/or services.”).⁸

Whether termed the use of “multiple marks” or “co-branding,” our determination on the sufficiency of the required specimens of use must assess whether the use of Applicant’s mark acts as a source indicator for the goods listed in the application.

⁶ See also *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1465 (TTAB 2014) (“Petitioner sold its volume discount buying services to Burke Healthcare and co-branded the PERKSCARD.”).

⁷ See also *In re Trek 2000 Int’l Ltd.*, 97 USPQ2d 1106, 1110 (TTAB 2010) (“Applicant authorizes other companies to co-brand and sell USB storage devices bearing the THUMBDRIVE trademark in the United States, including Memorex, Creative Technology Ltd., Imation, Iomega and TEAC.”); *Nike, Inc. v. WNBA Enter., LLC*, 85 USPQ2d 1187, 1191 (TTAB 2007) (“Opposer sells its merchandise under its private brand, and is also licensed to co-brand its merchandise with the names and logos of sports leagues and teams”).

⁸ See also *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1749 (TTAB 2006) (“Starbucks also has engaged in co-branding and strategic partnership marketing with firms such as Hewlett-Packard (‘HP’), T-Mobile, BankOne Corporation and VISA.”).

III. Analysis

Registration was refused because the specimens of use do not show use of the mark WEGE in commerce as a source indicator for beer. The various specimens – the label, the bottle, the handled box – all show the same use of WEGE as part of the term BREWED WITH WEGE OF HANOVER PRETZELS. In Applicant’s view, the specimens show that the mark WEGE indeed is placed on beer labels and beer containers in compliance with the requirements for use of a mark on goods in commerce. In the Examining Attorney’s view, the specimens show use of the mark with pretzels, and not beer, and so the specimens are unacceptable for failure to show the mark in use in commerce on the goods identified in the application.

We acknowledge that use of a mark on the label or container for beer generally constitutes an acceptable specimen for a beer mark. *See, for example, In re Coors Brewing Co.*, 343 F3d 1340, 68 USPQ2d 1059, 1060 (Fed. Cir. 2003) (“The specimen of use submitted with the application was a color image of a beer label displaying the mark.”). However, as discussed, the mere presence of the proposed mark WEGE on Applicant’s beer label or box does not address the fundamental question of whether the use functions as a trademark to indicate the source of Applicant’s beer. We find that it does not.

The consumer encountering Applicant’s beer with the prominent “A design and ALDUS BREWING CO.” logo in close proximity to the words “pretzel wheat ale” and the smaller, physically separate designation “BREWED WITH WEGE OF HANOVER PRETZELS” will perceive the “A design and ALDUS BREWING CO.”

logo as the trademark for the beer, and the phrase “BREWED WITH WEGE OF HANOVER PRETZELS” as indicating the source of the pretzels with which the beer is brewed. To be clear, there is nothing inherent to the term WEGE which prevents it from functioning as a beer trademark. It is Applicant’s choice to directly associate WEGE with pretzels by only using WEGE as part of “BREWED WITH WEGE OF HANOVER PRETZELS” which prevents the association between WEGE and beer.⁹ *See Bose*, 192 USPQ at 216 (“The specimens which are of record fail to support, indeed they contradict, the use of SYNCOM as a trademark with respect to loudspeaker systems for high-fidelity music reproduction.”); *Fallon*, at *5 (“We agree with the Examining Attorney that Applicant did not make a sufficient ‘reference to the [goods] or highlight it in some manner where prospective customers would unquestionably associate the wording THERMAL MATRIX with [the goods].’”).

In sum, we have carefully examined the specimens submitted by Applicant, and agree with the Examining Attorney that none of the specimens show use of the mark WEGE to indicate the source of beer.

IV. Decision

The refusal to register Applicant’s mark WEGE for “beer” under Sections 1 and 45 of the Trademark Act for failure to submit an acceptable specimen of use is affirmed.

⁹ In this regard we note that Applicant’s brief ignores the exclusive use of WEGE as part of the phrase “BREWED WITH WEGE OF HANOVER PRETZELS,” and so offers no explanation as to what impact the wording as a whole will have on the perception of the purchasing public.