

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
October 27, 2009

Mailed:
January 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re E.A. Sween Company

Serial No. 77048091

Stephen Baird, Esq. of Winthrop & Weinstine, P.A. for E.A.
Sween Company

Nakia D. Henry, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Grendel, Walsh and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark DELI EXPRESS SAN LUIS, in standard character
form, for "burritos; snack cakes; and snack rolls, namely,
sweet rolls" in International Class 30.¹

¹ Serial No. 77048091, filed November 20, 2006, based on an
allegation of first use and use in commerce as of January 30,
1990.

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 1(d)(1), 15 U.S.C. § 1051, 37 C.F.R. § 2.51.

The appeal has been fully briefed and, on October 27, 2009, an oral hearing was held. After careful consideration of the evidence and arguments of record, we affirm the refusal to register.

"An application under section 1(a) of the Act ... must ... include one specimen showing the mark as used on or in connection with the goods..." Trademark Rule 2.56(a). Trademark Rule 2.51(b) provides that (**emphasis added**):

(b) In an application under section 1(b) of the Act, the drawing of the mark must be a **substantially exact representation** of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

The specimen of record is shown below:



The specimen is clearly a photograph of a packaged "sweet roll." The portion of the proposed mark consisting of DELI EXPRESS is in the top left corner of the label, in a red and yellow border and with the registration symbol ® in the lower right of the red banner. The portion of the proposed mark consisting of SAN LUIS, appears to the right with a green background following a stylized yellow triangle and is also immediately followed by the registration symbol ®.

Applicant notes that it is the owner of existing registrations for marks DELI EXPRESS (Reg. Nos. 1220359 and

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1265869) and SAN LUIS (Reg. No. 1665521).² Applicant argues that its proposed mark is merely a composite of these previously-registered marks and that it is "free to choose the elements of its composite mark that it wants to register," citing to TBMP § 807.12(d) (2d ed. rev. 2004). Brief, p. 5. Applicant also argues that the specimen "depicts the words on the same horizontal plane" and that "consumers will naturally read the terms together." *Id.*

The examining attorney, on the other hand, argues that the proposed mark "as conveyed on the specimen, demonstrates two separate commercial impressions, in particular, the 'Deli Express' and the 'San Luis' [elements]." Brief, at (unnumbered) p. 3. Accordingly, the examining attorney concludes, the "proposed mark does not match or create a substantially exact representation of the submitted specimen." *Id.* at 5.

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). And, as applicant argues, an owner of previously-registered marks is not prohibited from combining any (or all) elements of those registered

² Applicant claimed ownership of these registrations during the prosecution of the application and submitted copies of other registrations that it owns.

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marks into a single mark and registering said mark so long as the composite mark appears on the specimen of use in such a manner that the elements would not be perceived as constituting multiple marks, i.e., having separate commercial impressions. The reason for this is that an application must be limited to one mark. 15 U.S.C. §1051(a)(1); 37 C.F.R. §2.52; see also, *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999), and authority cited therein. Thus, the applied-for mark is only registrable if it is a unitary composite mark engendering a unique and distinct commercial impression. See *In re Walker-Home Petroleum, Inc.*, 229 USPQ 773 (TTAB 1985).

The question of whether applicant's proposed mark will be perceived as a unitary mark, albeit a composite of elements, or if it will be viewed as constituting multiple marks is essentially specimen-driven. That is, 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

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of the average purchaser to this display of the mark. See *In re Magic Muffler Service, Inc.*, 184 USPQ 125 (TTAB 1974).

Here, we agree with the examining attorney that the specimen depicts the two literal portions DELI EXPRESS and SAN LUIS in such a manner that consumers would not perceive them as constituting a single composite mark. First, the DELI EXPRESS portion is not only in a different font but is contained within a yellow-background, and then a larger red background, separated from the remainder of the packaging design by a black bar outlining the top left corner of the package. The other literal portion, SAN LUIS, is outside of that border area and is further separated by a fanciful triangle design and placed upon a green background. The term CONCHA appears below these two elements in a lighter green box. Taken together, we find that the impression left by this specimen is that the two elements, DELI EXPRESS and SAN LUIS, are two separate trademarks rather than the single mark shown on the drawing page. Even accepting applicant's assertion that DELI EXPRESS is a house mark, there is nothing about the use of SAN LUIS that suggests that these two elements together form the impression of a single trademark. Consumers are more likely to view DELI EXPRESS as the house mark and SAN LUIS

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as a separate trademark indicating perhaps a line of goods, e.g., food items derived from Mexican or Tex-Mex cuisine. Again, based on the manner in which they are depicted in the specimen, we believe the consumer would perceive the two elements as two different trademarks, rather than a single trademark.

Accordingly, we find that applicant's drawing of the mark is not a substantially exact representation of the mark as used in commerce, Trademark Rule 2.51(a), and that the examining attorney's requirement for a substitute specimen was appropriate.

Decision: The refusal to register is affirmed.