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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HEB Grocery Company, L.P.

Serial No. 76329770

Kirt S. O'Neill and John A. Tang of Akin, Gump, Strauss, Hauer & Feld, L.L.P. for HEB Grocery Company, L.P.

David C. Reihner, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Cissel, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

HEB Grocery Company, L.P. has filed an application to register the designation "MEAL DEAL!" as a service mark for "supermarket services."¹

Registration has been finally refused under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052,

¹ Ser. No. 76329770, filed on October 24, 2001, which is based on an allegation of a date of first use anywhere and in commerce of July 15, 1998.

1053 and 1127, solely on the basis that, as used by applicant in the manner indicated by the specimens, the designation sought to be registered does not function as a service mark to identify and distinguish applicant's services but, instead, is simply "a merchandising slogan." Copies of the relevant portions (in slightly reduced form) of the specimens are reproduced below.

10-24-2001
U.S. Patent & TM Office Mail Receipt # 88

Classic SELECTIONS

KING RANCH STYLE CHICKEN
MAKING SAUCE IN THE OVEN. TASTE THE KING RANCH FLAVOR. SERVED WITH A CRISPY CHICKEN CRUST.
5 SERVINGS
NET WT. 34 OZ. (1.03 LBS. 2 OZ.) 984g

Meal Deal!
buy any H-E-B Classic Selection Entrées
35-40 oz. pkg.
\$5.49 ea.
Choose from: Chicken A La King, Lasagna with Meat Sauce, Vegetable Lasagna, Cheese Lasagna, Stuffed Green Peppers, Beef Stroganoff with Noodles, Chunky Chicken with Noodles, Beef Shepherd's Pie, King Ranch Chicken, Oriental Style Rice with Chicken, Rice with Chicken & Broccoli, and Baked Penne with Meat Sauce.

get free

- **H-E-B Soda**
12 pk., 12 oz. cans, any flavor
- **Mrs. Smith's Apple or Cherry Cobbler**
32 oz. pkg.
- **Pillsbury Frozen Biscuits**
25 oz. pkg.

free!
H-E-B Soda, 12 pk., 12 oz. cans with the purchase of H-E-B Classic Selection Entrées, 35-40 oz. box.
R18718 IN-AD COUPON 01 GOOD 10/18/00 THRU 10/24/00 R18718
* Limit one coupon per purchase of product indicated.
* Coupon may not be mechanically reproduced, doubled or combined with any other offer.
5 41220 23101 5

free!
Mrs. Smith's Apple or Cherry Cobbler, 32 oz. pkg. with the purchase of H-E-B Classic Selection Entrées, 35-40 oz. box.
R18743 IN-AD COUPON 01 GOOD 10/18/00 THRU 10/24/00 R18743
* Limit one coupon per purchase of product indicated.
* Coupon may not be mechanically reproduced, doubled or combined with any other offer.
5 77700 11401 1

free!
Pillsbury Frozen Biscuits, 25 oz. pkg. with the purchase of H-E-B Classic Selection Entrées, 35-40 oz. box.
R18791 IN-AD COUPON 01 GOOD 10/18/00 THRU 10/24/00 R18791
* Limit one coupon per purchase of product indicated.
* Coupon may not be mechanically reproduced, doubled or combined with any other offer.
5 18000 15301 0

Prices Good Wednesday, October 18 thru Tuesday, October 24, 2000 At your neighborhood H-E-B Stores including H-E-B Marketplace -Others not valid at Broadway Central Market

H-E-B Taco Meal Deal!
buy Two Packages of H-E-B Fully Cooked Seasoned Beef Crumbles, \$2.99 ea.
12 oz. pkg., regular, Italian or taco
& H-E-B Fancy Shredded Cheddar Cheese, 12 oz. pkg., \$2.99 ea.
get free
with in-store coupons

- **Tia Rosa Taco Shells**
10 ct. pkg.
- **Fresh Express Shreds!**
8 oz. pkg.
- **Pace Picante Sauce**
8 oz. jar

#16

H-E-B savor flavors

with H-E-B and Hill Country Fare Brands

get free

sparerib Meal Deal!™

H-E-B Seasoned Pork Spareribs, \$2.99 lb.
sweet barbeque, full slab



- Hill Country Fare White Sandwich Bread
thin or extra thin
- Hill Country Fare Corn or Cut Green Beans
14.5-15.25 oz. can
- H-E-B Soft Drink
3 L. btl., assorted varieties, regular or diet

get free

H-E-B Classic Selections Pizza, \$2.76-34.46
22.76-34.46 oz. box
assorted varieties



- H-E-B Creamy Creations® Premium Ice Cream
1 pint ctr., regular, frozen yogurt, light or no sugar added, assorted varieties
- H-E-B Soft Drinks
3 L. btl., assorted varieties, regular or diet

Prices Good Wednesday, July 18 Thru Tuesday, July 24, 2001
At Your Alice, Beeville, Fallurus, Kenedy, Mathis And Rotzgie H-E-B Stores.
Due to the popularity of our Low Prices Every Day, we reserve the right to limit quantities.
*Printed on recycled paper. *Some items may not be available in all stores. © 2001 H-E-B Food Stores

VISIT WWW.HEB.COM



Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Applicant, noting in its initial brief that, under Sections 1 and 3 of the Trademark Act, the "owner of a service mark that is used in commerce may register its mark on the Principal Register" and that, pursuant to Section 45 of the Trademark Act, a service mark is defined in pertinent part as "a word used to identify and distinguish the services of one person from the services of another," argues that (footnote omitted):

Applicant's mark as used in commerce (as evidenced by the specimens of record) clearly demonstrates a word that is used to distinguish the services of one person from the services of another. The specimens of record consist of newspaper advertisements. The mark is in very large print as compared with the rest of the text in the advertisements. In addition, the mark is in bold print and is set aside from the rest of the text in the advertisements

....

Furthermore, Applicant uses the common law trademark designation "TM" to notify others of the term MEAL DEAL!['s] trademark significance. Clearly, a purchaser of Applicant's services would view the words "MEAL DEAL!" as an indicator of source. The various specimens of record evidence that Applicant's mark is uniformly displayed providing an unmistakable impression to consumers of a brand name.

Moreover, with respect to the Examining Attorney's contention that consumers would regard the designation "MEAL DEAL!" in applicant's newspaper ads solely as a "merchandising slogan" which is without any service mark significance,

applicant asserts in its initial brief that "a term may serve dual functions" and that "[a]s long as one of the functions is one of an indicator of source, such [a] term may function as a trademark." Applicant reiterates, in view thereof, that as shown by the specimens, its "use of the mark MEAL DEAL! in big/bold type style and use of the common law trademark designation 'TM' clearly demonstrates that the mark MEAL DEAL! functions as a trademark." Citing *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983), applicant additionally submits in its initial brief that the Examining Attorney's inclusion in the record of "various electronic excerpted articles to suggest that the term 'MEAL DEAL!' is a commonly used commercial designation" is improper inasmuch as "evidence for a refusal to register an applicant's mark (based on a failure to function as a trademark) can only be found by [examination of] an applicant's specimens of record." Applicant further urges in its initial brief, however, that "even if the excerpts are allowed as permissible evidence, the ... Examining Attorney has failed to provide a single reference showing that others are using Applicant's mark 'MEAL DEAL!' (with an exclamation point) as a commercial designation" (footnote omitted). Applicant accordingly concludes that because "the specimens of record evidence Applicant's use of the mark 'MEAL

DEAL!' as an indicator of source," the refusal to register "should be reversed."²

As stated by the Court in *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976): "The Trademark Act is not an act to register mere words, but rather to register trademarks [or service marks]. Before there can be registration, there must be a trademark [or service mark], and unless words have been so used they cannot qualify. *In re Standard Oil Co.*, 47 CCPA 829, 275 F.2d 945, 125 USPQ 227 (1960)."³ The court, noting

² Nonetheless, in its initial brief, applicant further asserts that:

In the alternative, should the Board be inclined to affirm the ... Examining Attorney's Section [1,] 2, 3 and 45 refusal, Applicant respectfully requests that the appeal be suspended and the instant application be remanded ... for amendment of the basis of the application to Section 1(b) of the Lanham Act. See TBMP Section 1205 and TMEP Section 806.03(c). Applicant includes [herewith] a verified statement under 37 C.F.R. Section 2.20 declaring that Applicant had a bona fide intent to use the mark in commerce at the time of the application filing date

Since the ... refusal was based on Applicant's specimens of record, the amendment of the basis to Section 1(b) will allow Applicant the ability to submit an

acceptable specimen pending the issuance of a Notice of Allowance.

However, as set forth in what is currently TBMP §1205.01 (2d ed. June 2003), "[a]n application which has been considered and decided on appeal may be amended, if at all, only in accordance with 37 CFR §2.142(g)," which provides in relevant part that such an application "will not be reopened except for the entry of a disclaimer under §6 of the Act of 1946." Thus, as correctly noted by the Examining Attorney in his brief, the alternative requested by applicant is not permitted at this stage of the appeal.

³ In this regard, Section 45 of the Trademark Act, 15 U.S.C. §1127, defines the term "service mark" in relevant part as including "any

that "the classic function of a trademark [or service mark] is to point out distinctively the origin of the goods [or services] to which it is attached," further indicated that (footnote omitted):

An important function of specimens in a trademark [or service mark] application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark [or service mark] use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark [or service mark]* with respect to the goods [or services respectively] named in the application.

Id. at 215-16. Moreover, as pointed out by the Board in *In re Remington Products, Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987):

[T]he mere fact that [an] applicant's slogan [or designation] appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark [or service mark]. To be a mark, the term, or slogan, must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods [or services] in question. Mere intent that a term

word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." Likewise, the same section defines the term "trademark" in pertinent part as including "any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

function as a trademark [or service mark] is not enough in and of itself, any more than attachment of the trademark [or service mark] symbol would be, to make a term a trademark [or service mark].

A critical element in determining whether a term is a trademark [or service mark] is the impression the term makes on the relevant public. In this case, the inquiry becomes would the term be perceived as a source indicator or merely an informational slogan?

We agree with the Examining Attorney that the manner of use of the designation "MEAL DEAL!," as evidenced by the specimens of record, demonstrates that such terminology would be perceived by applicant's customers and potential purchasers of its supermarket services as merely "a merchandising slogan" which is devoid of service mark significance. As the Examining Attorney persuasively observes in his brief:

The use by applicant of the designation MEAL DEAL! (a common advertising expression) along with other wording and representations of food packaging on its advertising specimens imparts to consumers the message that they will receive favorable bargains for food [items] under certain circumstances. Applicant's designation MEAL DEAL! informs purchasers about bargains for food [items], but does not act as a service mark.

In support of his position, the Examining Attorney has made of record definitions from Webster's II New Riverside University Dictionary (1988) which, in pertinent part, define "meal" as "[t]he food served and eaten in one sitting" and

"deal" as "[a] favorable bargain or sale." The Examining Attorney has also made of record excerpts from his search of the "NEXIS" database showing that the informational statement "MEAL DEAL(S)" "is a commonly used advertising expression" in the grocery and supermarket industry and thus, as used on the specimens furnished by applicant, would be perceived by its customers as simply a merchandising slogan for certain special offers on food items and not as a service mark for applicant's supermarket services. The latter evidence, as the Examining Attorney correctly points out in his brief, "is acceptable to show the public understanding of commercial wording" and therefore, contrary to applicant's contention, may properly be considered in assessing the public's reaction to the manner of use of the designation "MEAL DEAL!" as shown by the specimens of record. See, e.g., In re Manco, Inc., 24 USPQ2d 1938, 1942 (TTAB 1992). Representative excerpts are set forth below (emphasis added):

"G&R Felpausch ... recently completed a successful "**Meal Deals**" promotion in which its general merchandise and center store teams worked together to encourage trial of a specialty food product line.

....

In addition to the in-store promotional materials, the pasta-pot **Meal Deal** also was advertised in the stores' weekly circular.

G&R Felpausch conducts two or three such **Meal Deal** promotions per year" -- Supermarket News, April 8, 2002;

"**Meal deals**, which combine beverages and snacks . . . , are becoming a big business." -- Promo, February 2002;

"Did you know that Bi-Lo grocery stores features [sic] **meal deals** each week? For example, last week the store . . . offered two Red Baron pizzas, a six-pack of Pepsi cola and a Pepperidge Farm layer cake for \$9.58. Look for flyers advertising each week's deal at the front of the stores." -- Myrtle Beach Sun-News, January 30, 2002;

"Menu: Complete turkey **meal deals** ranging from \$22.99 for 2 to \$34.99 for 8. Highlights: Now here's a **meal deal** for 2: 2 pounds rotisserie turkey breast, 1 pound mashed potatoes, 1 pint gravy, 1 pound dressing, 1 pound green bean casserole, 1 pound cranberry salad, 4 dinner rolls for \$22.99." -- Daily Oklahoman, October 18, 2000;

"More than half a page in the Denver division's circular recently was devoted to '**meal deals**' and 'sandwich deals' and the page was headlined 'deli lunch deals.' Items bundled together were offered at prices reduced even from their everyday 'deal' retail. Three different types of sandwiches, bundled with a salad and soda, were offered in the ad. There was a 'classic sandwich deal, which included a sandwich, a 5.5-ounce salad and a 32-ounce fountain drink for \$3.79. . . .

Another, a 'gourmet sandwich **meal deal**,' offered the same accoutrements with 'any whole gourmet sandwich' for \$4.79. A photo of a sandwich on a sub roll with salad and soda alongside illustrated that part of the ad. Also a 'wrap sandwich **meal deal**' was advertised for \$4.79. That included any wrap sandwich with a salad and fountain drink. Each of the sandwich deal ads indicated that there was a savings of 50 cents." -- Supermarket News, October 12, 1998; and

"Randalls Food Market offered shoppers a 'Super **Meal Deal**' by tying together items from the produce and meat departments.

With the purchase of a boneless chuck roast, shoppers received five pounds of russet potatoes, three pounds of yellow onions and one pound of carrots free, according to an ad that ran in the Houston Chronicle three weeks ago." -- Supermarket News, May 27, 1996.

In light of the above, it is clear that, irrespective of the fact that the designation "MEAL DEALS!" appears in applicant's advertising in a relatively large-size bold print which is set aside from the rest of the text in the ads and is accompanied by the symbol "TM," actual and prospective customers viewing the ads would perceive such designation solely as a merchandising or informational slogan touting a deal or bargain on certain food items which, when consumed together, would make a meal. Specifically, applicant's "Meal Deal!" ad offers a free "H-E-B Soda," "Mrs. Smith's Apple or Cherry Cobbler" and "Pillsbury Frozen Biscuits" if customers "buy any H-E-B Classic Selection Entrées," while its "taco Meal Deal!" ad indicates that shoppers "get free" a package of "Tia Rosa Taco Shells," a package of "Fresh Express Shreds!" and a jar of "Pace Picante Sauce" when they buy both "[t]wo packages of H-E-B Fully Cooked Seasoned Beef Crumbles" and "H-E-B Fancy Shredded Cheddar Cheese." Similarly, applicant's "sparerib Meal Deal!" and "pizza Meal Deal!" ads respectively provide that consumers who

"buy H-E-B Seasoned Pork Spareribs ... get free ... Hill Country Fare White Sandwich Bread," "Hill Country Fare Corn or Cut Green Beans" and a "H-E-B Soft Drink," while those who "buy H-E-B Classic Selections Pizza ... get free ... H-E-B Creamy Creations Premium Ice Cream" and "H-E-B Soft Drinks."

Thus, contrary to applicant's contention, as so used the designation "MEAL DEAL!" would not be additionally regarded by purchasers of certain specially advertised food products as a source indicator for applicant's supermarket services, notwithstanding applicant's intent that such designation function as a service mark by the inclusion therein of an exclamation point. See, e.g., In re Brock Residence Inns, Inc., 222 USPQ 920, 922 (TTAB 1984) [designation "FOR A DAY, A WEEK, A MONTH OR MORE!" for hotel services held so informational in character that consumers are unlikely to perceive it as an indication of source, with the Board noting that "[t]he presence of the exclamation point at the end of the designation does not alter our opinion because it serves as well to emphasize the ... informational significance of the designation as to indicate any other meaning"]; and In re Nosler Bullets, Inc., 169 USPQ 62, 64 (TTAB 1971) [mere fact that an applicant "may at times use the designation TM in connection with the term does not make an otherwise unregistrable term a trademark"]. Furthermore, the fact that applicant appears to have consistently utilized the

designation "MEAL DEAL! in big/bold type style" simply serves to highlight or draw attention to such offers or specials, much in the same way that, for instance, the big and bold expression "fresh produce!" in the flyer featuring its sparerib and pizza "MEAL DEAL!" directs consumers to the prices being offered by applicant on certain fruits and vegetables.

The designation at issue in this appeal, therefore, is most analogous to the holdings in, for example, *In re Wakefern Food Corp.*, 222 USPQ 76, 78 (TTAB 1984), in which the Board found that, as used in advertising and promotional material submitted as specimens of use, the phrase "WHY PAY MORE!" was a "relatively common merchandising slogan [which] does not act or function as a mark which identifies and distinguishes applicant's [supermarket] services from those of others"; and in *In re Niagara Frontier Services, Inc.*, supra at 285, in which the Board held that, as used in newspaper advertisements furnished as specimens of use, the slogan "WE MAKE IT, YOU BAKE IT!" referred "only to the pizza which may be purchased in applicant's store" and "in no way serves to function as a service mark to identify and distinguish applicant's supermarket grocery store services." Similarly, as previously explained, the designation "MEAL DEAL!," being a form or slight variant of the fairly commonly used commercial phrase "meal deal," is used by applicant in the specimens of record simply as a

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merchandising slogan and does not function as a mark which identifies and distinguishes applicant's supermarket services.

Decision: The refusal under Sections 1, 2, 3 and 45, is affirmed.