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12/16/2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re R. Torre & Company

Serial No. 76383794

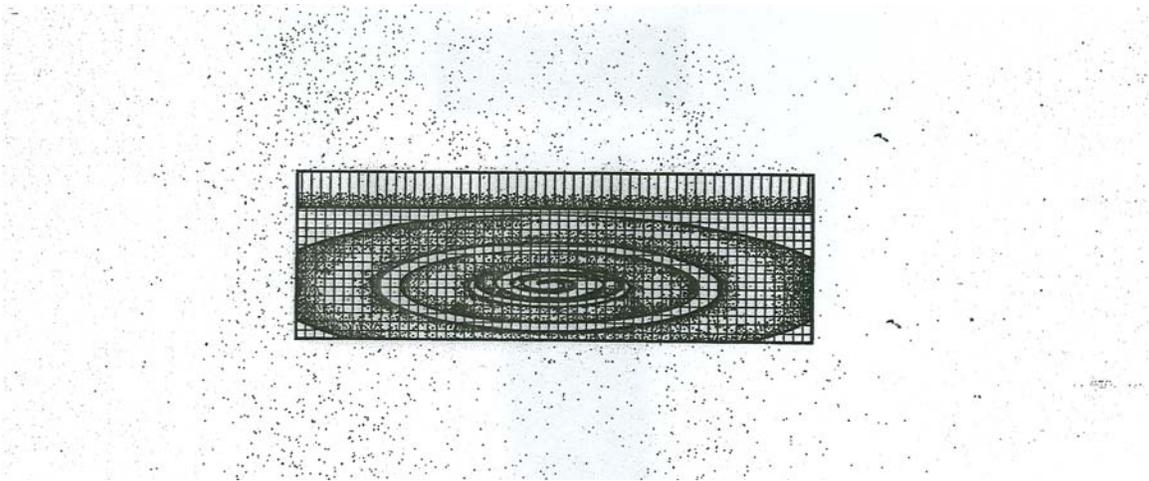
David S. D'Ascenzo of Kolisch Hartwell, P.C. for R. Torre & Company.

Mark T. Mullen, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Hanak, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

R. Torre & Company (applicant) seeks to register the design shown below for "fruit puree base for use in the preparation of fruit drinks, smoothies and the like." The application was filed on March 15, 2002 with a claimed first use date of April 7, 2000. In its application, applicant stated as follows: "The drawing is lined for the colors red and yellow. The drawing consists of red and yellow regions, with the yellow region including a swirl design."



In the final Office Action dated August 18, 2003, the Examining Attorney -- citing Trademark Rule 2.72(a) -- refused registration "because the drawing displays a mark that differs from the display of the mark on the specimen." When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

At the outset, this Board wishes to clarify the issue on appeal. As just noted, in the final Office Action the Examining Attorney refused registration "because the drawing displays a mark that differs from the display of the mark on the specimen." At page 4 of its brief, applicant states that the Examining Attorney's refusal is based on "the ground that the submitted specimen does not show the mark for which registration is sought." Moreover, at page 7 of its brief, applicant states that the Examining

Attorney refused registration "on the ground that applicant's drawing displays a mark that differs from the mark shown in the [specimens]." At page 3 of his brief, the Examining Attorney states as follows: "The sole issue on appeal is whether applicant's mark ... as it appears on the drawing page agrees with the mark as it appears on the specimen of record."

Based on the above statements by both the applicant and the Examining Attorney, it would seem clear that the only issue before this Board is whether the mark as it appears on the drawing conforms to the mark as it appears on the specimen of use. However, both the Examining Attorney and the applicant have construed the sole issue to encompass a related, but still distinct, second issue. At page 3 of his brief, the Examining Attorney states as follows: "Specifically, the issue is whether applicant's proposed mark, a swirl design, makes a separate and distinct commercial impression apart from the many additional wording and design elements that appear on the specimen of record." Likewise, at page 7 of its brief, applicant states as follows: "The issue to be decided on this appeal is whether applicant's mark, as presented on applicant's originally and subsequently presented specimens, provides a separate and distinct commercial

impression, apart from the overlying word marks and design elements."

We find that the only issue before this Board is whether applicant's mark as shown in its drawing conforms to the mark shown on applicant's specimens. Because we find that it does not, we affirm the refusal to register. Assuming purely for the sake of argument that the issue before this Board was whether applicant's mark, as it appears on applicant's specimens, presents a separate and distinct commercial impression, we would likewise affirm the refusal to register because as used on the specimens, applicant's mark does not present a separate and distinct commercial impression.

Applicant's original specimen submitted with its application is a picture of a cup of applicant's fruit puree base. Unfortunately, we are unable to meaningfully show this specimen because applicant's mark -- or to be precise, a portion of applicant's mark -- simply is not visible in any reproduction. Suffice it to say, that on applicant's original specimen only one half of applicant's mark, as shown in applicant's drawing, is visible. The other half of applicant's mark is totally obliterated by wording and other design features. To be more specific, half of applicant's mark is obliterated by applicant's word

trademark FRUSIA; the generic wording "whole fruit smoothie base strawberry"; and the depiction of strawberries.

Applicant's other specimens suffer from the same defect in that they show only one half of applicant's mark as it appears in applicant's drawing. In applicant's additional specimens, its word trademark FRUSIA blocks a portion of applicant's applied for swirl design mark. The only difference between applicant's original specimen and applicant's additional specimens is that the overlying generic wording and overlying depiction of fruits vary. Thus, in one of applicant's additional specimens the generic words read "whole fruit smoothie base raspberry" (emphasis added) and there is a depiction (obviously) of raspberries as opposed to strawberries.

It must be remembered that "an important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use." In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976). Thus, if the mark as it appears on the specimen(s) does not agree with the mark as shown on the drawing, then the specimen simply does not show "trademark use" of the mark as sought to be registered, that is, as depicted on the drawing page.

In this case, it is blatantly clear that the mark as shown on the drawing page (the mark sought to be registered) is not being used on the specimen(s). As previously noted, only half of the mark as shown on the drawing page is visible on the specimen(s). Applicant can simply not register a design mark when the specimen of use shows only half of the mark as it appears in the drawing. By way of analogy, if applicant depicted on its drawing page an eight-letter word mark, it certainly could not register this eight-letter word mark if only four of the eight letters were visible on the specimen of use. To hold otherwise would mean that applicant could register the hypothetical mark BLUEBIRD if it submitted a specimen of use that showed only the word BLUE, or only the word BIRD.

As noted earlier in this opinion, we simply cannot reproduce applicant's specimen such that the half of applicant's mark as shown on the drawing page is visible. However, there is no dispute that on applicant's specimens, applicant's word trademark FRUSIA, descriptive wording and other designs (various fruits) are totally superimposed on half of applicant's mark such that said half is just not visible. In this regard, we note that applicant makes the following statement at page 6 of its reply brief:

"Applicant does not dispute, and has never disputed, that

there are overlying text and graphic elements over portions of its mark when the mark is used in commerce [i.e. on the specimens]." However, applicant attempts to justify this obliteration of half of its mark on its specimens by stating that "anytime a mark is a background design mark, it will inherently have overlying elements when used in commerce." (Applicant's reply brief page 6).

We disagree. Applicant has not cited a single case where a design mark as shown on the drawing was permitted to be registered when said design mark on the specimen was substantially obliterated by wording and/or other designs.

To be clear, applicant has cited the case of In re Swift Co., 223 F.2d 950, 106 USPQ 286 (CCPA 1955) where applicant's design mark, as depicted in the drawing, was permitted to be registered despite the fact that as shown in the actual label (specimen of use) there was substantial wording and other designs between the two elements of applicant's design as shown on the drawing. In that case, applicant's mark consisted of two dark horizontal bands. The bottom horizontal band was approximately three times as thick as the top horizontal band. Between the two dark horizontal bands, there was a large "void" space that was approximately twice as "thick" as the two separate dark bands combined. As depicted in the specimen of use, there

was in this "void" space the word trademark SWIFT'S repeated twice along with other wording and smaller designs.

We find that the Swift case does not dictate a different result here. In Swift, all of applicant's design mark as shown in applicant's drawing was fully visible in applicant's specimen of use. In other words, neither the trademark SWIFT'S nor the other wording and smaller designs in any way obliterated a single portion of applicant's design as shown in applicant's drawing. This is in stark contrast to the present case where applicant's word trademark FRUSIA, generic terminology and fruit designs obliterate approximately half of applicant's design mark as shown in applicant's drawing.

It is for this reason that we sustain the refusal to register. Put quite simply, applicant's design mark as it appears on the drawing page does not agree with "the mark" as it appears on applicant's specimen(s). To the extent that the issue in this case may be construed as to whether or not applicant's design makes a "separate and distinct commercial impression" apart from the wording and other designs on applicant's label, we find that it simply cannot and does not. Even assuming purely for the sake of argument that half of applicant's mark as shown on the

specimens makes a "separate and distinct commercial impression," this does not mean that applicant's entire mark likewise makes a "separate and distinct commercial impression." Because only half of applicant's mark is visible on the specimen, then applicant's mark (as shown on the drawing page) cannot make such a separate and distinct commercial impression.

Decision: The refusal to register is affirmed.