This Opinion is not a Precedent of the TTAB

Mailed: February 26, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CB Specialists, Inc.

Serial No. 87689179

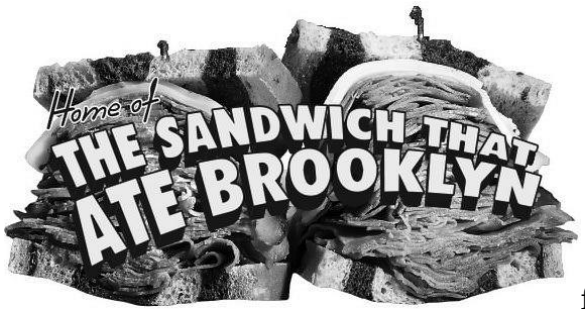
Zachary D. Messa of Johnson, Pope, Bokor, Ruppel & Burns, LLP
for CB Specialists, Inc.

Anthony Rinker, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Taylor, Ritchie, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

CB Specialists, Inc. ("Applicant") seeks registration on the Principal Register of the composite mark



for "restaurant services, including sit-down services of food and take-out restaurant service" in International

Class 43.[1]

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground that the mark shown in the drawing is not a substantially exact representation of the mark shown in the specimens of use. 15 U.S.C. §§ 1051(a), 1053, 1127; Trademark Rules 2.34(a)(1)(iv), 2.51(a), (b)(2), 37 C.F.R. §§ 2.34(a)(1)(iv), 2.51(a), (b)(2).[2]

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

I. Discussion

An applicant who files a use-based application must file a drawing of the mark and a specimen showing its use in commerce. 15 U.S.C. §§ 1051(a), 1053, 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.51(a), *cited in In re Univ. of Miami*, 123 USPQ2d 1075, 1077

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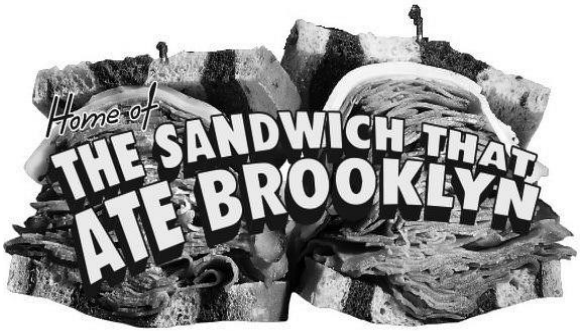
[1] Application Serial No. 87689179 was filed on November 17, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use of the mark anywhere and in commerce since at least as early as January 26, 2010. Applicant's description of the mark states that "the mark consists of the term 'Home of' appearing above the term 'The sandwich that' which appears above the term 'Ate Brooklyn' in stylized format with a sandwich appearing in the background." Color is not claimed as a feature of the mark. The application disclaims the exclusive right to use the design of a sandwich apart from the mark as shown.

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

[2] In this case, the Examining Attorney found that Applicant's original specimen, submitted with its application, did not agree with its applied-for mark as shown in the drawing, and so the Examining Attorney required Applicant to submit substitute specimens. March 8, 2018 Office Action at TSDR 2. Applicant complied. We therefore focus our analysis on the substitute specimens.

(TTAB 2017). 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," as shown by the specimen. 37 C.F.R. § 2.51(a); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §§ 807.12(a), 1301.04(f)(i) (Oct. 2018). If the drawing and specimen of use do not match sufficiently under this standard, the applicant has failed to prove use of the mark in commerce, and its application may be refused registration. *See In re WAY Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016); 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:61.50 (5th ed. Nov. 2019 update) ("It is fundamental to United States trademark registration practice that use must precede registration. Without use, there is no 'trademark' to be recorded on the federal register of marks. The filing of a specimen with the Patent and Trademark Office (USPTO) is the way the applicant proves this use.").

The drawing of Applicant's applied-for mark is shown below on the left, and one of its substitute specimens is shown on the right:

	 [3]

[3] Sept. 10, 2018 Response to Office Action at 2.

The substitute specimen shows the applied-for mark superimposed on another registered mark owned by Applicant,

, for the same services: "restaurant services, including sit-down services of food and take-out restaurant service" in International Class 43. Applicant calls the "THE LUCKY DILL" mark its "House Mark."[4]

A. Arguments of Applicant and the Examining Attorney

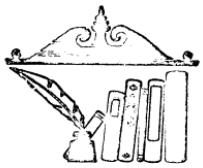
Applicant contends that the drawing of its applied-for "HOME OF THE SANDWICH THAT ATE BROOKLYN" and design mark "is incorporated in its entirety into the Specimen, and the inclusion of the House Mark behind Applicant's Mark depicted in the Specimen does not destroy this exact representation."[5] *See In re Tekelec-Airtronic*, 188 USPQ 694 (TTAB 1975).[6]

The Examining Attorney counters that "The applied-for mark does not present a separate and distinct commercial impression apart from 'THE LUCKY DILL' and

[4] Reg. No. 5502514, registered on June 26, 2018. The "House Mark" consists of "THE" appearing vertically adjacent to "LUCKY" and the "I" in "DILL represented by a pickle. Color is not claimed as a feature of the mark. *See* Applicant's brief, 7 TTABVUE 11; Applicant's April 3, 2019 Request for Reconsideration at 3. The prior registration was not properly made of record during examination, but the Examining Attorney did not object to its submission with Applicant's brief. Indeed, the Examining Attorney discussed Applicant's "House Mark," the subject of the registration, in his brief, so it may be considered. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.02(e) (2019).

[5] Applicant's brief, 7 TTABVUE 5.

[6] Applicant also relies on *In re ITT Indus, Inc.*, 2006 WL 2558019 (TTAB 2006), a nonprecedential decision in which the Board reversed a refusal based on mutilation, permitting the applicant to register the mark in its drawing.

pickle design as used on the substitute specimen of use because the combination of words and overlapping designs that form a composite whole (1) are physically joined and (2) forms a unique message to consumers as to the particular source of the restaurant services i.e., 'THE LUCKY DILL' is the 'HOME OF THE SANDWICH THAT ATE BROOKLYN' and sandwich design."[7] In support of this position, the Examining Attorney cites seven Board decisions, each finding that an element of a composite mark did not present a separate and distinct commercial impression apart from the mark as a whole, as shown on the specimen.[8] For example, in *In re Library Restaurant, Inc.,* 194 USPQ 446 (TTAB 1977) the applicant applied to register   , which was part of the mark depicted in the specimen:  .

services." *Id.* at 448-49.

Similarly, in *In re Miller Sports*, 51 USPQ2d 1059 (TTAB 1999) the applicant applied to register  even though the specimens showed that composite

[7] Examining Attorney's brief, 9 TTABVUE 4.

[8] Examining Attorney's brief, 9 TTABVUE 5-6.

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