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This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Herzog

Serial No. 75809642

Douglas A. Miro of Ostrolenk, Faber, Gerb & Soffen, LLP for
Kenneth J. Herzog.

Eugenia K. Martin, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Simms, Hairston and Rogers,
Administrative Trademark Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

Applicant Kenneth J. Herzog filed an application to register FULL-FILL YOUR NEEDS on the Principal Register as a trademark for goods identified as "machinery used in the packaging industry for filling containers of various sizes and shapes," in Class 7. The application was filed September 23, 1999 based on applicant's stated intention to use the mark in commerce on or in connection with the identified goods.

The examining attorney eventually approved the mark for publication for opposition. It was unopposed and a notice of allowance issued.¹

Applicant eventually filed a statement of use attesting to the commencement of use of the mark. Included with the statement of use was a specimen label displaying the following:

**Full-Fill Your Needs™
With Fills-All® Fillers²**

The examining attorney refused to accept the specimen, stating that the applicant had created "an entire sentence, which creates its own commercial impression aside from the proposed mark." Applicant was informed that it could file a substitute specimen showing only the phrase in the application drawing, but it could not amend the mark in the drawing to the complete phrase shown on the specimen, because it would be a material alteration of the applied-for mark.

¹ The application became abandoned for failure to file a statement of use within the time designated in the notice of allowance. However, the application was subsequently reinstated to pending status.

² The illustration above is not in the precise typeface shown on the specimen label, but is sufficient to illustrate its look. Applicant owns Registration No. 2529383, issued January 15, 2002, for the mark FILLS-ALL for "fluids filling machines for use in an industrial fluids packaging system," in Class 7.

While applicant and the examining attorney have argued the question whether it would be a material alteration for applicant to amend the mark from FULL-FILL YOUR NEEDS to FULL-FILL YOUR NEEDS WITH FILLS-ALL FILLERS, applicant did not propose such an amendment and it is not a question before us in this appeal.

The examining attorney asserts that, although elements of a composite mark may be separately registered when they create separate and distinct commercial impressions, the phrase FULL-FILL YOUR NEEDS does not create a distinct commercial impression. In essence, she contends that the specimen would be perceived as showing only one mark and it is the entire sentence. Therefore, no portion thereof can be registered based solely on use of the entire sentence.

Applicant asserts that its phrase FULL-FILL YOUR NEEDS is set off from the whole phrase on the label because it is on a separate line and has the superscript "TM" designation appended to it. In essence, applicant is arguing that, while the entire phrase on the specimens may be read as a whole, those who view the phrase will also perceive the first line and the separately registered FILLS-ALL as marks embedded within the entire phrase.

Other arguments presented by applicant and the examining attorney actually have more to do with the

question of material alteration than with the question whether, from the point of view of a prospective purchaser, the first line of the phrase would be perceived as a mark embedded in the whole. Also, applicant and the examining attorney have argued the value of prior reported decisions.³

Clearly, the question of whether the specimen label will be perceived as displaying only one mark or a sentence with other marks embedded in it and recognizable as such is a subjective matter. The Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992) ("The issue must be decided on the facts of each case"; Federal Circuit affirmed Board finding that it was not a mutilation for applicant to seek to register CHABLIS WITH A TWIST when label showed vertically stacked words CALIFORNIA CHABLIS WITH A TWIST). See also, In re Boyd Coffee Co., 25 USPQ2d 2052, 2053-54 (TTAB 1993) ("Finally, we should state that this decision is somewhat subjective and that there is little pertinent case law on which to base our judgment. Many of the so-called 'mutilation' cases involved attempts by applicants to register designs or backgrounds apart from words with which they are used."). In *Boyd*, the Board

³ We agree with the examining attorney that it was improper for applicant to rely on decisions not designated as citable.

clearly noted the critical role likely consumer perception plays, noting that different or clearer specimens might have shown contrast necessary for the Board to have concluded that an element of applicant's composite mark would have been viewed as standing out from the whole. Id.

In this case, we agree with applicant that prospective purchasers of its machines would view the phrase FULL-FILL YOUR NEEDS as a separate and distinct phrase embedded in the composite sentence shown on applicant's specimen. Its placement alone on the first line and its demarcation by the superscript "TM" designation serve to promote this recognition. We note, too, that this application does not involve an attempt by applicant to register only a portion of a complete sentence that has been in long use. Rather, applicant settled on the mark, applied under the intent-to-use provisions of the Trademark Act, and then put the mark into use, albeit as a mark embedded in a longer phrase. Thus, this is not a situation wherein consumers were conditioned to look for the entire phrase and would, perhaps, view use of just a portion thereof as a mutilation of what they were used to seeing. Applicant's presentation will condition consumers from the start to recognize the entire phrase as well as the embedded marks.

Decision: The refusal of registration is reversed.