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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

99-517

Re: Trademark Registration of :
Beaulieu of America, Inc. :
Registration No. 1,715,868 :
Issued: September 15, 1992 : On Petition
For: DIATRON SDN :
Petition Filed: March 22, 1999 :

Beaulieu Group, LLC (“Petitioner”)¹ has petitioned the Commissioner to (1) reverse the Post Registration Affidavit-Renewal Examiner’s (“Examiner”) denial to accept an amendment of the mark in the above-referenced registration pursuant to 15 U.S.C. §1057(e) (“Section 7 Amendment”); and (2) reverse the Examiner’s denial to accept Petitioner’s combined affidavit of continued use or excusable nonuse and incontestability pursuant to 15 U.S.C. §§1058 and 1065 (“Combined Sections 8 and 15 Affidavit”). The petition is denied. 37 C.F.R. §2.146(a)(3).

FACTS

The above-referenced registration issued on September 15, 1992 for the mark DIATRON SDN. On September 15, 1998, Petitioner filed the Section 7 Amendment and the Combined Sections 8 and 15 Affidavit. In Office Actions dated January 29, 1999, the Examiner issued refusals of both. In the case of the Section 7 Amendment, the Examiner refused acceptance of the proposed amendment of the mark as registered on the ground that this was a material alteration of the commercial impression of the mark. In the case of the Combined Sections 8 and 15 Affidavit, the Examiner withheld its acceptance on the ground that the specimens filed with the affidavit did not show the mark identified in the registration. The mark as registered and the proposed amended mark (which is also the mark shown in the specimens filed with the Combined Sections 8 and 15 Affidavit) are shown below.

¹ Petitioner is the assignee of the entire interest and goodwill of the above-referenced registration as shown in the Office records of the Trademark Assignment Branch at reel 1632, frame 0919.

DIATRON SDN

Mark as Registered

DIATRON SOLUTION DYED NYLON

Proposed Amended Mark

Petitioner's Arguments

Petitioner argues that the acronym SDN stands for SOLUTION DYED NYLON. Petitioner also asserts that SOLUTION DYED NYLON is generic wording as applied to the identified goods. In an affidavit filed with this petition, Petitioner states further that "SDN is commonly understood in the relevant market to mean Solution Dyed Nylon and is used interchangeably therefore." In addition, Petitioner has submitted a disclaimer of the terms SOLTUION DYED NYLON apart from the mark as shown.² Accordingly, Petitioner believes that there is no change or significant alteration of the commercial impression of the mark because no new meaning or element is being added by the amendment.

ANALYSIS

The general test of whether an alteration of a mark is material is whether the mark would have to be republished after the alteration to present fairly the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it is tantamount to a new mark appropriate for a new application. *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988); *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986); *Visa International Service Association v. Life-Code Systems Inc.*, 220 USPQ 740 (TTAB 1983); *In re E.M. Townsend & Co.*, 143 USPQ 318 (Comm'r Pats. 1964).

Because the standards for determining whether a mark set forth in a specimen is materially different from the mark set forth in an application or in a registration are the same, the Commissioner will review under a *de novo* standard the question of whether the proposed amended mark is materially different from the mark set forth in the registration. *See In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996).

Here, the proposed amended mark spells out the acronym SDN, replacing the acronym with the terms SOLUTION DYED NYLON. While Petitioner asserted that the acronym and terms are used interchangeably in the relevant industry and filed a disclaimer of the terms SOLUTION DYED NYLON, the evidence of record does not establish that SDN and SOLUTION DYED NYLON are identical in meaning and connotation. The evidence is merely comprised of Petitioner's statement of record that the term "SDN is commonly understood in the relevant market to mean Solution Dyed Nylon and is used interchangeably therefore [sic]." Other evidence such as dictionary entries, articles or patent excerpts from the relevant industry to support Petitioner's assertion that the terms are interchangeable is absent from the record. *Compare with In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996)(The acronym NY was held to be a recognized shortened form of NEW YORK supported by evidence.) Hence, the replacement of the acronym with the terms SOLUTION DYED NYLON in the proposed

² The disclaimer was filed on October 7, 1999.

amended mark constitutes a material alteration of the commercial impression of the mark that would require republication.

DECISION

The petition is denied. The registration will be cancelled in due course.

Robert M. Anderson
Deputy Assistant Commissioner
for Trademarks

Date:

RMA:SLC

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