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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Societe D'Importation De Diffusion Ou Distribution  
D'Articles De Sport S.I.D.A.S.**

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Serial No. 74/610,551

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**Sheridan Neimark** of Browdy and Neimark, P.L.L.C. for applicant.

John Michos, Trademark Examining Attorney, Law Office 105  
(Thomas G. Howell, Managing Attorney).

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Before **Cissel**, Hohein and Hairston, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 13, 1994, applicant, a corporation organized and existing under the laws of France, filed the above-referenced application. Applicant's goods were identified in the application as "orthopedic soles and shoes," in Class 10. Although the heading of the application listed the mark sought to be registered as "PODIATECH," the cover letter received with the application and the drawing submitted as part of the application itself showed the mark as "PODITECH." The application was based on applicant's ownership of a

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registration in France<sup>1</sup> and applicant's assertion that it possessed a bona fide intention to use the mark in commerce. A copy of the French registration certificate was submitted with the application to the U.S. Patent and Trademark Office. A translation of it was subsequently submitted at the request of the Examining Attorney. The mark shown on these two documents is "PODIATECH," just as it is in the heading of the U.S. application.

The Examining Attorney refused registration under Section 44 of the Lanham Act because the mark "PODITECH" shown on the drawing is not the same mark as the mark "PODIATECH," which is shown in the French registration certificate. He noted that Trademark Rule 2.51(3) requires that the drawing in the U.S. application must be a substantially exact representation of the mark as it appears in the drawing in the registration certificate issued in applicant's country of origin. Further, he advised applicant that amendment of the drawing to conform to the French registration and the heading of the United States application would not be permitted because such an amendment would materially alter the character of the mark, and such alterations are prohibited by Trademark Rule 2.72(a).

Applicant nonetheless submitted such an amendment, but the Examining Attorney refused to accept it. The refusal to register under Section 44 was repeated. Applicant responded

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<sup>1</sup> Reg. No. 1,245,244, issued May 17, 1983.

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with argument that the proposed amendment should be allowed, but the Examining Attorney was not persuaded.

When the refusal to register was made final, applicant appealed. Briefs were filed by both applicant and the Examining Attorney, but applicant did not request an oral hearing before the Board.

Trademark Rule 2.51(a)(3) requires the drawing of the trademark in the U.S. application to be "a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the country of origin of the applicant." Because the drawing submitted with the instant application is not a substantially exact representation of the mark as it appears in the French registration, the issue becomes whether the drawing may be amended to show the same mark which is registered in France.

Trademark Rule 2.72(a) states that "[a]mendments may not be made to the description or drawing of the mark if the character of the mark is materially altered. The determination of whether a proposed amendment materially alters the character of the mark will be made by comparing the proposed amendment with the description or drawing of the mark as originally filed." Paragraph (d) of Rule 2.72 notes that "[i]n applications under Section 44 of the Act, amendments to the description or drawing of the mark may be permitted only if warranted by the description or drawing of the mark in the

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foreign registration certificate." Thus, an amendment that conforms with the foreign registration must not be a material alteration. In re Hacot-Columbier, \_\_F.3d\_\_, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), citing In re Abolio y Rubio S.A.C.I. y G., 24 USPQ2d 1152, 1154-55(TTAB 1992).

The test for whether a proposed amendment constitutes a material alteration of the mark is set forth in Visa Int'l Serv. Ass'n v. Life-Code Sys., Inc., 220 USPQ 740, 743,744, (TTAB 1983): "The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark..." The essence of the test is whether, if the mark were to be published in the form shown in the amended version of it, there could be someone who might oppose registration of it who would not have opposed the mark which was shown in the original drawing. TMEP Section 807.14(d) notes that "[t]hese general rules are subject to exceptions. Each case must be decided on its own facts. The controlling question is always whether the new and old form of the marks create essentially the same commercial impression."

In the instant case, the commercial impression engendered by "PODIATECH" differs from that of "PODITECH," so the change from one to the other would be a material alteration.

"PODIATECH," as used as a trademark for orthopedic soles and shoes, is suggestive of podiatry, which is, of course, the study and treatment of foot ailments. "PODITECH," on the other

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hand, does not possess this suggestiveness, because it does not begin with the same six letters and three syllables that the word "podiatry" begins with. "Podi" is not a known word or term. "Pod" is a word used to identify a seed vessel or the fruit of a plant, or a housing for various things on an aircraft, such as landing gear or weapons, but the term "pod" has no recognized meaning or suggestiveness in connection with orthopedic shoes or insoles. "Pod" is listed in the American Heritage Dictionary of the English Language, (Houghton Mifflin Company, 1976), along with "pode," as a suffix which "[i]ndicates a specified kind or number of feet," as in "psuedopod," but this connotation makes no sense in connection with the goods listed in the instant application.

Both the mark shown in the drawing in the U.S. application and the mark shown in the French registration end with the term "TECH," which is suggestive of "technical" or "technique," but when the marks are considered in their entireties, as they must be, the one registered in France suggests podiatry, while the one shown in the drawing submitted with the U.S. application does not.

This difference in commercial impression is determinative of the issue under Trademark Rule 2.72(a) because it is an impermissible material alteration if the commercial impression created by the mark in the proposed amendment is different from the one engendered by the mark shown in the original drawing.

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Someone using a mark which refers to or suggests podiatry or podiatric goods or services could have a reasonable belief that he would be damaged by the registration of the mark in the French registration, whereas the mark in the original U.S. application drawing might not have been opposed by such a person.

Applicant argues that the decision in *In re ECCS, Inc.*, 94 F.3d 1578, 39 USPQ2d 2002 (Fed. Cir. 1996), mandates allowance of the proposed amendment in the instant case. In that case, the Court reversed the refusal to accept an amendment to the drawing in a use-based application which brought the drawing into agreement with the specimens of use which had been submitted with the application as filed. The Court noted that the application, as originally filed, was "internally inconsistent," in that the display of the mark in the drawing was slightly different from the display of the mark as it was actually used, as evidenced by the specimens. The Court reasoned that changing the drawing to agree with the specimens should be allowed in order to remove this ambiguity in the application as it was filed. The specimens showed "EXA" on a separate line above "MODULE," whereas the original drawing showed the mark sought to be registered as "EXAMODULE," with no space between the two elements. The amendment to change the drawing to "EXA MODULE" was permitted. The Court relied heavily on the fact that applicant had used the mark with space

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between "EXA" and "MODULE," and that all applicant sought to accomplish by amending the erroneous drawing was to register the mark in the form in which it had been used.

That case is certainly parallel to the instant one in several respects. In ECCS, the mark applicant had used, and therefore had the right to register, was the mark shown on the specimens, and the amendment sought to bring the application drawing into agreement with the specimens. In the instant case, the claim of registrability is based on the French registration, and in a sense, the U.S. application is "internally inconsistent," in that the heading shows the mark applicant claims the right to register under Section 44 of the Act, whereas the mark shown in the drawing is not exactly the same.

The two cases are distinguishable, however, because adding the space between "EXA" and "MODULE" in ECCS did not result in a mark with a different commercial impression. Anyone who would have had reason to oppose registration of "EXAMODULE" would have had the same problem with "EXA MODULE," and anyone who would have opposed registration of the latter would have opposed the application for the mark as it was presented in the drawing originally submitted with the application.

In the case at hand, however, as noted above, because "PODIATECH" has a connotation which is suggestive as applied to orthopedic shoes and soles which "PODITECH" does not have, the

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commercial impression of the mark applicant has registered in its country of origin differs from the commercial impression of the mark shown in the drawing submitted with its application to register it in this country. Because the commercial impressions of the two marks differ, the proposed amendment would constitute a material alteration, and is therefore not permitted under Trademark Rule 2.72(a).

Accordingly, the refusal to register under Section 44 of the Act is affirmed because the mark shown in the drawing submitted with the U.S. application is not a substantially exact representation of the mark as it appears in the French registration. The refusal to accept the proposed amended drawing is affirmed under Trademark Rule 2.72(a) because the proposed amendment represents a material alteration of the drawing as originally filed.

R. F. Cissel

G. D. Hohein

P. T. Hairston  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board

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