

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 1/28/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Schering Aktiengesellschaft

Serial No. 74/077,096

Marilyn Matthes Brogan of Curtis, Morris & Safford for
applicant.

Linda E. Blohm, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Schering Aktiengesellschaft seeks registration of the
mark PROGRESS for "herbicides for agricultural, domestic and
other related uses."¹

The Examining Attorney has finally refused registration
on the ground that the specimens, consisting of several
identical labels (which appear to be labels affixed to

¹ Serial No. 74/077,096, in International Class 5, filed July 10, 1990,
based on a bona fide intention to use the mark in commerce. Following
publication of the mark for opposition and issuance of a notice of
allowance, applicant filed its statement of use on June 15, 1994,
alleging first use and first use in commerce on May 6, 1994.

containers for the goods), do not show use of the mark as it appears in the drawing. The Examining Attorney's position is that the mark in the drawing, PROGRESS, is an incomplete representation, i.e., a mutilation, of the mark as used on the specimens because it omits the term, BETAMIX. The relevant portion of the label is reproduced below.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

Trademark Rule 2.51(a)(2) provides, in part, that "once a statement of use ... has been filed, the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods[.]" The mere fact that two or more elements form a composite mark does not necessarily mean that those elements cannot be registered separately. To the contrary, it is well settled that an applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which

indicates the source of applicant's goods or services and distinguishes applicants goods or services from those of others. *See, e.g., Institut National des Appellations D'Origine v. Vintners International Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992), *citing In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (CCPA 1950); *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969); *In re Tekelec-Airtronic*, 188 USPQ 694 (TTAB 1975); *In re Lear Siegler, Inc.*, 190 USPQ 317 (TTAB 1976); and *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983). *See also, Trademark Manual of Examining Procedure*, sections 807.14 and 807.14(b) and cases cited therein.

The standard enunciated herein for determining whether the mark in the drawing is a mutilation of the mark as used, as evidenced by the specimens, is the same regardless of whether the application is filed under Section 1(a) of the Act, based upon use of the mark in commerce, or, as herein, under Section 1(b) of the Act, based upon a bona fide intention to use the mark in commerce, with specimens submitted in connection with a statement of use.

In support of her conclusion that BETAMIX is an essential and integral part of the mark as used on the specimens, the Examining Attorney argues that PROGRESS does not create a commercial impression distinct and separate from BETAMIX PROGRESS, and that the two terms, BETAMIX and

PROGRESS, appear in close proximity to one another and are depicted in the identical style and size lettering; that, as such, the term PROGRESS is not separately identifiable as a mark apart from the phrase BETAMIX PROGRESS absent applicant's demonstrating that BETAMIX is a house mark or used in conjunction with other terms or that PROGRESS is used alone; and that applicant did not submit such evidence.

Applicant asserts that BETAMIX PROGRESS, as the phrase appears on the specimens, is not a unitary phrase possessing a distinct commercial impression; rather, the specimens demonstrate applicant's use of PROGRESS as a trademark.² Applicant states that BETAMIX is a house mark of applicant. Additionally, the record includes applicant's statement, confirmed by the Examining Attorney, that it owns Registration No. 1,212,121 for the mark BETAMIX for "sugar beet herbicide"³ and the Examining Attorney's statement that applicant also owns Registration No. 1,865,143 for the mark

² Along with its notice of appeal herein, applicant submitted a request for reconsideration. The Board remanded the application to the Examining Attorney, who, upon reconsideration, reinstated the final refusal. Following reinstatement of the appeal, applicant submitted a second request for remand and reconsideration along with several exhibits. The Board denied the request for remand on the ground that the evidence submitted therewith could have been submitted prior to the appeal. Thus, the Examining Attorney did not consider this evidence, nor do we consider this evidence as part of the record in our determination herein.

³ According to the records of the PTO, this registration issued on October 12, 1982 (Sections 8 & 15 accepted and acknowledged, respectively), in International Class 5, alleging dates of first use and first use in commerce of April 14, 1981.

BETAMIX PROGRESS⁴ for the same goods as identified herein.⁵

In this case, it is our view that the elements asserted by the Examining Attorney to be the mark, BETAMIX and PROGRESS, are not so merged together in either presentation or significance that PROGRESS cannot be regarded as a separable element creating a separate and distinct commercial impression. We find that applicant has adequately established that BETAMIX is a house mark by its uncontradicted statement to that effect and the evidence that applicant owns a registration for the mark BETAMIX alone, for essentially the same goods as herein. Further, although appearing together in the same size and type letters on the same line on the specimen, we note that BETAMIX appears to be a fanciful term, in contrast with the term PROGRESS, which has a suggestive connotation in and of itself when applied to the goods. In this respect, in view of the distinctly different connotations of the two terms, by preceding PROGRESS in the phrase BETAMIX PROGRESS, BETAMIX gives the appearance of a house mark. The two terms

⁴ According to the records of the PTO, this registration issued on November 29, 1994, in International Class 5. Filed based upon an allegation of a bona fide intention to use the mark in commerce, a statement of use was filed alleging dates of first use and first use in commerce of May 6, 1994.

⁵ While there is no copy of either noted registration in the record, we will consider them properly of record as both applicant and the Examining Attorney acknowledge the existence of these registrations and neither objects to our consideration thereof. Applicant also indicates its ownership of several pending applications for other marks including the term BETAMIX. However, the Examining Attorney notes that these

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do not appear to flow one from the other. Thus, we find that PROGRESS forms a commercial impression separate from the BETAMIX element.

Therefore, we conclude that PROGRESS, as used on the specimens, functions as a mark in and of itself. As such, it is not a mutilation of the mark as depicted on the specimens.

Decision: The refusal to register on the ground that the specimens do not evidence use of the mark in the application is reversed. The application shall be forwarded for issuance of the registration on the Principal Register in due course.

E. J. Seeherman

T. J. Quinn

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board

applications have been abandoned. We find these references to abandoned applications unpersuasive in our consideration of the issue herein.