

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

SEPT 11, 97

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re L. Perrigo Company

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Serial No. 74/361,830

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H. R. Reick, of Price, Heneveld, Cooper, DeWitt & Litton for  
applicant.

Angela M. Micheli, Trademark Examining Attorney, Law Office  
108 (David E. Shallant, Managing Attorney).

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Before Seeherman, Hohein and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

L. Perrigo Company has filed a trademark application to  
register the mark CONFIRMED RELEASE and design for "dietary  
supplements."<sup>1</sup> The mark is shown below as it appears in the  
drawing submitted with the application.

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<sup>1</sup> Serial No. 74/361,830, in International Class 5, filed February 22,  
1993, based on a bona fide intention to use the mark in commerce. The  
application includes a disclaimer of the phrase CONFIRMED RELEASE apart  
from the mark as a whole. The mark was published for opposition on  
September 14, 1993, and applicant filed its statement of use and  
specimens on May 18, 1994, alleging dates of first use and first use in  
commerce of November 11, 1993.



With its statement of use applicant submitted labels as specimens of use of the mark. The mark is shown below as it appears on the specimens of record.



The Examining Attorney concluded that the mark as shown on the specimens of record is materially different from the mark as shown in the drawing of record and she required the applicant to submit substitute specimens. Applicant responded by arguing that the mark as shown both in the drawing of record and on the labels submitted as specimens is materially the same. Applicant also submitted an amendment to the drawing showing the mark as it appears on the specimens of record. The Examining Attorney renewed the requirement for substitute specimens and refused to accept the amendment to the drawing on the ground that the character of the mark would be materially altered thereby.

The Trademark Examining Attorney has finally refused registration, pursuant to Trademark Rule 2.72(a), on the ground that applicant did not comply with the requirement to

submit substitute specimens showing the mark as depicted in the drawing as originally filed and that the proposed amendment to the drawing is unacceptable because it would materially alter the character of the mark.

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

In determining whether the Examining Attorney's requirement for substitute specimens and refusal to accept the proposed amendment to the drawing are proper, the question before us is whether the mark, as shown on the specimens of record and in the proposed amendment to the drawing, constitutes a material alteration of the mark shown in the original drawing.

In this regard, the Examining Attorney contends that, in view of the generic nature of the phrase CONFIRMED RELEASE, the design elements of the mark, including the lined oval which applicant proposes to delete, are the dominant features of the mark; that, in fact, it is the lined oval which makes the mark distinctive; and that the removal of the lined oval results in a mark that does not create the same commercial impression as the original mark.

Applicant contends, on the other hand, that the lined oval proposed to be deleted is "a minuscule design element."

Applicant describes its mark as follows (applicant's brief, p. 3):

The mark, as originally filed, constituted the terms CONFIRMED RELEASE which are printed in a distinctive type font in which the 'C' and 'D' of CONFIRMED are enlarged and integrated with the reflected tapered arch design. Thus, the printing of the term CONFIRMED RELEASE itself includes distinctive design elements. Further, the reflected tapered arches are not a common geometric form such as a square, rectangle, triangle, oval or a circle, but rather is (sic) an arbitrary design without any meaning. These dominant features enclose a small striated oval design under the 'E' in the word RELEASE.

Applicant contends, further, that in view of the size of the mark as it appears on the specimens of record, the lined oval design would appear minuscule, would not create a separate commercial impression, and, thus, is not a material part of the overall mark.<sup>2</sup>

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[.]"

Trademark Rule 2.72(a) provides, in part, that "[a]mendments

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<sup>2</sup> The fact that the mark as a whole may appear small relative to the other elements on the labels submitted as specimens is irrelevant to our consideration herein as the issue before us is the registrability of the mark in the application regardless of the specific size in which that mark may be used in a particular instance. Applicant is not precluded from using its mark in any size it chooses. Conversely, to the extent that applicant is arguing that the lined oval is small relative to the other elements of the mark, regardless of the size of the mark as a whole, this is one of several factors considered in determining the overall commercial impression of the mark.

may not be made to the description or drawing of the mark if the character of the mark is materially altered."

The Board has previously articulated a test for determining whether a change in a mark is material:

[T]he old and new forms of the mark must create the same general commercial impression or create the impression of being essentially the same mark.

*In re Vienna Sausage Manufacturing Co.*, 16 USPQ2d 2044, 2046 (TTAB 1990). See also, *Visa International Service Assn. v. Life-Code Systems*, 220 USPQ 740, 743-744 (TTAB 1983).

Applying this test in the instant case, we find that the mark as it appears on the specimens and in the proposed amended drawing constitutes a material alteration of the mark as it appears in the original drawing. Not only must the modified mark in the amended drawing contain the essence of the original mark; the new form must also create the impression of being essentially the same mark. The merely descriptive phrase CONFIRMED RELEASE<sup>3</sup> appearing within a circle created by two tapered arches imparts a decidedly different commercial impression from the same mark with the completely arbitrary lined oval included within the circle and centered below the words. Without the lined oval, the mark is relatively undistinctive. While we recognize that such a mark includes a tapering of the bordering circle and

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<sup>3</sup> In view of the disclaimer of record, by which applicant admits that this phrase is merely descriptive, it is unnecessary for us to determine whether this phrase is, as the Examining Attorney contends, generic in connection with the identified goods.

a slight enlargement of the "C" and "D" in CONFIRMED, it is the lined oval which provides a visual focus and lends a distinctive quality to the mark.

Thus, viewed in their entireties, the proposed amended mark, without the lined oval, does not contain the essence of the original mark and does not create essentially the same commercial impression as the original mark.

This case is distinguishable from *Visa, supra*. In *Visa*, the modified mark contained the essence of the original mark. There was no addition or deletion of matter; the elements comprising the mark remained the same. When the mark was amended such that the designation OMNI-VISA appeared below (rather than above) an upward (rather than downward) pointing airplane, the amended mark retained essentially the same commercial impression as the original mark.

Decision: The refusal to register is affirmed on the ground that the mark as it appears on the specimens submitted with the statement of use is materially different from the mark in the drawing originally submitted and, thus, the Examining Attorney properly required substitute specimens showing the mark as it appears in the drawing

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originally submitted and she properly refused to accept an amendment to that original drawing.

E. J. Seeherman

G. D. Hohein

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