

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 6/18/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Greg LeBlanc, Inc.

Serial No. 75/028,266

R. Bennett Ford, Jr. and William David Kiesel of Roy, Kiesel & Tucker for applicant.

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(Sidney I. Moskowitz, Managing Attorney)

Before Cissel, Hanak and Hohein, Administrative Trademark Judges.
Opinion by Hohein, Administrative Trademark Judge:

Greg LeBlanc, Inc. has filed an application to register the mark "POLLY'S PRICE" for "retail automobile dealership" services.¹

Registration has been finally refused on the ground that "the specimens [of use] display the mark as HOME OF POLLY'S PRICE" rather than "POLLY'S PRICE". Stated otherwise, the Examining Attorney has finally refused registration on the basis

¹ Ser. No. 75/028,266, filed on May 29, 1996, which alleges dates of first use of March 3, 1995. The word "PRICE" is disclaimed.

Ser. No. 75/028,266

that the mark "POLLY'S PRICE" constitutes a mutilation of the unitary composite mark "HOME OF POLLY'S PRICE" as shown in the three identical advertisements, one of which is reproduced below (in reduced size), which applicant submitted as specimens of service mark use of the mark it seeks to register.

Although also stating, in his final refusal, that "the phrase GET POLLY'S PRICE[!] which appears in the specimens does not function as a service mark because it appears in small typeface in comparison to other matter in the specimens," the Examining Attorney added, however, that even "[a]ssuming for [the] sake of argument that use of GET POLLY'S PRICE[!] in the specimens showed

service mark use, said wording would be unacceptable to show service mark use [of the mark POLLY'S PRICE] for the identical reasoning set forth" with respect to the mark "HOME OF POLLY'S PRICE".

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

As a preliminary matter, we observe that both applicant and the Examining Attorney are essentially in agreement with the long-standing principle that an applicant may apply to register any element of a composite mark displayed on the specimens of use if that element presents a separate and distinct commercial impression as a mark; that is, the element in and of itself functions as a mark since, as shown by the manner of its use on the specimens, it creates a separate impression which is indicative of the source of the applicant's goods or services and distinguishes such 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, 259-60 (CCPA 1950); In re Tekelec-Airtronic, 188 USPQ 694, 695 (TTAB 1975); and In re Berg Electronics, Inc., 163 USPQ 487, 487-88 (TTAB 1969). Furthermore, we note that, on appeal, the Examining Attorney states that, "for purposes of this brief, the examining attorney will consider GET POLLY'S PRICE! to be a service mark." The Examining Attorney adds, however, that such consideration "does not change his position that that the mark [POLLY'S PRICE]

in the drawing is not a substantially exact representation of the mark[s] as ... used in commerce, and further, constitutes a mutilation of the mark[s] as ... used in commerce."

Turning, therefore, to the merits of this appeal, it is the Examining Attorney's position that because slogans, such as the marks "HOME OF POLLY'S PRICE" and "GET POLLY'S PRICE!" are considered to be unitary phrases, a combination of only certain of the components thereof may not be registered separately where, as here, the applicant's specimens show use of the combination of the components solely as elements of the separate slogans. Specifically, and citing Trademark Rule 2.51(b)(1), which mandates that in the case of an application based upon use in commerce, "the drawing of a service mark shall be a substantially exact representation of the mark as used in the sale or advertising of the services," the Examining Attorney argues that (footnote omitted):

[T]he mark in the drawing, POLLY'S PRICE, is not a substantially exact representation of the marks in the specimens because additional matter that appears in the marks in the specimens creates two different composite marks, GET POLLY'S PRICE! and HOME OF POLLY'S PRICE, both of which are unitary slogans. The mark in the drawing, POLLY'S PRICE, represents a thing, while the marks in the specimens, GET POLLY'S PRICE! and HOME OF POLLY'S PRICE represent a command which directs purchasers to obtain that thing and a place where one can obtain that thing, respectively. As such, the marks in the specimens form different marks from the mark in the drawing and therefore [the mark POLLY'S PRICE is] ... not [in either instance a] substantially exact representation[] ... [thereof]. TMEP Section 807.14.

Elements of composite marks as used on specimens are registrable where those elements create separate and distinct commercial impressions. TMEP Section 807.14 and cases cited therein. The Trademark Trial and Appeal Board has held, however, that portions of unitary word marks do not create a separate and distinct commercial impression. Particularly noteworthy is the Board's decision in *In re Morganroth*, 208 USPQ 284 (TTAB 1980). Therein, the Board affirmed a refusal to register NATUR-ALL-IZE YOUR HAIR COLORING when the applicant's only use of the proposed mark was as a portion of a slogan NATUR-ALL-IZE YOUR HAIR COLORING WITH ANOTHER NEW SERVICE. The examining attorney submits that affirming the refusal of registration would be consistent with this decision.

The applicant has not submitted specimens which show the mark POLLY'S PRICE used as a separate mark. As used in commerce, GET POLLY'S PRICE! and HOME OF POLLY'S PRICE each create a single commercial impression. As noted hereinabove, where a unitary mark creates a single commercial impression, an attempt to separate a portion of that mark is an impermissible mutilation. *In re Chemical Dynamics, Inc.*, 5 USPQ[2d] 1828, 1830 (Fed. Cir. 1988). Because the mark in the drawing omits the wording GET and HOME OF, which are essential and integral to creating the commercial impressions [conveyed by] the applicant's unitary slogans, the mark in the drawing constitutes an impermissible incomplete representation or mutilation of the mark as used in commerce. TMEP Section 807.14(b).

Though admittedly the additional wording that expands the mark in the drawing to the slogans GET POLLY'S PRICE! and HOME OF POLLY'S PRICE is rather diluted, the examining attorney submits that the slogans that the applicant uses in its specimens are unitary nonetheless and create single commercial impressions. Therefore, their component parts cannot be registered separately.

Applicant, on the other hand, contends that its specimens demonstrate that the phrase "POLLY'S PRICE" creates a separate and distinct commercial impression and thus functions as a mark. In particular, applicant maintains that: (**emphasis in original**):

As depicted in the specimens, the phrase "POLLY'S PRICE" designates a **thing**. In contrast, the composite mark "HOME OF POLLY'S PRICE" refers to a **place** where consumers can obtain the **thing**. In further contrast, the composite mark "GET POLLY'S PRICE" is an **instruction** to consumers to acquire the **thing**. Thus, the composite marks rely on the core commercial impression of "POLLY'S PRICE," and in doing so, contribute to and reinforce the separate and distinct commercial impression created by "POLLY'S PRICE."

Additionally, applicant's use of the mark "POLLY'S PRICE" as the common component of **two different** composite marks in **one advertisement** provides further support for concluding that "POLLY'S PRICE" creates a separate and distinct commercial impression. Dual use of "POLLY'S PRICE" in one advertisement highlights the mark. Furthermore, the contrast between the two composite marks in one advertisement, with "POLLY'S PRICE" being the common feature, contributes to and reinforces the separate and distinct commercial impression created by "POLLY'S PRICE."

....

The separate and distinct impression created by "POLLY'S PRICE" is further demonstrated by considering the elements of the two composite marks in isolation. "HOME OF" and "GET" are far too common to create a distinct commercial impression. Thus, the other elements in the composite marks must rely upon "POLLY'S PRICE" for their distinctiveness.

We would agree with the Examining Attorney that, if applicant's specimens solely displayed the slogan "HOME OF POLLY'S PRICE" or only showed the slogan "GET POLLY'S PRICE!," applicant's attempt to register just the words "POLLY'S PRICE" would not be "a substantially exact representation of the mark as used in the sale or advertising of the services," as required by Trademark Rule 2.51(b)(1), and thus would constitute a mutilation of the featured slogan. Indeed, while each of the slogans "HOME OF POLLY'S PRICE" and "GET POLLY'S PRICE!" is a unitary composite, it simply goes too far for the Examining Attorney to postulate, where the applicant's specimens utilize both of such marks and also prominently display a parrot design, an immutable rule that:

Just as registrable slogans are considered unitary and should not be broken up to require disclaimers, see section 1213.06, the examining attorney submits that slogans are unitary and should not be broken up to register components thereof. Rather, the examining attorney submits that each slogan is a separate mark that should be registered individually. The examining attorney further submits that applicant's attempt to register POLLY'S PRICE standing alone, rather than each of the slogans separately, is merely an impermissible and transparent attempt to register all present and future slogans featuring the wording POLLY'S PRICE in one application. See *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977).

We concur, instead, with applicant that its specimens demonstrate that the words "POLLY'S PRICE" create a separate and distinct commercial impression which functions as a mark for applicant's retail automobile dealership services. Specifically,

when the unitary composite mark "HOME OF POLLY'S PRICE" is used, in the same advertisement, in conjunction with the unitary composite mark "GET POLLY'S PRICE!," and both of such slogans are displayed in association with a parrot which is obviously named "Polly,"² it is plain that, given the admittedly "rather diluted" or commonplace nature of the words "GET" and "HOME OF" as components of advertising slogans, the source-signifying component in each of the slogans is the words "POLLY'S PRICE". As such, those words, in the context of applicant's specimen advertisements, present a separate and distinct commercial impression as a mark for applicant's services and are therefore registrable.

Decision: The refusal to register is reversed.

R. F. Cissel

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board

² In view of the ubiquitous saying "Polly want a cracker," we agree with applicant that Polly is "a name which is synonymous with parrots" and thus would be readily understood as naming the parrot depicted in applicant's advertising of its services.