

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

APRIL 27, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **International Business Machines Corporation**

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Serial No. 74/**727,766**

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**Alexander Tognino** for **International Business Machines Corporation**.

**Anne T. Madden**, Trademark Examining Attorney, Law Office 102 (**Thomas Shaw**, Managing Attorney).

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

Opinion by Bucher, Administrative Trademark Judge:

Applicant, **International Business Machines Corporation**, a **New York corporation**, has filed an application to register the figurative element shown below:



This mark was to be registered in connection with "computer software and instruction manuals sold as a unit therewith for management of information on enterprise networks."<sup>1</sup>

The Trademark Examining Attorney issued a final refusal to register based upon Section 1 of the Trademark Act, 15 U.S.C. §1051, on the ground that applicant's mark as shown in the drawing is not a substantially exact representation of the matter used by applicant on the substitute specimens of record. Furthermore, the Trademark Examining Attorney deemed an amendment to the drawing to be impermissible in this case -- to allow applicant to change its earlier drawing to match the images shown on the new specimens would constitute an impermissible alteration.

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

In her initial Office action of March 26, 1996, the Trademark Examining Attorney told applicant that the original specimens were unacceptable for goods. Generally, things such as informational sheets, advertisements and

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<sup>1</sup> Serial No. 74/727,755, filed September 12, 1995, alleging use since February 28, 1994. In addition to the computer software items in International Class 9, the original application also recited "services for information/management handling systems products," in International Class 42. However these services were deleted from the application during the course of prosecution.

newsletters are not acceptable to show use of a mark for goods such as enterprise management software. See In re Schiapparelli Searle, 26 USPQ2d 1520(TTAB 1993).

Applicant then submitted substitute specimens -- photocopies of packaging sleeves for the software. While the software wrappers were an acceptable type of specimen for these goods, the Trademark Examining Attorney argues that the design (the "crouching hero") shown on these packaging sleeves is a different mark:



The Trademark Examining Attorney enumerates a litany of visual changes that contribute to the emergence of an entirely different character from the substitute specimens.

We agree that given the character traits of this very different hero, the figure of a "flying hero" shown on the drawing page is not a substantially exact representation<sup>2</sup> of the crouching figure shown on the substitute specimens.<sup>3</sup>

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<sup>2</sup> See language of 37 C.F.R. Section 2.51(a)(1).

<sup>3</sup> The original service mark specimens filed herein by applicant reflected a substantially identical image to the flying super hero depicted on the drawing page. Even though not appropriate to show use of this exact mark on goods, the Trademark Examining Attorney argues that clearly applicant was using this version of the character in its marketing program, and

Our reviewing court<sup>4</sup> agreed with the agency that

"substantially exact representation" is a tight standard:

The regulation's term "substantially" permits some inconsequential variation from the "exact representation" standard. In United Rum Merchants Ltd. v. Distillers Corp. (S.A.), 9 USPQ2d 1481, 1483-84 (TTAB 1988)... the Board noted that an applicant may delete nonmaterial informational matter, such as net weight or content information, from the foreign registration of an entire label. *Id.* at 1484. Beyond such limited exceptions to the "exact representation" standard, however, any difference between the mark in the drawing and the mark in the foreign registration requires the examiner to refuse registration.

In re Hacot-Colombier, 105 F.3d 616, 41 USPQ2d 1523

(Fed. Cir. 1997).

The image on applicant's drawing page was in no way inconsistent with the image on the specimens as originally filed. Even the most thorough of Trademark Examining Attorneys would detect no "ambiguity in the application as initially filed." See In re ECCS Inc., 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996) ["EXAMODULE" on the drawing page was found "internally inconsistent" with the words

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fully intended with this particular application to seek the protection of a federal registration for the image of the flying hero.

<sup>4</sup> In that case [In re Hacot-Colombier, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997)], the application was filed under Section 44 of the Act.

"EXA" and "MODULE" appearing on different lines in the specimens].

Here, applicant has not attempted to submit pre-existing specimens showing the flying hero on acceptable specimens for goods in Int. Cl 9. Neither has it submitted an amended drawing depicting the crouching hero. Hence, in upholding the refusal to register on this threshold issue, we do not need to resolve the more difficult question of material alteration -- that is, whether the Office's acceptance of an amended drawing (i.e., a substantially exact representation of the crouching hero) would entail significant changes to the character of the mark.

Decision: We affirm the refusal to register under Section 1 of the Lanham Act.

R. F. Cissel

P. T. Hairston

D. E. Bucher

Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board