

Hearing:  
November 18, 1999

Paper No. 36  
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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JUNE 7, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Really Useful Group Limited

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Serial No. 74/235,972

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Donald Huff of Watson Cole Grindle Watson, P.L.L.C. for The Really Useful Group Limited.

Amos Matthews, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Simms, Cissel and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

The Really Useful Group Limited seeks registration of the mark shown below for a variety of goods in four



international classes.<sup>1</sup> The Examining Attorney has finally

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<sup>1</sup> Serial No. 74/235,972, filed January 8, 1992, based on a claim of a bona fide intention to use the mark in commerce. Registration originally was sought for goods and services in

refused registration on the ground that the specimens, consisting of labels, photographs, brochures, and flyers, 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 is an incomplete representation, i.e., a mutilation, of the mark illustrated by the specimens, because the blank space in the drawing, between the words

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seven international classes. Following publication of the mark for opposition and issuance of a notice of allowance, applicant filed its statement of use on January 29, 1997, deleting two classes of goods and services and alleging June 12, 1991 as the date of first use anywhere and February 25, 1993 as the date of first use in commerce for the goods in the remaining five classes. Subsequently, another class of services was deleted prior to this appeal. The resulting identification follows:

name plates, ornaments, plaques, statues, statuettes, figurines, key rings, key fobs, key blanks, key chains, money boxes; all the above goods being made of non-precious metals, in International Class 6;

television sets, radios, video cassette recorders, video disc players, phonographs, and audio receivers, pre-recorded audio and video cassette tapes containing musical and dramatic works, blank audio and video tapes; magnetic and optical discs all for recording sound or video; and accessories therefor; sunglasses, sunglass cases, in International Class 9;

writing paper and envelopes; printed publications in the form of theatrical programmes, books, newspapers and magazines; posters, unmounted photographs and photograph albums; greeting cards and postcards, decalcomanias, ordinary playing cards, covers for cheque books, in International Class 16; and

sweatshirts, T-shirts, shirts, shorts, trousers, socks, blousons, caps, training shoes, and basketball shoes, in International Class 25.

AMAZING and DREAMCOAT is, in the mark illustrated by the specimens, filled with the term TECHNICOLOR.<sup>2</sup>

In the final refusal of registration, the Examining Attorney required applicant to submit substitute specimens showing the mark as presented in the drawing, noting that applicant did not have the option of inserting the term TECHNICOLOR in the drawing because that would result in a material alteration of the mark. Applicant has appealed. Both applicant and the Examining Attorney filed briefs and presented arguments at an oral hearing. We affirm the refusal of registration.

Applicant has argued that it has the option of amending the mark in its drawing, because inserting TECHNICOLOR would not result in a material alteration of the mark in the drawing. Applicant states, however, that it does not wish to make the amendment and, in fact, is contractually bound not to seek registration of its mark with TECHNICOLOR as a portion thereof. Accordingly, the question of whether applicant may amend its drawing is not

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<sup>2</sup> This term is the subject of various registrations owned by Technicolor Videocassette BV and applicant, as a condition for its licensed use of the mark, entered into an agreement providing that any use will specify that "Technicolor is the registered trade mark of the Technicolor group of companies."

before us on appeal.<sup>3</sup> The sole issue before us is whether the mark, as it appears in the drawing of record in the application, is a mutilation of the mark actually used, as evidenced by the specimens of record.

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 fact that two or more elements form a composite mark does not necessarily mean that those elements cannot be registered separately. On the other hand, it is well established that an applicant may apply to register an element of a composite mark only 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 applicant's goods or services from those of others. See, e.g., In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) and In re San Diego National League Baseball Club, Inc., 224 USPQ 1067, 1070 (TTAB 1983). See also, Trademark Manual of

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<sup>3</sup> In this regard, we note our familiarity with In re ECCS, Inc., 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996), In re Dekra e.V., 44 USPQ2d 1693 (TTAB 1997), and the recently amended Trademark Rule 2.72, 37 C.F.R. §2.72, but need not consider their applicability to this case.

Examining Procedure, Sections 807.14 and 807.14(b), and authorities discussed therein.

A copy of one of the specimens submitted by applicant, a photograph of a T-shirt bearing the mark, appears below; the arcing bands of various shades of gray, which run across the words in the mark, appear in color in the original photograph.

It is our view that the words in the stylized display of applicant's mark, as illustrated by the specimens, are fully integrated, because of the common typeface, the rainbow of colors that wash over all the terms in the mark, and the jigsaw puzzle-like means by which the words fit together. As described by applicant, the words in the mark

create the image of "cloth on a hanger." This image is broken when TECHNICOLOR is removed, much as the pattern of cloth is disturbed when torn.

We are not persuaded otherwise by applicant's arguments. Applicant acknowledges that the application was filed under the intent-to-use provision of the Trademark Act and that there were no specimens when it was first examined. Nonetheless, applicant contends that its "mark is very well known to the American public"; that "[s]urely, the attorneys examining the application were very familiar with the stage play by this name"; that "[o]ne certainly did not need specimens of use at hand to know that the word 'TECHNICOLOR' was not present in the drawing"; and that the only explanation for the Examining Attorney's failure to raise the mutilation issue during initial examination is "[t]he word 'TECHNICOLOR' is not a critical element of applicant's mark.". Applicant also contends that the mark in the drawing is distinctive and coherent.

We have no evidence regarding the familiarity of consumers with applicant's play. In any event, whether individuals familiar with the play, when viewing the mark in the drawing, would think of applicant's play is not the issue before us. Rather, the issue is whether the mark in the drawing is separable from the composite mark on the

specimens and whether the mark on the drawing creates a separate and distinct commercial impression. Applicant's contention that viewers would perceive the mark in the drawing is unsupported by any appreciable evidence.

Compare *Chemical Dynamics, supra*, 839 F. 2d at 1571, 5 USPQ2d at 1830, where only evidence regarding separate perception of an element of a composite mark was declaration by appellant's vice president.

Here, we have only a handful of references to "Joseph and the Amazing Dreamcoat" retrieved from the West Publishing Co. "AllNewsPlus" database of newspaper and periodical articles.<sup>4</sup> Specifically, there are four references. One appears in a newspaper headline. We give this little weight, as headlines often employ chopped phrases or shorthand references. The remaining three references include one brief mention in a newspaper's listing of events; another brief mention in a casting call for a local production of the play, which was included in a

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<sup>4</sup> Applicant's initial search of the database apparently retrieved eight references. Only five were made of record before the appeal, and one is from a foreign publication which, therefore, has no bearing on how individuals in the United States will perceive applicant's mark. Applicant attached other references from a second search to its reply brief on appeal, but we have not considered these. The record on appeal is to be completed prior to filing of the notice of appeal. At the oral hearing, the examining attorney did not address the reply brief submissions or otherwise treat them as properly of record. Likewise, we do not treat them as properly made of record.

column featuring numerous items of local interest; and the last appears in a short piece profiling a teenager, wherein there is a passing reference to the teen's participation in a local production of the play. We find these references unpersuasive.

Applicant also argues that it has not claimed color as a part of its mark, and thereby contests the Examining Attorney's contention that applicant's use of the word TECHNICOLOR and its overlay on its mark of a rainbow of colors tend to reinforce each other and demonstrate the significance of the word in the overall mark. Our reliance on applicant's use of color as establishing that its mark is a unitary composite is based not on the Examining Attorney's reinforcement argument but, rather, on the fact that the rainbow display of colors flows over all the words in the mark, so that when one word is removed, the rainbow effect is broken and the mutilation is that much more apparent.

Finally, we note that the Court of Appeals for the Federal Circuit has held that a mark with a "phantom" element is unregistrable. See In re International Flavors & Fragrances Inc., 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999). In that case, the Court noted that under Trademark Act Section 22, 15 U.S.C. §1072, registration serves as

constructive notice to the public of the registrant's ownership of the mark and thus precludes another user from claiming innocent misappropriation as a trademark infringement defense. To make constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce. The court stated that "phantom" marks with missing elements encompass too many potential combinations and permutations to make a thorough and effective search possible and, therefore, the registration of these marks does not provide adequate notice to competitors and the public. *Id.* at 1367-68, 51 USPQ2d at 1517-18. The mark applicant proposes to register may be viewed as one which contains a "phantom" element because the mark as used contains an element that would not be revealed in any search of the register. Thus, registration of applicant's proposed mark may run counter to *International Flavors*.<sup>5</sup>

Decision: The refusal of registration on the ground that the specimens do not evidence use of the mark in the application is affirmed.

R. L. Simms

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<sup>5</sup> We do not, by this observation, suggest that any case wherein an applicant seeks registration of only an element of a composite mark will run afoul of the Court's decision in *International Flavors*.

R. F. Cissel

G. F. Rogers

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board