

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MARCH 29, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Kraus-Anderson, Incorporated

---

Serial No. 75/089,869

---

Elizabeth Buckingham of Dorsey & Whitney for Kraus-Anderson, Incorporated

Linda Blohm, Trademark Examining Attorney, Law Office 110  
(Chris Pederson, Managing Attorney)

---

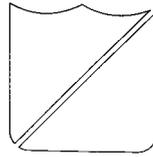
Before Hanak, Quinn and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Applicant seeks registration of its "split shield" design, set forth below, as a trade and service mark for a printed publication in International Class 16 and various services in International Classes 36, 37, 41 and 42.<sup>1</sup>

---

<sup>1</sup> Serial No. 75/089,869, claiming first use and first use in commerce as of July 1968 for all the services and first use in commerce as of February 1970 for the publication in class 16. We



In her initial Office action, the Examining Attorney refused registration of the design, under Sections 1, 2, and 45 of the Trademark Act, on the ground that it fails to function as a mark. In a subsequent Office action, she asserted that the specimens of use do not show use of the design sought to be registered and required submission of substitute specimens. Set forth below is a reproduction of the mark portrayed by the specimens. The portion of the design that frames the letter "K" is in red on the specimens; the portion framing the letter "A" is in black.



Both the refusal of registration and the requirement for filing of substitute specimens were made final. Applicant has appealed. Both the applicant and the

---

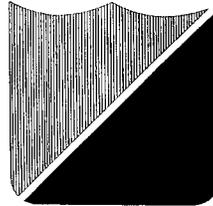
do not list the precise identifications because they are not relevant to either the refusal of registration or our decision.

Examining Attorney filed briefs, but an oral hearing was not requested.

With its reply brief, applicant submitted copies of third-party registrations, in an attempt to prove that designs of shields and crests are not common elements in marks that have been registered for applicant's goods and services. It is well settled that the record in an application should be complete prior to the filing of an appeal and that the Board generally will not consider evidence filed by the applicant or Examining Attorney with a brief. See Trademark Rule 2.142(d) and **In re Juleigh Jeans Sportswear Inc.**, 24 USPQ2d 1694 (TTAB 1992). The third-party registrations not having been properly made of record, we have not considered them in reaching our decision. We note that there is no other evidence in the record.

We first consider the requirement for substitute specimens. The Examining Attorney asserts that "[t]he drawing displays the mark as a two part white shield design. This differs from the display of the mark on the specimens, where it appears as a two part red and black shield design with the lettering **K** and **A**." Applicant argues that it is merely attempting to register one element of the composite mark illustrated by its specimens and that

it was able, with the same specimens, to register the following mark, with a statement that the drawing is lined for the colors red and black.



We do not view the present case as an attempt by applicant to register a white split shield design based on use of a red and black split shield design featuring the letters "K" and "A." Rather, this is a case where applicant seeks to register the outline of its composite mark, on the theory that consumers viewing the composite would also perceive the outline alone, just as consumers would perceive the red and black split shield design apart from the composite.<sup>2</sup>

To the extent that the Examining Attorney's requirement for substitute specimens is based on her

---

<sup>2</sup> As there is no evidence of record regarding consumer perception of the composite, any discussion of other impressions made by the composite is necessarily theoretical. While the Office has registered the red and black split shield design, the most that the registration establishes is that the Examining Attorney apparently concluded that this portion of the composite creates a distinct commercial impression.

conclusion that the applicant seeks to register a white split shield design and the specimens do not illustrate use of such a mark, the requirement is inappropriate and the refusal of registration based on failure to meet the requirement is reversed. To the extent that the requirement for substitute specimens is based on the Examining Attorney's conclusion that applicant's use of the composite mark would not result in separate perception of the outline by consumers and, therefore, to register the outline applicant would have to file specimens showing use of the outline alone, the requirement is bound up with the substantive refusal of registration.

This case is not unlike **In re Wendy's International, Inc.**, 227 USPQ 884 (TTAB 1985). There, the Examining Attorney refused registration of a "domed-top rectangle" which comprised the border of applicant's signs for its restaurants. In *Wendy's*, the Examining Attorney refused registration on the ground that the mark in the drawing did not agree with the mark in actual use, as illustrated by the specimens. The Examining Attorney contended that the specimens showed only a composite mark featuring words, color and other design features and that the border did not present a separate commercial impression.

In affirming the refusal of registration, this Board did not focus on the asserted divergence between the mark in the drawing and the composite mark illustrated by the specimens. Rather, the focus was on whether "the background display of [the] mark ... sought to be registered, ... may be registered without any showing of secondary meaning if, by its nature, it is sufficiently distinctive or unique so as to create a commercial impression separate and apart from the remainder of the mark." *Wendy's, supra*, at 885 (citation omitted).

Also helpful to our analysis is the case of **In re Chemical Dynamics Inc.**, 5 USPQ2d 1828 (Fed. Cir. 1988) (medicine dropper and droplet refused separate registration because specimens showed use only as part of composite mark in which dropper intersected handle of watering can bearing the words "7 DROPS"). In that case, the Examining Attorney determined the medicine dropper and droplet could not be registered based on use of the composite because that element was inextricably bound up in the composite and any attempt to separate out the dropper portion alone resulted in an impermissible mutilation of the composite. After the Board affirmed the refusal of registration, that applicant appealed to our reviewing court.

The court cited with approval the test of Professor McCarthy that "[a] background design which is always used in connection with word marks must create a commercial impression on buyers separate and apart from the word marks for the design to be protectable as a separate mark." *Chemical Dynamics, supra* at 1829 (citation to McCarthy's treatise omitted). The court went on to note that the same test applies when the applicant is seeking to register not the entire background, but only an element thereof.<sup>3</sup> *Id.* Finally, the court noted that the Board properly applied the test and affirmed the mutilation refusal. *Id.* at 1830.

In the *Wendy's* case, the Board recognized that the question whether a border or background design of a composite mark creates a separate commercial impression "is necessarily a subjective determination based on the visual impact of the design..." *Wendy's, supra* at 886. Professor McCarthy recognizes the subjective nature of the inquiry and posits that the commercial impression created by a background design "must be totally separate and apart... The design must emerge out of the 'background' and 'hit the buyer in the eye'..." 1 J.T. McCarthy Trademarks and Unfair

---

<sup>3</sup> The applicant in *Chemical Dynamics* had already registered the entire background design, but without its words. The reported decision involved an effort to obtain a separate registration for one element of the background.

Competition §7.28 (4<sup>th</sup> ed. 1999). See also **In re Swift & Co.**, 106 USPQ 286, 289 (CCPA 1955) ("It is axiomatic, of course, that a trademark must be distinctive... and, with particular regard to symbols and devices, should be displayed with such prominence as will enable easy recognition.")

Applicant argues that its composite is "prominently displayed on Applicant's business cards, literature, vehicles, and equipment..." The argument is inapposite, however, because it is not the prominence or extent of display of the composite that is in issue.

The letters "K" and "A" and the red and black split shield are elements of applicant's composite mark that are readily recognizable. In contrast, we do not find the outline of applicant's composite to be displayed in such a manner that consumers will easily and readily recognize it.

Moreover, we have no evidence on which we could base a finding that the outline is or would be separately recognized by consumers. Cf. **In re Chemical Dynamics**, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (vice president's conclusory statement that element of mark created a distinct commercial impression held insufficient; absence of facts from which customer recognition could be inferred also held significant); **Seabrook Foods, Inc. v. Bar-Well**

**Foods Limited**, 196 USPQ 289, 291 n.8 (CCPA 1977) (in distinguishing *Swift* case, court noted that Swift had used "look for" advertising to promote customer recognition); and **In re Anton/Bauer Inc.**, 7 USPQ2d 1380, 1383 (TTAB 1988) (applicant offered no evidence to show promotion of its background designs "in a way that would set those designs apart from the word mark for which they serve as background.").

The cases on which applicant relies are not helpful in regard to the question whether the outline creates a separate commercial impression. Applicant has discussed cases in which designs were registered as inherently distinctive and, therefore, no showing of acquired distinctiveness was necessary.<sup>4</sup> Three of these decisions, however, concern trade dress applied to packaging, not background designs or elements of composite marks.

While the case of **In re W.B. Roddenbery Co., Inc.**, 135 USPQ 215 (TTAB 1962), did involve background designs, the case is distinguishable because there the applicant sought to register the entirety of each of four background designs, including elements of color, and omitted only the

---

<sup>4</sup> Though the Examining Attorney suggested that the applicant consider amending its application to proceed under a claim of acquired distinctiveness, applicant has proceeded on the theory that its mark is inherently distinctive and a showing of acquired distinctiveness is unnecessary.

wording from each composite. The *Roddenbery* case involved applications more akin to applicant's application to register its red and black split shield design without the letters "K" and "A".

Finally, the case of **In re Omni Spectra, Inc.**, 143 USPQ 458 (TTAB 1964) also is distinguishable. Though that decision characterizes the involved mark as a background design, the design element was clearly separate from the words with which it was used and, therefore, the only question the Board faced was whether the design element was distinctive.

Since we do not find the outline of applicant's composite mark to create a separate commercial impression, we need not reach the question whether the split shield design, absent use of lettering or colors, is inherently distinctive or is registrable only on a showing of acquired distinctiveness. Moreover, were it necessary to address that question, we would be handicapped by the failure of both the Examining Attorney and the applicant to provide us with evidence regarding the prevalence of shield designs generally, or for the particular goods and services of applicant.<sup>5</sup>

---

<sup>5</sup> The colloquy presented by the Examining Attorney's brief and applicant's reply brief, regarding the number of registered marks

**Ser. No.** 75/089,869

Decision: The refusal of registration based on the requirement for substitute specimens is, to the extent noted herein, reversed. The refusal of registration based on the failure of the outline of applicant's composite design to function as a separate mark is affirmed.

E. W. Hanak

T. J. Quinn

G. F. Rogers

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

---

falling within a particular design code of the Office's automated search system is, in this regard, uninformative.