

Oral Hearing:  
14  
June 6, 2000  
GHD/gdh

Paper No.

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

11/6/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Hoover Precision Products, Inc.

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Serial No. 75/333,163

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Thomas M. Galgano and Daniel P. Burke of Galgano & Burke for  
Hoover Precision Products, Inc.

Vivian M. First, Trademark Examining Attorney, Law Office 104  
(Sidney I. Moskowitz, Managing Attorney).

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Before Hohein, Hairston and Chapman, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Hoover Precision Products, Inc. has filed an  
application to register the mark shown below

for "precision, semi-precision and specialty balls for use as pen tips."<sup>1</sup>

Registration has been finally refused on the ground that the mark sought to be registered, as shown on the drawing, "is an unacceptable mutilation of the applicant's trademark" as shown on the specimens of use, and that applicant must therefore submit properly verified "substitute specimens showing use of the mark as it appears on the drawing." The specimens of record, which appear to be portions of the cartons in which applicant's goods are packaged, evidence the following manner of use:

Applicant has appealed. Briefs have been filed<sup>2</sup> and an oral hearing was held. We affirm the refusal to register.

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<sup>1</sup> Ser. No. 75/333,163, filed on July 30, 1997, which alleges dates of first use of May 1, 1990. In the application as originally filed, applicant claims, pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), that "[t]he mark has become distinctive of the goods through the applicant's substantially exclusive and continued use [thereof] for at least the five years immediately before the date of this statement."

<sup>2</sup> Although applicant, in its brief, alternatively maintains that its mark, as such appears on the drawing, is "capable of serving as a trademark and, therefore, at a minimum, should be registrable on the Supplemental Register," the Examining Attorney correctly points out in her brief that "[s]ince the record does not contain an amendment

As a preliminary matter, we observe that there appears to be no disagreement by either applicant or the Examining Attorney 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 Raychem Corp., 12 USPQ2d

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to the Supplemental Register, the issue is not properly raised during this appeal." Moreover, and in any event, it is consideration of the specimens of record, rather than a matter of the particular register on which registration is sought, which is determinative of whether the specimens evidence use of the mark which applicant seeks to register or whether applicant has "mutilated" its mark. Accordingly, no further consideration will be given to applicant's alternative contention.

In addition, inasmuch as Trademark Rule 2.142(d) provides in relevant part that, since the record in an application should be complete prior to the filing of an appeal, the Board will ordinarily not consider additional evidence submitted thereafter, we sustain the Examining Attorney's objection in her brief to "the untimely submission of applicant's letterhead evidence (Exh. A of applicant's brief)," which evidence was submitted for the first time with applicant's brief.

1399, 1400 (TTAB 1989); Tekelec-Airtronic, 188 USPQ 694, 695 (TTAB 1975); and In re Berg Electronics, Inc., 163 USPQ 487, 487-88 (TTAB 1969).

Turning, therefore, to the merits of this appeal, applicant argues among other things that as a manufacturer of ball bearings for various uses, including "pen ball tips," it "uses a logo which consist[s] of the words TSUBAKI and HOOVER which are positioned over the face of the ball bearing and polygonal base" on which such a bearing rests. According to applicant, "HOOVER is the first and main component of Applicant's name and TSUBAKI (with a 'T' having an elongated top leg) is a contraction of the name of its parent company Tsubakimoto Precision Products, Co., Ltd." Applicant argues that as so used, the ball bearing design which it seeks to register creates a separate and distinct commercial impression. In particular, applicant asserts that such is the case because:

Applicants' [sic] ball bearing design is not a common basic shape. While it does represent a circular ball bearing, the shading thereof is distinctive. Similarly, the incomplete polygonal base has a distinctive shape and is uniquely shaded. Indeed, it is respectfully submitted that the ball bearing background design is either inherently distinctive and/or distinctive as a result of secondary meaning - namely as a result of the continuous use thereof since 1990.

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We concur with the Examining Attorney, however, that the ball bearing design which applicant seeks to register "is an unacceptable mutilation of the applicant's mark" as shown on the packing carton specimens. Rather than being "uncommon," such design, including the shading, is obviously highly suggestive or illustrative of a ball bearing, whether as displayed on a stand or base or as representative of a pen ball tip. Applicant's design, as actually used on the specimens, plainly functions as a background or vehicle for the display of the word marks "TSUBAKI" and "HOOVER," and none of the advertising literature furnished by applicant demonstrates that the design alone is promoted as a mark. As the Examining Attorney accurately points out in her brief with respect to the evidence offered by applicant:

The statement of "substantially exclusive and continuous use" does not indicate that the ball bearing design was used separately from the word [HOOVER and the word] TSUBAKI and curved lines design so as to create its own distinct impression in the minds of consumers. As to the submitted advertisements, they do not show the ball bearing design alone in the manner depicted in the drawing because they include the word HOOVER inserted into the base element of the design.

We consequently find that there is nothing in the record which substantiates applicant's position that the ball bearing design it seeks to register, as it is actually used on

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the specimens, presents a separate and distinct commercial impression which, in and of itself, functions as a mark indicative of the source of applicant's goods. Absent, therefore, properly verified substitute specimens showing use of the mark as it appears on the drawing, such mark is not registrable.

**Decision:** The refusal to register is affirmed.

G. D. Hohein

P. T. Hairston

B. A. Chapman  
Administrative Trademark  
Trademark Trial and Appeal

Judges,  
Board