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AS PRECEDENT OF THE TTAB 8/15/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Who? Vision Systems, Inc.*

Serial No. 75/399,617

*Marguerite L. Gunn*¹ of Knobbe, Martens, Olson & Bear, LLP
for *Who? Vision Systems, Inc.*

Kathleen Keener Elsner,² Trademark Examining Attorney, Law
Office 103 (*Michael Szoke*, Managing Attorney)

Before *Sams, Bottorff and Holtzman*, Administrative
Trademark Judges.

Opinion by *Bottorff*, Administrative Trademark Judge:

On December 3, 1997, applicant filed an intent-to-use
application, the first sentence of which reads, in relevant
part, as follows: "Applicant requests registration of the
above identified trademark shown in the accompanying

¹ Applicant was represented by different counsel during
prosecution of the application. Applicant's appeal brief and
reply brief were filed by the counsel identified above.

² A different Trademark Examining Attorney was responsible for
examination of the application; the appeal brief was filed by the
Trademark Examining Attorney identified above.

drawing..." At the top right corner of the first page of the application, in the manner of a header, the following appears:

MARK: **TACTILESENSE**
International Class: **09**

However, on the drawing page submitted with the original application, the mark is depicted as TACILESENSE, rather than TACTILESENSE. Applicant's goods, as set forth in the amended identification of goods, are "fingerprint imaging systems, namely fingerprint image generator, image sensor, and image processor," in International Class 9.

On August 12, 1998, applicant filed a paper requesting that the mark shown on the drawing page of the original application be amended from TACILESENSE to TACTILESENSE. Applicant also submitted a substitute drawing page upon which the mark depicted is TACTILESENSE. In support of the requested amendment, applicant asserted that TACILESENSE, the mark set forth on the original drawing page, was an inadvertent misspelling of TACTILESENSE and the result of a typographical error.

The Trademark Examining Attorney refused to accept applicant's proposed amendment of the mark, on the ground

that the proposed amendment would constitute a material alteration of the mark. When that refusal was made final, this appeal ensued. Applicant and the Trademark Examining Attorney have filed main briefs, and applicant has filed a reply brief. No oral hearing was requested.

Before we reach the particulars of this case, we believe that a brief discussion of recent developments in the law pertaining to the amendment of marks in applications is in order. Under the Trademark Rules of Practice, an amendment to the drawing of the mark may be allowed only if the amendment does not materially alter the mark. See former Trademark Rule 2.72(a) ("Amendments may not be made to the description or drawing of the mark if the character of the mark is materially altered"),³ and

³ Former Trademark Rule 2.72, in its entirety, reads as follows:

§2.72 Amendments to description or drawing of the mark.

(a) Amendments may not be made to the description or drawing of the mark if the character of the mark is materially altered. The determination of whether a proposed amendment materially alters the character of the mark will be made by comparing the proposed amendment with the description or drawing of the mark as originally filed.

(b) In applications under section 1(a) of the Act, amendments to the description or drawing of the mark may be permitted only if warranted by the specimens (or facsimiles) as originally filed, or supported by additional specimens (or facsimiles) and a supplemental affidavit or declaration in accordance with §2.20 alleging that the mark shown in the amended drawing was in use prior to the filing date of the application.

(c) In applications under section 1(b) of the Act, amendments to the description or drawing of the mark, which

current (as amended effective October 30, 1999) Trademark Rules 2.72(a)(2), 2.72(b)(2) and 2.72(c)(2) ("... the applicant may amend the description or drawing of the mark only if: ... [t]he proposed amendment does not materially alter the mark").⁴

are filed after submission of an amendment to allege use under §2.76 or a statement of use under §2.88, may be permitted only if warranted by the specimens (or facsimiles) filed, or supported by additional specimens (or facsimiles) and a supplemental affidavit or declaration in accordance with §2.20 alleging that the mark shown in the amended drawing is in use in commerce. In the case of a statement of use under §2.88, applicant must verify that the mark shown in the amended drawing was in use in commerce prior to the filing of the statement of use or prior to the expiration of the time allowed to applicant for filing a statement of use.

(d) In applications under section 44 of the Act, amendments to the description or drawing of the mark may be permitted only if warranted by the description or drawing of the mark in the foreign registration certificate.

⁴ Current Trademark Rule 2.72, in its entirety, reads as follows:

§2.72 Amendments to description or drawing of the mark.

(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under §2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(b) In an application based on a bona fide intention to use a mark in commerce under section 1(b) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens filed with an amendment to allege use or statement of use, or substitute specimens filed under §2.59(b), support the proposed amendment; and

However, in *In re ECCS, Inc.*, 94 F.3d 1578, 39 USPQ2d 2002 (Fed. Cir. 1996), a case involving former Trademark Rule 2.72(a), the Court of Appeals for the Federal Circuit reversed the Board's affirmance of the Office's refusal to allow an applicant to amend the drawing of its mark from EXAMODULE, the mark which appeared on the original drawing, to the mark which appeared on the specimens submitted with the original application, i.e., EXA MODULE (on two lines). The Court held that the material alteration standard of former Trademark Rule 2.72(a) was inapplicable in that case because the application as originally filed contained an ambiguity as to what the mark sought to be registered was. The Court explained:

The second sentence of Rule 2.72(a) [which reads: "The determination of whether a proposed amendment materially alters the character of

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

(c) In an application based on a claim of priority under section 44(d) of the Act, or on a mark duly registered in the country of origin of the foreign applicant under section 44(e) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The description or drawing of the mark in the foreign registration certificate supports the amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.

the mark will be made by comparing the proposed amendment with the *description or drawing of the mark as originally filed* (emphasis by the Court)] obviously assumes that one knows what "the mark as originally filed" was, which is clearly not this case where the specimens and the drawing are in conflict, thus creating an ambiguity with respect to the mark. The basic question here is: What *is* the mark applicant originally sought to register? A related basic question is: What mark has been acquired by use? ...

...

...the PTO refused to accept [applicant's substitute drawing depicting the mark as EXA MODULE], insisting that "[a]pplicant initially sought registration for 'EXAMODULE.'" This raises a fundamental question - is that true? When an initial application contains specimens showing the *actual* use of a mark in commerce, thus giving rise to ownership, and a *drawing which does not correspond* to the mark which the applicant owns, what is the mark sought to be registered and how do we find the answer to that question?

39 USPQ2d at 2003-04.

The Court went on to identify two distinct categories of amendments to drawings in trademark applications:

In the first category ... are amendments to *conform* the drawing to the mark sought to be registered as shown by the specimens "showing the mark as actually used"

...

In the second category of amendments to drawings are those which attempt to *change the mark* described in the application as originally filed where there has been no ambiguity as to

what it is or inconsistency between the specimens and drawing as originally filed.”

39 USPQ2d at 2005 (emphasis in original). The Court held that the issue of material alteration arises only in cases involving the second category of amendments to marks; an amendment which falls within the first category may be approved even if it effectively would result in a material alteration. That is, when proposed amendment of the drawing is offered not for the purpose of changing the mark, but merely to remove an initial ambiguity as to what the mark sought to be registered is, then the material alteration analysis required by former Trademark Rule 2.72(a) is not applicable.

In *In re Dekra e.V.*, 44 USPQ2d 1693 (TTAB 1997), the Board, applying the analysis set forth by the Court in *ECCS*, reversed the Office’s refusal to allow a Section 44(e) applicant to amend the drawing of its mark to conform to the mark as it appeared on the foreign registration certificate submitted with the original application. The Board found that there was an internal inconsistency, in the application papers as originally filed, between the mark appearing on the drawing page and the mark in which applicant had ownership rights, i.e., the mark appearing on the foreign registration certificate, and that the proposed

amendment accordingly fell within the first category of amendments set out by the Court in *ECCS*. The Board found itself constrained, under *ECCS*, to allow the amendment, regardless of whether it resulted in a material alteration. 44 USPQ2d at 1696.

In response to *ECCS* and *Dekra*, and as part of a general rules change package which took effect on October 30, 1999,⁵ the Office amended the Trademark Rules pertaining to amendments to drawings of marks in applications. (The texts of former Rule 2.72 and amended Rule 2.72 are set forth *supra* at footnotes 3 and 4.) In its Notice of Final Rulemaking, published at 64 Fed. Reg. 48900 (Sept. 8, 1999) and in the Official Gazette at 1226 TMOG 103 (Sept. 28, 1999), the agency stated its reasons for the amendments as follows:

Material Alteration

⁵ According to the Notice of Final Rulemaking, the rules change package was enacted "to implement the Trademark Law Treaty Implementation Act of 1998 (TLTIA), Pub. L. 105-330, 112 Stat. 3064 (15 U.S.C. 1051), and to otherwise simplify and clarify procedures for registering trademarks, and for maintaining and renewing trademark registrations. TLTIA implements the Trademark Law Treaty (TLT). TLT is to make the procedural requirements of the different national trademark offices more consistent." 64 Fed. Reg. 48900 (1999). The Notice of Final Rulemaking also provides that the "Effective Date" of the rules change is October 30, 1999, and that "[t]he TLTIA amendments to the Act, and these rule changes, shall apply to any application for registration of a trademark pending on, or filed on or after, October 30, 1999." *Id.*

The Federal Circuit held in *In re ECCS*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996) that an applicant may amend an application based on use to correct an "internal inconsistency" in the original application. *Id.* at 1581, 39 USPQ2d at 2004. An application is "internally inconsistent" if the mark on the drawing does not agree with the mark on the specimens filed with the application. *Id.* As a result, the Office has been accepting all amendments to drawings in use-based applications if there is an inconsistency in the initial application.

However, the Office does not believe that it is in the public interest to accept amendments that materially alter the mark on the original drawing. When the Office receives a new application, the mark on the drawing is promptly filed in the Trademark Search Library and entered into the Office's electronic and administrative systems. Because the granting of a filing date to an application potentially establishes a date of constructive use of the mark under section 7(c) of the Act, timely and accurate public notification of the filing of applications is important. Accepting an amendment that materially alters the mark on the original drawing is unfair to third parties who search Office records between the application filing date and the date of the amendment, because they do not have accurate information about earlier-filed applications. Relying on the search of Office records, a third party may innocently begin using a mark that conflicts with the amended mark, but not with the original mark. Also, an examining attorney may approve a later-filed application for registration of a mark that conflicts with the amended mark, but not with the original mark. Therefore, the Office is amending §2.72 to prohibit amendments that materially alter the mark on the original drawing.

64 Fed. Reg. at 48902. Also, as will be discussed more fully *infra*, the amendments to the Trademark Rules included

an amendment to Trademark Rule 2.52(a), by which the following new provision was added: "A drawing depicts the mark sought to be registered."

With this background in mind, we turn to the issues presented by this case. The arguments of the Trademark Examining Attorney and of applicant may be briefly summarized as follows.

The Trademark Examining Attorney argues that applicant's proposed amendment of its mark from TACILESENSE to TACTILESENSE would be a material alteration of the mark, impermissible under Trademark Rule 2.72. She also argues that the "two-category" amendment analysis of *ECCS* has been superseded by the amended Trademark Rules, which by their terms are applicable to this case. Moreover, she contends, even if the *ECCS* two-category analysis were still viable and applicable in this case, applicant's proposed amendment would fall within the second category of amendments and thus would be governed by the material alteration standard.

For its part, applicant argues that its proposed amendment is intended merely to resolve the ambiguity in its original application papers as to what its mark is, that the amendment therefore falls within the first category of amendments outlined by the Court in *ECCS*, and that the material alteration standard accordingly is

inapplicable to this case. Applicant also argues that the amended Trademark Rules should not apply to this case because their effective date, October 30, 1999, is subsequent to applicant's filing of its request for amendment and the Trademark Examining Attorney's refusal thereof. Applicant further argues that even if the amended rules apply to this case, the language of those amended rules does not obviate the *ECES* two-category amendment analysis mandated by the Federal Circuit. Finally, applicant argues that, in any event, its proposed amendment is permissible because it would not constitute a material alteration of its mark.

Before we reach the material alteration issue underlying the Trademark Examining Attorney's refusal, we must determine whether applicant is correct in arguing that the material alteration analysis is irrelevant to this case under the analysis set forth in *ECES* and *Dekra*, or whether, instead, the Trademark Examining Attorney is correct in contending that the *ECES/Dekra* analysis has been superseded by the recent amendments to the Trademark Rules. First, however, we must decide whether those amended rules are to be applied retroactively in this case.

We find that the October 30, 1999 amendments to the Trademark Rules are indeed applicable to this case. The

Supreme Court has stated that "congressional enactments and administrative rules will not be construed to have retroactive effect unless their language requires this result." *Bowen v. Georgetown University Hospital, et al.*, 488 U.S. 204, 208 (1988). See also *Clairol Inc. v. Compagnie D'Editions et de Propagande du Journal La Vie Claire-Cevic S.A.*, 24 USPQ2d 1224 (TTAB 1992). The Notice of Final Rulemaking pertaining to the 1999 amendments to the Trademark Rules, at 64 Fed. Reg. 48900, expressly states that "these rule changes[] shall apply to any application for registration pending on, or filed on or after, October 30, 1999."⁶ In view of this explicit language giving retroactive effect to the rule changes, and because applicant's application in fact was pending on October 30, 1999, the amended rules must be deemed to apply to applicant's application and to govern this proceeding. *Cf. Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823, 1827 at n.8 (Fed. Cir. 1995).

We turn next to the issue of whether the "two-category" analysis used by the Court in construing former Trademark Rule 2.72 has been superseded by the recent amendments to the rules, or whether instead it has survived

⁶ See *supra*, footnote 5.

those amendments. It appears from the Notice of Final Rulemaking implementing the amended rules that the Office's intention in amending the rules was to provide, by rule, that the *ECCS* Court's question "what is the mark sought to be registered?" must be resolved by looking to the mark depicted on the original drawing. That is, in cases involving an "inconsistency" of the type involved in *ECCS* or *Dekra*, the Office's intention in amending the rules was to require that, contrary to the outcome in *ECCS* and *Dekra* and for reasons grounded in the public's interest in timely and adequate notice of the marks on file at the Office, such inconsistency is to be resolved by looking to the mark depicted in the original drawing, rather than to any other mark or marks which might be depicted elsewhere in the original application papers. To that end, the Office expressly stated that it "is amending §2.72 to prohibit amendments that materially alter the mark on the original drawing." Notice of Final Rulemaking, 64 Fed. Reg. at 48902 (emphasis added).⁷

⁷ Similarly, the Notice of Final Rulemaking includes the following statements: "...the Office does not believe that it is in the public interest to accept amendments that materially alter the mark on the original drawing;" "[a]ccepting an amendment that materially alters the mark on the original drawing is unfair to third parties..." Notice of Final Rulemaking, 64 Fed. Reg. at 48902 (emphasis added).

It does not appear, however, that the actual amendments to Trademark Rule 2.72 suffice to effect the Office's stated intention. Contrary to the Office's assertion in the Notice of Final Rulemaking, amended Trademark Rule 2.72 makes no reference to material alteration of "the mark on the original drawing." Amended Trademark Rule 2.72 requires only that the proposed amendment "not materially alter the mark." (Emphasis added.) As applicant notes, the language of amended Trademark Rule 2.72 does not answer or obviate the preliminary question raised by the Court in construing former Trademark Rule 2.72, i.e., what is "the mark" sought to be registered?⁸

⁸ Applicant notes that the operative language used in amended Trademark Rule 2.72 is essentially identical to the operative language of former Trademark Rule 2.72. That is, the former rule's prohibition of amendments to the description or drawing of the mark "if the character of the mark is materially altered" is essentially and substantively identical to the amended rule's requirement that "the proposed amendment does not materially alter the mark." Likewise, the former rule's provision that the material alteration determination is to be made by comparing the proposed amendment "with the description or drawing of the mark as originally filed" is essentially identical to the amended rule's provision that the material alteration determination is to be made by comparing the proposed amendment "with the description or drawing of the mark filed with the original application." Applicant argues that under both the former and amended versions of the rule, the "basic question" raised by the *ECCS* Court in cases involving an ambiguity in the original application papers, i.e., "what is the mark applicant originally sought to register?", still remains to be resolved.

However, this ambiguity in amended Trademark Rule 2.72 is resolved when the rule is read in conjunction with amended Trademark Rule 2.52(a), which provides, *inter alia*: "A drawing depicts the mark sought to be registered." This provision in amended Trademark Rule 2.52(a) is new; the former Trademark Rules included no such express definition of "the mark sought to be registered." Thus, amended Trademark Rule 2.72 prohibits any amendment which materially alters "the mark," and amended Trademark Rule 2.52(a) clarifies that "the mark" sought to be registered is the mark which appears on the drawing. We believe this to be a reasonable interpretation of the amended rules, one which gives effect to the Office's expressly stated intention that the Court's questions in *ECCS*, i.e., "what is the mark sought to be registered and how do we find the answer to that question?", be answered by looking to the mark depicted on the original drawing, rather than any other mark or marks which might be depicted elsewhere in the original application papers.

We conclude that the "two-category" analysis posited by the Court in *In re ECCS, Inc.*, *supra*, is no longer necessary or viable in view of the recent amendments to the Trademark Rules. Because the "mark sought to be registered" in an application is now defined, by rule, as

the mark which is depicted on the drawing, there can be no "internal inconsistency" or "ambiguity" of the type found by the Court in *ECCS*. Likewise, the "first category" of amendments identified by the Court, i.e., amendments which seek merely to resolve an internal ambiguity or inconsistency as to what the mark is, and to which the material alteration standard is not applicable, no longer exists.⁹ Instead, under the new rules, any and all proposed amendments are subject to the material alteration standard, and no amendment is permissible if it materially alters the

⁹ Additionally, even if the *ECCS* "two-category" analysis were deemed to be applicable despite the amendments to the Trademark Rules, we would affirm the Trademark Examining Attorney's refusal in this case. We agree with her contention that *ECCS* and *Dekra* are distinguishable, on their facts, from the present case. Applicant has submitted neither specimens of use nor a foreign registration certificate, and there thus is no basis for finding, as in *ECCS* or *Dekra*, an internal inconsistency between the mark depicted on applicant's original drawing and the mark depicted on such specimens or foreign registration certificate. See *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997); *In re CTB, Inc.*, 52 USPQ2d 1471 (TTAB 1999); *In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996). Moreover, *ECCS* and *Dekra* each involved an inconsistency between the mark appearing on the drawing and the mark in which, as was apparent from the original application filing, the applicant had actual ownership rights which were pre-existent to, and independent of, the filing of the application. In each case, the applicant was allowed to conform the mark on its drawing to the mark in which it held actual ownership rights. By contrast, nothing in the original application papers filed by applicant demonstrates that applicant had, as of the filing date, any such pre-existing, independent ownership rights in its proposed amended mark. Therefore, the rationale underlying the allowance of the amendments in *ECCS* and *Dekra*, i.e., to conform the mark on the drawing to the mark shown in the application papers to be the mark which is actually owned by the applicant, has no applicability in the present case.

mark sought to be registered, i.e., the mark depicted on the drawing.

Having determined that the *ECCS/Dekra* "two-category" analysis has been superseded by the amended Trademark Rules, that those amended rules govern this proceeding, and that the material alteration standard accordingly is applicable, it remains to be decided whether applicant's proposed amendment of its mark from TACILESENSE to TACTILESENSE would be a material alteration prohibited under amended Trademark Rule 2.72(b)(2).

The test for determining whether an amendment is a material alteration was articulated in *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983): "The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark." 220 USPQ at 743. "That is, the new and old forms of the mark must create essentially the same commercial impression." *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988).

We find that the proposed amendment of applicant's mark from TACILESENSE to TACTILESENSE would be a material alteration of the mark. As applied to the goods identified in the application, i.e., "fingerprint imaging systems,

namely fingerprint image generator, image sensor, and image processor," TACTILESENSE and TACILESENSE have distinctly different commercial impressions.

TACTILESENSE is a composite of two actual words, each of which has suggestive significance in relation to the other and as applied to the goods. "Tactile" is defined as "perceptible by touch" and "of or relating to the sense of touch." Webster's Ninth New Collegiate Dictionary (1990) at 1201. "Sense" is defined, inter alia, as "the faculty of perceiving by means of sense organs" and "a specialized animal function or mechanism (as sight, hearing, smell, taste, or touch) basically involving a stimulus and a sense organ." *Id.* at 1071. Together, the words "tactile" and "sense" create a connotation suggesting the sense of touch, a commercial impression which is reinforced by the very nature of applicant's goods. By contrast, no such connotation is created by the mark TACILESENSE. "Tacile" is not a word at all, and its meaninglessness is not alleviated by combining it with the word "sense." Nor does the composite TACILESENSE have any recognizable meaning, either in itself or in relation to the goods. Whatever connotation TACILESENSE might have, it certainly does not

have the same distinctive connotation, as applied to the goods, that TACTILESENSE has.¹⁰

We are not persuaded by applicant's argument that TACILESENSE and TACTILESENSE would be similar in terms of sound if the "C" in TACILESENSE were pronounced as a hard "c", as in "cat." We have not been able to identify any word in which a "c", when followed by an "i", is pronounced as a hard "c" or "k" sound, nor has applicant identified any such words. Rather, in all such words, e.g., "facile," "tacit" and "specimen," the "c" is pronounced like an "s", not like a "k".

It is settled, at least in the likelihood of confusion context, that there is no "correct" pronunciation of a trademark. See, e.g., *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985). However, it does not follow that any and all suggested pronunciations of a trademark must be deemed to be "correct" or viable, even those which are inherently implausible and inconsistent with common phonetic usage and practice. For the reasons stated above, we find it highly implausible that anyone

¹⁰ The difference in meanings between TACILESENSE and TACTILESENSE is not negligible, thus distinguishing this case from *In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996) ("NEW YORK JEWELRY OUTLET" not a material alteration of "NY JEWELRY OUTLET"), and from *In re Larios, S.A.*, 35 USPQ2d 1214 (TTAB 1995) ("VINO DE MALAGA LARIOS" and design not a material alteration of "GRAN VINO MALAGA LARIOS" with similar design).

would pronounce TACILESENSE with a hard "c" or "k" sound, as suggested by applicant. Rather, the "c" in TACILESENSE would be pronounced as a soft "c" or "s" sound, unlike the hard "c" or "k" sound of the "c" in TACTILESENSE.

TACILESENSE and TACTILESENSE are further phonetically distinguished by the presence of the second "t" sound in TACTILESENSE and the absence of that second "t" sound in TACILESENSE. We accordingly conclude that TACILESENSE and TACTILESENSE are dissimilar phonetically. The phonetic dissimilarities between the two terms, as well as their obviously dissimilar meanings or connotations, preclude any finding that the two terms create essentially the same commercial impression.

Nor are we persuaded by applicant's other arguments on the material alteration issue. First, the determination of whether the proposed amendment would be a material alteration is not governed by whether the Trademark Examining Attorney's initial search of the Office's database for potentially conflicting marks was broad enough to locate marks which would conflict with TACTILESENSE as well as TACILESENSE. The necessity of a new search can be a factor to consider, but it is not controlling. *In re Vienna Sausage Manufacturing Co.*, 16 USPQ2d 2044, 2047

(TTAB 1990); see also *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1162 (TTAB 1990).

Second, it is not relevant that applicant's mark has not yet been published and that republication therefore is unnecessary. The question is not whether the mark must, in fact, be republished. Rather, the issue is whether, assuming that the original mark had already been published, republication of the amended mark would be necessary in order to give fair notice to third parties. We find that such republication in fact would be necessary in this case.

Third, our legal determination as to whether applicant's proposed amendment is a material alteration of the mark is not affected by the apparent fact that the proposed amendment was erroneously entered into the Office's automated database many months after the application filing date,¹¹ or that, according to applicant,

¹¹ After the proposed amendment and substitute drawing page were filed by applicant, the Office's review and amendment clerk entered the substitute drawing into the application file and the proposed amended mark, TACTILESENSE, was entered into the Office's automated database. Despite the prior Trademark Examining Attorney's rejection of applicant's proposed amendment and substitute drawing, it appears that the application record and the Office's automated database were never corrected to reinstate the original drawing as the operative drawing, as required by TMEP section 807.14(a)(i). Thus, since November 12, 1998, the Office's automated database apparently has erroneously and improperly displayed the mark sought to be registered as TACTILESENSE, rather than as TACILESENSE.

Be that as it may, however, for nearly an entire year after the December 3, 1997 application filing date, applicant's mark

a commercial search service has displayed the amended mark rather than the original mark for an unknown period of time.

Finally, we are not persuaded by applicant's "description of the mark" argument. Applicant notes that Trademark Rule 2.72, in both its former and its amended forms, provides that the determination as to whether a proposed amendment materially alters the mark is to be made by comparing the proposed amendment with "the description or drawing of the mark" in the original application. Applicant argues that the reference to TACTILESENSE in the upper-right corner of the first page of applicant's original application constitutes a "description of the mark" within the meaning of Trademark Rule 2.72, and that

was displayed in the Office's database as TACILESENSE, the mark appearing on applicant's original drawing. During that year, the database provided no notice that anyone was seeking to register the materially different mark TACTILESENSE. Applicant's proposed amended mark is not made any less of a material alteration by the wholly fortuitous fact that the Office erroneously and improperly entered the proposed amended mark into the database almost a year after the application filing date.

On a related note, applicant contends in its reply brief that, by its proposed amendment, "Applicant is merely trying to correct an internal inconsistency which the Office failed to discover in its initial review of the application." (Reply brief, p. 7.) However, the Office was under no obligation to review applicant's drawing to ensure that it accurately set forth the mark applicant intended to register; that obligation was applicant's. The Office committed no error when it initially entered into its database the mark appearing on applicant's original drawing. The Office's error was the improper entry of the proposed amended mark into the database nearly a year later.

because applicant's proposed amended mark is identical to the mark depicted in that "description" of the mark, the proposed amendment is not a material alteration of the mark.

However, "description of the mark" is a term of art in the Trademark Rules, and we accord the term its usual significance as it is used in Trademark Rule 2.72. That is, a "description of the mark" is a discrete written statement, included in the application and generally printed on the registration certificate, which explains, clarifies or states the nature of the mark when that nature is not apparent from the drawing of the mark itself, or in cases where a drawing is not required. See, e.g., Trademark Rule 2.37¹²; Trademark Rule 2.52(a)(2)(ii)¹³;

¹² **Description of mark.** A description of the mark, which must be acceptable to the Examiner of Trademarks, may be included in the application, and must be included if required by the examiner. If the mark is displayed in color or a color combination, the colors should be described in the application." (Prior to October 30, 1999, the effective date of the amended rules, this rule was numbered as Rule 2.35.)

¹³ "...For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include in the body of the application a written description of the mark and explain the purpose of the broken lines."

Trademark Rule 2.52(a)(vi)¹⁴; and Trademark Rule 2.52(a)(3)¹⁵. See generally TMEP section 808. With respect to the operation of Trademark Rule 2.72 in the context of the "description of the mark," see *In re Orange Communications Inc.*, 41 USPQ2d 1036, 1037-38 at n.1 (TTAB 1996).

In summary, we have carefully considered all of applicant's arguments in support of its contention that its proposed amendment would not be a material alteration of the mark, but we are not persuaded. TACILESENSE and TACTILESENSE do not create essentially the same commercial impression, and the proposed amendment from TACILESENSE to TACTILESENSE accordingly would be a material alteration

¹⁴ "If a drawing cannot adequately depict all significant features of the mark, the applicant must also submit a written description of the mark."

¹⁵ "Sound, scent and non-visual marks. The applicant is not required to submit a drawing if the applicant's mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed written description of the mark."

prohibited under amended Trademark Rule 2.72(b)(2).¹⁶

Decision: The refusal to register is affirmed.

J. D. Sams

C. M. Bottorff

T. E. Holtzman

Administrative Trademark Judges
Trademark Trial and Appeal Board

¹⁶ The Trademark Examining Attorney also has argued that applicant's proposed amendment is impermissible under amended Trademark Rule 2.72(b)(1). That subsection, she argues, provides that an amendment to a mark in an intent-to-use application must be supported by the specimens submitted with an amendment to allege use or statement of use. She contends that applicant's proposed amendment accordingly must be refused because applicant has not yet filed an amendment to allege use or a statement of use, and thus has not submitted any specimens of use which support the proposed amendment, as required by Trademark Rule 2.72(b)(1). We need not and do not reach that argument in this case, in view of our finding that applicant's proposed amendment is a material alteration which is impermissible under amended Trademark Rule 2.72(b)(2).