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Paper No. 15
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Accu-Sort Systems, Inc.

Serial No. 75/415,705

John J. O'Malley and C. Frederick Koenig III of Volpe and Koenig, P.C. for Accu-Sort Systems, Inc.

Josette M. Beverly, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Quinn, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

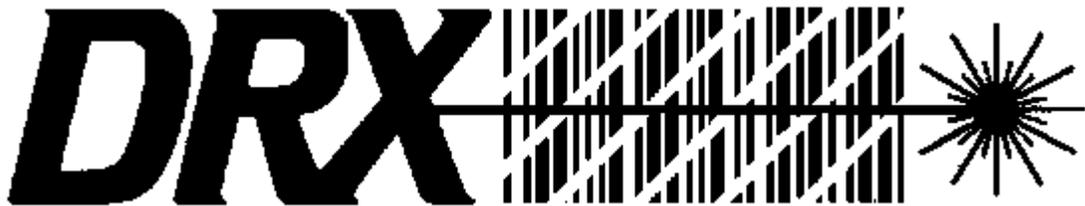
Accu-Sort Systems, Inc. seeks registration of the alleged mark shown below



for "automatic identification scanners and apparatus utilizing such scanners for reading labels and other identification markings on goods and packaging of goods to facilitate

inventory control, tracking, sorting, and/or distribution of such goods" in International Class 9.¹

The Trademark Examining Attorney made final her refusal of registration on the ground that the specimens of record, consisting of an adhesive label affixed to the front panel of the scanners, do not show use of the mark as it appears in the drawing. The Trademark Examining Attorney focused on the portion of the label having the letters DRX and the design features on the right side of the letters.



The Trademark Examining Attorney essentially contends that the matter presented in applicant's drawing omits essential and integral elements from the mark as it appears on the specimens. According to the Trademark Examining Attorney, because of the way the bar code design is so merged with the rest of the composite, the applied-for matter is an incomplete representation, or a "mutilation," of the mark as it appears

¹ Application Serial No. 75/415,705, filed on January 9, 1998, with claimed first use and first use in commerce on October 1, 1991. Applicant indicated by amendment that the lining shown in the drawing is a feature of the mark and does not indicate color. The original application papers also included a claim of acquired distinctiveness based upon an allegation of "substantially exclusive" use since October 1, 1991.

on the specimens. She argues that the stylized bar code design is fully integrated into the larger composite shown on the specimens, i.e., that the bar code does not create a separate and distinct commercial impression as a mark apart from the letters DRX and the balance of the design features as seen above.

By contrast, applicant argues that "the BAR CODE design, STAR design, and DRX word portions on the specimens create separate and distinct commercial impressions apart from each other." (applicant's brief, p. 3).

The critical question before the Board in this appeal is whether or not the specimens submitted with this application actually support registration of the applied-for mark. Trademark Rule 2.51(a)(1) provides, in part, that "... the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods[.]" After careful consideration of the record before us in this appeal, including the arguments of applicant and the Trademark Examining Attorney, we hold that the requirement for substitute specimens is justified.

Actually, there appears to be agreement between applicant and the Trademark 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 *provided* that element presents a separate and distinct commercial

impression as a mark. Specifically, this case turns on whether or not the applied-for element functions as a mark judged by the manner of its use on the specimens. The component is registrable, if indeed it creates a separate and distinct commercial impression which in and of itself is indicative of the source of the applicant's goods and distinguishes such from those of others. See Institut National des Appellations D'Origine v. Vintners International Co., Inc., 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992); In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989); In re San Diego National League Baseball Club, Inc., 224 USPQ 1067 (TTAB 1983); In re Lear-Seigler, Inc., 190 USPQ 317 (TTAB 1976); and In re Berg Electronics, Inc., 163 USPQ 487, 487-88 (TTAB 1969). See also, Trademark Manual of Examining Procedure, Sections 807.14(a) and 807.14(b), and cases cited therein.

As stated by the Court of Appeals for the Federal Circuit in the case of Institut National, *supra* at 1197:

'Mutilation' is a concept long recognized as a part of trademark registration case law. In re Servel, Inc., 181 F.2d 192, 85 USPQ 257, 259-60 (CCPA 1950). The issue must be decided on the facts of each case.

And later in the Institut National case, the Court cited Professor McCarthy's treatise² saying that the question is

² The current citation in McCarthy's treatise on this subject is 3 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §19:59 (4th ed. 1999).

"what exactly is the 'trademark'?" and further quoted Professor McCarthy as follows:

It all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct "trademark" in and of itself.

Turning, therefore, to the merits of this appeal, applicant argues that any such determination of the commercial impression created by the trademark is most subjective; that the bar code design herein is centrally located in the composite shown on the specimens; that the bar code design is distinct in nature; and that the bar code design creates a separate commercial impression and is therefore registrable based upon these specimens, and without the DRX wording or star design.

Beginning with the language of Trademark Rule 2.51(a)(1), we note that the drawing image is not a substantially exact representation of the mark as used on the specimens, even if one focuses on only that part of the image contained within the four corners of the bar code.

If one views the bar code image in the drawing and bar code image on the specimen as both strictly inanimate, two-dimensional objects, there are several differences.



First, the image in the drawing shows a horizontal white line on what might be deemed to be the trigger line. By contrast, the specimens show a red line totally filling the middle area where it intersects with the vertical bars. Hence, the specimens suggest that behind that red horizontal line, the vertical brown bars may not be broken in the middle at all, as seen prominently on the drawing of record.

Second, as presented on applicant's specimens of record, the applied-for bar code design is unquestionably shown in extremely close proximity to the large, italicized DRX lettering. Both the DRX letters and the bar code design are of the exact same height and both are presented in the same shade of brown. The letters DRX, the bar code and the red line and star design are all physically intertwined. These spatial and physical relationships alone are critical to how purchasers of this code scanning device would perceive the mark when viewing this composite matter. Hence, we agree with the Trademark Examining Attorney that the mark presented in

the drawing is an inseparable element of the entire mark as shown on the specimens.

As further support for this result, we note that the image on the drawing appears to be static and two-dimensional. By contrast, the purchasers who see these specimens will view the stylized bar code design in a dynamic fashion that suggests a three-dimensional activity.

Specifically, this technology uses a light source to read bar code symbologies, not unlike the ubiquitous scanning technology in retail markets that identifies the Uniform Product Code (UPC). Hence, consumers throughout the country, and especially an individual purchasing these high technology products from applicant, should recognize that a vertical pattern of repeating wide and narrow bars mixed with wide and narrow spaces represents a machine-readable bar code. Although based upon our experiences with UPC symbols, standard bar codes have continuous, unbroken vertical bars from top to bottom, the applied-for matter is unmistakably drawn from such bar code symbology.

The overall impression created by the intertwined elements of the composite mark, as shown on the specimens, is anything but static. If the crossing point of the two strokes of the letter "X" within the DRX lettering were seen as a light emitting device, there is a bright red line moving

toward the right edge of the adhesive label. The red beam of light cuts directly across the very center of the bar code. Quite close to the edge of the label, the thin red line terminates in the center of a bright red, starburst design.³

We find that the instant case is not unlike In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993). There, the Examining Attorney refused registration on the ground that the applicant applied for silhouette of a cup and saucer sitting on a table top:



was a mutilation of the composite mark in actual use, as illustrated by the specimens:



In the Boyd Coffee case, the Trademark Examining Attorney contended that the specimens showed a composite mark featuring

³ This is the design referred to herein as applicant's "star"

the cup and saucer design as well as the sunburst design. In affirming the refusal of registration in that case, this Board agreed with the Trademark Examining Attorney that the cup and saucer design did not present a separate commercial impression, noting, *inter alia*, that the sunburst design seemed to be emanating from the cup. *supra* at 2053. In fact, the Trademark Examining Attorney in the Boyd Coffee case had actually named the overall impression imparted by the specimens as "sunshine-in-a-cup." Similarly, we find in the instant case that the specimens suggest "scanning a bar code."

And while applicant argues as a point in favor of registration that its stylized bar code design is "centrally located" within the composite, such was also obviously the case with the specimens in the reported decision involving the image of a coffee cup and saucer.

However, each of these decisions turns on the facts as presented on these records, and in both cases, the elements the respective applicants want to extract are in each case inextricably bound together with other design features within the composite, as shown on the respective specimens of record. While three separate elements comprise the composite mark in the instant case, consumers who encounter this composite matter for the first time will form a dynamic commercial

design.

impression. The lettering, the light beam and the bar code (especially in view of the logical mental connection between the bar code design and the activity of bar code scanners/decoders) are proximate, touching and interacting.

Also helpful to our analysis is the case of In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). In this case, our principal reviewing court concurred with the Board that the mark as applied for (the medicine dropper and droplet alone) could not be registered based upon the composite image on the specimens, as shown below:



As we saw in the composite image in the Boyd Coffee case, this is another example where trade dress involves dynamic, three-dimensional imagery. The dropper of Chemical Dynamics is in the foreground where it intersects the handle of the watering can, and the droplet is logically coming out of the dropper and falling into the watering can below. Hence, in Chemical Dynamics, it was determined that in the context of the design, the applied-for elements were inextricably bound

up in the interrelated elements comprising the entire composite, and that applicant's attempt to separate out the dropper and droplet portions resulted in an impermissible mutilation of a single, unified design.

In consequence thereof, a properly verified substitute specimen, in which the stylized bar code design projects a separate and distinctive commercial impression, would be necessary in order for applicant to register such design alone as a mark for its goods. Given applicant's failure to comply with this requirement, we affirm the refusal of the Trademark Examining Attorney to register this matter.

Decision: The refusal to register is affirmed.