

2/26/02

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

Paper No. 14  
HRW

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Fenwick-Keats Realty, L.L.C.

---

Serial No. 75/569,622

---

**Sandra M. Koenig** of Fay, Sharpe, Fagan, Minnich & McKee, LLP for Fenwick-Keats Realty, L.L.C.

**Scott M. Oslick**, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

---

Before Wendel, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Fenwick-Keats Realty, L.L.C. has filed an application to register the sign post design, as depicted below, as a mark for “real estate brokerage services.”<sup>1[1]</sup>

---

<sup>1[1]</sup> Serial No. 75/569,622, filed October 14, 1998, claiming a first use date and first use in commerce date of August 1989.

Registration has been finally refused under Sections 1, 2, 3 and 45 of the Trademark Act on the ground that the mark shown in the drawing is a mutilation or incomplete representation of the mark as being used on the specimens and additionally on the ground that the mark shown in the drawing differs from that shown in the specimens of record. The specimens of record show use of the following:

The refusals have been appealed. Both applicant and the Examining Attorney have filed briefs but an oral hearing was not requested.

The Examining Attorney maintains that applicant's sign post design, although inherently distinctive, does not create a commercial impression separate and apart from the wording "FENWICK" and "KEATS" with which it is used in the specimens of record. He argues that it is the wording used in conjunction with the sign post design which identifies applicant's services. Noting that wording is an integral part of a street sign or cross road sign and without wording the signs would serve no purpose, the Examining Attorney argues that potential consumers, upon encountering applicant's mark as used on the specimens would instantly recognize the wording as an integral part of the

sign post design. Thus, the Examining Attorney argues that the mark, as shown in the drawing, is a mutilation or incomplete representation of the mark actually being used in the specimens. In view of this difference between the design sought to be registered and the mark shown in the specimens, the Examining Attorney has required that substitute specimens showing the sign post design alone be submitted.

Applicant contends that the background design of the sign post without wording creates a commercial impression separate and apart from the wording “FENWICK KEATS” and thus registration without the wording is appropriate. Applicant argues that the wording is not integral with the design and that it is the sign post design itself which points to applicant as the source of real estate services. According to applicant, crossroad sign posts are not used by others to indicate a source of real estate services. Applicant points to third-party registrations for various sign post designs without any words as support for registration of its sign post design. Applicant insists that since the street sign creates a separate commercial impression apart from the wording, there is no mutilation or incomplete representation and the present specimens support the mark as shown in the drawing.

As noted by our principal reviewing court in *Institut National des Appellations D’Origine v. Vintners International Co. Inc*, 958 F2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992), citing 1 J. T. McCarthy, *Trademarks and Unfair Competition* § 19:17 (2d ed. 1984), the issue of mutilation “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." It is well settled that an applicant may seek to register any element of a composite mark 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 *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999) and the cases cited therein. Moreover, when an applicant seeks to register a background design that is used in connection with a word and/or design mark, the background design may be registered as a mark only if it creates a commercial impression separate and apart from the word and/or design mark in conjunction with which it is used. In *re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998); *In re Anton Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988).

Thus, whether we consider the issue as one of mutilation or one of registration of a background design, the question to be resolved is whether applicant's sign post design creates a commercial impression separate and distinct from the composite of the sign post design and wording thereon.

Applicant relies heavily upon our decision in *In re National Institute for Automotive Service Excellence*, 218 USPQ 744 (TTAB 1983) as support for registration of its background sign post design. In that case, the Board found that the applicant's background meshed gears design was distinctive in nature,

created a visual impact, or a commercial impression, separate and apart from the words superimposed thereon and thus was registrable without the words.

We agree with the Examining Attorney that the present situation differs from that in *In re National Institute for Automotive Service Excellence, supra*, in that while wording is not typically viewed as an integral part of a design such as meshed gears, wording is an integral part of a street sign. There is no separate and distinct visual impact created by a street post sign absent any wording; a street sign by its very nature exists as a carrier for the words written thereon. Potential purchasers would not be likely to view the sign post alone as an indication of source when faced with the mark as used in the specimens of record. By contrast, in the *National Institute for Automotive Service Excellence* case, the meshed gear design in itself, without any wording, created a distinct and separate commercial impression.

Applicant also relies upon *In re Interstate Bakeries Corp.*, 153 USPQ 489 (TTAB 1967), wherein the checkered gingham background design which appeared on wrappers, containers and bands for the applicant's bakery goods was found to be registrable. Here again we find no parallel to the present situation. There was no specific wording used in connection with the gingham background which might be viewed by purchasers as an integral part of the design. Furthermore, while the Board found the gingham background arbitrary and eye catching, and apparently not commonplace in the bakery field, the Board also pointed to the strong evidence of promotion and of public recognition of the

gingham design as an indication of origin as support for its conclusion that the design functioned as a mark. Here we have no evidence of any promotion or public recognition of the sign post design in itself as an indication of source; we have only the specimens of record which show use of the sign posts in conjunction with the wording “FENWICK KEATS” as the indication of source of the real estate brokerage services.

Applicant asserts that the present circumstances are readily distinguishable from the mark involved in *In re Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1977). In that case the words THE LIBRARY were found to be so intimately related in appearance to the other elements of the mark as used by the applicant that it was not possible to conclude that the pictorial features by themselves created a separate commercial impression. We agree that the cited case differs from the present situation in that there the words were found to be “integral elements inseparable from the balance of the overall visual presentation.” *Id.* at 448. Here the wording does not add to the symmetry or to the outline of the sign post design. The sign posts stand independent of the wording. It is the general concept or impression of a sign post as the bearer of street names or other information which makes the wording an integral part of the sign post design. The sign post, absent any wording, does not create a distinct and separate commercial impression such that purchasers would look to this design alone as an indication of origin, particularly since these purchasers are faced only with the design being used in conjunction with the wording.

Finally, applicant points to copies of several third-party registrations in which sign posts or similar devices has been separately registered for various goods and/or services.<sup>2[2]</sup> However, we are without the file histories for these registrations and have no indication of the manner in which these marks are being used, with or without wording. Accordingly, the registrations are irrelevant to the registrability of the present sign post design, which as shown by the specimens, is used in conjunction with wording, as would be expected for a sign post.

Accordingly, we find that sign post design does not create a commercial impression separate and distinct from the composite mark shown in the specimens of record, namely the sign post and the wording thereon. The mark shown in the drawing is a mutilation or incomplete representation of the mark as being used on the specimens. Furthermore, because the mark shown in the drawing differs from that being used in the specimens, the Examining Attorney's requirement for substitute specimens showing the sign post design alone was proper.

Decision: The refusals to register are affirmed.

---

<sup>2[2]</sup> While the Examining Attorney is entirely correct that the copies of the two registrations which originate from a private trademark search have not properly been made of record, we have taken the registrations into consideration as a group.