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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alchemy Nominees Pty LTD

Serial No. 75/501,743

David G. Boutell of Flynn Thiel Boutell & Tanis, P.C. for
Alchemy Nominees Pty LTD.

Hellen M. Bryan-Johnson, Trademark Examining Attorney, Law
Office 114 (K. Margaret Le, Managing Attorney).

Before Hairston, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

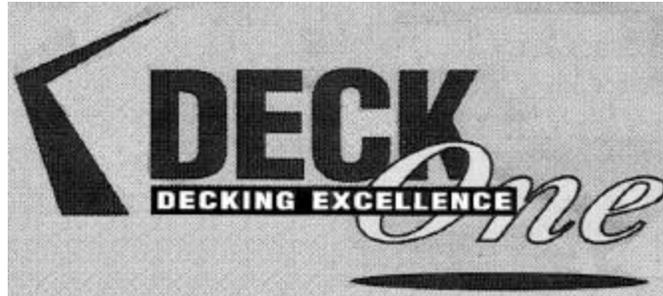
Alchemy Nominees Pty LTD seeks registration on the
Principal Register for the mark shown below:



as used in connection with goods identified, as amended, as
"metal building products, namely, nails, screws, bolts, metal

strapping, and fasteners for holding decking planks to a timber joist," in International Class 6.¹

This case is now before the Board on appeal from the final refusal to register on the ground that the specimen of record does not show use of the mark as it appears in the drawing. The composite mark is printed several different places on the specimen, and each time it includes the additional wording "Decking Excellence" in a rectangle superimposed over the initial portion of the word ONE, as follows:



The Trademark Examining Attorney essentially contends that this new composite form, as it appears on the specimen, creates a separate commercial impression from that presented in applicant's drawing. According to the Trademark Examining

¹ Application Serial No. 75/501,743 was filed on June 15, 1998, based upon applicant's claim of a *bona fide* intention to use the mark in commerce. Following the United States Patent and Trademark Office's issuance of a Notice of Allowance, applicant timely filed its Statement of Use under Trademark Rule 2.88, claiming use of this mark anywhere at least as early as January 31, 1999 and use in commerce at least as early as March 25, 1999, and including the required specimen.

Attorney, this is true because of the way the additional words DECKING EXCELLENCE are placed prominently in the foreground of the mark, partially obscuring and thereby diminishing the relative significance of the word "ONE."

By contrast, applicant argues that as shown on its specimen, the term "DECKING EXCELLENCE represents non-distinctive unregistrable matter," and that this laudatory slogan appears in small print, and it is placed inside a box. As a result, applicant argues that it is totally separate from the stylized DECK ONE lettering and does not change the commercial impression of the DECK ONE mark as shown in its drawing.

Applicant has argued that a new specimen is not required and has indicated no interest in amending the mark as shown in the drawing. Hence, the sole question before the Board in this appeal is whether or not the specimen submitted with the Statement of Use in this Intent-to-Use application actually supports registration of the applied-for mark.

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 a substitute specimen is not justified in light of the relatively minor alteration involved herein.

We begin our analysis with the language of Trademark Rule 2.51(a)(2):

"In an application under §1(b) of the Act, the drawing of the trademark shall be a substantially exact representation of the mark as intended to be used on or in connection with the goods specified in the application, and once ... a statement of use under §2.88 has been filed, the drawing of the trademark shall be a *substantially exact representation* of the mark as used on or in connection with the goods."

We note that Rule 2.51(a)(1) as it applies to use-based applications and Rule 2.51(a)(2) as it applies to intent-to-use-based applications are essentially the same. Most published Board decisions dealing with the "substantially exact representation" standard involve the owner of a mark filing a use-based application who has consciously culled out for registration just a portion of a larger composite mark. By contrast, in the instant case, it appears that sometime between the time this intent-to-use application was filed in June 1998 and the time the mark was first used in January 1999, applicant added the DECKING EXCELLENCE element. Nonetheless, these reported decisions are relevant because the test is the same whether the owner of a mark already in use has pulled out for registration a portion of a composite mark or the owner of an ITU application has added additional matter between the time of filing the trademark application and eventually making commercial usage.

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 specimen of use, *provided* that applied-for element, in and of itself, presents a separate and distinct commercial impression as a mark. 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 (TTAB 1989); In re Lear-Seigler, Inc., 190 USPQ 317 (TTAB 1976); and In re Berg Electronics, Inc., 163 USPQ 487 (TTAB 1969).²

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,

² See also Trademark Manual of Examining Procedure (TMEP) §807.14(b), (Third Edition 2002):

[I]n an application under §1 of the Trademark Act, the applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark used or intended to be used if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s)...

259-60 (CCPA 1950). The issue must be decided on the facts of each case.

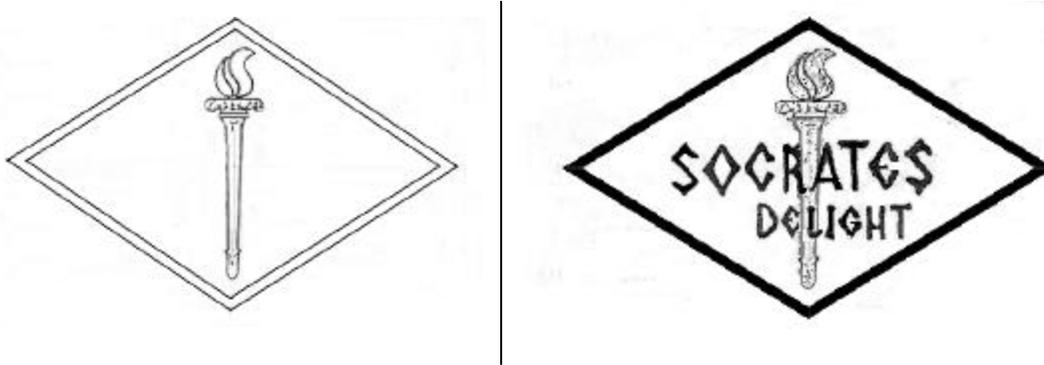
And later in the Institut National case, the Court cited Professor J. Thomas McCarthy's treatise³ saying that the question is "what exactly is the 'trademark'?" and further quoted Professor McCarthy as follows:

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.

Based largely upon the spatial and physical relationship of the elements herein, the Trademark Examining Attorney variously describes the new wording element on the specimen as being "merged," "intertwined" or "interwoven" with DECK ONE. In her judgment, the new wording is "integrated" with the balance of the specimen image, thereby making it an "essential" part of the composite mark. She notes that the additional words " ... are inside a rectangular carrier and superimposed over a significant part of the word ONE. Therefore, the specimens show a well-integrated mark in which the individual elements cannot be separated without mutilating the mark." (Examining Attorney's appeal brief, p. 3).

³ The current citation in McCarthy's treatise on this subject is 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §19:59 (4th ed. 2001).

In support of her position, the Trademark Examining Attorney cites to In re Sperouleas, 227 USPQ 166 (TTAB 1985), where the Board found that the design could not be registered apart from the wording. Images of the drawing and usage on the Sperouleas specimens follow:



The Board's finding of mutilation in the Sperouleas case is premised on the fact that within a composite where literal elements are prominent and placed over top of rather commonplace design features, the design feature may not be lifted out for separate registration. Conversely, the Board in Sperouleas stated:

" ... [T]he words in this case may be lifted from the design and separately registered, since as aforementioned they form the dominant part of the mark and since they are not obliterated by any part of the design ..."

Sperouleas *supra* at 168. The Board implied that it would not have found mutilation if applicant had applied to register the special form presentation of SOCRATES DELIGHT within the diamond design, but without the torch design. Thus, this hypothetical culling is closer to the facts of the instant

case than was Sperouleas' actual attempt to register the torch and diamond design without the wording.

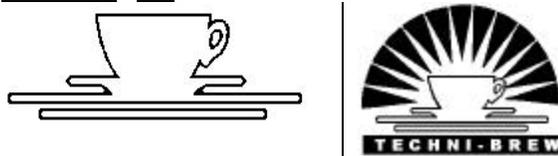
In this case, we acknowledge that the spatial placement and overlapping physical relationship of the wording "Decking Excellence" (i.e., underlining the word "Deck" and covering up a portion of the word "One") create some degree of physical connectedness between the literal elements of the composite shown on the specimen. On the other hand, we do not agree with the Trademark Examining Attorney that the wording "Decking Excellence" is an inseparable element of the entire mark as shown on the specimens. Rather, we find that visually the laudatory term "Decking Excellence" comprises an incidental overlay. As to connotation, the wording "Decking Excellence" merely accentuates the "preeminent" connotation of "Deck One." Finally, the unique design of the critical components of the mark remain unchanged between these two presentations, leaving the overall commercial impression of the DECK ONE mark unchanged with this addition:



In order to better calibrate our analysis, we review a number of reported trademark registration decisions where

applied-for elements were indeed found to be inextricably bound together with other design features within their respective composite marks, and hence could not be extracted. These decisions are helpful to our analysis inasmuch as the explanations all involve more than merely some degree of touching between (or among) the elements shown on the specimens in question. For example, prominently placed, arbitrary wording generally cannot be deleted. An element cannot be culled if it appears to be interacting in some manner with other elements in the composite as shown on the specimen. Similarly, the mutilation concept prohibits the removal of critical elements if their removal would change the overall look and feel of the mark.⁴ Each of the half-

⁴ In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993),



In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988),



In re Miller Sports Inc., 51 USPQ2d 1059 (TTAB 1999),



dozen cases cited above (where the applied-for matter differs from the composite image as actually used) presents an excellent visual example of the respective applicant's mutilation of a mark's commercial impression.

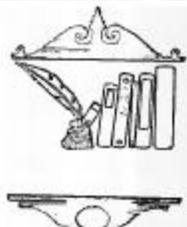
However, none of these basic fact patterns is present herein. When comparing the drawing of the mark (i.e., the matter for which applicant is seeking registration) with the composite mark as shown on the specimen, applicant has not pulled out a design feature for registration; applicant has not deleted arbitrary matter; applicant has not culled out some words from among other words of the same or similar size located together on the same line; and applicant has not changed the overall look and feel of the mark. Rather, the matter that applicant herein has attempted to pull out for

In re San Diego National League Baseball Club, Inc., 224 USPQ 1067 (TTAB 1983) [overturned on separate issue of mere descriptiveness of publications (In Re WNBA Enterprises, LLC, ___ USPQ2d ____, Serial No. 75/599,525 (TTAB June 11, 2003))]:

PADRES REPORT



In re Library Restaurant, Inc., 194 USPQ 446 (TTAB 1977),



registration comprises the only source-indicating material shown in the composite on the specimens as ultimately used. Accordingly, we find that the instant case is more like that of Schechter Bros. Modular Corp., 182 USPQ 694 (TTAB 1974):



The Board reversed the Examining Attorney, permitting applicant to cull out the primary wording and part of the design, and explained its reasoning as follows:

It is applicant's position that the subject matter of the application does not in any way destroy the commercial impression engendered by the total composite mark shown in its specimens. Applicant submits that the impression created by the mark as shown in its specimens is essentially what it is attempting to register in that the omission of the shadow image of the word portion does not obliterate or destroy the mark.

We agree with applicant. The shadow image is in effect a redundancy - it makes for an interesting logo but it is the word portion of the mark that creates the essential impression in this particular instance. And, purchasers of the goods are not likely to repeat that word mark or be impressed thereby only if it is repeated in the shadow image form.

The fact that applicant is the owner of a registration for "RAINAIRE," simpliciter, is indicative of what applicant basically considers its mark to be. In our opinion, the deletion of the shadow image is but a minor alteration and does not create a new and different mark creating a different commercial impression. It is our opinion that what is sought to be registered and the matter shown in the specimens are basically the same marks creating the same impressions. Applicant is not obligated to file a new drawing or new specimens.

As noted earlier, this case presents us with a factual judgment as to whether the designation for which registration is sought is a separate and distinct trademark. We find that applicant's mark as shown on the drawing is a substantially exact representation of the mark shown on the specimen of record because the DECK ONE and design mark shown in the drawing makes a separate and distinct commercial impression - with or without the largely incidental element added to this design, as shown on the specimen.

Decision: The refusal to register based upon a requirement for an acceptable, substitute specimen is reversed.