

THIS DISPOSITION IS
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Hearing: August 16, 2005

Mailed: September 30, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Gray Foxes

Serial No. 76544022

Vincent L. Ramik of Diller, Ramik & Wight for The Gray Foxes.

Odessa Bibbins, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Seeherman, Walters and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, The Gray Foxes, seeks to register the mark shown
below for "golf towels" in International Class 25 and "clothing,
namely hats and shirts" in International Class 25.¹

¹ Serial No. 76544022 filed September 11, 2003, based on an allegation
of first use and first use in commerce in both classes on July 10,
1988. Applicant states that the lining and stippling are for shading
purposes only.



The trademark examining attorney has refused registration of the mark on the ground that the mark shown in the drawing does not agree with the use of the mark on the specimens.² In view of the differences between the mark sought to be registered and the mark shown in the specimens, the examining attorney required that applicant submit substitute specimens properly showing the mark as used.³ In addition, the examining attorney stated that applicant may not submit an amended drawing to conform to the display of the mark on the specimens because the character of the mark would be materially altered.

When the refusal was made final, applicant appealed. Briefs have been filed, and an oral hearing was held.

² In the initial Office action the examining attorney required only that applicant clarify the lining and stippling in the mark. Registration was refused in the second action upon the examining attorney's further consideration of the application.

³ The examining attorney states in her brief that applicant was also offered the option of amending the filing basis of the application to Section 1(b). However, we do not see where this option appears in any Office action nor has applicant sought to make such an amendment.

The issue before us, as the examining attorney acknowledges in her brief, is whether the mark, as it appears in the drawing in the application, is a substantially exact representation of the mark as used on the specimens. See Trademark Rule 2.51(a).⁴

The mark as it appears on applicant's specimens for Class 25 is reproduced below. The mark is used in the same manner on the specimens for Class 18.⁵ As described by applicant, the mark on the specimens consists of "a fanciful fox standing upon a 'golf green' from which rises a golf 'flag stick' carrying a flag bearing thereon '19.'" Also appearing on the specimens is the stylized wording "LAKE MONTICELLO" which is curved along the lower edge of the "golf green." Applicant is seeking to register the entirety of the composite except for the wording "LAKE MONTICELLO."

⁴ Applicant specifically states that it is not seeking to amend the mark to include this other element in the drawing. Thus, there is no issue as to whether there is a material alteration of the mark, and the examining attorney's arguments in this regard have not been considered.

⁵ In her final action, the examining attorney also based the refusal on the omission from the drawing of the name "Lou Monte" which, along with "Lake Monticello," appears in the mark on the specimen for Class 18. The examining attorney withdrew this basis for the refusal in her brief. Thus, we do not consider "Lou Monte" as forming part of the composite mark as it appears on the specimens for Class 18.



The examining attorney contends that the wording "LAKE MONTICELLO" along with the wording and design shown on the specimens form a composite word and design mark, all of which, according to the examining attorney, contribute to a unified commercial impression "that is distinctly different than the mark on the drawing." As the basis for this contention, the examining attorney argues that the wording appears "in extremely close proximity beneath [the design]" and concludes that the "spatial proximity in this case is very significant in the commercial connotation of the mark."

It is applicant's contention that the mark as shown on the drawing creates a separate and distinct commercial impression apart from the wording "LAKE MONTICELLO," "irrespective of 'proximity.'" Applicant argues that the deletion of this element is not a mutilation because, according to applicant, that term is neither an integral nor essential part of the mark. In particular, applicant argues that "LAKE MONTICELLO" is "totally

separate from, spaced above [sic]" the other elements in the mark and moreover is informational and therefore not essential to the commercial impression of the mark. In this regard, applicant states that Lake Monticello is a city, a community and an association in Charlottesville, Virginia, and that its golf association is part of the Lake Monticello community.

Applicant has submitted pages from the website of the Lake Monticello Owners' Association which describe the Lake Monticello organization and applicant's golf association.

Trademark Rule 2.51(a) provides that "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services." The issue in this case concerns the deletion of an element, the stylized wording "LAKE MONTICELLO," that appears in the specimens. The question is whether the mark sought to be registered is a "mutilation" or an incomplete representation of the mark that is actually used. See, e.g., *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

It is well settled that an applicant may seek to register any portion of a composite mark if that portion 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 *Institut National des Appellations D'Origine v. Vintners International Co.*

Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); and Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). If the portion of the mark sought to be registered does not create a separate and distinct commercial impression, the result is an impermissible mutilation of the mark as used.

As noted by our primary reviewing Court in Chemical Dynamics, supra at 1829, quoting 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."

We agree with applicant that THE GRAY FOXES and design composite shown in the drawing creates a separate commercial impression apart from the wording "LAKE MONTICELLO." Contrary to the examining attorney's apparent contention, the mere fact that two or more elements of a composite mark are in close proximity to each other does not necessarily mean that those elements cannot be registered separately. Proximity is a consideration but it is not the only consideration. It is the overall commercial impression of the mark that is controlling. Here, the term "LAKE MONTICELLO" is proximate to the remaining portion of the composite, but it is nonetheless physically separated from the design. In addition to its physical separation, the term appears in smaller size and slightly different stylization than

the other wording in the mark, "THE GRAY FOXES," and it is also less prominent than that wording. We view "LAKE MONTICELLO" as a visually insignificant part of the composite mark such that its removal does not disturb any aspect of the mark's visual continuity.

We also view "LAKE MONTICELLO" as a conceptually insignificant part of the mark. It is a nondistinctive geographic term with no inherent trademark significance. See, for example, *The Institut National des Appellations D'Origine*, supra at 1197 (holding that CHABLIS WITH A TWIST is not a mutilation of CALIFORNIA CHABLIS WITH A TWIST in part because of the geographic significance of "California."). Moreover, this geographic term is not connected in meaning to any other portion of the composite mark. Instead, it performs a purely informational function and contributes nothing of significance to the overall commercial impression of the mark.

Accordingly, we find that THE GRAY FOXES and design composite creates a separate and distinct commercial impression apart from "LAKE MONTICELLO," and that it therefore may be registered as a mark.

In view of the foregoing, we find that the mark shown in the drawing is a substantially exact representation of the mark shown on the specimens.

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Decision: The refusal to register and the requirement for substitute specimens are reversed.