

THIS DISPOSITION IS NOT  
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THE TTAB

Mailed: July 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re In Mook Kim

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Serial No. 78483075

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Mark D. Hansing of McKee, Voorhees & Sease, PLC for In Mook Kim

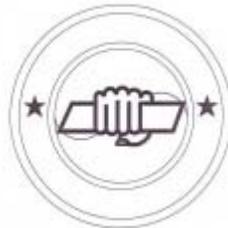
Kim Saito, Trademark Examining Attorney, Law Office 102  
(Thomas V. Shaw, Managing Attorney).

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Before Holtzman, Drost and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

In Mook Kim has filed an application to register, on the Principal Register, the mark shown below,



for services ultimately recited as "Instruction and training in the martial arts including the instruction of

Tae Kwon Do and Instruction in the tournament rules and procedures for, and conduct of, the sport of Tae Kwon Do" in International Class 41. The application was filed on September 14, 2004, based upon allegations of first use on September 15, 1970 and use in commerce on May 12, 1971. 15 U.S.C. §1051(a).

The 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. 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 or to amend the filing basis of the application to Section 1(b). 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, but applicant did not request an oral hearing. We reverse the refusal to register.

The sole issue before us 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. Trademark Rule 2.51(a).

The mark as it appears on applicant's specimens (one in color, one in black and white) is reproduced below.



As described by the applicant the mark in the drawing consists of a "representation of [a] fist grabbing [a] chevron, [a] split circle surrounding that combination, two concentric circles, and stars on each side of the fist." Br. p. 4. Applicant states that "The only difference between the specimen and the drawing is the removal [of] 'KIM'S ACADEMY OF TAE KWON DO' from the white background between the two concentric circles, removal of three Korean letters or characters in that same white area, and removal of two Korean characters in the white area in the chevron on each side of the fist." Id. The three Korean characters translate into English as "Tae Kwon Do" and the two Korean characters translate into English as "Tae" and "Kwon." Id. Applicant is seeking to register the graphic design without the English and Korean wording.

The examining attorney contends that the "English wording and Korean characters are integrated element [sic]

in the applicant's mark." Br. unnumbered p. 4. As the basis for this contention, the examining attorney argues that "in the specimen, the English wording and the Korean characters crowd the outer circle virtually hiding the two five-pointed stars whereas the drawing shows an open expanse in the outer circle" and "the fist design is flanked by two Korean characters again giving the mark a cluttered appearance rather than the clean, empty space in the drawing." Id. Further, she states that "the additional words on the submitted specimen indicate the source of the services by including the name and type of the business in two languages printed in bold, capital letters", thus "[w]ithout the Korean characters and English wording, the mark in the drawing does not have the same commercial impression as the mark depicted in the specimens" and even "[a]ssuming that the lettering is not distinguishable...the lettering still provides a visual cue to consumers that there is some writing in the outer circle." Br. unnumbered p. 5. The examining attorney distinguishes the cases cited by applicant noting that in *In re Esso Standard Oil Co.*, 305 F.2d 495, 134 USPQ 402 (CCPA 1962), the written elements "were clearly separable and distinct elements from the background display" and in *In re National Institute for Automotive Service Excellence*,

218 USPQ2d 744, 745 (TTAB 1983) "the Board reasoned that at a distance the design stood out separate from the words and provided a means of ready recognition" by contrast to the present case where "When viewed from a distance, the design portion of the applicant's mark does not provide a means of ready recognition apart from the associated wording." Br. unnumbered p. 6. The examining attorney points to *In re Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1997) as a similar example where the "wording was so intimately related in appearance to the other elements in the mark that the design by itself was not a separable element." *Id.*

It is applicant's contention that the mark as shown in the drawing creates a separate and distinct commercial impression apart from the English and Korean wording. Applicant argues that the deletion of this element is not a mutilation because the "design of a clenched fist, around [a] horizontal chevron, over a split circle, surrounded by two concentric circles, and two spaced apart stars, is not a 'common basic shape'" and "creates 'a visual impact separate and apart from the word superimposed thereon.'" Br. p. 5. In support of this contention, applicant points to several examples of use in the record where the mark is displayed on different items, e.g., a patch, letterhead, poster, etc., and emphasizes that the wording and lettering

are not distinguishable but the graphic design is.<sup>1</sup>

Applicant distinguishes *In re Library*, supra, by noting the large gap left between the quill and ink bottle and several books when the wording was removed, and *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999), by noting that the M and skater design were merged into the entire word.

Trademark Rule 2.51(a)(1) provides that "the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods." The issue in this case concerns the deletion of the wording "KIM'S ACADEMY OF TAE KWON DO" and the Korean characters, that appear in the specimens.<sup>2</sup> The question is whether the mark sought to be registered is a "mutilation" or an incomplete presentation of the mark that

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<sup>1</sup> We note applicant's request that we take judicial notice "that a 3 or 4 inch diameter patch, worn by thousands over thirty years, with letters an inch or less tall would be perceived from a distance where the words would not be readable." However, this is not the type of fact of which we may take judicial notice.

<sup>2</sup> We note the split circle in the middle did not reproduce well in the depiction of the specimens in this decision, however, it is visible in the examining attorney's brief and the depiction of the split circle in the specimens is not in dispute. We also note the slight differences in the graphic elements between the drawing and the specimens, namely, the extra knuckle on the hand in the drawing and the slightly higher placement of the stars in the specimens. Again, these differences are not in dispute, and the examining attorney found the graphic elements in the specimens to be a substantially exact representation of the graphic elements in the drawing. "As used on the specimen, the design element is the same as the drawing..." Br. unnumbered p. 3.

is actually used. See, e.g., *In re Miller Sports Inc.*, supra.

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.*, 939 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, 5 USPQ2d at 1829, quoting 1 J.T. McCarthy, *Trademarks and Unfair Competitions* §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 the applicant that the design shown in the drawing creates a separate commercial impression apart

from the English and Korean wording. The fact that the wording is in close proximity to the graphic elements does not dictate that those elements cannot be registered separately. While proximity is a consideration, it is the overall commercial impression of the mark that is controlling. We find the facts of this case more similar to *In re Esso, supra*, and *In re National Institute, supra*, than to *In re Library, supra*. The wording in the circle is more akin to wording appearing within a background design as was the case in *In re Esso*, rather than acting almost as a bookend and a shelf in *In re Library*. Although the stars also appear in the circle, they are easily distinguishable as part of the graphic design and not part of the wording. In addition, the Korean characters appearing on what the applicant refers to as a chevron, and what appears to be a diploma, are hardly noticeable. By contrast, we find the graphic elements visually distinctive and draw the observer's attention away from the wording.

Accordingly, we find that the graphic design creates a separate and distinct commercial impression apart from the wording "KIM'S ACADEMY OF TAE KWON DO" and the Korean characters, and that it therefore may be registered as a mark.

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

**Decision:** The refusal to register is reversed.