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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Board of Trustees of The University of Alabama and
Auburn University

Serial No. 76143855

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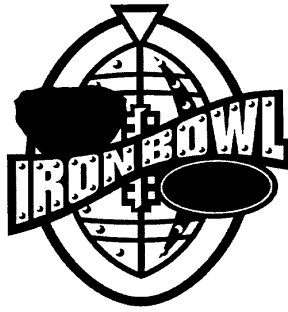
Before Hanak, Bottorff and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

The Board of Trustees of The University of Alabama and
Auburn University, joint applicants, seek to register the mark
shown below for the following goods (as amended):

Clothing, namely, t-shirts, in Class 25.

Entertainment services, namely arranging and conducting
athletic events, in Class 41.



The application was filed on October 9, 2000 based on applicants' assertion of a bona fide intention to use the mark in commerce. Following publication of the mark for opposition on August 28, 2001, applicants filed a statement of use together with the required specimens alleging dates of first use of the mark and first use in commerce on October 30, 2000. The examining attorney rejected the statement of use and refused registration of the mark essentially on the ground that the mark shown in the drawing did not agree with the use of the mark on the specimens.¹ In view of the differences between the mark sought to be registered and the mark shown in the specimens, the examining attorney has required that substitute specimens properly showing the mark as used be submitted.

When the refusals were made final, applicants appealed. Briefs have been filed. An oral hearing was held.

¹ An additional refusal on the ground that the proposed mark is ornamental as used on the goods in Class 25 was subsequently withdrawn by the examining attorney.

To be clear, the 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.² See Trademark Rule 2.51(a).

The mark as it appears on applicants' specimen for t-shirts in Class 25 contains several design and word elements that are not present in the drawing. Those elements consist of an elephant head design and a tiger eyes design on the upper left and lower right quadrants of the football, respectively; the wording "ALABAMA VS AUBURN" within the top portion of the oval with "VS" in the center of the triangle; and the date "NOVEMBER 18, 2000" following the inner curve of the oval at the bottom of the football.

Like the mark shown in the specimen for Class 25, the mark in the Class 41 specimen also includes the elephant head and tiger eyes designs. However, unlike the Class 25 specimen and the drawing of the mark, the mark in the Class 41 specimen does not contain the concentric oval design with the triangle at the top or the wording "ALABAMA VS AUBURN." In addition, the date

² As applicants correctly point out in their brief, the examining attorney improperly characterized the issue in her brief as "whether the mark as it appears on the specimens constitutes a material alteration of the mark as shown in the drawing of record." Examining Attorney's Brief, unnumbered p. 2. However, at least at certain points in her brief, the examining attorney addressed the appropriate issue of whether the drawing of the mark is a substantially exact representation of the mark as used.

"NOVEMBER 18, 2000" floats outside the bottom rim of the football.

Trademark Rule 2.51(a) provides that once a statement of use has been filed, the drawing of the trademark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services. The case before us actually presents two separate issues involving the question of whether the mark in the drawing is a "substantially exact" representation of the mark as used. One issue concerns the addition of certain elements to the drawing of the mark that do not appear in the mark as shown on the specimens for the Class 41 services, i.e., the concentric oval and triangle design.³ The other issue concerns the deletion of certain elements from the drawing of the mark that appear in the specimens for both classes of goods and services, including the elephant head and tiger eyes designs. The latter issue, as it relates to applicants' attempt to register a separate part of the composite mark shown on the specimens, is one of whether the mark sought to be registered is a "mutilation" or an incomplete representation of the mark that is actually used. See, e.g., 3 J. Thomas McCarthy, *McCarthy on*

³ Applicants contend on page 14 of their brief that this issue was not addressed by the examining attorney until the denial of applicants' request for reconsideration. We find that the examining attorney sufficiently raised this issue in both actions that were issued prior to the denial of the request for reconsideration.

Trademarks & Unfair Competition, §19:59 (4th ed. 2003)

("'Mutilation' refers to a situation where a seller seeks registration of something less than the totality of his trademark."). Applicants have indicated that they are specifically not seeking to amend the drawing to include these other elements in the drawing of their mark. Thus, contrary to the examining attorney's contention, there is no issue as to whether there is a material alteration of the mark.

We turn first to the question of whether the drawing of the mark is a mutilation of the mark as actually used.

Applicants maintain that the applied-for mark creates a distinct commercial impression and is therefore registrable. It is applicants' position that the nature of the "Iron Bowl" game makes it "highly likely that consumers ... will perceive the Iron Bowl Design as a mark separate and distinct from the Elephant Head and Tiger Eyes Designs used in conjunction therewith."⁴ Brief, p. 11. Specifically, applicants explain, based on evidence made of record, that the "Iron Bowl" is a widely known, century-old annual football game between joint applicants the University of Alabama and Auburn University; that the elephant head design itself is used by co-applicant, The Board of Trustees

⁴ Applicants consistently refer to the term "IRON BOWL" as separate words although that is not necessarily the commercial impression conveyed by either one of the specimens of record. Nevertheless, for the sake of consistency, and since it does not affect any aspect of our

of the University of Alabama, and the tiger eyes design is used and registered by co-applicant Auburn University; that consumers are aware that the underlying football match is always between the University of Alabama and Auburn University; and that therefore consumers will recognize the elephant head and tiger eyes designs of those participants as marks separate and distinct from the IRON BOWL and design mark.

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 thereby performs the trademark function of identifying the source of an applicant's goods and services and distinguishing those goods and 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

determination in this case, we will likewise refer to "IRON BOWL" as separate words in this decision.

judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself." The question of whether the designation sought to be registered creates a separate and distinct commercial impression must be determined based on the specimens of use.

As shown above, the marks in both specimens contain the stylized words "IRON BOWL" emblazoned horizontally at a slight upward tilt across the middle of a composite design. This composite design serves as a background design for the words "IRON BOWL" and consists of a football with various design components including the elephant head and tiger eyes designs. Applicants are seeking to register only the portion of this background design consisting of the football and the blackened areas in the spaces where the two animal head designs once appeared.

We have no problem finding that the designation can function as a mark apart from the wording "ALABAMA VS AUBURN" and the date "NOVEMBER 18, 2000" because the omission of these elements does not disturb the integrity of any aspect of the overall design. The date is mere informational matter, the phrase "ALABAMA VS AUBURN" is not particularly prominent or even visible, and neither of these elements is physically intertwined with any other elements of the composite mark.

However, we find that the portion of the background design that is left after the animal head designs have been extracted does not create a distinct commercial impression apart from the deleted elements and does not function without those elements on its own as a separate mark. All of the background design elements in the mark combine to form a single, unified commercial impression. The deleted elements are not only visually prominent, but they are physically integrated into the football and contribute to the symmetry and balance of the overall design. The unitary nature of the overall background design is even more apparent in the Class 25 specimen where the concentric oval and triangle design gives the football a rounder, more expansive appearance thereby more fully integrating the two animal head designs. Applicants are correct that the mere fact that two or more elements form a composite mark or are in close proximity does not necessarily mean that those elements cannot be registered separately. However, these two design elements are not only proximate to the other background elements, they are visually embedded in those elements. In fact, the extraction of the two animal head designs leaves physical holes in the football, thereby destroying the visual integrity of the background design as a composite whole.

Applicants contend that the specimens show that the designation creates a separate and distinct commercial impression

"not simply in terms of the visual impression" but also "in light of its likely interpretation and meaning to the relevant consuming public." Brief, p. 3. Applicants reason that the "Iron Bowl" is widely known as an annual football game between the University of Alabama and Auburn University (as shown by the materials made of record) and that consumers that "are likely to encounter merchandise bearing Applicants' mark will readily perceive the Elephant Head Design as an Alabama mark and the Tiger Eyes as an Auburn mark." Brief, p. 3. Pointing to third-party registrations for a Budweiser label design and a Coca Cola bottle design, applicants further argue that their proposed mark is "at least as distinctive" as those registered designs, noting that it too has interior space for the placement of additional marks. Brief, p. 8. Applicants contend that the blank spaces in the registered design marks, as in applicants' design, "are a visual cue to the viewer leading him or her to expect that other marks will appear in that interior space" thereby indicating to consumers "that the logos are separable from the applied-for mark" and thereby "reinforcing their commercial impression as distinct from the Iron Bowl Design." Brief, p. 13.

There are a number of problems with applicants' arguments. To begin with, there is no support for applicants' contention that consumers would expect that a word or other design element would appear in the Budweiser label design or the Coca Cola

bottle design, or in applicants' own mark for that matter. Moreover, whether consumers would or would not expect other marks to appear in the spaces of either registrants' or applicants' mark is beside the point.⁵ The only relevant point is that the label and bottle designs, in and of themselves, function as marks, with or without wording, to identify and distinguish the source of the registrants' respective products. What applicants seek to register does not perform this function.

In addition, in deciding whether the mark sought to be registered creates a separate and distinct commercial impression, the question is not whether "Iron Bowl" or the animal head designs are well known marks in and of themselves, or whether those designations are used separately, or whether they create a separate commercial impression apart from the rest of the background design. Applicants are not seeking to register any of these designations apart from the rest of the mark. The mark for which registration is sought is not deemed to create a separate and distinct commercial impression merely because the deleted elements are separately recognized as marks owned by applicants.

⁵ In any event, it is more likely that a continued expectation that the animal head designs would appear in the mark would support a finding that the designation sought to be registered does not function on its own, that is, apart from those other designs, as a separate mark.

Further, it is not relevant whether "Iron Bowl" or the elephant head and tiger eyes design would be recognized by consumers in any and all possible manners of use or display. The relevant consideration is whether this particular form of the mark for which applicants seek registration, as used in the particular manner displayed on applicants' specimens, would be perceived as a mark separate and apart from those other designations. See, e.g., *In re Franklin Press, Inc.*, 199 USPQ 819, 823 (TTAB 1978) ("a salient consideration in determining registrability is ... whether the mark in question would be recognizable by the purchasers of the goods or services *as the mark that they have encountered in the marketplace.*" Emphasis added.).

In addition to the registrations for the Budweiser label and Coca Cola bottle design, applicants point to *In re Esso Standard Oil Co.*, 305 F.2d 495, 134 USPQ 402 (CCPA 1962), *In re Schenectady Varnish Co., Inc.*, 280 F.2d 495, 126 USPQ 395 (CCPA 1960), *In re Swift & Company*, 233 F.2d 950, 106 USPQ 286 (CCPA 1955), and numerous other cases in support of their position that the mark herein is registrable.⁶ However, the label and bottle design as well as all of the cases cited by applicants involve the registration of the entirety of a background design apart

⁶ Applicant's citations to nonprecedential decisions of the Board have not been considered.

from a composite word and design mark. Merely because words and design portions can be registered separately even when used as parts of a composite mark does not necessarily mean that a particular portion of a composite design can itself be broken out and registered separately as applicants are trying to do here.

We find that this case is very similar to *In re Chemical Dynamics, supra*. That case involved an application to register the portion of the background design shown below consisting of the dropper and droplet design but not the can:⁷



The Court affirmed the Board's finding that the eye-dropper, handle of the watering can and water droplet were "interrelated elements of a single unified design" and consequently that the dropper/droplet component of the mark did not perform a trademark function in and of itself, that is, apart from the remaining background elements.

Similarly, in the present case, the elephant head and tiger eyes designs are integral elements of a visually unified design.

⁷ The Court specifically noted that the word portion of the mark had already been separately registered.

Applicants' deletion of these elements and replacement with two black geometric shapes destroys the visual impact of the mark as a whole and the continuity of the overall design.

This case also similar in concept to *In re Volante International Holdings*, 196 USPQ 188 (TTAB 1977) wherein the Board found that the portion of the design applicant was attempting to register was an "inseparable" part of the remaining complex and elaborate design features of the mark.

In addition, we note *In re Boyd Coffee Co.*, 25 USPQ2d 2053 (TTAB 1993), where the Board refused to allow registration of coffee cup and saucer design apart from the accompanying sunburst design finding that both designs were integral features of a unitary mark.

Inasmuch as we find that the mark sought to be registered is a mutilation of the mark as used, the refusal to register on this basis is affirmed.

We turn then to the question of whether, in view of the addition of the concentric oval and triangle design to the mark in the drawing, such mark is a substantially exact representation of the mark as shown in the specimen for the Class 41 services. Applicants argue in this regard that these elements "do not materially alter the design" because "their addition or subtraction does not change the overall commercial impression" of the mark. Brief, p. 13.

The determination of whether the drawing is a "substantially exact" representation of the mark is a stricter standard than the material alteration test, a more flexible standard that is used to evaluate proposed amendments of the mark. See, e.g., *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997) and *United Rum Merchants Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481 (TTAB 1988). See also *In re Larios S.A.*, 35 USPQ2d 1214 (TTAB 1995). While an applicant may be permitted to amend the drawing to conform to the mark shown in the specimens on the basis that the overall commercial impression is the same, the term "substantially" allows only nonmaterial variations from an "exact" representation of the mark. See, e.g., *In re Hacot-Colombier*, *supra*.

The mark in the drawing is clearly not an immaterial variation of the mark as used. The concentric oval and triangle composite is an entirely new and different design feature that stands out from the football and the other elements in the mark and creates an obvious visual disparity between the mark in the drawing and the mark as shown in the Class 41 specimens.

Even applying the more flexible material alteration test, we would find that this design element is significant enough to indeed change the overall commercial impression of the mark, thereby requiring a further search and republication to afford fairness to potential opposers.

In view of the foregoing, we find that the mark shown in the drawing is not a substantially exact representation of the mark shown on the specimen for either the Class 25 goods or the Class 41 services; and further that the examining attorney's requirement for substitute specimens showing use of the mark shown in the drawing was proper.

Decision: The refusals to register are affirmed.