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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ciba Specialty Chemical Corporation

Serial No. 76438403

JoAnn Villamizar, Esq. for Ciba Specialty Chemical Corporation.

Glenn Clark, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Hohein, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Ciba Specialty Chemical Corporation has filed an application to register the mark RECYCLOSSORB for goods amended to read "chemicals, namely, light stabilizers for use in the manufacture of outdoor articles, namely, plastic, lumber, crates, drums and the like." The application, filed August 7, 2002, is based on applicant's claimed date of first use and first use in commerce of July 1, 2002. The application includes the following statement:

"The numbers following the mark are not part of the mark as shown." The specimen shows the mark as follows:

RECYCLOSSORB ® 550.

In his first Office action, the Examining Attorney, *inter alia*, citing Trademark Rule 2.61(b), noted that the number "550" is not shown in the drawing. The Examining Attorney, in view thereof, required applicant to state if it believed that the number is merely a grade designation or model number, and to submit evidence showing use of the mark with other similar notations.

In response, applicant stated that "The designation '550' following the mark is a composition description and is not part of the mark. ... the abbreviation '550' is not being used in a trademark sense. This is the first product in the RECYCLOSSORB product line and, thus, additional labels showing a variety of compositions is [sic] not available at this time."

In his next Office action, and citing Trademark Rule 2.51¹ and TMEP §807.14 (3d ed. 2002), the Examining Attorney stated that the drawing of the mark RECYCLOSSORB differs from the display of the mark RECYCLOSSORB 550 shown on the

¹ Trademark Rule 2.51(a) states, in relevant part, 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."

specimens; that the designation "550" identifies a grade designation or model number; that applicant stated additional labels showing a variety of compositions were not available; and that, therefore, applicant must submit a substitute specimen showing use of the mark as it appears in the drawing.

In response, applicant restated its previous explanation, and submitted evidence in the form of screen prints from its website and some third-party websites as evidence that the use of numbers (or letters) as a composition description is the "standard practice of the industry." Applicant argued that "The grade designation is standard in the industry as shown in the attachments and, thus, is not part of the mark but only indicates the specific chemical product in a series of related chemicals from a specific source."

The Examining Attorney then made final the requirement for a substitute specimen showing the mark as it appears in the drawing, explaining that he had considered applicant's arguments and evidence and "found them unpersuasive." He again cited Trademark Rule 2.51.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

As shown by the prosecution history of this case as related above, the Examining Attorney has refused registration based on his requirement that applicant submit a substitute specimen showing the mark without the numbers "550" (along with an affidavit or declaration that the substitute specimen was in use as of a date prior to the filing date of the application as required by Trademark Rule 2.59(a)).

The Examining Attorney contends that the mark RECYCLOSSORB is not a substantially exact representation of the mark RECYCLOSSORB 550 shown on the specimens; that the word and the number appear in the same font, size and color on the specimens; that the word alone does not create a separate and distinct commercial impression; and that although the registration symbol appears between the word RECYCLOSSORB and the number "550," use of the registration symbol is improper where the mark has not been federally registered. The Examining Attorney finds applicant's evidence of industry use of numbers as grade designations to be unpersuasive because here applicant has not used a second grade designation for its RECYCLOSSORB product line; and that applicant may never use its RECYCLOSSORB mark with any product grade designation other than "550." He concludes that registration must be refused, based on the

requirement for a substitute specimen, inasmuch as the current specimens do not show (are not a substantially exact representation of) the mark as it appears in the drawing, i.e., the word RECYCLOSSORB alone.

Applicant contends that customers and competitors in the relevant industry recognize that marks indicating the source of the goods are followed by grade designations, or more specifically, "a numerical or other designation indicating the specific chemical product sold under the specific trademark, in order to distinguish the many types of chemicals sold under a specific mark" (brief, p. 2); that the number following the mark is essentially "a short hand designation of the chemical being sold" (brief, p. 2); that purchasers of these products understand the mark is the word and not the number designation following the word; and that the mark RECYCLOSSORB creates a separate commercial impression without the number "550."

We clarify that the only issue before the Board is whether applicant's mark as shown in the drawing conforms to the mark shown on applicant's specimens (that is, whether the mark RECYCLOSSORB shown in the drawing is a substantially exact representation of the mark as used on the specimens). Because we find that it does, we reverse the refusal to register.

As explained in 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §19:59 (4th ed. 2001):

"Mutilation" refers to a situation where a seller seeks registration of something less than the totality of his trademark. That is, the seller "mutilates" his trademark, severs a part of it, and seeks registration only of that part. The Patent and Trademark Office may then reject registration, saying that the applicant is trying to register something less than his full trademark, thereby attempting to obtain protection for an element that is only his in combination with other words or symbols. (footnote and citations omitted).

The number "550" is somewhat spatially separated from the word RECYCLOSSORB and the encircled "R" is placed between the word and the number. In addition, in this case, applicant has submitted evidence that generally the entities in the relevant industry (applicant, as well as its competitors, including GE Specialty Chemicals, Atofina and Clariant) use numbers to specify the various composition descriptions within a line of a particular chemical. Applicant's evidence of pages from its website includes several trademarks almost all of which include at least some, and in most cases many, listings for a single mark each with a different number (or letter and number) designation (e.g., ATMER, CHIMASSORB, IRGAFOS, IRGANOX, IRGAMOD, IRGASAN, RECYCLOSTAB, TINUVIN, UVITEX). The same

is true of the evidence for each of the third-party websites -- GE Specialty Chemicals, Atofina and Clariant. Applicant also submitted photocopies of six labels showing its mark IRGANOX followed by different numbers (259, 1520, 1330, 1098, 1076 and 1010). It is clear that it is common industry practice to utilize the number not as a mark or part of a mark, but as a chemical composition designation to differentiate between the specific products in a series of related chemical products.²

While the Examining Attorney is correct that applicant has not yet offered a second product in its RECYCLOSSORB product line, applicant has clearly stated that its product sold under RECYCLOSSORB 550 is the first product in a product line. Certainly, the evidence from applicant's website indicates that its various product line marks are, in fact, used with composition designation numbers. Such use is analogous to use of a mark followed by a generic term for the particular goods. The Examining Attorney, on

² The cases cited by the Examining Attorney, including *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999), are inapposite here. The Miller Sports case involved the mark MILLER SPORTS (in stylized lettering) and a skater design on a black background, but the applicant applied to register only the skater design and the partial capital letter "M." The case now before the Board does not involve the applicant attempting to register an incomplete and inseparable portion of a composite word and design mark.

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the other hand, offers only speculation that applicant will not use the mark RECYCLOSSORB for a line of products.

We agree with applicant that its mark is registrable without the number designation. That is, applicant's drawing presents a substantially exact representation of the mark as actually used in commerce, and applicant need not submit a new specimen showing the mark without the number designation.

Decision: The refusal to register based on the requirement for a substitute specimen is reversed.