

Mailed: February 23, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Honda Motor Co., Ltd.

Application Serial No. 77044023

Anthony L. Fletcher of Fish & Richardson P.C. for Honda
Motor Co., Ltd.

April K. Roach, Examining Attorney, Law Office 115 (J. Brett
Golden, Managing Attorney).

**Before Bucher, Zervas, and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Honda Motor Co., Ltd. filed an application for
registration of the mark ACURA RL (in standard characters)
for "automobiles and structural parts therefor" in
International Class 12.¹ The examining attorney has refused
to register the mark in light of her final requirement for
an acceptable specimen of use.

We affirm.

¹ Filed November 14, 2006, alleging first use and use in commerce
at least as early as October 31, 2004.

I. Evidentiary Matter

Before turning to the substance of the appeal, we address the examining attorney's objection to the evidence attached to applicant's brief.

The examining attorney's final office action was issued on December 19, 2007. Under the applicable rules, applicant was allowed six months in which to (1) file a request for reconsideration of the final requirement, submitting any appropriate evidence, argument, or amendment to put the application in condition for approval, Trademark Rule 2.64(b); or (2) file a notice of appeal, Trademark Rule 2.64(a). These options were not exclusive; applicants can (and quite frequently do) file both a request for reconsideration and a notice of appeal. In this case, applicant filed its notice of appeal on June 19, 2008, the last day available to do so, but did not file a request for reconsideration at any time after issuance of the final office action.

Three days before its brief was due, applicant requested an extension of time "to review the record, applicable precedents and, possibly, other material to write the necessary brief ... with sufficient thought and research to be most useful to the Board...." Req. to Extend (Aug. 15, 2008). The Board granted applicant's request. Nonetheless, instead of filing its appeal brief on the new

due date, applicant instead filed a motion to remand the file to the examining attorney to consider approximately twenty-one pages of new evidence. Applicant claimed the reason the proffered evidence had not been submitted during examination was that during examination, the examining attorney required a proper specimen, but never specifically advised the applicant that it could submit evidence or argument in an attempt to convince the examining attorney that the requirement itself was incorrect.

"The record in the application should be complete prior to the filing of an appeal." Trademark Rule 2.142(d). Unlike the case with a request for reconsideration filed prior to appeal (which will be entered into the record and considered as a matter of course), a request to remand for further examination in light of new evidence after an appeal is filed will only be granted upon a showing of good cause. *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 636, n.4 (TTAB 1986); *In re Chung, Jeanne & Kim Company, Inc.*, 226 USPQ 938, 940, n.6 (TTAB 1985) ("Ordinarily, the Board will not consider evidence submitted after appeal unless it is accompanied by a request to suspend and remand where an applicant shows good cause for its failure to timely introduce the evidence."); TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 1207.02 (2d ed. rev. 2004).

Upon consideration of applicant's request for remand, the Board Paralegal Specialist found that applicant had not shown good cause for a remand. The grounds for applicant's request were not among those the Board typically finds to constitute good cause for a remand. Further, "[a]lthough the Examining Attorney did not specifically invite applicant to submit arguments or evidence to traverse the refusal/requirement, it strains credulity to believe that applicant was unaware that it could do so." Order at 2 (Sep. 5, 2008).

Applicant filed its appeal brief on October 6, 2008. Notwithstanding the Board's denial of applicant's remand request, applicant attached to its brief approximately eighty-seven pages of evidence in support of its argument that the examining attorney's requirement for a new specimen was improper. The examining attorney objected to this evidence in her brief. In its reply brief, applicant now admits that it

was not unaware that it was within its right to attempt to argue with the Examiner, and, perhaps in retrospect it should have. However, the decision was made at the time, not in retrospect. And experience has taught many practitioners that arguing with Examiners about subjective judgments is very rarely productive.

Reply at 2.

We see no error in the Paralegal Specialist's order. We think it is obvious, as applicant now recognizes, that an

applicant always has the option to submit evidence and argument in response to an office action.² The evidence applicant now wants the Board to consider could have been submitted after the examining attorney's Priority Action or during the six months after the Final Office Action which applicant had to file its notice of appeal. Had applicant done so, the evidence would have been in the record prior to appeal.

Applicant offered no reasonable explanation for why it had not submitted this evidence earlier. Applicant now argues that it may have been counter-productive to do so because applicant feared that the examining attorney might be stubborn. But whether timely submission of applicant's evidence would have resulted in the examining attorney's withdrawal of the requirement is beside the point; the Board does not examine applications, and we will not consider evidence which has not been previously considered by the examining attorney.

Accordingly, the examining attorney's objection is well-taken as the evidence attached to applicant's brief is untimely. The evidence will be disregarded, along with those portions of applicant's brief which discuss it.

² We believe these options would have been obvious to any applicant or its counsel. Even if they were not, however, we note that applicant's counsel in this case has decades of experience practicing before the USPTO, and was clearly aware of his choices in responding to an office action.

II. Specimens

Applicant submitted two specimens in support of its application. Submitted with its application, the original specimen appears as follows:



Upon examination, the examining attorney advised applicant that

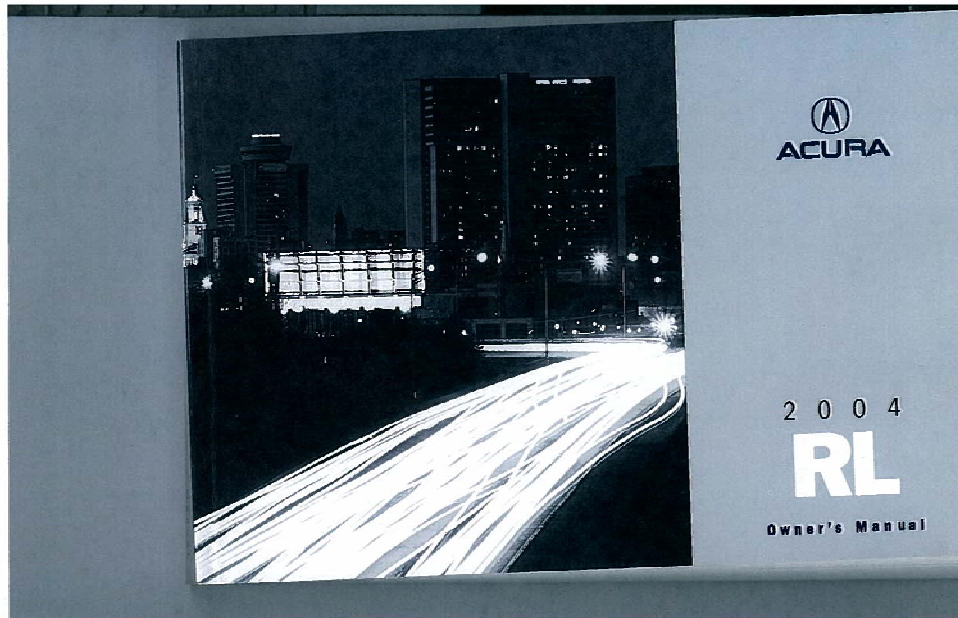
... [r]egistration is refused because the application seeks registration of more than one mark. An applicant may apply for only mark in a single application.

Elements of the mark on the drawing page appear as two separate marks on the specimen. Specifically, the drawing page shows: the mark as "ACURA RL". However, the specimen shows these elements separated to such a degree that they appear as separate marks.

Priority Action (Apr. 2, 2007) (citations omitted).

In response to the Priority Action, applicant submitted the following substitute specimen (the cover of the owner's manual for the identified goods), supported by an affidavit

confirming that the specimen was in use at least as early as the filing date of the application:



The examining attorney found the substitute specimen inadequate for the same reason, and issued a final action requiring an appropriate specimen:

The refusal to register pending receipt of an acceptable specimen because the application seeks registration of more than one mark is made final. An applicant may apply for only one mark in a single application.

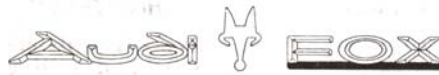
Elements of the mark on the drawing page appear as two separate marks on the substitute specimen. Specifically, the drawing page shows the following elements: "ACURA RL". However, the specimen shows these elements separated to such a degree that they appear as separate marks. Specifically, applicant's substitute specimen shows the wording "ACURA" just below a graphic on the top right side of the manual and the wording "RL on the bottom right side, separated by significant empty space and the year "2004".

Final Office Action (Dec. 19, 2007) (citations omitted).

III. Discussion

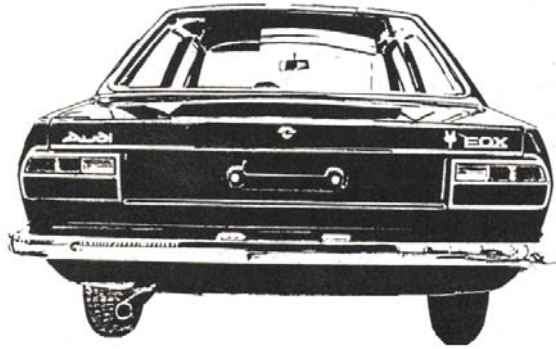
"An application under section 1(a) of the Act ... must ... include one specimen showing the mark as used on or in connection with the goods...." Trademark Rule 2.56(a). The application must also include a drawing of the mark, which "must be a substantially exact representation of the mark as used on or in connection with the goods...." Trademark Rule 2.51(a). In other words, the drawing and specimen must agree.³

This case is "on all fours" with our decision in *In re Audi NSU Auto Union AG*, 197 USPQ 649 (TTAB 1977). In *Audi*, the applicant sought registration of a mark depicted in the drawing accompanying the application as follows:



Applicant's specimen showed use of the mark as follows:

³ When the drawing and specimen do not agree, an applicant may amend the drawing to conform to the specimen if the amendment does not constitute a material alteration the mark in the original drawing, Trademark Rule 2.72(a). Alternatively, the applicant may file a substitute specimen which conforms to the drawing, Trademark Rule 2.59(a). The "material alteration" standard is not an issue in this case because applicant has not attempted to amend its drawing. See *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1123, n.3 (TTAB 2008).



Note that the word "AUDI" appears over the left tail light, while the word "FOX" and the stylized fox-head design appear over the right. As in the case at bar, the examining attorney in *Audi* refused registration because the specimen showed use of two separate marks: "AUDI," on the one hand, and "FOX" and design, on the other.

On appeal, the Board held that

[t]he likely impact produced by a mark or by two marks on the purchasing public has to be assessed in the light of the way in which the relevant purchasing public has been conditioned to perceive other marks in the industry. It is a matter for judicial notice that automobiles in this country are most often sold under dual designations, the house or divisional mark and the line mark. ... In view of this common, indeed pervasive practice, which is followed by foreign-based manufacturers of cars exported to the United States ... we believe the average person would regard "AUDI" and "FOX" and design as two separate marks, the first as a house mark and the second as a line mark for the "FOX" series of vehicles produced by Audi. ... This does not, however, rule out the possibility of combining two marks into a single composite mark if the specimens show that the composite projects a unitary commercial impression. Everything depends on the specimens, which, in this case, show the use of two discrete marks.

Much has been made of the space between "AUDI" and "FOX" and design on the lid of the

car's trunk. Applicant explains that the space results from esthetic and engineering considerations. Regardless of the cause, the arrangement does tend to reaffirm the public's probable understanding that two marks are being used.

Audi, 197 USPQ at 650-51.

Applicant complains that unlike *Audi*, this case involves a "special form mark," *i.e.*, one sought to be registered "without claim to any particular font style, size, or color," Trademark Rule 2.52(a). Reply Br. at 5-6 ("Both the original and second proffered specimen show the word and letters. That they are separated by roughly 4 feet (in the original) or two to three inches (in the later-submitted specimen) is of no moment, because the mark is being registered in no particular form.").

Applicant confuses the effect of a standard-character drawing with the requirement for a specimen of the mark, and the relation of the specimen to the drawing. While a special form drawing permits the applied-for mark to be used in a wide variety of forms, the applicant must still submit a specimen of the mark, and the drawing must be a substantially exact representation of the mark as depicted on that specimen. Regardless of the type of drawing in the application, the specimens must indicate use of the applied-for matter as a mark - *i.e.*, a single mark. If the specimen shows two elements of the drawing used as two separate

marks, rather than a single one, then a new specimen must be submitted.⁴

As was the case in *Audi*, we find that the impression left by the specimens of record is that of two marks, rather than one. As used on the first specimen - applicant's vehicle - the word ACURA appears on the far left side of the trunk of the car, while the letters "RL" appear on the far right. The two marks are separated by applicant's corporate "A" logo, the trunk handle, and considerable space. As in *Audi*, we find that the likely impression here is that ACURA is the trademark for a line (or "make") of cars, while RL is a trademark for a particular "model" of that line. But whatever the perceived meaning of the individual elements, it is clear from the specimen - which depicts them separated by other matter and by physical space - that they do not form the impression of a single trademark.

Applicant's substitute specimen fares no better. This specimen depicts the cover of an owner's manual for applicant's vehicle. On the right-hand side of the cover appear several items: Towards the top of the page is the word ACURA, in black, immediately below applicant's "A" logo, also in black. Several inches below that appear the

⁴ An amended drawing is clearly inappropriate if the specimen depicts the matter to be registered as more than one mark because any drawing accurately depicting the "mark" as used would necessarily depict two separate marks, and an application is

numerals "2004" in black, above the letters "RL" in large, white letters. Finally, the words "Owner's Manual" appear near the bottom edge of the page.

Similar to the depiction of the mark on applicant's original specimen, there is nothing about the use of "ACURA" and "RL" on this specimen which might indicate that they are in fact a single mark. The two elements are physically separated by a significant amount of blank space⁵ and the numerals "2004." "ACURA" is depicted in black in close proximity to applicant's logo, while the letters RL appear in a different font, different color, and different size. As was the case with the specimen depicting the rear of applicant's vehicle, we do not believe that a relevant consumer viewing applicant's owner's manual would understand the terms "ACURA" and "RL" to comprise a single mark, rather than two.

limited to a single mark. Trademark Rule 2.52 ("The drawing must show only one mark.").

⁵ Applicant makes much of the fact that the separation of "ACURA" and "RL" on its original specimen was several feet, while the separation on the owner's manual is only a matter of inches. We are not concerned with the absolute distance between the parts of applicant's mark in feet and inches because the perceived distance between them is relative. It is the resulting impression that is important. A separation of several feet might appear negligible when used on a large billboard, while a separation of several inches may appear large when used on a proportionally much smaller surface like the manual cover at issue here.

Conclusion

After careful consideration, we find that applicant's drawing of the mark is not a substantially exact representation of the mark as used in commerce, Trademark Rule 2.51(a), and that the examining attorney's requirement for a substitute specimen was appropriate.

Decision: The refusal to register is accordingly affirmed.