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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Certa ProPainters, Ltd.

Serial No. 77046679

Lane Fisher, F. Joseph Dunn and William R. Graefe of Fisher Zucker for Certa ProPainters, Ltd.

Robert J. Struck, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Quinn, Drost and Zervas, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Certa ProPainters, Ltd., a limited partnership organized under the laws of Massachusetts, filed an application to register the mark shown below

*Born in Canada*   
*Spreading all over the world.*

for "house painting; painting; painting in the field of residential and commercial buildings."<sup>1</sup>

The trademark examining attorney refused registration under Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), on the ground that applicant's proposed mark contains a simulation of a flag of a foreign nation, specifically Canada, and/or displays the official national insignia of Canada, namely the Canadian maple leaf.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Before turning to the merits of the appeal, we first consider an evidentiary matter. Applicant's brief makes specific reference, for the first time during the prosecution of its application, to several "non-simulative" flag designs in third-party registered marks. More specifically, applicant points out that the USPTO uses "maple leaf" as a design code for searching trademarks, and that there are 509 live registered marks containing a maple leaf design. In its brief, applicant reproduced six of these third-party registered marks, each showing use of an

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<sup>1</sup> Application Serial No. 77046679, filed November 17, 2006, based on a bona fide intention to use the mark in commerce. The application includes the following statements: "The mark consists of a maple leaf with solid bar to the right of leaf and the words BORN IN CANADA SPREADING ALL OVER THE WORLD. Color is not claimed as a feature of the mark."

11-pointed maple leaf next to the word "Canada." Applicant also reproduced nine third-party registered marks, each showing "clear imitations of the Canadian flag (and/or other flags)" or "non-simulative" flags. (Brief, pp. 8-10).

The examining attorney, in his brief, objected to this evidence and the arguments based thereon on the ground that the registrations were not properly made of record.

Firstly, the evidentiary record in an application should be complete prior to the filing of an appeal. Additional evidence filed after appeal normally will be given no consideration. Trademark Rule 2.142(d); and TBMP §1207.01 (2d ed. rev. 2004). Secondly, to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n. 2 (TTAB 1998); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Merely listing such registrations and/or reproducing the registered marks, as applicant has done here, is insufficient to make the registrations of record. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998). See TMEP §710.03 (5<sup>th</sup> ed. 2007); and TBMP §1208.02 (2d ed. rev. 2004).

In view of the above, the examining attorney's objection is sustained, and the third-party registration evidence has not been considered in reaching our decision. We acknowledge, however, that the USPTO uses "Maple leaf" as a design code for searching trademarks. (Design Search Code Manual, Category 05.03.03).

Applicant, in its brief, also refers to certain information retrieved from Wikipedia. The examining attorney has not raised any issue with respect to the accuracy of the Wikipedia evidence relating to the Canadian flag relied upon by applicant, nor has he objected to the timeliness of the submission; rather, he has referred to it in his brief. Accordingly, we have considered this evidence. *In re Carrier Consulting Corp.*, 84 USPQ2d 1028, 1032 (TTAB 2007).

Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), provides that "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it...consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." The Trademark Manual

of Examining Procedure (TMEP) §1204 (5<sup>th</sup> ed. 2007) comments  
on this statutory provision as follows:

Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), bars the registration on either the Principal Register or the Supplemental Register of marks that consist of or comprise (whether consisting solely of, or having incorporated in them) the flag, coat of arms, or other insignia of the United States, of any state or municipality, or of any foreign nation. Section 2(b) also bars the registration of marks that consist of or comprise any simulation of such symbols.

Section 2(b) differs from the provision of §2(a) regarding national symbols (*see* TMEP §1203.03(b)) in that §2(b) requires no additional element, such as disparagement or a false suggestion of a connection, to preclude registration.

This section of the TMEP goes on to state that flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority. The wording "other insignia" has not been interpreted broadly, but is considered to include only those emblems and devices that also represent such authority and that are of the same general class and character as flags and coats of arms. *See In re U.S. Department of the Interior*, 142 USPQ 506 (TTAB 1964). The incorporation in a mark of individual or distorted features that are merely suggestive of flags, coats of arms or other insignia does not bar registration

under Section 2(b). See *Knorr-Nahrmittel A.G. v. Havland International, Inc.*, 206 USPQ 827, 833 (TTAB 1980).

An Examination Guide sheds additional light on Section 2(b) refusals. The Office issued, on November 27, 2007, Examination Guide 2-07 pertaining to "Section 2(b) - Flags and Government Insignia." Although the guidelines contained therein are helpful in reaching our decision, surprisingly neither the examining attorney nor applicant cited to this guideline in the briefs.<sup>2</sup>

The guide includes, in pertinent part, the following language relating to flags and simulations of flags:

Registration must be refused under §2(b) if the design sought to be registered includes a true representation of the flag of...any foreign nation, or is a simulation thereof. A refusal must be issued if the design would be perceived by the public as a flag, whether or not other matter appears with or on the flag. The examining attorney should consider the following factors, in regard to both color drawings and black-and-white drawings, to determine whether the design is perceived as a flag: 1) color; 2) presentation of the mark; 3) words or other designs on the drawing; 4) use of the mark on the specimens.

Generally a refusal should be made where a black-and-white drawing contains unmistakable features of the

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<sup>2</sup> Given that the guide issued in November 2007, the briefs were the first opportunity for applicant and the examining attorney to rely on the guide.

flag, or contains features of the flag  
along with indicia of a nation...

The evidence of record shows that on February 15, 1965, the Canadian Parliament adopted the flag depicted below as the national flag of Canada. Since the introduction of the Canadian flag, "the maple leaf has become the country's most important national symbol." (www.dfait-maeci.gc.ca).<sup>3</sup>



Wikipedia describes the flag as follows: "a vertical bicolour triband of red, white, and red in a 1:2:1 ratio, with a red maple leaf charged in the Canadian pale in the center." Another description reads as follows: "two vertical bands of red (hoist and fly side, half width), with white square between them; an 11-pointed red maple leaf is centered in the white square; the official colors of Canada are red and white." (www.cia.gov/cia/publications/factbook). The term "maple leaf," as defined in relevant part, means "the leaf of the

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<sup>3</sup> The cited website is the official website of the department of "Foreign Affairs and International Trade Canada," a branch of the Canadian government.

maple, used as the Canadian national emblem."

(www.askoxford.com).

It is clear that applicant's mark does not include the entirety of the actual Canadian flag. Thus, the issue for us to decide is whether what is shown in the mark is a "simulation," as contemplated by Section 2(b), of the Canadian flag. The Board has stated:

In determining this issue, it is our opinion that the term "simulation" is used in the context of Section 2(b) of the Statute in its usual and generally understood meaning, namely to refer to something that gives the appearance or effect or has the characteristics of an original item. (Webster's Third New International Dictionary, Unabridged Edition, 1965.) Whether or not a simulation exists in a proceeding of this character must necessarily be one of first impression gathered from a view of such mark without a careful analysis and side-by-side comparison with [the actual flag].

Focus must be on general recollection of the [flag] by purchasers, and a comparison of it with applicant's mark.

*In re Advance Industrial Security, Inc.*, 194 USPQ 344, 346 (TTAB 1977). See also *In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973).

The analysis of what constitutes a "simulation" should not be a strictly quantitative one. While we must consider that the "1:2:1" ratio of the Canadian flag is not present

in applicant's mark and that a majority of the flag's features are depicted in the mark, we must ultimately balance these considerations against the overall visual impression made by the mark.

The fact that the maple leaf and bar design portion of applicant's mark either suggests or calls to mind the Canadian flag is insufficient to bar registration of the design as a simulation of the Canadian flag. In our view, the maple leaf and bar design does not look like the Canadian flag or a simulation of the flag; rather, the design comprises disembodied elements of the flag. After seeing applicant's mark, the viewer must still provide substantial, additional details to complete an image of the flag of Canada.

Applicant's mark does not include an outline of the flag, thereby making it even less apparent that a flag is being depicted. Further, in the location where the left side bar of the Canadian flag would be, applicant's mark contains words, thereby adding to our view that the design only suggests the Canadian flag, and is not a simulation of a flag. As applicant points out: "CANADA is positioned on Applicant's Mark such that it takes up the area where the entire first 'colour band,' and most of the second white band, would be on the official flag of Canada," and "the

official Canadian flag does not include any words anywhere on its authentic design." (Brief, p. 6). Rather than enhancing the perception that the mark is a simulation of the Canadian flag, we find that, if anything, the location of the words "BORN IN CANADA SPREADING ALL OVER THE WORLD," next to disembodied elements of the Canadian flag, detracts from any perception that the mark is a simulation of a flag. Applicant's mark simply suggests the Canadian origin of its services in the same manner that a red, white and blue design with stars suggests an American product.

We emphasize that the test is not whether purchasers will be able to guess that the mark is suggesting a national flag. If that were the case, many marks that suggest the American flag by incorporating a stylized red, white and blue design with stars would be barred from registration under Section 2(b). We do not read the prohibitions of Section 2(b) to reach such marks.

Our decision herein is in accord with the guidance offered in Examination Guide 2-07. Of particular significance to the present case is the following language:

C. Stylized flag designs are not refused under Section 2(b)

Marks containing elements of flags in a stylized or **incomplete form** are not refused under Section 2(b). The mere presence of some significant elements

of flags, such as stars and stripes (U.S. flag) or a maple leaf (Canadian flag) does not necessarily warrant a refusal.

**If the flag design fits one of these scenarios, do not refuse registration under Section 2(b):**

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2. The flag is substantially obscured by words or designs.

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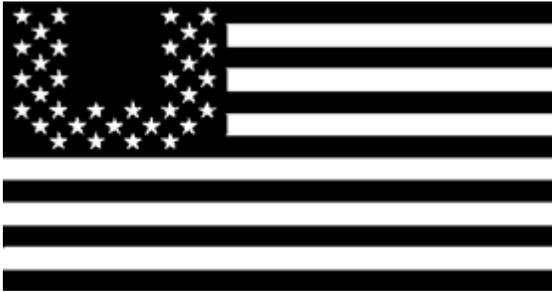
5. **A significant feature is missing or changed.**  
[emphasis added]

The examples below are set forth in Appendix B of the Examination Guide as "Stylized Designs That **Are Registrable** Under Section 2(b)." [emphasis in original]

2. Flag Is Substantially Obscured By Other Matter - No Section 2(b) Refusal



5. Significant Feature Is Changed - No Section 2(b) Refusal



As indicated above, the Canadian flag is significantly changed in applicant's mark. Further, the missing flag portion is replaced by wording.

As a second ground for refusal the examining attorney contends that the mark includes an official insignia of Canada, namely an 11-pointed maple leaf. The examining attorney characterizes it as "an important Canadian emblem of governmental authority and is protected under Article 6ter of the Paris Convention" and that "the maple leaf is almost universally considered by the public as an emblem of Canada."

Insofar as a maple leaf acting as the national insignia of Canada, the following information is of record:

The maple leaf has been associated with Canada for some time; in 1868, it figured in coats of arms granted to Ontario and Quebec, and in both World Wars, it appeared on regimental badges. Since the 1965 introduction of the Canadian flag, the maple leaf has become the country's most important

national symbol. (www.dfait-  
maeci.gc.ca)

Inasmuch as the 11-pointed maple leaf design is not a flag or coat of arms, we consider whether the design is an "insignia" of Canada as contemplated by Section 2(b). As indicated earlier in this opinion, the wording "other insignia" "should not be interpreted broadly, but should be considered to include only those emblems and devices that also represent [governmental] authority and that are of the same general class and character as flags and coats of arms." TMEP §1204 (5<sup>th</sup> ed. 2007). See also *U.S. Department of the Interior*, 142 USPQ at 507; and Examination Guide 2-07.

When we consider the 11-pointed maple leaf design under such guidelines, we find that the design does not constitute an "insignia" that is prohibited registration by Section 2(b). A variety of mundane, everyday symbols are used by countries and governments at all levels. The symbols include a wide range of animals (e.g., eagles, bears, etc.) and vegetation (e.g., trees, flowers, etc.). The 11-pointed maple leaf design, standing alone, does not rise to the level of being an emblem of Canadian governmental authority. That is to say, the record falls short of establishing that an 11-pointed maple leaf design

*per se* has been adopted by the Canadian government to signify governmental or sovereign authority. Although the 11-pointed maple leaf design may be a national symbol that is suggestive of the Canadian government, the record does not prove that the Canadian government has specifically adopted the design as an "insignia" to represent the government. See *Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F.Supp. 895, 127 USPQ 312, 323 (E.D. Ark. 1960) [a representation of the Statue of Liberty held not to be an "insignia of the United States"]; and *Heroes Inc. v. The Boomer Esiason Hero's Foundation Inc.*, 43 USPQ2d 1193, 1197-98 (D.D.C. 1997) [a representation of the U.S. Capitol building does not violate Section 2(b) because the Capitol is not an "insignia of the United States"]. Thus, in the context of this case, while the 11-pointed maple leaf may serve as a national symbol of Canada, in the same manner that the U.S. Capitol building or the Statue of Liberty serves as a symbol of the United States, we find that the 11-pointed maple leaf does not qualify for protection as an "insignia" under Section 2(b).

**Decision:** The refusal to register under Section 2(b) is reversed.