

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
June 3, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kappa Alpha Order

Serial No. 77463997
Serial No. 77464003
(Consolidated)

Lindsay Yeakel Capps and Jack A. Wheat of Stites & Harbison
PLLC for Kappa Alpha Order.

Heather D. Thompson, Trademark Examining Attorney, Law
Office 109 (Dan Vavonese, Managing Attorney).

Before Quinn, Grendel and Kuhlke, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Kappa Alpha Order (applicant) has filed two
applications seeking registrations of the mark depicted
below.



In application Serial No. 77463997, applicant seeks to register the mark as a collective membership mark (in Class 200), "to indicate membership in a collegiate fraternal organization."¹

In application Serial No. 77464003, applicant seeks to register the mark as a trademark for "fabric flags" (in Class 24).²

Both applications include the following "Description of Mark" statement:

The mark consists of a design for a flag containing a white shield toward the center bearing the crimson Greek letters 'K' and 'A' above a crimson-colored Greek cross with a

¹ This application was filed on May 2, 2008, and is based on use in commerce pursuant to Trademark Act Section 1(a), 15 U.S.C. §1051(a). 1967 is asserted in the application to be the date of first use of the mark and the date of first use of the mark in commerce.

² This application was filed on May 2, 2008, and is based on use in commerce pursuant to Trademark Act Section 1(a), 15 U.S.C. §1051(a). 1967 is asserted in the application to be the date of first use of the mark and the date of first use of the mark in commerce. This application includes a claim of acquired distinctiveness pursuant to Trademark Act Section 2(f), 15 U.S.C. §1052(f).

crimson-colored background to the left of the shield and a gold-colored background to the right of the shield.

Also, both applications include the following "Colors Claimed" statement: "The color(s) crimson, white and gold are claimed as a feature of the mark."

In both applications, the Trademark Examining Attorney has issued final refusals of registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051 and 1127, on the ground that the mark is not in lawful use in commerce. Specifically, the Trademark Examining Attorney contends that applicant's use of the mark is not lawful use in commerce because it is in violation of 18 U.S.C. §706 (hereinafter the "Red Cross statute" or "the statute"), which, in pertinent part, prohibits unauthorized use of "the emblem of the Greek red cross on a white ground, or any sign or insignia made or colored in imitation thereof...."³

³ The Red Cross statute provides in its entirety as follows:

§706. Red Cross.

Whoever wears or displays the sign of the Red Cross or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of or an agent for the American National Red Cross; or

Whoever, whether a corporation, association or person, other than the American National Red Cross and its duly authorized employees and agents and the sanitary and hospital authorities of the armed forces of the

Applicant has appealed the final refusals in both applications. The appeals were consolidated by order of the Board dated April 15, 2010, and we shall decide them in this single opinion. The appeals are fully briefed.

We reverse the refusals to register as to both applications.

Trademark Act Section 1(a)(1), 15 U.S.C. §1051(a)(1), in pertinent part, provides that "the owner of a trademark used in commerce may request registration of its trademark...." Trademark Act Section 45, 15 U.S.C. §1127, in pertinent part, provides that "the word 'commerce' means all commerce which may lawfully be regulated by Congress."

In an application seeking to register a mark based on use in commerce under Trademark Act Section 1(a), such use of the mark in commerce must be lawful use in commerce. If the use of the mark upon which the application is based is not lawful use in commerce, including any use in violation

United States, uses the emblem of the Greek red cross on a white ground, or any sign or insignia made or colored in imitation thereof or the words "Red Cross" or "Geneva Cross" or any combination of these words-

Shall be fined under this title or imprisoned not more than six months, or both.

This section shall not make unlawful the use of any such emblem, sign, insignia or words which was lawful on the date of enactment of this title [June 25, 1948].

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of a federal statute, registration must be refused under Trademark Act Sections 1 and 45. *See In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1381 (TTAB 1993); *In re Stellar Int'l, Inc.*, 159 USPQ 48, 51 (TTAB 1968).

Refusal of registration under Trademark Act Sections 1 and 45 based on unlawful use of the mark in commerce is proper "when the issue of compliance [with the pertinent statute] has previously been determined (with a finding of non-compliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a statute regulating the sale of the parties' goods." *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2047 (TTAB 1988).

In the present case, the issue is whether applicant's mark constitutes a per se violation of the Red Cross statute, 18 U.S.C. §706.⁴ Because the Red Cross statute is penal in nature, it must be strictly construed in our determination of whether registration of applicant's mark must be refused because use of the mark is or would be unlawful under the statute. *See Ex Parte National Hospital Association*, 42 USPQ 632, 632 (Comm'r of Pat. 1939).

⁴ There is no suggestion that applicant's use of its mark has previously been determined to be unlawful by a relevant court or government agency.

The second clause of the statute makes unlawful any "use[] [of] the emblem of the Greek red cross on a white ground, or any sign or insignia made or colored in imitation thereof" by anyone not duly authorized to make such use. It appears that applicant has no such authorization to use the Red Cross emblem; applicant does not contend otherwise. However, we find that applicant's mark does not "use[] the emblem of the Greek red cross on a white ground," nor does it constitute a "sign or insignia made or colored in imitation thereof."

We find that the mark clearly depicts a Greek red cross.⁵ However, we find that when the mark is viewed as a whole, the distinctive shield design upon which the Greek red cross appears cannot be said to be merely a "white ground" within the meaning of the statute. Also, we find that the presence of the prominent red letters "KA" on the shield further serves to to make the mark, when viewed in its entirety, more than merely "the emblem of the Greek red cross on a white ground."

For these reasons, and under the required strict construction of the Red Cross statute, we find that applicant's mark does not violate the statute. Applicant's

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use of the mark therefore is not unlawful use, and it suffices as the basis for registration of the mark under Trademark Act Sections 1 and 45.

Decision: The refusals to register in both applications are reversed.

⁵ In the applications, applicant has claimed the color "crimson" as a feature of the mark. We find crimson to be a particular shade of red (and applicant does not contend otherwise).