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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	1175856 ONTARIO LTD.
Applied for Mark	WSI
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In re Trademark Application of 1175856 Ontario Ltd.	)	
	)	Law Office 115
Serial No.: 78/442207	)	
	)	Tracy L. Fletcher
Filed: June 28, 2004	)	Examining Attorney
	)	
Trademark: WSI and Design	)	

APPLICANT'S APPEAL BRIEF

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I. INTRODUCTION

This appeal involves applicant's efforts to register applicant's Mark WSI and Globe Design. The Mark consists of the lettering WSI together with a Design of a representation of a globe over the letter "I", as shown in the drawing submitted with the original application, and as shown in the subsequent substitute drawing filed with applicant's response dated July 25, 2005 (shown below).

The mark as shown on the specimen submitted with the application appears below.

The mark as shown on the substitute specimen submitted with applicant's response dated July 25, 2005 appears below.

It is readily apparent that the specimen shows the Mark WSI and Globe Design, as shown in the drawing. The specimen also shows a "Curve" or "Arc" alongside the Mark. The Mark that applicant seeks to register -- as shown on the drawing – does not include the "Curve."

The Examining Attorney refused registration on the basis that the mark as shown in the drawing differs from the mark as shown on the specimen because the specimen shows the additional element of the "Curve." Applicant appeals from the final decision of the Examining Attorney dated October 11, 2005 in which the Examining Attorney maintained the requirement for Applicant to submit a substitute specimen which shows the form of the mark in the drawing.

Applicant believes that its specimen shows multiple distinct marks and that it is uniquely within the province of the Applicant – and not the Examiner – to determine the form of the mark to be registered when, as here, the specimen shows that mark and it makes a distinct commercial impression. Here, the specimen shows the exact form of the Mark sought to be registered, notwithstanding the additional "Curve" on the specimen, which is distinctly different and separable subject matter.

Applicant respectfully requests that the refusal to register Applicant's Mark as shown in the drawing be reversed and that Applicant's Mark as shown in the drawing be approved for publication.

II. STATEMENT OF RELEVANT FACTS AND PROCEDURAL HISTORY

On June 28, 2004, Applicant filed an application for registration of its Mark WSI and Globe Design, for services in Intl. Classes 35 and 42. The application included a drawing of the Mark WSI and Globe Design.

Applicant also submitted a specimen for each class, which consisted of Applicant's web pages, on which the Mark WSI and Globe Design is shown. The specimen also shows the added element of the "Curve."

On February 5, 2005, the Examining Attorney issued a non-final office action which said that the Mark as shown on the drawing differed from the display of the Mark as shown on the specimen, citing the addition of the "Curve" on the specimen. The Examining Attorney requested a substitute specimen and said that Applicant could not amend the drawing to conform to the specimen because it would result in a material alteration. The Examining Attorney also requested a new drawing that would reproduce satisfactorily, and asked Applicant to amend its recitation of services.

On July 25, 2005, Applicant submitted a response that (1) amended the recitation of services in Classes 35 and 42 and also added Class 41; (2) included an additional specimen for the Class 41 services; (3) submitted a substitute drawing (shown above) which again consisted of the lettering WSI and the Globe Design; and (4) submitted arguments against the Examining Attorney's request for substitute specimens that show the mark without the "Curve" because the submitted specimens show the mark sought to be registered, namely, WSI and the Globe Design, notwithstanding the additional "Curve" element that appears on the specimens.

On October 11, 2005, the Examining Attorney issued a final office action maintaining that the Mark as shown in the drawing differs from that shown on the specimen. The Examining Attorney also requested further amendments to the Class 42 services.

In a telephone interview with the Examining Attorney on March 14, 2006, Applicant's counsel agreed to the proposed amendment to the Class 42 services.

The Examining Attorney issued an Examiner's Amendment regarding the Class 42 amendment on March 15, 2006, and the final requirement for a specimen that shows the mark as displayed in the drawing was continued and maintained.

On March 20, 2006, Applicant timely filed its Notice of Appeal.

III. ARGUMENT

Applicant respectfully disagrees with the Examining Attorney's request that Applicant must submit substitute specimens that show the Mark WSI and Globe Design with the "Curve." Applicant believes that the Mark as submitted on the drawing - WSI and Globe Design - is a separable element, and that it should be registerable as shown on the drawing.

The commercial impression of the Mark as recognized by consumers consists of the letters WSI and the Globe Design. These elements comprise the dominant feature of the mark and appear on the specimen. Indeed, these two elements are related to one another with WSI identifying Applicant's business name and the Globe Design signifying the potential global reach of the business. These two related elements together form a distinct commercial impression. The third element on the specimen – the Curve – is a fanciful design element without any apparent meaning and without any conceptual relationship to the letters WSI or the Globe Design. The Curve makes it own, separate, distinguishable commercial impression.

As a general rule, applicants are entitled to register their marks for the long run. For example, even though an applicant may always use its word mark in stylized letters with a logo, applicants routinely register the word mark alone in block letters. This makes sense for trademark owners, since typestyles or logos may change over time, but the block letter registration may live forever so long as it remains in use in any form. Here, too, Applicant is entitled to have the flexibility of registering its mark consisting of the letters WSI and the Globe

Design – which together form a distinct commercial impression. Applicant deserves the flexibility of being able to use its Mark with or without the Curve where, as here, the Curve is separate from the other components and makes a distinct commercial impression. For these reasons, Applicant should be able to register its Mark in the form set forth in the application, and the requirement for a substitute specimen should be withdrawn.

In *In re Schechter Brothers Modular Corp.*, 182 USPQ 694 (TTAB 1974), the applicant filed an application for the mark RAINAIRE AND DESIGN. The specimen accompanying the application showed the mark as RAINAIRE PRODUCTS AND DESIGN, with a shadowing image of the word RAINAIRE. The drawing of the mark did not include the shadowing. The Examiner held that the mark as sought to be registered in the application was a mutilation of the mark as shown on the specimen. The applicant argued that the commercial impression of the mark as filed was not compromised by the design as shown on the specimen. Applicant argued that the impression of the mark as shown on the specimen was essentially what was being applied for, and that the omission of the shadowing did not obliterate or destroy the mark. The TTAB agreed with the applicant, and said the shadowing was "an interesting logo," but the word portion of the mark created the essential impression. Further, applicant owned a registration for the word RAINAIRE. The TTAB found that the deletion of the shadowing was only a "minor alteration" and did not create a new mark. Thus, the TTAB held that "what is sought to be registered and the matter shown in the specimens are basically the same marks" and that applicant was not required to file a new drawing or specimens.

The same analysis applies here. Applicant's drawing consists of the wording WSI and a Design of a Globe. The specimen also shows this Mark, but the specimen also contains additional matter in the form of a Curve. The predominant feature of the mark is the wording

WSI and the Design of the Globe. This is what the consumers will see and recognize as the mark. The addition of the Curve is, as the TTAB mentioned in *Schechter*, supra, an "interesting logo," but the essential impression that consumers will recognize is the wording WSI and the Globe Design together. In addition, Applicant owns a pending application for WSI alone (Appln. No. 78/442198), just as the applicant in *Schechter* owned a registration for the mark RAINAIRE.

In *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969), the applicant sought to register the mark GRIPLET in a Stylized format, with a triangle over the letter "I," and a Stylized letter "G." The specimen submitted showed the mark GRIPLET (Stylized) with the wording BERG and an asterisk before the letter "G" in GRIPLET. The Examiner refused registration on the grounds that the mark in the drawing was a mutilation of the unitary mark shown on the specimen. The Board stated that:

> it is well established that one may use a composite mark in connection with a product and register separately its several elements if each element is used in such a manner as to create a separate and distinct commercial impression from the other elements..."

The Board reversed the Examiner and found that the mark GRIPLET as used on the specimen created a separate and distinct impression from the house mark BERG.

As posed by McCarthy, the question is whether the "designation for which registration is sought create a commercial impression on the average buyer, separate and apart from other matter on a label?" *McCarthy, McCarthy on Trademarks and Unfair Competition,* §19:59, Vol. 3 (2005), citing *Berg*.

Applicant's mark WSI and GLOBE DESIGN is completely separable and distinct from the Curve element. As stated in *McCarthy*:

> It is to the registrant's advantage to attempt to cull out of its trade symbols those parts that create a separate commercial impression on buyers, and obtain a separate federal registration for each such part. If he obtains such separate registrations, his legal position is superior to that if he merely had a registration for the whole assemblage of letters, words and design that appear on his labels. For example, he may obtain registration for a design or symbol which, although used on a label as background for word marks, itself creates a separate commercial impression on buyers.

McCarthy, McCarthy on Trademarks and Unfair Competition, §19:60.1, Vol. 3 (2005).

Many companies use and obtain registrations for marks that consist of words alone, and marks that consist of designs alone. Yet, when these marks are used in advertisements, on signage, buildings, or literature, oftentimes the word mark will be used in combination with the design mark, where each stands side by side. Under the Examining Attorney's reasoning, companies would never be able to obtain registrations for the words or the designs alone because the specimens or actual uses show the combination of marks. This is an unrealistic view that is inconsistent with commercial reality and the flexibility with which marks are used and displayed by trademark owners.

For the reasons stated above, Applicant respectfully submits that its Mark as shown in the drawing, namely, WSI and GLOBE DESIGN, should be registerable, notwithstanding that the specimens show the additional Curve element.

Applicant respectfully requests that the Board reverse the Examining Attorney's requirement for a substitute specimen, that the requirement for a substitute specimen be withdrawn, and that Applicant's application be approved for publication.

Respectfully submitted,

Linda Urbanik Johnson 4/24/06

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