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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/442207

APPLICANT: 1175856 ONTARIO LTD.

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: WSI

CORRESPONDENT'S REFERENCE/DOCKET NO: 301741-00000

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

The Office has reassigned this application to the undersigned Examining Attorney. Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark WSI (and globe design) on the basis that the specimen does not show use of the mark as it appears in the drawing, as the drawing is an incomplete representation of the mark. *See* TMEP §§ 807.14, 807.14(b).

FACTS

Applicant seeks registration on the Principal Register for the trademark WSI (and globe design) for “franchising services, namely, offering technical assistance in the establishment and/or operation of businesses that provide website development, internet marketing services, and design and web hosting services,” in class 35; “training in the field of internet and websites used for businesses,” in class 41; and “technical consulting services for businesses in the field of Internet and website use; website development and design; and web hosting services namely hosting the websites of others on a computer server for a global computer network,” in class 42; based on the applicant's use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a).

In an Office action dated February 5, 2005, registration was refused because (1) the mark differed in the drawing as compared to the specimen, (2) the drawing was unacceptable, and (3) the recitation and classification of the services was indefinite. Applicant ultimately submitted an acceptable drawing comprising the letters WSI and featuring a globe design serving to “dot the I” but bearing no other design elements.

Please see Figure 1 in the attached summary of drawings and specimens showing the amended drawing.

The specimen of record submitted with the application also displayed the mark as WSI with a small globe dotting the I. However the examining attorney rejected that specimen as not agreeing with the drawing because the specimen also featured a curved arc beginning behind the letters “SI” in the mark and bending around the I to touch the globe. Please see Figure 2 in the attached summary of drawings and specimens showing the proposed mark in the original specimen.

Applicant later submitted a substitute specimen that clearly showed the lettering WSI with the globe and with the arc curving around the lettering. Please see Figure 3 in the attached summary of drawings and specimens showing the proposed mark in the substitute specimen.

The refusal to register was made final in an Office action mailed October 11, 2005. The Examining Attorney also offered applicant the option to amend the filing basis to Section 1(b) to resolve the issue, however, the applicant elected not to amend the filing basis.

On March 15, 2006, applicant submitted an acceptable recitation of services. This appeal followed.

ISSUE

The sole issue on appeal in this case is whether the mark as used on the specimen of record is a substantially exact representation of the mark as applied for in the drawing of record, as required by Trademark Rule 37 C.F.R. 2.51(a).

ARGUMENT

I. THE DRAWING IS AN INCOMPLETE REPRESENTATION OF THE MARK AS DISPLAYED IN THE SPECIMENS.

In an application filed under Section 1(a) of the Trademark Act, the drawing of the mark must be a *substantially exact* representation of the mark as used on or in connection with the services, as shown by the specimen. 37 C.F.R. §§2.51(a) and 2.72(a)(1) (emphasis added). The determinative factor is whether the subject matter in the drawing, for which registration is sought, makes a separate and distinct commercial impression apart from the other elements present in the mark as used on the specimen. See *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989); *In re Sperouleas*, 227 USPQ 166 (TTAB 1985); *In re Mango Records*, 189 USPQ 126 (TTAB 1975). When a drawing does not constitute a complete mark because essential and integral subject matter is missing, it is an incomplete mark and may not be registered. TMEP §807.12(d).

Here, the drawing is an incomplete representation of the mark as used on the specimen. The applicant has elected to seek registration for only part of the drawing. Indeed, applicant seeks registration for the wording and part of the design but has removed additional elements that are “essential and integral subject matter.” This mutilation makes a dramatic difference in the commercial impression of the mark.

The drawing in this case presents two interrelated elements: (1) the wording of the mark (WSI) and (2) a globe design. However, the specimens show three interrelated

elements: (1) the wording, (2) the globe, and (3) a curved arc. In this case, the images common to the drawing and the specimens, namely, the lettering and the globe, are closely related as the globe serves to “dot the I.” Additionally, as applicant notes, the globe serves to signify “the potential global reach of [applicant’s business.” Applicant’s Brief at 4. In a similar way, the arc is closely integrated with both the wording and the globe as it gives the appearance of motion to the globe. Moreover, the curve serves to convey an impression of activity, agility, and the ability to move and react to applicant’s customers needs and desires, all highly desirable characteristics for applicant’s business of technical assistance, training, and consulting.

The arc appears to begin behind the letters SI in applicant’s specimens and the arc is displayed in precisely the same color and shade as the wording in the proposed mark. The arc continues its apparent movement from left to right and curves around the letter I before coming to rest on the globe. As such, the arc is closely integrated with the wording as it is presented in the same color and also serves to unify the letters by “holding” them together. Additionally, the arc serves to create a unitary design with the globe as the arc creates the impression of movement by curving around the letters and touching the globe. This impression of movement relates to the globe as it presents the notion that the globe is spinning, but also relates to the notion of fluidity and agility and the ability to adapt to different scenarios in a business setting. Consequently, the globe and the arc are fundamental to creating the commercial impression in applicant’s mark.

Applicant argues that consumers would recognize the dominant features of the mark as being the lettering and the globe design. Further, applicant argues that the curve “is a fanciful design element without any apparent meaning and without any conceptual

relationship to the letters WSI or the Globe Design.” Applicant’s Brief at 4. As noted above, this is simply not the case. The curve is closely integrated with the letters and serves to bind the mark together. Moreover, the curve creates the impression of movement, both in terms of a globe spinning along its vertical axis and as relates to agility and adaptation in the business world. These connections establish that the curve is closely related to both the lettering and the globe. Because the association between the globe and the wording is as strong as the association between the curve and the wording and indeed, as strong as the association between the curve and the globe itself, the elements of the mark are closely related and there is no single dominant design element. Rather, each of the two design elements in the specimen is accorded equal weight.

II. THE CASES APPLICANT HAS CITED DO NOT SUPPORT ITS ARGUMENT.

Applicant argues that *In re Schecter Brothers Modular Corp.*, 182 USPQ 694 (TTAB 1974) supports its argument that the addition of the arc does not alter the commercial impression of the mark in its case. Applicant’s Brief at 5-6. However, applicant’s reliance on that case is misplaced. There, the wording of the mark was repeated in a shadow element. The Board in that case found that the shadow created “a redundancy” and added no further information to the mark. *Schecter*, 182 USPQ at 695. In this case, however, the arc adds an element to the mark and alters the overall commercial impression as it serves to “tie” together the letters in the wording and also creates the impression of motion in the mark. Finally, and in stark contrast to the design in *Schecter*, the arc is not a mere replication of a design already contained in the drawing; it serves as a distinct design element that is capable of indicating source.

Applicant's claim of ownership of a pending application Serial No. 78442198 in an effort to draw further parallels to *Schecter* is immaterial. Here, the examining attorney cannot consider the application as it was not properly made of record. If the applicant had intended to reference an existing application, the applicant must have introduced an actual copy of the application to the record. *Cf. In re Duofold*, 184 USPQ 638, 641 (TTAB 1984).

Applicant also argues that *In re Berg Elec., Inc.*, 163 USPQ 487 (TTAB 1969) supports its argument that the curve element of its mark is separate and therefore registrable. Applicant's Brief at 6. Again, however, applicant's reliance is misplaced. In *Berg*, the applicant sought registration for the stylized representation of the word GRIPLET. There, the specimen also included the housemark BERG. The words slightly overlapped and the differences in color and the size of the elements were significant factors in the Board's holding that the elements were separable. Further, in that case, the applicant provided "ampl[e]" evidence of use supporting the distinctiveness of the GRIPLET element. *Berg*, 163 USPQ at 488.

The instant case does not present the addition of an established house mark to a specimen. Instead, applicant seeks to add a new and distinctive design element to the specimens showing use. Additionally, unlike *Berg*, the applicant in this case has provided no evidence as to how the drawing elements are used separately so as to establish the curve as a source indicator independently of the use shown in the specimens submitted.

Consequently, the case law cited in its brief does not support applicant's arguments in favor of registration.

III. STYLIZED DRAWINGS MUST BE SUBSTANTIALLY EXACT REPLICAS OF THE MARKS USED IN THE SPECIMENS.

Applicant suggests that applicants in general are “entitled to register their marks for the long run” and therefore that applicant is entitled to register its mark in one form (e.g., the wording and the globe) but make use of the mark in other forms (e.g., the wording, the globe, and the curve). Applicant suggests that one way to establish these rights is through the use of “block letters.” Applicant’s Brief at 4-5.

Applicants have the option to seek registration for two basic forms of trademarks: standard character or special form. Applicant correctly implies that in marks registered in standard character form the rights reside in the words or letters themselves and not in any particular representation thereof. *In re Melville Corp.*, 18 USPQ2d 1387 (TTAB 1991); TMEP §807.04(b). However, the instant mark is not in standard character form. As noted above, the drawing is a special form drawing containing particular design elements that applicant presumably found important to protect. A special form drawing includes “in whole or in part, of special characteristics such as elements of design or color, styles of lettering, or unusual forms of punctuation.” TMEP §807.04(a). Such an application requires that the drawing be a “substantially exact representation” of the specimen. 37 C.F.R. §2.51(a).

Applicant states that it “deserves the flexibility of being able to use its Mark with . . . the Curve . . .” Applicant’s Brief at 5. The examining attorney agrees and encourages applicant to pursue a separate application for that particular representation.

CONCLUSION

The elements WSI, the globe design, and the curved arc are so merged together in the presentation of applicant's mark on the specimen that the wording WSI and the globe design cannot be regarded as a separable element creating a separate and distinct commercial impression. The lettering and the design elements are presented in a unitary form with the arc curving around the lettering and touching the globe, thereby presenting an impression of movement both in the elements of the mark and in relation to the underlying business. Thus, the applied-for-mark, WSI (and globe design), does not form a commercial impression separate and distinct from the composite WSI (with globe and arc designs) as actually used. Therefore, the applied-for-mark, as used on the specimens, does not function as a mark for the recited services in and of itself. As such, the mark is a mutilation of the mark as depicted on the specimen.

For the foregoing reasons, the Examining Attorney respectfully requests the refusal of registration based on the requirement for a substitute specimen due to the fact that the specimen does not show use of the mark as is appears in the drawing, as the drawing is an incomplete representation of the mark, be affirmed.

Respectfully submitted,

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