

This Opinion is not a
Precedent of the TTAB

Mailed: November 8, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Cree, Inc.

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Serial No. 85838153

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Harris W. Henderson of Kilpatrick Townsend & Stockton LLP for Cree, Inc.

Won T. Oh, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

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Before Cataldo, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

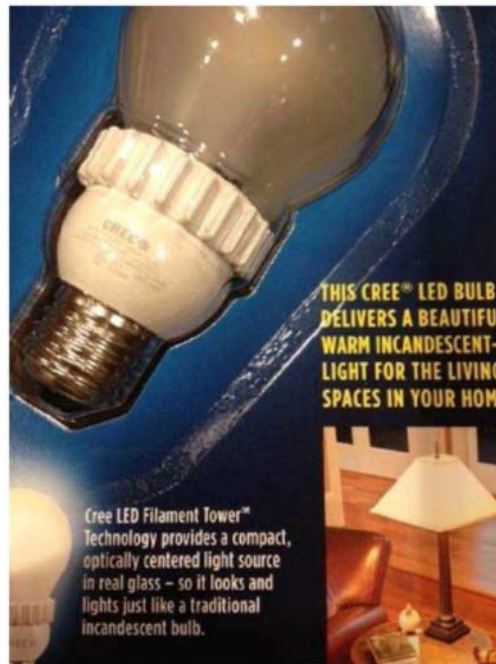
Cree, Inc. (“Applicant”) seeks registration on the Principal Register of the mark
FILAMENT TOWER (in standard characters) for “LED (light emitting diode) lighting
fixtures, excluding light towers; LED (light emitting diode) light bulbs,” in
International Class 11.¹

¹ Application Serial No. 85838153 was filed on February 1, 2013, under Section 1(b) of the Trademark Act, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce. The application was published for opposition on January 21, 2014. A Notice of Allowance issued on March 18, 2014. Applicant filed its Statement of Use on August 5, 2014.

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground that the specimens of record do not show the applied-for-mark as displayed in the drawing of the application. Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127; 37 C.F.R. §§ 2.34(a)(1)(iv) and 2.56(a). The Trademark Examining Attorney explained that the mark on the specimens differed materially from the drawing of the mark in the application.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

The specimens of use are digital photographs of packaging shown below:





During the prosecution of the application, Applicant submitted an excerpt from its website displaying the mark sought to be registered in its advertising as shown below:



The screenshot shows the Cree website header with the Cree logo and navigation links: PRODUCTS, BUY NOW, LEARN, CONNECT, NEWS. Below the header, there is a promotional banner for Cree LED Filament Tower Technology. The banner includes a small image of the Cree LED Filament Tower bulb and a text block that reads: "Cree LED Filament Tower™ Technology. Want to light like a light bulb? Start with the source of light. Cree LED Filament Tower™ Technology is designed to emulate the look and feel of an incandescent filament but provide all the benefits of LED technology, long life and efficiency. The design of the Cree LED Filament Tower provides a compact, and optically centered and balanced light source (like the tungsten filament in an incandescent bulb) to deliver the warm, all-around light you and your lamps and fixtures love."

The Trademark Examining Attorney contends that the mark displayed in the specimens is **Cree LED Filament Tower Technology** “because there is nothing about the size of stylization of the terms to suggest that FILAMENT TOWER is a separate unique term.”²

Applicant, in response, makes the following arguments:

1. Consumers are familiar with the use of trademarks that brand specific technology offerings alongside a trademark owner’s house mark and other descriptive wording;
2. Applicant frequently uses a superscript “TM” in connection with the FILAMENT TOWER mark, and does so in the specimens;
3. Applicant uses the FILAMENT TOWER mark in its promotional materials and on its website in a manner that reinforces the mark’s separate function as a source indicator; and

² Examining Attorney’s Brief (unnumbered) p. 4 (9 TTABVue 5).

4. The specimens show use of the FILAMENT TOWER mark alongside the CREE house mark and the terms “LED” and “Technology.”³

Trademark Rule 2.51(b), 37 C.F.R. § 2.51(b), provides, in relevant part, that “the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” Likewise, Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a), provides, in relevant part, that the specimen must show the mark as used on or in connection with the goods or services. TMEP § 807.12 (April 2016) summarizes the requirements for the mark in the drawing as compared to the mark in the specimen.

For applications under §1 of the Trademark Act, the drawing must always be compared to the specimen of record to determine whether they match. See 37 C.F.R. §2.51(a)-(b) [sic]. The first step is to analyze whether the mark in the drawing is a substantially exact representation of the mark shown on the specimen.

In this case, the mark sought to be registered – FILAMENT TOWER – is displayed as **Cree LED Filament Tower™ Technology**.

The issue before us is whether FILAMENT TOWER is a complete mark or merely part of a larger mark. In other words, are “Cree LED” and “Technology” essential and integral subject matter missing from the drawing?

It is well settled that an applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of applicant's goods or

³ Applicant’s Brief, p. 12 (7 TTABVUE 15).

services and distinguishes applicant's goods or services from those of others. *See, e.g., In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *Institut National des Appellations D'Origine v. Vintners Int'l. Co., Inc.*, 954 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992) (determining “what exactly is the ‘trademark?’” “all boils down to a judgment as to whether the designation for which registration is sought comprises a separate and distinct ‘trademark’ in and of itself.”). It is the overall commercial impression of the mark that is controlling. *1175856 Ontario*, 81 USPQ2d 1446, 1448 (TTAB 2006).

Of particular interest in the present case is the way in which prior cases have determined what constitutes a “separate” commercial impression. In *In re Chemical Dynamics*, the applicant used the mark shown below, but sought to register only the portion representing an eyedropper:



The Court, in affirming the Board’s refusal of registration, explained:

The three elements of the background – the dropper, the droplet, and the watering can – are *interrelated elements of a single unified design*. We agree with the Board that these elements constitute ‘a unitary mark which creates a single commercial impression and that to try to separate out the eyedropper portion of the mark results in an impermissible mutilation.’

5 USPQ2d at 1830 (emphasis supplied).

The case before us is substantially similar to *In re Semans*, 193 USPQ 727 (TTAB 1977). There, the applicant sought to register the mark KRAZY, but the specimen of use showed use of the KRAZY MIXED-UP. The Board, in affirming the examining attorney's refusal of registration, explained:

The specimen labels, as shown above, show use of "KRAZY" on the same line and in the same script, whether it be plain or in a distinctive arrangement, as the expression "MIXED-UP", which would tend to suggest that applicant has made no effort to emphasize any one portion of this grouping. Additionally significant is the fact that the expression "KRAZY MIXED-UP" is treated on these labels as a separate unit apart from "JANE'S" and the name of the goods such as rice, lemon pepper marinade, and the like. Thus, as we view it, "KRAZY MIXED-UP" is a unitary phrase, of which "KRAZY" is an integral part, it is used by applicant as a single composite mark, it is a play on a unitary colloquial expression, and there is nothing in the record to suggest that customers and prospective purchasers of applicant's goods separate the phrase into component parts and utilize "KRAZY" alone to call for and refer to the goods.

193 USPQ2d at 729.

Turning to the case before us, the mark shown in the application drawing – FILAMENT TOWER – is manifestly not "a substantially exact representation" of the mark that Applicant is actually using – **Cree LED Filament Tower Technology** (at least to the extent that such use is demonstrated by the specimens of record and Applicant's website). The question is whether FILAMENT TOWER, as it appears on the specimens, engenders a separate and distinct commercial impression. FILAMENT TOWER is an interrelated element of the single unitary phrase **Cree LED Filament Tower Technology** because there is nothing to distinguish or separate FILAMENT TOWER from the rest of the phrase. Further, there is no

evidence documenting Applicant's use of FILAMENT TOWER as a stand-alone mark from which consumers could identify FILAMENT TOWER separate and apart from the entire phrase **Cree LED Filament Tower Technology**. Thus, although Applicant uses FILAMENT TOWER alongside the CREE mark and the terms "LED" and "Technology," Applicant does not use FILAMENT TOWER in its promotional materials and on its website in a manner that reinforces its significance as a mark separate and apart from the rest of the phrase.

Despite the fact that Applicant, based on this record, is always using FILAMENT TOWER in conjunction with the phrase "Cree LED Filament Tower" or "Cree LED Filament Tower Technology," Applicant is asking consumers, who are merely interested in buying a light bulb, to parse "Cree LED Filament Tower" or "Cree LED Filament Tower Technology" into its component parts (*i.e.*, the Cree house mark, the generic term LED, the trademark at issue Filament Tower, and Technology which is just a puff term to show the sophistication of the product) even though there is nothing in the way the phrase is displayed that would distinguish the components.

We find the cases cited by Applicant to be distinguishable.

In re Royal Body Care Inc., 83 USPQ2d 1564, 1567 (TTAB 2007), where applicant sought to register the mark NANOCEUTICAL when it was embedded in the phrase RBC'S NANOCEUTICAL, the Board found that "the terms RBC's and NANOCEUTICAL are separate, not connected. They do create two separate impressions." 83 USPQ2d at 1567. As noted in *Institut National des Appellations D'Origine v. Vintners Int'l. Co., Inc.*, determining whether FILAMENT TOWER

creates a separate commercial impression is a judgment call and, in this case, there is nothing in the record that supports a finding that FILAMENT TOWER creates a commercial impression separate and apart from **Cree LED Filament Tower Technology**. As shown below, the specimens show FILAMENT TOWER used as a part of a unitary term:

Cree LED Filament Tower™ Technology provides a compact, optically centered light source in real glass – so it looks and lights just like a traditional incandescent bulb.

Likewise, Applicant uses **Cree LED Filament Tower Technology** as a unitary term in its website as shown below:

Cree LED Filament Tower™ Technology

Want to light like a bulb? Start with the source of light. Cree LED Filament Tower™ Technology is designed to emulate the look and feel of an incandescent filament but provide all the benefits of LED technology, long life and efficiency. The design of the Cree LED Filament Tower provides a compact and optically centered and balanced light source (like the tungsten filament in an incandescent bulb) to deliver the warm, all-around light you and your lamps and fixtures love.

In re Emco, Inc., 158 USPQ 622, 623 (TTAB 1968), where applicant sought to register the mark RESPONSER and the specimen displayed the mark as MEYER RESPONSER (Meyer being the name of applicant's president), the Board found that the term RESPONSER identifies and distinguishes applicant's goods, in part, because applicant used RESPONSER as a stand-alone mark in other materials.

As indicated by the instruction sheet which accompanies applicant's device, and which was used prior to the filing of the application for registration, the device is referred to by the designation "RESPONSER", simpliciter. The record further shows that applicant in letters directed to

prospective purchasers referred to its product by “RESPONSER” alone and that a prospective purchaser did the same. In an article published in Language Laboratories and Language Learning concerning applicant's device, emphasis was given to the designation “RESPONSER.”

158 USPQ at 622.

In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989), where applicant sought to register the mark TINEL-LOCK but the specimen displayed the mark as TRO6AI-TINEL-LOCK-RING, the Board noted that applicant submitted advertising displaying TINEL-LOCK as a stand-alone mark.

Submitted with the application was a simple advertising brochure, which refers to the “Tinel-Lock system” and to “Tinel-Lock heat-recoverable rings for cable shielding termination.” The brochure explains that the “Tinel-Lock ring is made from Tinel, a special shape-memory metal, which shrinks approximately 6% when heated, permanently attaching the cable shield to the adapter body.” Reference is made to “Tinel-Lock” adapters and rings at several places in the advertisement. “Tinel” is identified as a registered trademark, presumably for the metal of which applicant's goods are made. The third page of the brochure explains the part numbering schemes for both the “Tinel-Lock adapter and ring (2 piece-system)” and the “Tinel-Lock ring only.”

12 USPQ2d at 1399.

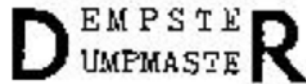
The Board then explained that the alpha-numeric designation was a model number and not essential to the commercial impression engendered by TINEL-LOCK and that the word “Ring” was a generic term.

Prospective purchasers of these highly technical goods would readily recognize both the part number and the name of the goods as such, and would therefore look only to the trademark “TINEL-LOCK” for source identification. The fact that hyphens connect both the part number and the generic term to the mark does not, under the

circumstances presented by this case, create a unitary expression such that “TINEL-LOCK” has no significance by itself as a trademark. Such independent significance is in fact supported by applicant's use of the mark without the part number or generic designation in its advertising materials.

12 USPQ2d at 1400.

In re Dempster Bros., 132 USPQ 300 (TTAB 1961), where applicant sought to register DUMPMMASTER and a specimen displayed the mark as shown below:

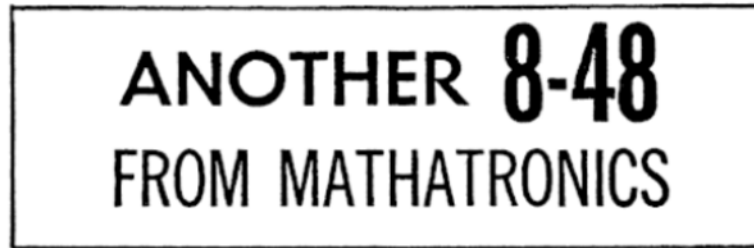


the Board found that DUMPMMASTER identified and distinguished applicant's goods because the record supported applicant's use of DUMPMMASTER as a stand-alone mark.

The record shows that applicant has consistently used the term “DUMPMMASTER”, per se, in its advertisements to refer to its products; that purchasers and prospective purchasers used that designation alone in making reference to applicant's product; that purchasers have ordered applicant's product by the term “DUMPMMASTER”, alone; that writers in various trade journals referred to applicant's product by the designation “DUMPMMASTER”; and that purchasers do in fact recognize “DUMPMMASTER” as being a brand of equipment made only by applicant.

132 USPQ at 300.

In re Barry Wright Corp., 155 USPQ 671, 672 (TTAB 1967), where the Board found that the mark 8-48, shown below, stands out as a distinguishable element separate and apart from the phrase “Another 8-48 From Mathatronics,” as shown below:



The Board provided no explanation for finding that 8-48 was a distinguishable element. It simply stated that “it is clear that the notation ‘8-48’ stands out as a distinguishable element separate and apart from the statement ‘ANOTHER 8-48 FROM MATHATRONICS.’” 155 USPQ at 672. Keeping in mind that making the determining “all boils down to a judgment,” *Institut National des Appellations D’Origine v. Vintners Int’l. Co., Inc.*, 22 USPQ2d at 1197, we presume that the Board focused on the presentation of 8-48 in larger print and the commercial impression of the phrase “Another 8-48 By Mathatronics” highlighting that the product is an 8-48 brand computer.

We are not persuaded that Applicant’s use of the superscript “TM” after the word “Tower” in the phrase **Cree LED Filament Tower™ Technology** distinguishes **FILAMENT TOWER** as a separate term. The common law trademark symbol applies equally to the phrase **Cree LED Filament Tower**. The use of the common law trademark symbol does not make an otherwise unregistrable designation a trademark. See *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532, 1538 n.5 (TTAB 2007); *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984).

We have also considered Applicant’s argument regarding consumers’ familiarity with sub-branding that offers specific branded technology in connection with a house

mark. However, Applicant's exhibits illustrating sub-branding do not help its cause. For example, GE's reveal® Whiter White Technology website excerpt uses the phrase as a unitary phrase and does not use Whiter White Technology as a stand-alone mark. Moreover, GE uses Whiter White Technology to describe a process for providing optimal lighting using less lumens, not as a mark identifying lamps. The Philips SpaceWise Technology website uses SpaceWise Technology as a stand-alone term. However, Philips also uses SpaceWise Technology as a process for providing more effective lighting using less power, not as a mark identifying a product.

Applicant's specimens of use and website show the mark that Applicant is using. That mark is substantially different from the mark that Applicant has applied to register. We find that the mark in Applicant's application is a mutilation of the mark that Applicant actually uses, and that the specimen of use does not support Applicant's allegation that it is using the mark that it seeks to register. The Trademark Examining Attorney's refusal to register the mark on that basis was correct.

Decision: The refusal to register Applicant's mark FILAMENT TOWER is affirmed.

Dissent by Ritchie:

I respectfully dissent. As the majority has noted, our primary reviewing court has indicated that this is a judgment call. *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *Institut National des Appellations D'Origine v.*

Vintners Int'l. Co., Inc., 954 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992). Nevertheless, we look at the evidence presented to determine whether the term that Applicant seeks to register, FILAMENT TOWER, creates a separate commercial impression in the submitted specimens. The Examining Attorney contends that the specimens show the proposed mark used together with Cree LED Filament Tower as a unitary term. However, Cree is Applicant's trade name, and LED names the product. I think it is thus clear that the term Filament Tower, in the specimen, creates a separate and distinct commercial impression. In this regard, the situation is similar to that of *In re Royal Body Care Inc.*, 83 USPQ2d 1564, 1568 (TTAB 2007), where the Board found that the first term consisted of a house mark with a separate commercial impression. In *Royal Body Care*, the applicant submitted examples of how it used RBC as a house mark. *Id.* at 1566. Likewise, in this case, Applicant submitted an excerpt from its website showing CREE used as a trademark separate and apart from FILAMENT TOWER.⁴

I would reverse.

⁴ February 27, 2015 Response to Office Action.