

<p>This Opinion Is Not a Precedent of the TTAB</p>
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MPT, Inc.

Serial No. 86316207

Donna M. Klett of Pearne & Gordon LLP
for MPT, Inc.

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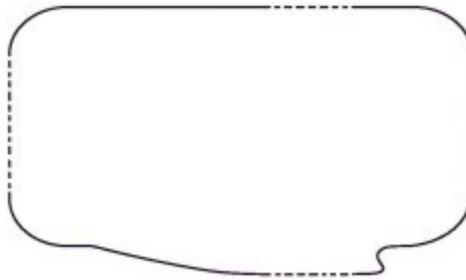
Before Greenbaum, Adlin, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

MPT, Inc. (“Applicant”) seeks registration on the Supplemental Register of the configuration mark shown below for “Printed paper labels; paper identification tags; printed paper labels; adhesive labels; paper die cut shapes; paper labels; paper tags;

placards of paper or cardboard; printed paper labels; coupons” in International Class 16 and “Plastic labels” in International Class 20:



The current description of the mark is:

The mark consists of the configuration of a label, placard, coupon, or tag for marketing or disseminating commercial messages to consumers or the general public, said configuration consisting of the four rounded, convex corners and the call-out indicator of a generally rectangular speech bubble, with the call-out indicator located at the bottom of the speech bubble and formed by an extended pointed portion connected to the lower right corner by a concave line and connected to the lower left corner by a sloped line. The broken lines in the drawing are used to show the placement of the mark and are not part of the mark.¹

Applicant’s original description stated that the dotted lines serve “to indicate that the height and width dimensions of the product are not claimed as a feature of the mark.”

June 20, 2014 Application. In its June 1, 2015 Response to Office Action, Applicant explained the broken lines as follows: “These unclaimed portions comprise portions of the straight walls at the four sides of the label that would fix their length.”

¹ Application Serial No. 86316207 was filed June 20, 2014, based on intent to use in commerce under Section 1(b), 15 U.S.C. § 1051(b). Applicant subsequently filed an allegation of use and an amendment to seek registration on the Supplemental Register, in order to overcome a nondistinctiveness refusal.

The Examining Attorney refused registration on three related grounds:²

1. The application seeks registration of more than one mark, in that the portion of the mark appearing in dotted lines represents a changeable or “phantom” element in violation of Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127;³
2. Applicant’s drawing is unacceptable pursuant to Section 1(a)(1) of the Act, 15 U.S.C. § 1051(a); and
3. The description of the mark is unacceptable pursuant to Trademark Rule 2.37, 37 C.F.R. § 2.37.

After the Examining Attorney made the refusals final, Applicant appealed. We affirm the phantom mark refusal and the description and drawing requirements.

II. Phantom Mark Refusal

A “phantom” trademark “is one in which an integral portion of the mark is generally represented by a blank or dashed line acting as a placeholder for a generic term or symbol that changes, depending on the use of the mark.” *In re Int’l Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1515 n.1 (Fed. Cir. 1999). Under the Trademark Act, however, “a trademark application may only seek to register a single mark.” *Id.* at 1516. A mark that contains a changeable or “phantom” element is more than one mark. *In re Primo Water Corp.*, 87 USPQ2d 1376, 1378 (TTAB 2008).

In *Primo Water*, the Board provided some background on phantom mark refusals:

As the Court discussed in *International Flavors*, a primary purpose of registration is to provide notice to potential users of the same or

² The Examining Attorney did not refuse registration on the Supplemental Register on the ground that the proposed mark is incapable of distinguishing Applicant’s goods under §§23(c) and 45 of the Trademark Act, 15 U.S.C. §§1091(c), 1127.

³ See also 15 U.S.C. § 1091(c) regarding eligibility of “a mark” for registration on the Supplemental Register.

a confusingly similar mark, and that to serve this purpose, the mark, as registered, must accurately reflect the way it is used in commerce so that someone who searches the registers of the USPTO for the mark, or a similar mark, will locate the registered mark. The Court further stated, at 51 USPQ2d 1517 -18, that “phantom” marks with missing elements “encompass too many combinations and permutations to make a thorough and effective search possible. The registration of such marks does not provide proper notice to other trademark users, thus failing to help bring order to the marketplace and defeating one of the vital purposes of federal trademark registration.”

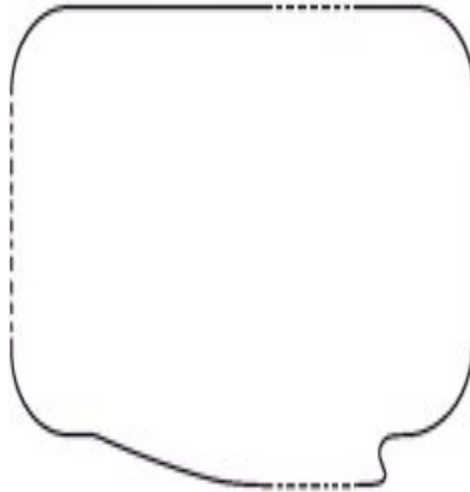
Id.

We find that the significantly different shapes that potentially could be created by varying the lengths and widths of the sides of this “generally rectangular” shape demonstrate the unacceptable phantom nature of the proposed mark. As shown below through two hypothetical examples of manipulation of the length and width, the resulting shapes can differ substantially. The first example is below:



The first example displays an elongated rectangular shape that is approximately twice as long and half as wide as that shown in Applicant’s drawing.

The second example is below:



The second example displays a rectangular shape that approximates a square.

The dotted lines also leave open the possibility that the missing elements may not be straight lines, presenting even more, in fact unlimited, potential for variation in the “*generally* rectangular” shape. As potential product designs of labels, the variations could look dissimilar and create completely different commercial impressions. Thus, we consider this case distinguishable from *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1813 (Fed. Cir. 2001), in which the commercial impression of the changeable element in the mark was “an area code, the possibilities of which are limited by the offerings of the telephone companies.” We see more of a parallel to *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001), wherein the Board rejected the applicant’s attempt to register a hologram device for trading cards, without limitation of the size, shape, or content of the hologram device. The Board found, *inter alia*, that the “myriad of shapes, sizes, contents and the like” resulted in an unacceptably large number of combinations that almost certainly would have varying commercial impressions. *Id.* at 1690. *See also In re Hayes*, 62 USPQ2d 1443, 1446 (TTAB 2002) (applicant was impermissibly seeking the

registration of multiple marks when it sought “to register all combinations and permutations of green, amber and red squares in a grid”).

Applicant argues that it merely seeks to register “portions of what is described as a ‘generally rectangular speech bubble,’” such that the broken lines are not “changeable placeholders.”⁴ However, as noted above, Applicant stated in its original description and in a response that the broken lines represent the varying lengths and widths it seeks to protect, rather than mere unclaimed but consistent portions of a single, unchanging product configuration. While Applicant’s proposed variations all may be talk bubbles, with three-dimensional configurations of the goods such as these, the form and shape of them are the essence of the mark, and Applicant’s proposed forms and shapes could diverge too much to be considered the same mark. *See id.* (“We disagree with applicants’ statement that a mark should be considered as a single mark as long as all variations fit within the characterization of the description”). More importantly, under the circumstances, Applicant’s use of broken lines in this drawing impermissibly opens the door to multiple marks, regardless of Applicant’s extraneous assurances to the contrary.

Public policy interests counsel against allowing Applicant the wide latitude it seeks to protect multiple configurations of goods with a single registration. In *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 215 (2000), the Supreme Court was concerned with “plausible threats of suit against new entrants.” The phantom

⁴ 4 TTABVue 8 (Applicant’s Brief).

elements in Applicant's mark and resulting lack of adequate notice of the claimed mark would generate the same concern.

Accordingly, we affirm the refusal to register on the ground that the changeable elements in Applicant's proposed mark result in multiple marks that cannot be protected in a single registration.

III. Drawing and Description of the Mark

An application for a product configuration mark must include an accurate drawing and description of the mark. *See* 37 C.F.R. §§ 2.37 & 2.52(b)(2) & (4) (description requirements for three-dimensional marks) and § 2.51(a) (requiring a drawing that is "a substantially exact representation of the mark"); *Trademark Manual of Examining Procedure* ("TMEP") § 1202.02(c) (April 2017). On the basis that the drawing and current description of the mark encompass more than one mark, the Examining Attorney made final requirements for an acceptable drawing and description.⁵

In *Hayes*, 62 USPQ2d 1443, 1444 (TTAB 2002), the Board affirmed a description requirement where the description stated that the drawing showed a "representative pattern of colors," "but no claim [wa]s made to a particular pattern of the three colors."

⁵ Pursuant to Rule 2.52(b)(4), broken (or dotted) lines may be used to show placement of a mark, such as on the goods or packaging on which it appears, or such lines may "show any other matter not claimed as part of the mark." 37 C.F.R. § 2.52(b)(4). Although the September 15, 2014 Office action required an amended description indicating, inter alia, that the broken lines "serve[] only to show the position or placement of the mark," that characterization does not seem appropriate in the context of this mark. Rather than indicating the position or placement of the mark, as indicated in Applicant's original description, these broken lines appear to serve the more unusual purpose of indicating that the length of the lines is not claimed as part of the mark, because Applicant wishes to reserve the possibility of varying the lengths.

The Board held that “applicants’ description of the mark is unacceptable in that it describes more than one mark.” *Id.* at 1445. In *In re Elvis Presley Ent, Inc.*, 50 USPQ2d 1632 (TTAB 1999), the Board affirmed a drawing requirement where the drawing consisted of “the likeness and image of Elvis Presley,” which would include all of the different poses of Elvis Presley, on the ground that the drawing encompassed more than one mark and was, therefore, unacceptable.

The drawing and description requirements in this case flow from Applicant’s attempt to register more than one mark in a single application. For that reason, based on our conclusion discussed above, both the drawing and description of the mark are improper. Therefore, the requirements for an acceptable drawing and description are appropriate.

Decision: We affirm the refusal to register and the requirements for an acceptable drawing and description of the mark.