

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TBL Licensing LLC

Serial No. 86684964

Sarah C. Hsia of Sneed PLLC,
for TBL Licensing LLC.

Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111,
Robert Lorenzo, Managing Attorney.

Before Quinn, Masiello and Pologeorgis,
Administrative Trademark Judges.

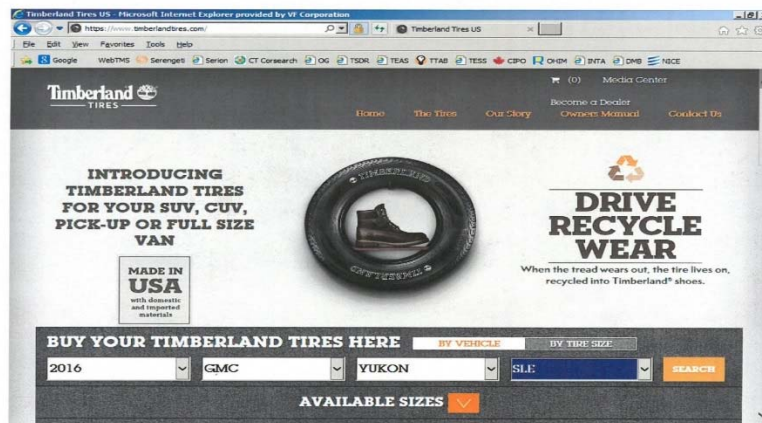
Opinion by Pologeorgis, Administrative Trademark Judge:

TBL Licensing LLC (“Applicant”) filed an intent-to-use application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register on the Principal Register the mark displayed below for “inner tubes for vehicle tires; tires” in International Class 12, and “distributorship services in the field of tires” in International Class 35.¹

¹ Application Serial No. 86684964 filed on July 7, 2015. The application includes the following description of the mark: “The mark consists of a boot inside a tire.”



After initial examination, the application was published for opposition and a notice of allowance issued. In due course, Applicant filed its statement of use with an accompanying specimen of use, as required by Trademark Act § 1(d), 15 U.S.C. § 1051(d). In its statement of use, Applicant amended the identification of goods and services by deleting the International Class 35 services in their entirety and limiting the International Class 12 goods to “tires.” The submitted specimen of use (a screen shot from Applicant’s website) displays Applicant’s applied-for mark as follows:



A closer view of the mark, as shown on the specimen of use, is displayed below:



Upon examination of the statement of use, the Trademark Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that the mark depicted on the specimen of use fails to provide sufficient evidence of use of the applied-for mark in commerce on, or in connection with, Applicant's identified goods in that the mark shown in the specimen of use is not a substantially exact representation of the mark depicted in the drawing.² The

² We note that while the Trademark Examining Attorney did not specifically couch her refusal in terms of "mutilation" of the mark, she nevertheless made clear in her refusal that the issue involved in this case is not only whether the mark in the drawing is a substantially exact representation of the mark as used on the specimen, but also whether the applied-for mark is an incomplete presentation of the mark as actually used. In other words, whether the drawing constitutes a mutilation of the mark. Accordingly, for purposes of completeness, we will also address the issue of mutilation *infra*.

Trademark Examining Attorney also refused to allow Applicant to amend the drawing to conform to the manner in which the mark is displayed on the submitted specimen of use because such an amendment to the drawing would purportedly constitute a material alteration of Applicant's applied-for mark.

When the refusals were made final, Applicant appealed. The appeal is fully briefed. We reverse the refusal to register under Sections 1 and 45 of the Trademark Act.

I. Arguments

In support of her refusal, the Trademark Examining Attorney maintains that the applied-for mark depicted on the drawing has substantial, material variations from the mark depicted on the specimen of use that result in the marks not being substantially exact.³ Specifically, the Trademark Examining Attorney contends that the marks are substantially and materially different based on the following variations: (1) stylization; (2) differences in the visual appearance of the design elements and elements comprising the design; and (3) the inclusion of additional wording on the specimen of use that is not included in the drawing.⁴

With regard to stylization, the Trademark Examining Attorney argues that, unlike the specimen of use, the tire and boot are displayed on the drawing in a caricature-type rendering featuring a nondescript tire with a nondescript tread

³ Trademark Examining Attorney's Appeal Brief, 6 TTABVue, TSDR pp. 6-7 (TSDR refers to the USPTO electronic file system Trademark Status and Document Retrieval available online).

⁴ *Id.*, TSDR p. 7.

pattern formed by two vertical lines that repeat around the outer tire surface or sidewall. In contrast, the Trademark Examining Attorney maintains that the mark, as displayed on the specimen, depicts an actual tire tread pattern and an actual boot.⁵

With regard to the visual appearance of the tire elements, the Examining Attorney argues that, unlike the drawing, the specimen of use includes a particular “D” style tread pattern along the outer tire surface and has other markings, wording and logos on the outer tire profile or sidewall.⁶ Additionally, the Examining Attorney maintains that, because the tire in the specimen is an actual tire, it includes indentions, markings and other elements embossed on the sidewall surface that are not present in the drawing.⁷

With respect to the boot element, the Trademark Examining Attorney maintains that the specimen of use (1) depicts a boot that is laced whereas the boot in the drawing is unlaced, (2) includes a logo embossed hang-tag hanging from the boot eyelet area and a padded ankle collar while the boot in the drawing displays neither, (3) includes side stitching, a logo emblazed on the side ankle area, and lug soles whereas the boot in the drawing does not, and (4) shows a bar element projecting down from the inside of the upper tire area while the drawing does not include such a bar.⁸

⁵ *Id.*

⁶ *Id.*, TSDR p. 8.

⁷ *Id.*, TSDR p. 9.

⁸ *Id.*, TSDR p. 8.

The Trademark Examining Attorney further contends that the marks also differ in that the mark shown on the specimen of use, unlike the mark displayed on the drawing, includes wording and design elements, namely, the term TIMBERLAND accompanied by a stylized tree logo on the top and lower tire side wall area, as well as the terms “CROSS BY RADAR,” “M+5,” “24” and other illegible markings on the tire sidewall area.⁹ With regard to the wording “CROSS BY RADAR” in particular, the Trademark Examining Attorney argues that the inclusion of these terms on the tire sidewall as depicted in the specimen of use appears to create a different commercial impression as demonstrating tires that originate from a source other than Applicant.¹⁰ In view of the aforementioned differences, the Trademark Examining Attorney concludes that the mark in the drawing and the mark shown in the specimen of use are not substantially exact.

Finally, the Trademark Examining Attorney argues that the omission of various wording and design elements in the drawing of the mark is an attempt by Applicant to register something less than the totality of its trademark and, therefore, constitutes a mutilation of the mark.¹¹

The crux of Applicant’s argument in traversing the Trademark Examining Attorney’s refusal is that any variations between the mark depicted in the drawing and the mark shown in the specimen of use are inconsequential and do not create a

⁹ *Id.*, TSDR p. 10.

¹⁰ *See* October 11, 2016 Final Office Action, TSDR p. 3.

¹¹ Trademark Examining Attorney’s Appeal Brief, 6 TTABVUE, TSDR pp. 13-15.

different overall commercial impression.¹² With respect to the tire design element specifically, Applicant maintains that the Trademark Examining Attorney has failed to introduce any evidence that the tread pattern displayed on the specimen of use is, in fact, indicative of a third-party source, such that it would convey a different commercial impression from the drawing.¹³ Further, while acknowledging that the Trademark Examining Attorney submitted evidence which purports to show that different tread patterns can be linked to different road conditions or manufacturers, Applicant contends that the Trademark Examining Attorney has not shown that the variations between Applicant's mark as displayed on the drawing as compared to the specimen of use alters the overall commercial impression thereof.¹⁴ Additionally, Applicant argues that while the actual representation of the tire tread as shown in the specimen of use is slightly different than the tire tread depiction in the drawing, such a variation is "a distinction without a difference: it does not cause the viewer to perceive the tire as some other object."¹⁵ Applicant further maintains that the slight variation in the representation of the tire tread in the specimen of use does not cause the viewer to perceive a different type of tire, such as a truck tire or a snow tire and, therefore, the mark shown in the specimen of use is a substantially exact representation of the mark depicted in the drawing.¹⁶

¹² Applicant's Appeal Brief, p. 4, 4 TTABVue 5.

¹³ *Id.* at p. 6, 4 TTABVue 7.

¹⁴ *Id.*

¹⁵ *Id.* at p. 7, 4 TTABVue 8.

¹⁶ *Id.*

With regard to the boot element, Applicant contends, as with the tire element, that minor visual differences between the boot as displayed in the drawing and the boot shown in the specimen of use are also inconsequential differences and do not change the essence or overall commercial impression of the mark. Specifically, Applicant maintains that “the profile of the boot in the specimen is exactly the same as in the drawing: the boot faces the same way, is positioned the same way in the center of the tire, has the same number of eyelets, etc.”¹⁷

With regard to the additional wording and design elements displayed in the mark shown in the specimen of use, Applicant argues that it is not required to claim these additional elements as part of its mark in that Applicant may choose to define what constitutes its mark, which it claims it has done.¹⁸ Furthermore, Applicant maintains that the USPTO has historically provided applicants with some discretion in deciding upon whether various elements should be registered separately.¹⁹

Finally, with regard to the Trademark Examining Attorney’s argument that the omission of various wording and design elements in the drawing of Applicant’s mark constitutes a mutilation of the mark, Applicant argues that the overall commercial impression of the mark depicted in the drawing and the mark shown in the specimen of use is identical, namely, a boot inside a tire.²⁰ Applicant further maintains that there is no evidence or sound argument supporting the proposition that the

¹⁷ *Id.* at p. 8, 4 TTABVUE 9.

¹⁸ *Id.* at pp. 10-11, 4 TTABVUE 11-12.

¹⁹ *Id.* at p. 11, 4 TTABVUE 12.

²⁰ Applicant’s Reply Brief, p. 4, 7 TTABVUE 8.

differences highlighted by the Trademark Examining Attorney do anything to change the overall commercial impression of Applicant's mark.²¹ Finally, Applicant contends that the mark it seeks to register, as displayed on the drawing, performs a trademark function in and of itself and makes a separate and distinct impression without the additional elements identified by the Trademark Examining Attorney.²²

II. Applicable Law

Trademark Act Section 1(a)(1), 15 U.S.C. § 1051(a)(1), requires an applicant to submit specimens of its mark as used. *See also* Trademark Rules 2.34(a)(1)(iv), 37 C.F.R. § 2.34(a)(1)(iv), and 2.56(a), 37 C.F.R. § 2.56(a) (“An application under section 1(a) of the Act . . . must [] include one specimen per class showing the mark as used on or in connection with the goods or services.”). An applicant also is required to submit a drawing, which “must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). “[T]he determination of whether a mark shown in the drawing is a substantially exact representation of the mark shown on the specimen is ‘assuredly a subjective one.’” *In re wTe Corp.*, 87 USPQ2d 1536, 1539 (TTAB 2008) (quoting *In re R.J. Reynolds Tobacco Co.*, 222 USPQ 552, 552 (TTAB 1984)). Indeed, “each case presents its own unique circumstances and requires a judgment as to that particular designation.” *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1146, 1448 (TTAB 2006).

²¹ *Id.*

²² *Id.* at pp. 4-5, 7 TTABVUE 8-9.

Under the Board's precedent, a drawing displaying only a "minor alteration" of the mark that "does not create a new and different mark creating a different commercial impression" from the matter shown in the specimens is acceptable. *In re Schechter Bros. Modular Corp.*, 182 USPQ 694, 695 (TTAB 1974); *see also In re Frankish Enters. Ltd.*, 113 USPQ2d 1964, 1974 (TTAB 2015) (quoting *Schechter*).

Additionally, "[i]n an application under §1 of the Trademark Act, the mark on the drawing must be a complete mark, as evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as 'mutilation.' This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered." TMEP § 807.12(d) (April 2017).

"However, in a §1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen." *Id.* The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s).

The question of whether a mark is a mutilation "boils down to a judgment as to whether that designation for which registration is sought comprises a separate and

distinct ‘trademark’ in and of itself.” *Institut National des Appellations D’Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992).

III. Analysis

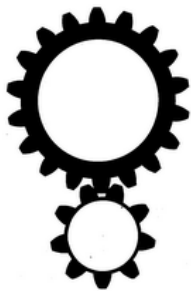
Applicant’s applied-for mark is a pure design mark that conveys a very distinct commercial impression, namely, the incongruous juxtaposition of a boot inside a tire. We find that the mark sought to be registered is validly displayed on the specimen of use. We also agree with Applicant that the variations in the tire and boot elements shown in the drawing, as compared to the mark depicted in the specimen of use, are not critical and do not alter the overall commercial impression of the applied-for mark. Moreover, the fact that the mark displayed in the drawing is a line drawing of a boot within a tire, while the mark shown on the specimen of use is a photographic representation of a boot inside a tire, does not alter the overall essence or commercial impression of the mark. Indeed, we are unaware of nor has the Trademark Examining Attorney cited to any case law or rule which prohibits an applicant from providing a simplified drawing of its applied-for mark when the specimen of use displays a photographic or three-dimensional representation of the mark.

We further find that the presence of the additional elements incorporated in the mark shown in the specimen of use, *i.e.*, the terms TIMBERLAND, CROSS BY RADAR, M+5, 24, as well as the tree logo design, do not detract from the acceptable display of the applied-for mark nor do they change the distinct commercial impression of Applicant’s applied-for mark, *i.e.*, a boot inside a tire. Merchants often present a mark together with other matter, including other marks, on their marketing

materials. Where a merchant uses more than one mark, it is free to choose which mark it wishes to register. *Institut National des Appellations D'Origine*, 22 USPQ2d at 1197; and *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); see also 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:6 (4th ed. September 2017 update) (there is no limitation on the number of trademarks that may appear on a specimen and serve to identify the source of the product). Moreover, we find that the specimen of use downplays the importance of most of the additional terms found on the specimen of use, several of which are barely noticeable. Additionally, the Trademark Examining Attorney has failed to establish that the concurrent display of the terms “TIMBERLAND,” “CROSS BY RADAR,” “M+5,” and “24” and the tree design log in the specimen of use would alter the overall commercial impression of the applied-for mark. Finally, we note that the Board, in somewhat analogous situations, has allowed owners of a composite mark to register separately one or more of its several elements. *In re Servel, Inc.*, 181 F.2d192, 85 USPQ 257, 260 (CCPA 1950) (allowing registration for SERVEL where specimens of use displayed the mark as SERVEL INKLINGS); *In re Sansui Electric Co., Ltd.*, 194 USPQ 202 (TTAB 1977) (Board allowed registration of QSE and QSD; specimens showed use as QSE-4 and QSD-4). We would point out, however, that in the present case we do not perceive the wording “TIMBERLAND,” “CROSS BY RADAR,” “M+5,” and “24” or the tree design logo as so integrated with the boot-and-tire design as to constitute a single composite mark.

Accordingly, we find that that the mark in the drawing is a substantially exact representation of the boot inside tire design mark shown in the specimen of use.

With regard to the issue of whether the drawing of the applied-for mark is a mutilation of the mark sought to be registered, we find that the mark as displayed on the drawing, namely, a boot inside a tire, constitutes a distinct trademark on its own and makes a separate and distinct commercial impression without the additional elements displayed in the specimen of use identified by the Trademark Examining Attorney. The additional word marks shown in the specimen of use are not inextricably bound to each other in any logical, discernable way and there is no substantial interrelationship between the additional terms and the boot and tire design itself that causes them to constitute a single, inseparable mark. We therefore find that the drawing of the mark is not an incomplete version of the mark used by Applicant on the specimen of use. *See In re University of Miami*, 123 USPQ2d 1075 (TTAB 2017) (holding that the mark consisting of an ibis in a sweater is registrable separately from the terms U and MIAMI); *In re Frankish*, 113 USPQ2d 1964 (TTAB 2015) (holding design configuration of monster truck registrable separately from the wording JURASSIC PARK on the vehicle); *In re Nat'l Inst. for Auto Serv. Excellence*, 218 USP 744, 745 (TTAB 1983) (reversing refusal to register meshed gear design



where specimens showed use of mark as



, finding design

to create “a visual impact separate and apart from the words superimposed thereon”); *In re Sterno, Inc.*, 137 USPQ 328 (TTAB 1963) (finding subject matter of application



to register creates a commercial impression separate and apart from applicant’s word mark STERNO and other matter appearing on label in



specimen); cf. *In re Big Pig Inc.*, 81 USPQ2d 1436 (TTAB 2006)

(holding word PSYCHO registrable apart from accompanying words and designs in



specimen).

IV. Conclusion

In view of the foregoing, we find that the mark shown in the drawing is a substantially exact representation of the boot inside tire design mark shown in the specimen of use and is not a mutilation of the mark that is used by Applicant. In light

of this determination, we need not address the Trademark Examining Attorney's refusal to allow Applicant to amend its drawing.

Decision: The refusal of registration under Sections 1 and 45 of the Trademark Act is reversed.