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UNITED STATES PATENT AND TRADEMARK OFFICE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

omelko

Mailed: October 29, 2004

Cancellation No. 92043074

TRI/MARK Corporation

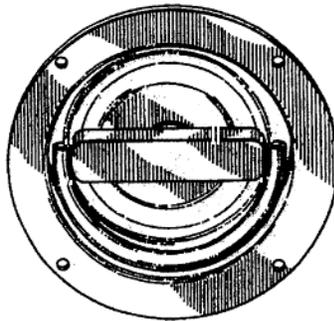
v.

HANSEN MANUFACTURING COMPANY

Before Hanak, Quinn and Rogers,  
Administrative Trademark Judges

By the Board:

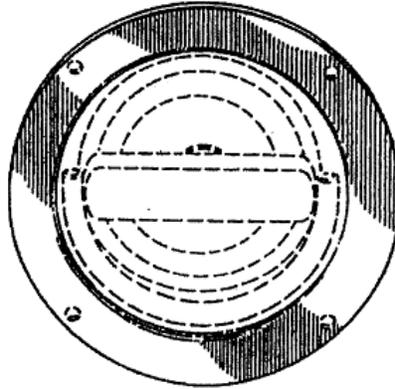
Hansen Manufacturing Company (hereinafter,  
"respondent") filed an application to register the mark  
shown below for "handle assemblies for vehicles, namely  
trucks and utility vehicles."



The mark subsequently registered, with a claim of  
acquired distinctiveness under § 2(f), but in the form shown  
below for "vehicle handle assembly for doors of emergency  
vehicles and fire trucks." Tri/Mark Corporation

**Cancellation No. 92043074**

(hereinafter "petitioner") has petitioned to cancel the registration:<sup>1</sup>



The mark is described in the registration certificate as consisting "of the substantially circular outer periphery of the flange of the vehicle handle assembly. The dotted lining in the drawing shows the position of the mark on the goods and is not part of the mark. The outer lining is for shading purposes only and does not indicate color."

As grounds for cancellation, petitioner alleges that respondent's "alleged" mark (1) "has not become distinctive of the respondent's goods in commerce and no customer recognition of said product design as a valid mark identifying only respondent has been achieved"; (2) "is functional since the registered feature is essential to the use or purpose of the product and/or affects the cost or quality of the goods of the registration...competitors need to copy the registered feature in order to compete

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<sup>1</sup> U.S. Registration No. 2275109, registered September 7, 1999, and asserting dates of first use and first use in commerce at least as early as 1940.

**Cancellation No. 92043074**

effectively"; (3) "has not been used as a trademark [per] TMEP § 1202.03"; (4) "is a mutilation of the unitary design for which registration was originally sought"; and (5) "should not have been issued in that, during prosecution, Respondent's amendments to the description and the drawing of the alleged mark materially altered the character of the alleged mark." Respondent denied the salient allegations of the complaint.

This case now comes up on petitioner's motion for summary judgment, filed April 14, 2004, on the fourth and fifth grounds set out above. The motion has been fully briefed by the parties.

In support of its claim that the mark was materially altered during prosecution, petitioner argues that after the examining attorney rejected the application on the basis that the features of the alleged mark all appeared to be functional, respondent deleted all of the features from its originally applied-for mark, except "the circular outer periphery of the D-ring handle." Relying on *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999), petitioner maintains that:

[T]here is no question but that the deletion of all design elements of [respondent's] vehicle handle assembly except for the circular outer periphery of the flange was a material alteration of [respondent's] alleged mark, as it created a very different overall commercial impression. Thus deletion of these elements from [respondent's] proposed mark created a different commercial impression and therefore constituted a material alteration. The Examining Attorney should

**Cancellation No. 92043074**

have rejected [respondent's] amendment to the drawing of the alleged mark on this basis

In regard to the claim of mutilation, petitioner cites, among other cases, *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 YSPQ2d 1828, 1829 (Fed. Cir. 1988), for the principle that the determinative factor for mutilation is whether or not the subject matter in question makes a separate and distinct impression apart from the other element(s); and petitioner argues:

Since the outer circular flange of [respondent's] vehicle handle assembly does not function as a separate and distinct "trademark" in and of itself, deletion of the other portions of the originally proposed mark constituted a mutilation of the alleged mark.

In response, respondent argues that petitioner's material alteration and mutilation claims are not proper grounds for cancellation; and even if they were, petitioner has not met its burden of proof on these two claims. Relying on, among other cases, *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355 (TTAB 2003), respondent argues that the Board has consistently held that issues not raised in ex parte examination may not be raised in a subsequent inter partes proceeding; and because the examining attorney did not raise these issues, or object to the respondent's application on these grounds during examination, petitioner's allegations are improper claims in this proceeding.

**Cancellation No. 92043074**

Respondent further argues that, in this case, respondent amended its drawing and description to disclaim the functional components of its mark and absent an explanation by petitioner as to why respondent's mark, (including the functional components) is unitary, the mark is presumed not to be unitary and the amended drawing and description are proper. Respondent also maintains that petitioner's cases supporting its claim of mutilation are distinguishable because, unlike this case, they all involved appeals of the examining attorney's refusal on the ground of mutilation and because the deleted portions of the marks were registrable components. Respondent asks that the Board deny petitioner's motion for summary judgment on these grounds and "grant *sua sponte* summary judgment in [respondent's] favor on the issues raised by [petitioner's] Motion."

In reply, citing *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 910 n. 10 [electronic version] (TTAB 1989) for the principle that the Board cannot decline to consider an issue because it is *ex parte* in nature, petitioner argues that material alteration and mutilation are proper grounds for cancellation. Petitioner further argues that respondent is procedurally estopped from raising a claim of improper grounds for

**Cancellation No. 92043074**

cancellation because respondent did not file a motion to dismiss the claims when it filed its answer.

Petitioner also maintains that it has met its burden of proof on summary judgment on the issue of material alteration because "[t]he deletion of all elements from the design of [respondent's] proposed mark, save one, dramatically changed the commercial impression of [respondent's] alleged mark from that which it originally proposed" (emphasis in original). Petitioner also argues that there is no genuine issue of fact on the claim of mutilation because respondent's specimens submitted during prosecution "demonstrated that the outer circular flange of the vehicle assembly was never emphasized separately to constitute a mark in and of itself, and therefore did not create a separate commercial impression from the vehicle assembly as a whole."

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine,

**Cancellation No. 92043074**

if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

We will first dispense with petitioner's assertion that respondent is estopped, on the basis of respondent's failure to file a motion to dismiss, from raising an argument of improper grounds for cancellation. Petitioner has provided no adequate support (and the Board is not aware of any) for petitioner's argument.

We turn to petitioner's claim that the registered mark is a mutilation of the unitary design for which registration was originally sought. Petitioner's motion for summary judgment is denied because there are genuine issues of material fact as to, at a minimum, what the evidence of acquired distinctiveness shows and whether consumers focus on the flange itself or the entire handle/flange assembly. These are issues for trial.

**Cancellation No. 92043074**

As to the question of whether the mark was materially altered during the examination process, we agree with respondent that this is not a proper claim to bring before this Board. Material alteration, by its very terms, focuses on examination. Furthermore, respondent complied with all examination requirements. Had the examining attorney objected during examination, defendant would have had an opportunity to comply. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). It would be manifestly unfair to penalize respondent for non-compliance with a requirement that was never made by the examining attorney. *Id.* Further we disagree with petitioner that *Crocker, supra*, establishes a per se rule that ex parte matters can be considered, or reconsidered, in Board proceedings. See *Saint-Gobain, supra* (whether description of mark is adequate is an examination issue and fails to state a proper ground for cancellation).

We note that respondent has not formally cross-moved for summary judgment but does not point to any genuine issues of material fact and has invited the Board to consider whether entry of summary judgment in respondent's favor as non-moving party is appropriate. If the Board concludes, upon motion for summary judgment, that there is no genuine issue of material fact, but that it is the nonmoving party, rather than the moving party, which is

**Cancellation No. 92043074**

entitled to judgment as a matter of law, the Board may, in appropriate cases, enter summary judgment sua sponte in favor of the nonmoving party. *See, for example, Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986).

In view thereof, petitioner's motion for summary judgment on the issue of material alteration is granted in favor of respondent.<sup>2</sup>

Proceedings herein are resumed with regard to the grounds of likelihood of confusion; non-distinctiveness; functionality; failure to function as a mark; and mutilation. Trial dates, including the close of discovery, are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	March 15, 2005
30-day testimony period for party in position of plaintiff to close:	June 13, 2005
30-day testimony period for party in position of defendant to close:	August 12, 2005
15-day rebuttal testimony period to close:	September 26, 2005

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<sup>2</sup> The parties are reminded that evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. *See* TBMP § 528.05(a) (2d ed. rev. 2004). This decision is interlocutory in nature. Appeal may be taken within two months after the entry of a final decision in the case. *See Interlocutory Decisions by the Trademark Trial and Appeal Board*, 1123 TMOG 36 (February 19, 1991), and *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589 (TTAB 1992). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989).

**Cancellation No. 92043074**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.