

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hudson Fairfax Group LLC

Serial No. 76662560

Walter D. Ames, Esq. for Hudson Fairfax Group LLC.

Colleen Dombrow, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Drost and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On July 5, 2006, Hudson Fairfax Group LLC applied to register the mark CONTINUUM, in standard character format, for services ultimately identified as "financial investment services in the nature of a total portfolio offering comprising an investment in organizations doing business in various regions of the world in the nature of a fund for equity and fixed income investments." The application is based on Section 1(a) of the Trademark Act, and claims a date of first use and first use in commerce as of April 3,

2006. Although applicant and the Examining Attorney have expressed the issue on appeal in different ways, the sole issue is whether the drawing in applicant's application is a substantially exact representation of the mark shown in the specimens. Specifically, it is the Examining Attorney's contention that the specimens show the mark as INDIA CONTINUUM FUND, and therefore that CONTINUUM, shown in the drawing, is a mutilation of that mark.

There are some preliminary procedural matters that we must address. With its reply brief applicant submitted evidence to show that third parties use INDIA in the name of mutual funds in order to demonstrate that INDIA cannot function as a mark for mutual fund services. Although applicant recognizes that this evidence has been submitted at a late stage in the appeal, applicant asserts that the Examining Attorney for the first time in her appeal brief took the position that INDIA was capable of functioning as a trademark. Applicant has also indicated that it has no objection to the Examining Attorney filing a surreply brief to address this new evidence.

Although applicant obviously wishes to shortcut much of the appeal process, Trademark Rule 2.142(d) is clear that the record in the application should be complete prior to the filing of an appeal. An applicant may file a

request for remand in order to attempt to make evidence of record after an appeal has been filed, see TBMP §1207.02. If the Board grants such a request, the application is remanded to the Examining Attorney for further examination, which would include the opportunity for the Examining Attorney to submit evidence to respond to that of the applicant, and for the applicant and the Examining Attorney to file supplemental briefs directed to such new evidence. A request for remand must be supported by a showing of good cause, and the later in the appeal process that the request is made, the stronger the reason that must be given for good cause to be found. Here, applicant has not filed a request for remand, nor has it made the necessary showing of good cause for such a request to be granted. In this connection, we note that in both the second Office action, mailed on June 19, 2007, and the third Office action, mailed December 4, 2007, the Examining Attorney asserted that INDIA is a source-indicating term. Applicant's offer to allow the Examining Attorney to submit a surreply brief (which is not provided for by the rules) is not a satisfactory basis for circumventing the rules and procedures of the Board. Accordingly, the evidence submitted by applicant with its reply brief has been given no consideration.

Applicant has also stated in its reply brief that it "readily disclaims any right of exclusivity of either of the words INDIA or FUND apart from the mark as used." Reply brief p. 3, n. 4. Applicant has apparently made this statement in connection with its argument that seeking registration for CONTINUUM is not a mutilation of INDIA CONTINUUM FUND because INDIA and FUND have no source-indicating capability. We point out that, because the mark applicant seeks to register is CONTINUUM per se, the issue of whether a disclaimer of INDIA or FUND would be necessary is not before us.

This brings us to the substantive issue in this appeal. Trademark Rule 2.51(a) provides that, in an application 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 goods and/or services." As noted, it is the Examining Attorney's position that the drawing, which is for the word CONTINUUM, is not a substantially exact representation of the mark used in connection with the services, because the specimens depict the mark as INDIA CONTINUUM FUND. Because the words INDIA and FUND do not appear in the drawing, the Examining Attorney contends that CONTINUUM is a mutilation of the mark as used.

There is no dispute that the specimens show the word CONTINUUM preceded by the word INDIA and followed by the word FUND, and that all three words are shown in the same type size and font, in a manner that stands out from the other wording in the specimens. However, the question before us is whether CONTINUUM creates a separate commercial impression, and therefore would not be considered a mutilation, because the words INDIA and FUND do not indicate source. In this respect, of the various "mutilation" cases discussed by the Examining Attorney,¹ the present situation is most similar to that in *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989), in which the applicant sought to register TINEL-LOCK for "metal rings for attaching a cable shield to an adapter," and submitted as specimens of use of that mark a label with TRO6AI-TINEL-LOCK-RING. The Board found that the specimens supported use of the mark shown in the drawing. Specifically, the Board found that RING was a generic term, and that "[o]rdinarily, even if it is used with a trademark, the

¹ In her brief the Examining Attorney presented an extensive review of the case law involving "mutilated marks," a review that drew a compliment from applicant: "[A]pplicant's counsel sincerely thanks the Examining Attorney for the collection of cases that was contained in the Examining Attorney's Appeal Brief. It will be maintained in his files as the starting point for any future consideration of the interesting issue of trademark mutilation." Reply brief, p. 1.

generic name of a product need not be included as part of the words applicant seeks to register unless it forms a part of a unitary mark." Id. at 1400. As for the "TRO6AI" element shown in the specimen, the Board found this to be a model number, and that such an element "does not usually function as a source identifier." Id. As a result, the Board found that:

the alpha-numeric designation appearing on the specimen in front of "TINEL-LOCK" is not essential to the commercial impression of "TINEL-LOCK" as a trademark for applicant's metal rings. In a similar sense, the generic term "RING," although connected to the model number and the source-identifying term, "TINEL-LOCK," by a hyphen, nonetheless plays no integral role in forming the portion of applicant's mark which distinguishes applicant's goods from those of others.

Id. The Board held that neither the part number nor the generic term was essential to the commercial impression created by the mark as shown in the specimens, and therefore that the mark TINEL-LOCK in the drawing was not a mutilation of the mark shown in the specimens, and the specimens showed use of the mark depicted in the drawing.

In the present case, there is no question that FUND is a generic term for applicant's services; this has been acknowledged by both applicant and the Examining Attorney. Nor can the inclusion of this generic word be considered

part of a unitary phrase or mark. As noted in Raychem, supra, even the use of hyphens connecting the model number and generic term with the trademark did not result in TRO6AI-TINEL-LOCK-RING being considered a unitary mark.

As for the word INDIA, the Examining Attorney has acknowledged that this term is geographically descriptive, but contends that it is not generic and is capable of functioning as a trademark, that it "could acquire significance as a trademark." Brief, p. 8. However, the mere fact that a term is not generic does not mean that it has trademark significance, nor is that the determining factor in whether the omission of that term results in a mutilation of the mark as actually used. For example, the model number shown in the specimen in the Raychem case, discussed above, was not considered a generic term. Moreover, in *The Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992), the Court found, inter alia, that the mark CHABLIS WITH A TWIST was not a mutilation despite the fact that the specimen labels also included the word CALIFORNIA. Although not finding CALIFORNIA to be a generic term, the Court said "'California' is, moreover, a geographically descriptive word wholly devoid of trademark significance because it

cannot distinguish [the applicant's] product from others."
22 USPQ2d at 1197.²

Because the word INDIA in connection with applicant's identified services identifies the geographic region in which applicant invests, it has no trademark significance as it is used in applicant's specimens. "INDIA identifies the country in which this particular CONTINUUM FUND invests." Response filed May 8, 2007, p. 6. Consumers viewing the phrase INDIA CONTINUUM FUND as used in applicant's specimens would view INDIA not as a source-identifying element, but merely as the geographic location of the investments.

Accordingly, although the words INDIA and FUND appear in applicant's specimens in the same size and type style as the word CONTINUUM, because INDIA and FUND do not have trademark significance, the word CONTINUUM for which applicant seeks registration and which appears in the drawing of the application is not a mutilation of

² As the Examining Attorney has pointed out, there are factual differences between the Institut National case and the present situation, including the requirement of the Bureau of Alcohol, Firearms and Tobacco that the word CALIFORNIA appear on the wine labels. However, those differences do not affect the Court's finding that the applicant's mark shown in the drawing was not a mutilation because the word CALIFORNIA had no trademark significance, as opposed to being generic.

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applicant's mark, and applicant's specimens are acceptable to show use of the applied-for mark.

Decision: The refusal of registration is reversed.