

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

Mailed: March 14, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dayton Power and Light Company

Serial Nos. 77445394 and 77445395

B. Joseph Schaeff of the law firm Dinsmore & Shohl, LLP for Dayton Power and Light Company.

Corey Boone, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Quinn, Ritchie, and Lykos, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Dayton Power and Light Company ("applicant") filed an application to register the mark displayed below



for the following recitation of services, as amended:

"promoting consumer awareness in the field of renewable energy and promoting consumer use of renewable energy sources through incentive programs where customers can purchase renewable energy

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certificate-based services" in International Class 35.¹ The description of the mark is as follows:

The mark consists of the word "GREEN" displayed in the color green, above the word "CONNECT" displayed in the color blue. To the right of the wording, there is a stylized design of a blue electrical plug and two green leaves. Applicant does not claim the background as a feature of the mark.

Applicant made the following claim of color and color location statement:

The color(s) green and blue is/are claimed as a feature of the mark.

Applicant also applied to register the mark GREEN CONNECT, in standard character format, for the identical services noted above.²

The examining attorney refused registration of both marks under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's marks so resemble the registered marks GREEN CONNECTED, in standard character form,³ and the design mark displayed below,⁴

¹ Application Serial No. 77445394, filed April 10, 2008, alleging April 2008 as the date of first use anywhere and in commerce.

² Application Serial No. 77445395, filed April 10, 2008, alleging April 2008 as the date of first use anywhere and in commerce.

³ Registration No. 3491788, issued August 26, 2008, with a disclaimer of "GREEN."

⁴ Registration No. 3495197, issued November 20, 2007, with a disclaimer of "GREEN." The description of the mark is as follows: The mark consists of the design of a capital green "G" intertwined with a capital dark grey "C", with word "Green" in dark grey and the word



both owned by the same entity, Green Connected, LLC, that when used on or in connection with applicant's identified services, they are likely to cause confusion or mistake or to deceive. The cited registrations are for the same services: "promoting the goods and services of others who engage in and promote environmentally sound practices in the fields of environmentally sound practices and environmentally sound lifestyles, residential and commercial renovation, construction and repair, storage, packaging, transportation, and logistics by means of providing a website with hypertext links to the web sites of others" in International Class 35 and "computer services, namely, search engine services for users seeking information about goods and services of others that engage in and promote environmentally sound practices and environmentally sound lifestyles" in International Class 42.

The examining attorney has also refused registration of both applications under Trademark Act §§ 1 and 45, on the ground that the applicant's specimens fail to show the applied-for

"Connected" in green, with a green leaf at the edge of the word "Green." The color(s) green and dark grey is/are claimed as a feature

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marks used in direct connection with the sale or advertising of the recited services. See 15 U.S.C. §§ 1051, 1052, 1053 and 1127 and 37 CFR §§ 2.56 and 2.76(b)(2). In addition, the examining attorney has refused registration of Application Serial No. 77445394 for applicant's design mark on the ground that the mark in the drawing is not a substantially exact representation of the mark as used on the specimens. See 37 C.F.R. § 2.51(a).

Applicant has appealed the examining attorney's final refusals to register both applications. Both applicant and the examining attorney have filed briefs. Because the Board deemed the cases to have common questions of fact and of law, and the records are largely identical, the appeals were previously consolidated. For the reasons explained below, we (1) reverse the refusals to register both applications under Section 2(d); (2) reverse the refusals to register both applications on the ground that the applicant's specimens fail to show the applied-for mark used in direct connection with the sale or advertising of the recited services; and (3) reverse the examining attorney's refusal of registration of Application Serial No. 77445394 on the ground that the mark in the drawing is not a substantially exact representation of the mark on the specimens.

of the mark.

I. *Procedural History*

Before discussing the merits of the appeal, the Board is compelled to comment on the procedural history of these consolidated proceedings.

The ex parte appeals for both applications commenced on September 21, 2010.⁵ On April 15, 2011, applicant requested that the Board remand both applications back to the examining attorney for consideration of the mark in a third-party application which the Office had approved for publication for opposition, Application Serial No. 76704421. Shortly thereafter, on May 31, 2011, the third-party application at issue matured into Registration No. 3968197. The Board granted applicant's request on June 7, 2011, finding that because the evidence was not previously available, applicant had demonstrated the requisite good cause.⁶ In that order, the Board instructed the examining attorney as follows:

Accordingly, we remand the application to the examining attorney to consider the new evidence, but the examining attorney should address this evidence in

⁵ Concurrently therewith, applicant filed its first request for remand accompanied by a request for reconsideration. The examining attorney denied the request for reconsideration and proceedings in the ex parte appeals were then resumed. Both appeals were consolidated on February 18, 2011.

⁶ The June 7 order also vacated the Board's prior order dated May 27, 2011 because it addressed the request for remand in Application Serial No. 77445394 only, despite the fact that the appeals had been previously consolidated. Further, the May 27, 2011 order erroneously granted the request for remand on the basis that applicant sought consideration by the examining attorney of a consent agreement.

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a supplemental appeal brief, to be issued within 60 days of the mailing date of this order. In addition, the examining attorney may submit with the supplemental appeal brief evidence directed to applicant's newly submitted evidence.

June 7, 2011 Board Order, p. 2.

The examining attorney, instead of merely considering the newly issued third-party registration, also argued against the remand on the ground that this evidence was available prior to commencement of the appeal.

First, we note that the examining attorney misapprehends the nature of the evidence the Board found sufficient to justify remand. While the examining attorney focuses on the pendency of the third-party application for a long period of time before the applicant requested remand, the significant factor was not the mere filing of the application but that the Office had approved the mark in the application for publication for opposition. Evidence of the Office's approval of the application clearly was not available prior to commencement of the appeal. Second, it is improper for the examining attorney to question a remand order after remand is granted by the Board. In a recently issued precedential opinion, *In re Dist. of Columbia*, 101 USPQ2d 1588, 1591 (TTAB 2012), a similar situation arose. As the Board explained:

...the Board may grant an applicant's request for remand upon a showing of good cause **with or without the consent of the examining or managing attorney - or,**

indeed, over their objection. Once the Board granted applicant's request and remanded the file to the examining attorney for consideration of this evidence, the three third-party registrations which were the subject of the remand request became part of the record. (emphasis added)

The Board discourages unwarranted questioning of decisions made to remand applications. To the extent that the examining attorney in this case may have believed that it was necessary to "preserve" an objection to the evidence prior to discussing it in the supplemental appeal brief, such belief is in error. Section 710.01(c) of the TMEP, and Section 1207.03 of the TBMP, both cited by the examining attorney as requiring the preservation of an objection prior to discussion of evidence made of record after an appeal has been filed clearly do not apply in the case of a remand. No reasonable reading of either section provides support for the examining attorney's objection to consideration of the evidence the Board allowed to be added to the record on an appropriate showing by the applicant.

II. *Section 2(d) Refusals*

Now we will consider the refusals to register both the GREEN CONNECT design and word marks. We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*,

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315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted relevant argument or evidence.

A. *The Marks*

We first turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E.I. du Pont De Nemours & Co.*, 177 USPQ at 567. Each of these characteristics of a mark, if appropriate, must be considered. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). While "the similarity of the marks in regard to one of these factors can be critical to a finding of similarity ... the law does not counsel that similarity in one factor alone automatically results in a finding that the marks are similar." *Coach Services Inc. v. Triumph Learning*

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LLC, 96 USPQ2d 1600, 1609 (TTAB 2010), *aff'd in part, vacated in part and remanded on other grounds*, __ F.3d __ (Fed. Cir. Feb. 21, 2012), 101 USPQ2d 1713 (Fed. Cir. 2012).

Applicant's and registrant's marks both share the disclaimed term GREEN as well as the word CONNECT and formative thereof (CONNECTED). Nonetheless, we find that there are crucial differences regarding the sound, appearance, meaning and, most critically, commercial impression of the marks.

Registrant's design mark includes the prominently displayed letters "GC," matter which does not appear at all in either applicant's design or word mark. Conversely, applicant's design mark contains the depiction of an electrical plug, an element notably absent from both registered marks. Hence, the marks at issue do possess key differences in sound and appearance.

Furthermore, the commercial impression of the marks, when considered within the context of applicant's and registrant's respective services, engender quite distinct meanings. See *e.g.*, *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSSOVER for brassieres creates a different commercial impression from CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for shoes engenders a different commercial impression from PLAYERS for underwear). The term "GREEN" as used in connection with both applicant's and registrant's services has the similar

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connotation. It is, however, highly suggestive of an environmentally friendly significance, and the meaning is slightly different for each mark. The word "GREEN" as applied to registrant's services is defined as "concerned with or supporting environmentalism," whereas "GREEN" as used in connection with applicant's services means "tending to preserve environmental quality (as by being recyclable, biodegradable, or nonpolluting)".⁷ Moreover, the words CONNECT and CONNECTED, used respectively in applicant's and registrant's marks, each have a somewhat different significance when considered in relation to the identified services. "CONNECT" when used in relation to applicant's services means "to become joined."⁸ This meaning is reinforced in applicant's design mark by the depiction of the electrical plug. The pictorial representation conveys the image that consumers who purchase renewable energy certificates to meet their electricity needs will be "joining" or connecting to "green" power by purchasing renewable energy credits. By contrast, "CONNECTED" as applied to registrant's Internet website and search engine services means "having social,

⁷ We take judicial notice of this term, located at *Merriam-Webster Online*, www.merriam-webster.com. The Board may take judicial notice of dictionary definitions obtained through an Internet web site which exist in printed format. See e.g., *Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

⁸ We take judicial notice of the words "connect" and "connected," located at *Merriam-Webster Online*, www.merriam-webster.com.

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professional, or commercial relationships." Thus, GREEN CONNECTED as applied to registrant's services has the distinct commercial impression of a service which facilitates professional connections with environmentally friendly businesses and environmentally concerned customers.

The Board's reasoning in the case of *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977) presents an apt analogy. The Board determined that the mark BOTTOMS UP when used in connection with men's suits, coats and trousers creates a different commercial impression from BOTTOMS UP for women's underwear and, therefore, was not likely to cause confusion:

But more important, and especially in this case is the nature of the marks and the commercial impression that they project in connection with the respective goods. Thus, if "BOTTOMS UP" can be deemed to have any suggestive connotation as applied to men's suits, coats and trousers, it will be in association with the drinking phrase, "drink up!" ... This is hardly the connotation that "BOTTOMS UP" would generate as applied to applicant's ladies' and children's underwear.

The same rationale applies to this case with equal force. Thus, the differences in commercial impression of marks explained above weigh in favor of not finding a likelihood of confusion.

B. *Strength/Weakness of Marks*

We next consider the strength of registrant's marks and the number and nature of similar marks in use for similar services.

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Applicant argues that because registrant's marks are weak, they are entitled to a limited scope of protection.

Based on the dictionary definitions discussed above, the term green is merely descriptive and appears in both applicant's and registrant's marks. Applicant also points to the fact that both applicant and registrant disclaimed term GREEN in each mark. We find this to be probative to the extent it demonstrates that GREEN is a descriptive term to designate environmentally friendly goods or services and that a disclaimer was appropriate.

In further support of this argument, applicant has submitted the following third-party registrations:⁹

Registration No. 3690757 for the mark GREEN CONNECTIVITY for "electrical wires and cables and electrical connectors" in International Class 9, registered on the Supplemental Register;

Registration No. 3649560 for the mark GREEN STUFF CONNECTION and design for "retail store services featuring earth friendly clothing, home goods, accessories and personal care items" in International Class 35, registered on the Principal Register with a disclaimer of GREEN;

Registration No. 3768435 for the mark THE GREEN CONNECTION for various lawn and garden products and

⁹ During the ex parte prosecution of the involved applications, applicant submitted additional third-party registrations to purportedly show that registrant's mark is diluted or weak. Insofar as applicant did not discuss these registrations in its appeal brief, we decline to discuss those registrations at length in this opinion. Nonetheless, we have reviewed those third-party registrations, and found them to be of little or no probative value because the commercial impressions are so distinct (e.g., GREEN R, GREEN CORNER), they have no impact on the strength of registrant's marks.

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services, including "retail stores services featuring organic materials, namely, mulch, loam, sand, stones, wood chips and firewood" in International Class 35 and "material treatment services in connection with recycling" in International Class 40, registered on the Principal Register with a disclaimer of GREEN; and

Registration No. 3968197 for the mark GREENRIDE CONNECT for "providing on-line forums for transmission of messages among computer users concerning information about environmentally friendly transportation options, route alternatives, ride-sharing, car-pooling, public transportation, bicycling and walking" in International Class 38, registered on the Principal Register with a disclaimer of CONNECT.¹⁰

It is well established that third-party registrations are not evidence of use of the marks in the marketplace, and they do not show that the public is familiar with them. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Third-party registrations may be relevant, however, to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

¹⁰ Applicant discussed and submitted for the first time third-party Registration No. 3963916 for the mark G GREENRIDE CONNECT and design with its reply brief. This registration was not included in applicant's request for remand. In view thereof, we have given no consideration to this registration. *See* Trademark Rule 2.142(d).

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The registration for the mark GREENRIDE CONNECT has some probative value since it shows that the word CONNECT is used to identify computer services designed to connect users with a shared interest in environmentalism. That being said, it is only a single registration. The probative value of the remaining third-party registrations is limited because the goods and services are dissimilar to the registrant's services. See *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). See also *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99 (CCPA 1972).

In addition, applicant has submitted a sample of the results from the Google® search engine for the phrase "green connect" to show that registrant's mark is weak or diluted. This evidence, however, is also of limited probative value because there is insufficient information to show the context of each use of the phrase on the third-party websites. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007). See also *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006).

After carefully considering all of the evidence bearing on the strength of registrant's mark, we find that the record reflects that the term "GREEN" has a descriptive meaning when used in connection with services relating to or promoting environmentalism, thereby rendering the term inherently weak as

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a source indicator in the environmental field. Therefore we find this *du Pont* factor to weigh against finding a likelihood of confusion.

C. *Relatedness of the Services*

Next we consider the similarities or dissimilarities of the services. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's applications vis-à-vis the services identified in the cited registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). The examining attorney bears the burden of establishing a prima facie that a relationship between the goods exists though persuasive evidence. *See In re Princeton Tectonics Inc.*, 95 USPQ2d 1509, 1512 (TTAB 2010).

To show that the involved services are related, the examining attorney has not submitted any evidence such as third-party registrations or materials obtained from third-party websites to show that consumers would perceive applicant's and registrant's services as emanating from the same source. Instead the examining attorney relies primarily on the respective recitation of services of the involved applications and registrations. As the examining attorney contends:

The parties' services are closely related in their essential nature and purposes. Both parties' stated purpose concerns the focus on and adherence to

environmentally conscious business practices. The applicant, as a power company, places emphasis on the use of renewable energy, which serves to reduce impact on the environment by avoiding the use of non-renewable resources that merely deplete finite sources that are converted to energy power. Similarly, the registrant promotes environmentally conscious practices by promoting the goods and services of others that fulfill such eco-friendly principles. Thus, the underlying natures of the parties' services - promotion of practices that reduce negative environmental impact - are identical.

Examining Attorney's Brief (unnumbered page).

The examining attorney relies on evidence obtained from registrant's website to argue that registrant's website and search engine services may conceivably link to the website of energy companies like applicant. For example, the examining attorney points to the following links on registrant's web site: "Google's PowerMeter to Show Home Energy" "Oil Price Slump Challenge to Obama Energy," "Electric Cards Spur New Battery Industry," "Energy Efficiency Could Save American's \$," "Algae: The Next Biofuel Bet," "FedEx Plans Largest Rooftop Solar Install", and "Ecobee Smart Thermostat Controlled by iPhone." Office Action dated August 21, 2009. In addition, the examining attorney points to a link promoting "Home Energy Loss Professionals (H.E.L.P.)," who focus on assisting consumers on increasing energy efficiency in buildings. *See id.* The examining attorney also points to another link promoting a company that produces tree-shaped electronic devices for

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capturing light energy to convert it to electric power.

September 25, 2010 Request for Reconsideration, pp. 10-11.

Lastly, the examining attorney has introduced a link to another company that like the applicant employs renewable energy, specifically to operate residential and commercial HVAC systems.

The examining attorney also contends that consumers encountering the applicant's services may mistakenly believe that they are endorsed by the registrant. As the examining attorney explains:

The registrant's key business interest involves evaluating and vouching for products and services provided by others where they meet criteria for practices deemed to be environmentally sound. In essence, the registrant finds, "certifies", and posts information about companies that engage in environmentally-friendly practices. Since the applicant is one such company within the ambit of the registrant's concern, this scenario thus presents an opportunity for confusion as to the marks and mistake as to the potential endorsement between the parties, if not the source of the services.

Examining Attorney's Brief (unnumbered page).

Applicant, however, points out that the services it provides in its capacity as a public utility company consist of renewable energy credits. By contrast, registrant's services are an Internet web site and search engine that 'connect' environmentally conscious consumers with 'green' businesses.

We agree with applicant that while the prefatory language of the recitation is similar insofar as the services pertain to

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"green" services, this is where the similarity ends. "[T]o demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods." *In re W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007), citing *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690 (TTAB 1977); *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517 (TTAB 1975). See also *Calypso Technology, Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213 (TTAB 2011). Reading each recitation in its entirety, it is clear that the services are quite distinct. Applicant is a public utility and the service that applicant provides is an incentive program whereby consumers can buy renewable energy credits (RECs). Registrant, by contrast, provides an online directory listing for companies that sell environmentally friendly products and services. Our conclusion is confirmed by registrant's specimens of record: "GreenConnected offers an online business profiling community to connect with companies who provide or use Green products or services." Office Action Response dated January 28, 2009.

The examining attorney concedes that applicant and registrant are not competitors. While we acknowledge that the recitation of registrant's website and search engine services is sufficiently broad as to encompass services retrieved from the green energy field, and that the examining attorney has

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introduced minimal evidence confirming this, the examining attorney has not introduced any evidence that consumers would perceive applicant's and registrant's marks as identifying services emanating from a common source.

We therefore conclude that the examining attorney has failed to establish a sufficient commercial relationship between applicant's and registrant's services so that, when rendered under the marks, consumers are likely to be confused as to source.

D. *Reverse Confusion*

The examining attorney also argues "reverse confusion" -- that is, consumers will be confused by the marks and will mistakenly view applicant, the junior user, as the source of registrant's services. In support thereof, the examining attorney relies on the assumption that because applicant has identified its services as "promoting consumer awareness in the field of renewable energy" and "promoting consumer use of renewable energy," the services in question are identical.

The Federal Circuit, our primary reviewing court, gives the following explanation of the concept of "reverse confusion:"

The term "reverse confusion" has been used to describe the situation where a significantly larger or prominent newcomer "saturates the market" with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. The junior user does not seek to benefit from the goodwill of the senior user; however, the

senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user.

The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. In considering likelihood of confusion as to the source of services that are not identical, or likelihood of confusion as to whether there is a relation between the source of the services, the extent of the registrant's and the newcomer's activities relating to the mark must be given weight appropriate to the circumstances.

In re Shell Oil Co., 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (citations omitted.)

The examining attorney has not submitted any evidence that applicant is a "significantly larger or prominent newcomer" who has "saturated the market" with GREEN CONNECT marks. Indeed, in an ex parte context, it would be difficult to establish these facts. Accordingly, the examining attorney's arguments concerning reverse confusion are unpersuasive.

E. *Summary*

To the extent that there are any other relevant *du Pont* factors, we treat them as neutral.

Because the marks have different connotations and commercial impressions when used in relation to the identified goods, and because the examining attorney has not demonstrated

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that the services are related, we conclude that applicant's marks are not likely to cause confusion with registrant's marks.

We emphasize that we have reached our determination that confusion is not likely based on the record before us. On a different record, such as might be adduced in an opposition proceeding, we might well come to a different conclusion.

III. *Specimen Refusals*

A. *Application Serial Nos. 77445394 and 77445395*

We will now discuss the trademark examining attorney's refusal to register both marks on the ground that applicant's specimens of record do not show the applied-for marks used in direct connection with the sale or advertising of the recited services. 15 U.S.C. §§ 1051, 1052, 1053 and 1127 and 37 CFR §§ 2.56 and 2.76(b)(2). For the reasons discussed herein, both refusals to register are reversed.

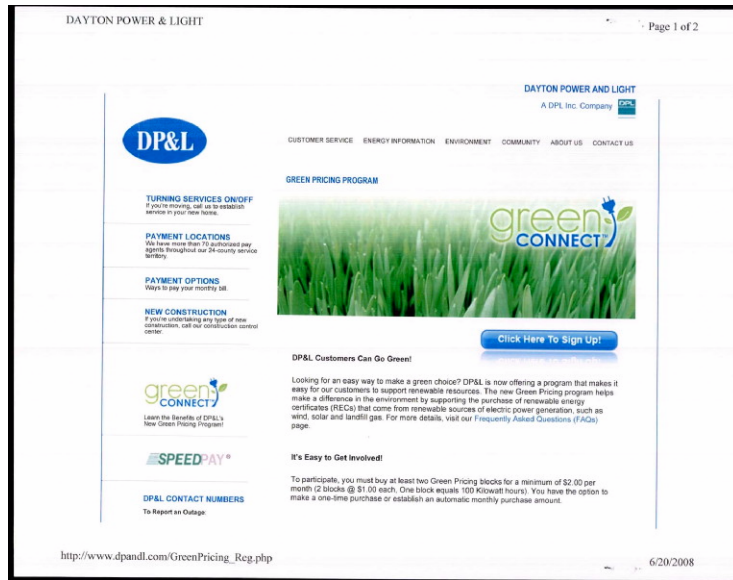
A service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." Trademark Act Section 45, 15 U.S.C. § 1127. Trademark Rule 2.56(a) provides, in part, that an application under section 1(a) of the Act, i.e., an application based on use in commerce, such as the

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applications at issue herein, must include one specimen showing the mark as used on or in connection with the sale or advertising of the services in commerce. Trademark Rule 2.56(b)(2) further specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." When used in advertising services, the service mark must not merely appear in the advertising material that also discusses or offers the services, but must be associated with the services in such a manner as would be sufficient to indicate to potential purchasers or users of the services that the mark identifies the services and their source. *See In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) ("The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor."). *See also In re Moody's Investors Service Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989) (requirement is for "a direct association between the mark sought to be registered and the services specified in the application, i.e., that [the mark] be used in such a manner that it would be readily perceived as identifying such services").

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In both applications, applicant submitted the identical specimen with its amendment to allege use.¹¹ The specimen consists of a printout from applicant's website and is displayed below:



The examining attorney takes the position that both applicant's word and design marks "appear in framed-off portions of the page, distanced from the explanation of the services." Examining Attorney's Brief (unnumbered page). In addition, the examining attorney maintains that the term "Green Pricing" is "used more prominently, consistently, and directly" than applicant's applied-for GREEN CONNECT marks to advertise

¹¹ During ex parte examination, applicant also submitted substitute specimens. We focus our analysis, however, solely on the specimen submitted with applicant's amendment to allege use because this presents applicant's strongest case.

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the services. *Id.* Applicant, on the other hand, contends that its GREEN CONNECT marks appear in "highly stylized fashion" on the web page, and that the designation "Green Pricing Program" appears in non-distinctive lettering in a less prominent manner than applicant's GREEN CONNECT marks. Applicant's Brief, p. 2.

In our view, the proximity of both applicant's word and design marks to the description of applicant's services is more than sufficient here to establish the necessary association between the marks and the services. In this regard, we note that applicant's applied-for mark prominently appears twice on the specimen of record: once on the left hand side of the web page and second on the upper right hand corner. On the web page, in close proximity to both marks is a detailed description of applicant's services:

Looking for an easy way to make a green choice? DP&L is now offering a program that makes it easy for our customers to support renewable resources. The new Green Pricing program helps make a difference in the environment by supporting the purchase of renewable energy certificates (RECs) that come from renewable sources of electric power generation, such as wind, solar and landfill gas.

We disagree with the examining attorney's assertion that the phrase "Green Pricing" more directly advertises applicant's services. Products or services may bear multiple marks. 1 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:2 (4th ed. 2010). It is clear from the description of the services

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on the specimen that applicant's GREEN CONNECT marks function as a source indicator for applicant's identified services. This determination is reinforced by the relative prominence of the GREEN CONNECT mark, as well as the position of the "button" below applicant's GREEN CONNECT mark enabling consumers to purchase applicant's identified renewable energy credits. Thus, prospective consumers will readily perceive the GREEN CONNECT marks as advertising applicant's identified services.

Accordingly, we conclude that applicant's specimens of record are acceptable for both applications on this basis.

B. *Application Serial No. 77445394*

The examining attorney has also refused registration of applicant's GREEN CONNECT design mark on a second ground, namely that the mark as it appears on the drawing is not a substantially exact representation of the mark on the specimen. See 37 C.F.R. § 2.51(a). The examining attorney argues that while applicant's design mark "features a light but discernible, greenish rectangular background," both displays of the mark on applicant's specimen fail to include the same background. Examining Attorney's Brief (unnumbered page). More specifically, the examining attorney contends that the smaller display of the mark on the specimens appears to have no background, and that the background for the larger display is

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either "transparent or filled with the grass images" as opposed to a "plain greenish rectangle." *Id.*

The "drawing depicts the mark sought to be registered." 37 CFR § 2.52. "In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, 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." 37 CFR § 2.51(b). "The regulation's term 'substantially' permits some inconsequential variation from the 'exact representation' standard." *In re Hacot-Columbier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997).

We find that this is an instance where there exists a minor, "inconsequential variation" between the mark as it appears on the drawing page and in the specimen. *See id.* During the course of ex parte prosecution, applicant amended its description of the mark to specifically exclude the "greenish rectangular background" as a feature of the mark. Office Action Response dated January 28, 2009, p. 1. The matter in question is merely a background color or carrier, as opposed to wording,

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stylized lettering, a design or pictorial representation. The background has no distinctive or source-indicating function, and it has no effect on the commercial impression of applicant's mark. As such, it was unnecessary for the examining attorney to require applicant to either (1) amend the drawing to remove the background, (2) submit a substitute specimen conforming with the drawing, (3) or amend the basis of the application to Section 1(b). See Office Action dated February 13, 2009.

Accordingly, the refusal to register is reversed.

DECISION: For the reasons explained below, we (1) reverse the refusals to register both applications under Section 2(d); (2) reverse the refusals to register both applications on the ground that the applicant's specimens fail to show the applied-for mark used in direct connection with the sale or advertising of the recited services; and (3) reverse the examining attorney's refusal of registration of Application Serial No. 77445394 on the ground that the mark in the drawing is not a substantially exact representation of the mark on the specimens.