

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

Mailed: September 30, 2010
JST

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AHL, Inc.

Serial No. 77741878

Robert C. Lyne, Jr. of Thompson McMullen for AHL, Inc.

Christopher L. Buongiorno, Trademark Examining Attorney,
Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Hairston, Cataldo and Taylor, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

AHL, Inc. has filed an application to register on the
Principal Register the mark HOME STATE (in standard
character form) for goods identified as "firearms" in
International Class 13.¹

Because there appears to be some confusion as to the
issue on appeal, a brief review of the relevant procedural
history is in order. The examining attorney originally

¹ Application Serial No. 77741878, filed May 21, 2009, and
asserting a bona fide intention to use the mark in commerce.

rejected the specimen accompanying applicant's application on two different grounds; the first being that it did not show use of the mark in commerce in connection with the goods, and the second, that the mark in the drawing was not a substantially exact representation of the mark as used on the specimen. The examining attorney required submission of a substitute specimen properly showing the mark as it appears in the drawing page and as used in connection with the goods. Applicant also was advised that it could not substitute an amended drawing to conform to the display of the mark on the specimen because the character of the mark would be materially altered. The requirement for a substitute specimen was made final. With its second request for reconsideration, applicant submitted its current specimen, which was accepted as an appropriate type of specimen. However, the examining attorney maintained the requirement, previously made final, for a substitute specimen because the mark in the drawing is not a substantially exact representation of the mark as used on the specimens as required by Trademark Rule 2.51.

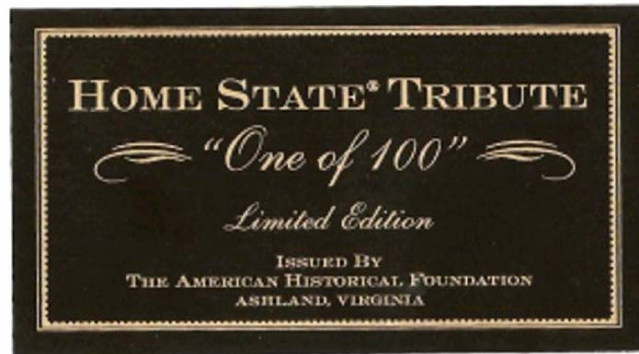
Accordingly, the sole issue on appeal is whether the mark in the application is a substantially exact representation of the mark as used on the specimens.

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The specimen of use ultimately accepted is reproduced below:



For ease of reading, we have reproduced below that part of the specimen showing the mark as it is applied to the goods:



It is the examining attorney's contention that the mark used on the specimen is HOME STATE TRIBUTE and not the mark in the drawing HOME STATE. The examining attorney particularly argues that "[a]pplicant is attempting to register the wording HOME STATE for firearms. However, there are no instances where the wording appears by itself on the specimens as a separate mark." Ex. atty. br.

unnumbered p. 3. The examining attorney further argues that as depicted on the specimen, "[t]he wording HOME STATE does not create a separate and distinct commercial impression." Ex. atty. br. unnumbered p. 6.

Applicant, in urging reversal of the refusal, contends:

The Examining Attorney has not stated any ground for a proper objection. There is nothing wrong with the mark's appearing "in conjunction with the term TRIBUTE", and there is nothing wrong with HOME STATE TRIBUTE'S having a "commercial impression." Neither prevents the mark on the drawing, HOME STATE, from being a "substantially exact representation of the mark on the specimen".

It is Applicant's position that the specimens do show the mark HOME STATE and thus the drawing is a substantially exact representation of the mark. The addition of the word TRIBUTE does not change this, in the absence of "mutilation" (i.e., "incomplete representation of mark") proscribed by TMEP 807.12(d) and/or relevant case law.
Applicant's br. p. 3.

Applicant also points out that the examining attorney has never stated that HOME STATE on the specimen fails to create a separate and distinct commercial impression, but nonetheless argues that it "believes that HOME STATE creates a separate and distinct commercial impression," although it contends that "it is not clear what relevance that belief has in this case outside the realm of mutilation."

Initially, we reject applicant's argument that "[t]he question [at issue] is whether an element of [its] composite mark is also a proper trademark." Reply br. p. 1. To be clear, the issue is not whether the mark depicted in the drawing page is a proper one, however it is construed. The question is only whether the mark on the drawing appears as the same mark, or substantially so, on the specimen.²

With this in mind, we consider the merits. Trademark Rule 2.51(b) provides that "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods..." It is well settled that an applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. See *Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); and *In re Chemical Dynamics Inc.*, 939

² We note additionally that while the examining attorney did not couch his refusal in terms of "mutilation" or "failure to create a distinct commercial impression," he nonetheless made clear that the issue involved in this case is whether the mark in the drawing is a substantially exact representation of the mark as used on the specimen.

F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). If the portion of the mark sought to be registered does not create a separate and distinct commercial impression, the result is an impermissible mutilation of the mark as used. As noted by our primary reviewing Court, the issue of mutilation "all 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." Chemical Dynamics, 5 USPQ2d at 1829, quoting 1 J.T. McCarthy, Trademark and Unfair Competition 909 (2d ed. 1984). We must decide each case on the unique fact of the particular case. In re Pharmavite LLC, 91 USPQ2d 1778, 1781 (TTAB 2009).

We agree with the examining attorney that the words HOME STATE do not create a separate commercial impression apart from the wording HOME STATE TRIBUTE as displayed on the specimen. Visually, all of the words are displayed on the same line and in the same font style, with the first letter in each word presented in upper case letters and the remaining letters of each word in smaller upper case letters. In addition, the only physical separation between the words HOME STATE and the word TRIBUTE is the placement

of the registration symbol after the word STATE.³ Given its much smaller-sized lettering, it is unlikely to be noticed and, even if it is, it fails to conceptually separate the wording.

In addition, we do not believe that consumers will perceive the words HOME STATE and the word TRIBUTE as conceptually distinct. Given the syntax and structure of the phrase HOME STATE TRIBUTE, it is clear that the word "TRIBUTE" is modified by the words HOME STATE and that the commercial impression rendered by the wording HOME STATE TRIBUTE is not severable. This perception is bolstered by the specimen, wherein the additional text on the specimen states: "Presenting... Your HOME STATE TRIBUTE .45," "The American Historical Foundation's First Colt® .45 in Honor of Your Home State!" (emphasis supplied)

Accordingly, we find that HOME STATE does not create a separate and distinct commercial impression apart from the word TRIBUTE.

We note applicant's argument that consumers would not automatically think that the word TRIBUTE is part of the mark because it is a descriptive noun and find it

³ We acknowledge applicant's explanation that the registration symbol was inadvertently used instead of the "TM" designation. For purposes of this decision, we do not find the mistake material.

unavailing. When the word "tribute" is viewed in the context of applicant's goods as identified, i.e., firearms, its meaning is arbitrary. In considering whether a term is descriptive, we must consider the mark in relation to the goods and services identified in the application. Other meanings of the term in other contexts are not relevant. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

After careful consideration of all of the arguments made by applicant and the examining attorney, even the ones not addressed here, for the reason discussed above, we find that the mark shown in the drawing is not a substantially exact representation of the mark shown on the specimens.

Decision: The requirement for a substitute specimen is affirmed.