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Subject: U.S. TRADEMARK APPLICATION NO. 85260060 - MANCHESTER SUUM  
CUIQUE PLACET - V-227A - Request for Reconsideration Denied - Return to TTAB

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Files: 85260060.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 85260060

**MARK:** MANCHESTER SUUM CUIQUE PLACET



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** MANCHESTER CIGARETTE  
TOBACCO LIMITED

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

V-227A

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE: 7/31/2012**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated January 12, 2012, are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

**MARK IN DRAWING DOES NOT MATCH MARK IN SPECIMEN OF USE –  
FINAL MAINTAINED AND CONTINUED**

The mark on the specimen disagrees with the mark on the drawing. In this case, the specimen displays the mark as the words "SUUM CUIQUE PLACET" inside of a banner

design underneath a castle design. The word “MANCHESTER” appears underneath the design of the castle and banner and is separated by a significant amount of space. The word “MANCHESTER” creates a separate commercial impression from the words “SUM CUIQUE PLACET” because of the amount of space between the words. Furthermore, because the words “SUM CUIQUE PLACET” are integrated into the design of the castle and banner, they create a separate commercial impression from the word “MANCHESTER.” The drawing shows the mark as “MANCHESTER SUUM CUIQUE PLACET” as one mark with a unitary impression.

In the request for reconsideration, applicant argues in support of finding the drawing matching the specimen of use. Examiner finds the arguments unpersuasive and denies the request for reconsideration for the following reasons.

The Board has found that space between pieces in a composite mark can create two separate commercial impressions. In *In re Audi NSU Auto Union AG*, 197 U.S.P.Q. 649 (TTAB 1977), the Trademark Trial and Appeal Board considered the distance between the word Audi and a fox head design and the term Fox. There, as here, the issue was “whether ‘AUDI’, ‘FOX’ and design create one commercial impression, . . ., or two commercial impressions . . .” *In re Audi*, at 650. The court stated that “[e]verything depends on the specimens . . .” and went on to find that on Audi’s specimen, the trunk of a car, the distance was enough to “show the use of two discrete marks.” *In re Audi*, at 650. Other cases have gone on to show that a much shorter distance is needed to find that a specimen actually displays two separate commercial impressions and not one unitary impression, especially when part of the claimed unitary mark is in close proximity to another phrase or design. See *In re Jordan Industries*, 210 U.S.P.Q. 158 (TTAB 1980) (court found JORDAN and JIF-LOK not unitary as one mark was placed above the other is a colored box and the lower word (Jif-lok) was part of a phrase or expression). In the instant case, applicant’s mark as used on the specimen is separated by a significant amount of space that is underscored by the fact that the words “suum cuique placet” appear on the top hinged lid of the box and the word “Manchester” appears on the bottom of the box. Moreover, the words “suum cuique placet” are integrated into the castle and banner design which is analogous to the facts of *In re Jordan Industries*, where the words were part of a phrase. As a whole, the mark on the specimen creates two separate commercial impressions which color alone cannot rectify.

Applicant’s reliance on *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977) and *In re Anton/Bauer Inc.*, 7 SUPQ2d 1380, (TTAB 1988), for the proposition that the words “suum cuique placet” create a separate commercial impression from the castle and banner design, is misplaced. The issue in *Seabrook Foods, Inc.* and *In re Anton/Bauer Inc.* is whether background designs may be registered separately when they are used as part of a mark composed of background designs and words. The Court of Patent Appeals and the Board referenced McCarthy for the principle that a background design which is combined with words is registrable if it creates a commercial impression separate and apart from the words in the mark. If the background design is inherently distinctive, it may be registered without evidence that it is recognized as a trademark (i.e., without proof of secondary meaning); if it is not

inherently distinctive, such proof is essential. *In re E.J. Brach & Sons*, 256 F.2d 325, 327, 118 U.S.P.Q. 308, 310 (CCPA 1958). Applicant argues that because the castle and banner design is not a common and basic shape, it creates a separate commercial impression from the words “suum cuique placet.” The issue in the present instance is not whether the words “suum cuique placet” create a separate commercial impression from the castle and banner design but whether the words “Manchester suum cuique placet” create a unitary commercial impression. As specified in detail above, the words “Manchester” and “suum cuique placet” create separate commercial impressions as used on the specimen of use.

**FILE WILL BE RETURNED TO TTAB**

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

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