

This Opinion is not a
Precedent of the TTAB

Mailed: November 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

*In re The Cruising Club of America, Inc.
and Royal Bermuda Yacht Club*

—
Serial No. 88159868
—

Charles P. Bacall of Verrill Dana LLP, for The Cruising Club of America, Inc. and
Royal Bermuda Yacht Club.

Heather A. Sales, Trademark Examining Attorney, Law Office 130,
John Lincoski, Managing Attorney.

—
Before Lykos, Shaw and Heasley,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

The Cruising Club of America, Inc. and Royal Bermuda Yacht Club (“Applicants”)
sought registration on the Principal Register of the following mark:



for “Tote bags; briefcases,” in International Class 18, and “Clothing, namely, shirts, jackets, vests, caps being headwear, hats, shorts, ties, and scarves,” in International Class 25.¹ The mark description as filed reads: “The mark consists of crossed flags superimposed on a lighthouse; the left-hand side flag is a representation of an American flag, and the right-hand side flag is a representation of an [sic] Bermudan flag.” Color is not claimed as a feature of the mark.

The Trademark Examining Attorney refused registration of Applicants’ mark under Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b), on the ground that it includes representations of the official flags of the United States and Bermuda. To obviate the Section 2(b) refusal, Applicants submitted an amended drawing of the mark which deleted the flags:



Applicants also amended the mark description to conform to the amended drawing so as to read: “The mark consists of crossed flagpoles superimposed on a lighthouse.” The Examining Attorney maintained the Section 2(b) refusal, and (1) refused to accept the amended drawing under Trademark Rule 2.72, 37 C.F.R. § 2.72, on the ground that it is a material alteration of the mark as filed; (2) refused to accept the

¹ Application Serial No. 88159868, filed on October 18, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicants’ allegation of first use of the mark anywhere and in commerce at least as early as December 31, 1962.

amended mark description under Trademark Rule 2.37, 37 C.F.R. § 2.37, because it does not match the original mark as filed; and (3) refused registration under Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a), because the mark as shown on the specimens of record does not match the mark as shown in the amended drawing.

When the refusals were made final, Applicants appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and the appeal resumed. Both Applicants and the Examining Attorney filed briefs. The Examining Attorney withdrew the specimen refusal in her brief.²

Insofar as we reverse the refusal to accept the amended drawing and the requirement for an amended description, as discussed below, the Section 2(b) refusal is therefore mooted, and the application shall proceed with the drawing of the mark as amended.

I. Evidentiary Objection

The Examining Attorney objects to evidence, not previously introduced, that Applicants attached to their brief. In accordance with Trademark Rules of Practice, “[t]he record in the application should be complete prior to the filing of an appeal.” Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Accordingly, the objection is

² Examining Attorney’s Br., 9 TTABVUE 3. See TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1204.04(b) (Oct. 2018) (“If the flag is deleted from the drawing, the specimen that shows the flag is still acceptable.”). Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. See, e.g., *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

sustained, and we do not consider any of the attachments to Applicants' Brief as evidence in our decision.

II. Section 2(b) refusal

We begin with the Trademark Act Section 2(b) refusal to register Applicants' mark as originally filed. Applicants do not argue against the Section 2(b) refusal because, in their view, the amendment to the drawing voids the refusal, but in the interests of completeness and to inform the discussion on material alteration of the mark, we nevertheless address the refusal, which the examining attorney included as part of the final Office action.

Section 2(b) prohibits registration, on either the Principal or Supplemental Register, of a mark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” Section 2(b) is an absolute bar to registration of marks that contain flags and other governmental insignia, and reflects the sentiment that such flags and insignia are symbols of government authority and not marks. *In re Dist. of Columbia*, 101 USPQ2d 1588, 1597 n.14 (TTAB 2012), *aff'd sub nom In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013). A Section 2(b) refusal is appropriate “if the design would be perceived by the public as a flag, regardless of whether other matter appears with or on the flag.” *In re Family Emergency Room LLC*, 121 USPQ2d 1886, 1887-88 (TTAB 2017); *see also In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, *2 (TTAB 2020). Thus, for example, the fact that a flag may be shown waving or moving in a breeze will not obviate the refusal if the

design would be perceived by the public as a flag. *See Ala. Tourism Dep't*, 2020 USPQ2d 10485 at *5.

The Examining Attorney introduced excerpts from several reference works showing that the flags in Applicants' mark as filed are, in fact, the same as the official flags of the United States and Bermuda.³ Applicants do not argue otherwise. We find that the average member of the general public seeing the proposed mark as originally filed would perceive the mark's flags as the flags of the United States and Bermuda. The presence of the lighthouse design and the depiction of the flags as waving or moving do not change this likely perception. Accordingly, we find the mark as originally filed, when considered in its entirety, is prohibited under Section 2(b) because it includes a design consisting of or comprising simulations of the flags of the United States and Bermuda.

III. The Amended Drawing

In an effort to obviate the Section 2(b) refusal, Applicants filed an amended drawing of the mark that deletes the flags. Trademark Rule 2.72(a)(2), provides that in an application based on use of a mark in commerce under Section 1(a) of the Act, an applicant may amend the drawing of the mark if "[t]he proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with

³ *See* THE WORLD FACTBOOK, Office Action of November 8, 2018, at TSDR 2-3; graphicsmaps.com and britannica.com, Office Action of May 13, 2019, at TSDR 2-7.

the description or drawing of the mark filed with the original application.” 37 C.F.R. § 2.72(a)(2).

The test for determining whether a proposed amendment to a mark avoids constituting a material alteration has been articulated as follows: “The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.” *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (quoting *Visa Int’l Serv. Ass’n v. Life-Code Sys., Inc.*, 220 USPQ 740, 743-44 (TTAB 1983)). In other words, “the new and old forms of the mark must create essentially the same commercial impression.” *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000). (quoting *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988)); accord *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001) (“To avoid material alteration, the new form must create the impression of being essentially the same mark.”) (citations and internal quotation marks omitted); see also *In re Guitar Straps Online*, 103 USPQ2d 1745 (TTAB 2012) (holding the addition of a question mark after the words “GOT STRAPS” would alter the commercial impression or meaning of the mark).

Regarding the deletion of unregistrable matter in response to a Trademark Act Section 2(b) refusal, TMEP § 1204.04(b), “Deletion of § 2(b) Matter,” explains that a mark may be amended to delete the unregistrable matter under certain circumstances:

The deletion of the unregistrable § 2(b) matter, which no party can have trademark rights in, will not be considered

a material alteration if the matter is separable from the other elements in the mark, e.g., if the flag design is spatially separated from other matter in the mark or is used as a background for other words or designs. If the flag is deleted from the drawing, the specimen that shows the flag is still acceptable. . . .

No deletion is allowed if the flag design is integrated into the overall mark in such a way that deletion would significantly change the commercial impression of the mark.

An amendment to the drawing showing the outline of the flag design absent the interior material is not permitted. Amending the mark from a national, state, or municipal flag to a blank flag changes the commercial impression of how the mark is used, or intended to be used, in commerce.

“Although the [TMEP] does not have the force of law, it ‘sets forth the guidelines and procedures followed by the examining attorneys’” at the USPTO. *In re Int’l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999) (quoting *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1664 n.8 (Fed. Cir. 1994)). We hold that the guidelines regarding deletion of Section 2(b) matter, as set forth in the TMEP, are appropriate under the rules to consider in determining whether Applicants may amend their mark to delete the unregistrable matter, namely, the flags of the United States and Bermuda. We will apply those guidelines in our analysis of the acceptability of Applicants’ proposed amended drawing.

For reference, Applicants’ mark as originally filed and the amended drawing are shown below. The only difference between the marks is that the flags have been removed in the amended drawing. The crossed flagpoles and the lighthouse remain.



The Examining Attorney first argues that the amendment changes the mark’s commercial impression by removing the geographic association created by the flags:

[T]he amendment to the mark does **not** create the same commercial impression as the old mark form. The original drawing, containing prominent flags of the United States of America and Bermuda, affixed to flagpoles crisscrossed over a lighthouse design, provides the overall commercial impression to consumers that applicant’s [sic] goods relate to/derive from/or are the source of the goods that are affiliated with the United States of America and Bermuda. . . . Contrarily, the proposed amendment sans both of the flags provides the overall commercial impression to consumers of merely a crossed out lighthouse with zero geographic indicators.⁴

In response, Applicants argue that the Examining Attorney’s position “seems to undermine the very concept of an amended drawing as contemplated in TMEP § 1204.04(b).”⁵ That is, “[t]he TMEP language states that it is permissible to delete the ‘unregisterable § 2(b) material . . . if the matter is separable from the other elements in the mark,’ but the Examining Attorney apparently believes that doing so will inevitably constitute a ‘material alteration.’”⁶ Applicants argue the amended drawing should be accepted because “the proposed amended drawing removed only

⁴ Examining Attorney’s Br., 9 TTABVUE 6-7.

⁵ Applicants’ Br., p. 7, 7 TTABVUE 11.

⁶ *Id.*

unregisterable and unprotectable § 2(b) matter. It retains the ‘essence of the original mark.’ The ‘essence’ of the mark is the St. David’s Lighthouse[.]”⁷

The presence of a national flag invariably suggests some association between a particular country and the applied-for goods or services. This is the principle underlying the Section 2(b) prohibition: to prevent applicants, even governmental entities, from obtaining trademark rights in symbols of government authority. *City of Houston*, 108 USPQ2d at 1331. The Examining Attorney’s argument that deletion of the flags in Applicants’ mark changes the commercial impression of the marks—by removing the geographic association that the goods relate to, derive from, or are sourced from the United States and Bermuda—would nearly always bar the deletion of a flag as a material alteration after a Section 2(b) refusal. Such an inflexible outcome is contrary to TMEP § 1204.04(b), which permits the deletion of unregistrable flag representations in some circumstances.

To determine whether the flags in the mark are “separable from the other elements in the mark” as described in TMEP § 1204.04(b), we may consider the specimens of record filed with the application. *See In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1316 (TTAB 2011) (A determination of a mark’s commercial impression may look to applicant’s efforts to create a separate commercial

⁷ *Id.*

impression). Applicants' specimens of use for the goods in classes 18 and 25 show use of the mark in association with the Newport to Bermuda yacht race:⁸



⁸ Application of October 18, 2018, TSDR, pp. 4 and 8. Although these two specimens include the wording "Newport Bermuda Race" and the years 1998 or 2014, these elements need not be considered part of the applied-for mark. *See* TMEP § 807.12(d) "An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen, i.e., the element performs a trademark function in and of itself. *See also In re Univ. of Miami*, 123 USPQ2d 1075, 1079 (TTAB 2017) (finding that the depiction of the mark in the drawing as a personified ibis wearing a hat and sweater created a separate and distinct commercial impression from literal elements that appeared on the hat and sweater in the specimens of use and thus the mark drawing was a substantially exact representation of the mark as used).



Applicants' specimens also include several examples of the mark with club pennants in place of the American and Bermudan flags, or with American flags with

fewer than the standard number of stars and stripes.⁹ Another example shows the lighthouse design without any flags and flagpoles at all.¹⁰



⁹ *Id.* at 6, 7, and 9. Given that Applicants are yacht clubs that organize a race from Newport to Bermuda, we do not consider Applicants' mark to be a phantom mark inasmuch as Applicants' alternative use of the lighthouse design with club pennants does not constitute "so many potential combinations that the drawing would not give adequate constructive notice to third parties as to the nature of the mark[.]" TMEP § 1214.01.

¹⁰ We note that this particular specimen of use is not acceptable under 37 C.F.R. § 2.51 because, without the flags or flagpoles, it is not a substantially exact representation mark as filed or as amended, but it, and the scarf shown below, nevertheless shows the significance of the St. David's lighthouse in the applied-for mark.



These examples suggest that the lighthouse and crossed flagpole design has a commercial impression independent of the particular flags displayed. Indeed, the representation of the lighthouse without any flags suggests that the St. David's

Lighthouse is the heart of the mark's commercial impression. We agree with Applicants that "[t]he 'essence' of the mark is the St. David's Lighthouse[.]"¹¹

The Examining Attorney further argues that the flags in the mark as filed are not spatially separable as defined in TMEP § 1204.04(b) and, therefore, may not be deleted:

In Applicant's originally applied-for mark three of the four corners of both of the flag elements lay flush against the flagpoles; and notably on applicant's submitted specimens of record, the drawing of the mark is displayed with the flags laying completely flush/attached to the flagpoles. Further, both flags attached to the flagpoles are superimposed crisscrossing *on top* of the lighthouse acting to highlight the importance of the flags to consumers viewing the mark. Accordingly, the flags are not spatially separable from the either flagpoles or the lighthouse, and removing them is a material alteration.¹²

Regarding the "spatially separated" language in TMEP §1204.04(b), Applicants argue that "the deletion of the flags has no impact on the remaining elements of the mark"¹³ and the "'flag elements' in the Subject Application are clearly no less 'spatially separable' than in the example from TMEP § 1204.04(b)(i), illustrating when 'The Flag Design May Be Deleted If It Is A Separable Element[.]'"¹⁴

TMEP § 1204.04(b)(i) provides five examples of marks incorporating flags which purportedly may or may not be amended to delete the flags based on whether the deletion represents a material alteration of the mark. The following three examples

¹¹ Applicants' Br., p. 7, 7 TTABVUE 11.

¹² Examining Attorney's Br., 9 TTABVUE 9.

¹³ Applicants' Br., p. 8, 7 TTABVUE 12.

¹⁴ *Id.*

represent marks that may be amended to delete the flag design because it is a separable element:



The following two examples represent marks that may not be amended to delete the flag design because it is integrated into the overall design:



We do not find these examples to be particularly helpful in the present case inasmuch as Applicants' mark includes elements from both categories. That is, the lighthouse in Applicants' mark is a significant additional element, comparable to the coffee cup or doctor in the first group of marks. But the flags in Applicants' mark are on flagpoles, similar to those found in the latter group of marks. However, we are not bound by the TMEP's examples. See *Guitar Straps Online*, 103 USPQ2d at 1751 (Board "not bound by hypotheticals discussed in the TMEP"). Spatially, the flags in Applicants' mark are far more removed or distanced from the other mark element, i.e., the lighthouse, than are the flags in the three examples of permissible amendments. That is, the flags are spatially separated from the lighthouse by being positioned on either side. We agree with the Examining Attorney that the flagpoles

cross in front of the lighthouse, but we do not think this affects the prominence of flagpoles. The poles are small and the fact that they cross in front of the lighthouse is hardly noticeable, particularly since the poles and the corresponding portion of the lighthouse are light in color. As noted above, the flags themselves are not in front of the lighthouse, but instead are off to either side. In any event, Applicants are not seeking to delete the flagpoles which would be a greater alteration of the mark.

On the other hand, both of the examples representing marks that may not be amended have flagpoles, and even crossed flagpoles, combined with minor embellishments such as small torches, ribbons, and a small baseball cap. But in these marks the flags are the central element. Deleting the flags in these examples eviscerates the commercial impression of the marks. Simply put, the other matter in these marks is not as prominent as the flags, unlike the lighthouse in Applicants' mark.

Based upon the foregoing, we find that the amendment to the drawing to delete unregistrable matter under Trademark Act Section 2(b) is not a material alteration of the mark. In consequence thereof, Applicants' amended drawing is accepted and is the operative drawing in the application.

IV. Description of the mark

Because the amended drawing is not a material alteration of the mark as filed, the requirement under Trademark Rule 2.37 for a corrected description of the mark is reversed. The amended description of the mark is the operative description.

Decision: The refusal to accept Applicants' amended drawing and the requirement for an amended description of the mark are reversed. Applicants' amended drawing and amended description will be entered, thereby mooting the Section 2(b) refusal. The application will proceed with the drawing as amended.