

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 24, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re University of Louisville
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Serial No. 90182509
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Jack A. Wheat, Esq. of McBrayer PLLC,
For University of Louisville.

Inga Ervin, Trademark Examining Attorney, Law Office 111
Chris Doninger, Managing Attorney.

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Before Lykos, Lynch, and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

The University of Louisville (“Applicant”) seeks registration on the Principal Register of the mark THE VILLE (in standard characters) for

Education services in the nature of courses at the university level; Entertainment services in the nature of live musical and dramatic performances; Entertainment in the nature of competitions in the field of intercollegiate sports; Arranging and conducting educational conferences; Arranging, organizing, conducting, and hosting social entertainment events; Organization of exhibitions for cultural or educational purposes; Organizing and

arranging exhibitions for entertainment purposes, in International Class 41.¹

Registration has been refused under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, on the basis that the specimen does not show the applied-for mark in use in commerce.

After the Trademark Examining Attorney made the refusal final, Applicant appealed. The appeal is fully briefed. We affirm the refusal to register.

I. Discussion

Trademark Act Section 1(a)(1), 15 U.S.C. § 1051(a)(1), requires an applicant to submit a specimen of its mark as used. *See also* Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a) (“An application under section 1(a) of the Act . . . must [] include one specimen per class showing the mark as used on or in connection with the goods or services.”). An applicant is also required to submit a drawing, which “must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). The use of the term “substantially” allows for some inconsequential variations from the representation in the drawing. *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997) (“The regulation’s term ‘substantially’ permits some inconsequential variation from the ‘exact representation’ standard.”).

¹ Application Serial No. 90182509 was filed on September 15, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as 2002.

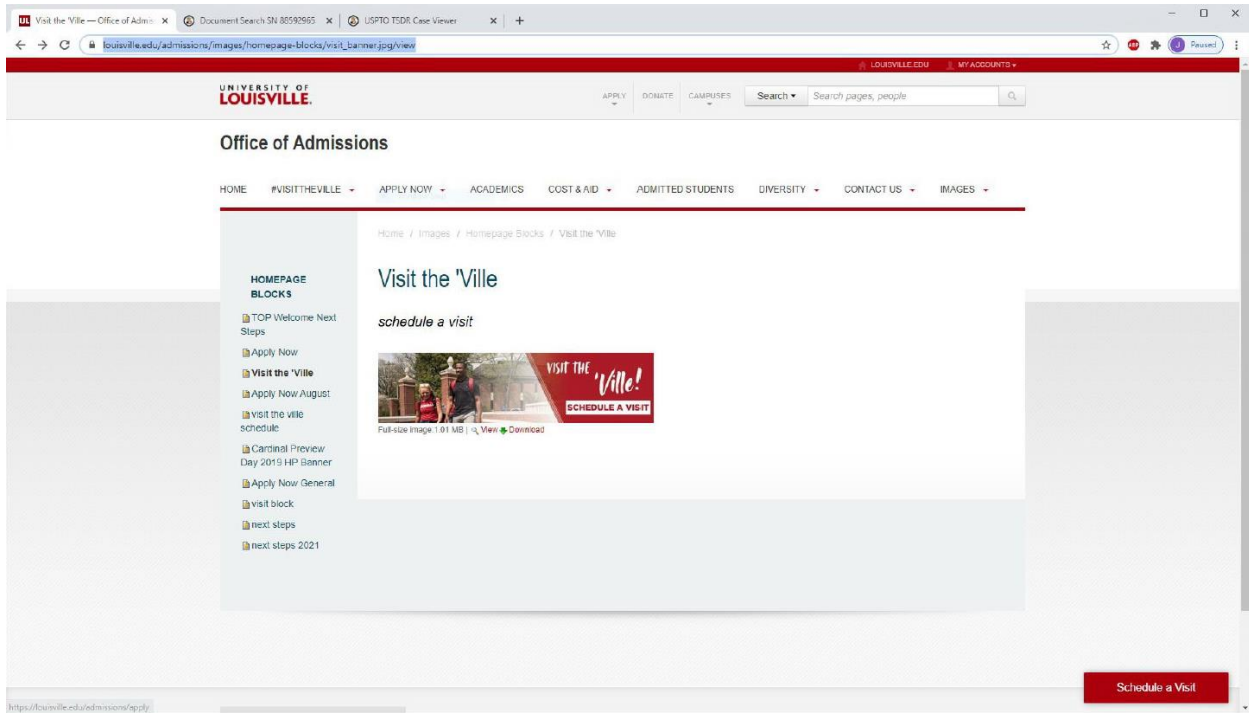
In the matter before us, the drawing depicts the mark as THE VILLE. The Examining Attorney refused to register the mark on the ground that the mark shown in the drawing does not agree with the mark in the specimen. In view of the differences between the mark sought to be registered and the mark shown in the specimen, the Examining Attorney required that Applicant submit a substitute specimen. However, Applicant maintained that the specimen was proper as-filed.

The sole issue before us whether the mark as it appears in the drawing in the application is a substantially exact representation of the mark on the specimen or if it is a mutilation thereof. *See* 37 C.F.R. § 2.51(a); TMEP § 807.12(a).

When the representation in a drawing does not constitute the complete mark, it is sometimes referred to as a “mutilation” of the mark. This term indicates that essential and integral subject matter is missing from the drawing. TMEP § 807.12(d). As noted by our primary reviewing court in *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988), 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.” *Id.* at 1829, quoting 1 J. T. McCarthy, MCCARTHY AND UNFAIR COMPETITION § 19:17 (2d ed. 1984).

Applicant’s specimen is shown below. The terms in the drawing, THE VILLE, appear on the specimen in various locations, but Applicant focuses its appeal on the use in the red field:²

² Applicant’s brief, p. 2 (4 TTABVUE 3).



As shown above, the phrase THE 'VILLE is shown together with the term VISIT. All of the terms VISIT THE 'VILLE and the exclamation point at the end appear above an icon which may be clicked to “Schedule a Visit”.

The specimen is a printout from the Office of Admissions page of Applicant’s website.³ Applicant contends that the commercial impression created by the specimen is the University’s nickname, namely, THE VILLE.⁴ The subject of the specimen is to invite potential students to THE VILLE.⁵ Applicant argues that, as the subject of the specimen is to promote the University in general to potential students, the added word “visit” does nothing to change the commercial impression, as the term VISIT is

³ Applicant’s brief, p. 2 (4 TTABVUE 3).

⁴ Applicant’s brief, p. 3 (4 TTABVUE 4).

⁵ Applicant’s brief, p. 3 (4 TTABVUE 4).

“totally non-distinctive”.⁶ According to Applicant, “[t]he very ‘commercial impression’ created by the specimen here is a reference to THE VILLE, the place, the locale, the institution, to where the potential students are invited to visit.”⁷

The Examining Attorney maintains that the specimen displays the mark VISIT THE ’VILLE, whereas in contrast, the drawing displays the mark as THE VILLE. Thus, the mark on the specimen does not agree with the mark in the drawing because the specimen (i) adds the word VISIT, and (ii) adds a leading apostrophe before the word VILLE. Accepting Applicant’s proposed focus on the presentation in the red field, the mark also includes an exclamation point after ’VILLE.⁸ Although the Examining Attorney concedes that leading apostrophe does not change the commercial impression,⁹ the same cannot be said for the word VISIT.¹⁰ Continuing, the Examining Attorney argues that, while it may be true that THE VILLE is abbreviated name of Applicant, the mark VISIT THE VILLE denotes an activity, i.e. to visit the university. Therefore, an invitation or command to visit a particular place, i.e., VISIT THE ’VILLE, creates a different commercial impression than simply naming the place itself, i.e., THE VILLE.¹¹ Contrary to Applicant’s argument, VISIT cannot be characterized as “nondistinctive” in this context. Moreover, the Examining

⁶ Applicant’s Reply brief, p. 3 (7 TTABVUE 4).

⁷ Applicant’s Reply brief, p. 2 (4 TTABVUE 3).

⁸ “[P]unctuation may play a part in the analysis of whether a phrase or slogan would be viewed as unitary.” TMEP § 1213.05(b)(ii).

⁹ Examining Attorney brief (6 TTABVUE 4).

¹⁰ Examining Attorney brief (6 TTABVUE 4).

¹¹ Examining Attorney brief (6 TTABVUE 4).

Attorney argues that, as VISIT was not part of the mark as-filed, this term was not searched for likelihood of confusion purposes. The Examining Attorney notes that, as a general rule, the addition of any element that would require a further search constitutes a material alteration of the mark.¹²

In this case, we find that the mark shown in the specimen is VISIT THE 'VILLE, and that these words are so merged together that the terms THE VILLE cannot be regarded as a separable element creating a separate and distinct commercial impression. Using Applicant's preferred focus on the red field in the specimen, the words VISIT THE 'VILLE! appear together. The words VISIT THE appear on the same line and in the same style and relatively smaller size font. The word 'VILLE! appears in a larger font below and slightly to the right, but in close proximity to the terms VISIT THE and, more importantly, completes the sentence started by VISIT THE. The use of the exclamation point reinforces the notion that the terms VISIT THE 'VILLE! should be read together to form an exhortation. While the webpage specimen also shows the wording in the mark as a heading, "Visit the 'Ville," and in various menu options such as "Visit the ville schedule," and "#VISITTHEVILLE," at no point does the specimen display the wording in the mark on its own, or as a separable element. Consequently, the drawing, which contains only the terms THE VILLE, constitutes a mutilation of the mark as depicted on the specimen. *See In re Semans*, 193 USPQ 727, 728-29 (TTAB 1976) (the mark KRAZY, displayed on the specimen on the same line and in the same script as the expression "MIXED-UP,"

¹² Examining Attorney brief (6 TTABVUE 4).

does not in itself function as a registrable trademark apart from the unitary phrase “KRAZY MIXED-UP” even though “MIXED-UP” was disclaimed); *see generally, In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1123-24 (TTAB 2008) (“Without the degree symbol, it is unclear what the ‘90’ in the drawing might refer to. However, when viewed on applicant’s specimens of use, the degree symbol in the mark would clearly be perceived as modifying the preceding number, making clear that its meaning is ‘ninety degrees,’ indicating that it refers to either an angle or a temperature. As such, the mark might possibly suggest to the potential purchaser that applicant’s sports clothing is made for playing in especially hot weather, or indeed that the mark refers to an angle, as applicant contends.”).

An applicant may seek to register any portion of a mark, if that portion presents a separate and distinct commercial impression. *In re 1175854 Ontario Ltd.*, 81 USPQ2d 1446, 1448 (TTAB 2006). Applicant has, in effect, applied to register only part of the mark shown in the specimen, but that portion, THE VILLE, does not create a separate commercial impression for the reasons discussed above.

Accordingly, under the circumstances in this case, we find that Applicant’s drawing of the mark is not a substantially exact representation of the mark as used in commerce. *See* Trademark Rule 2.51(a).

II. Decision

The refusal to register on the ground that the specimen does not evidence use of the mark in the application is affirmed.