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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **A. Ahlstrom Corporation**

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Serial No. 75/362,796

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**Robert A. Vanderhye of Nixon & Vanderhye P.C. for A. Ahlstrom Corporation.**

**Janice L. McMorrow**, Trademark Examining Attorney, Law Office 104 (**Sidney Moskowitz**, Managing Attorney).

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Before **Simms, Hanak and Drost**, Administrative Trademark Judges.

Opinion by **Simms**, Administrative Trademark Judge:

**A. Ahlstrom Corporation** (applicant), a corporation of Finland, has appealed from the final refusal of the Trademark Examining Attorney to register the asserted mark AHL for "machines and equipment for the pulp and paper industry, namely, agitators, mixers, digesters, thickeners, bleaching towers, presses, feeders, pulp screeners, pulp centrifugal cleaners, and replacement parts therefor."<sup>1</sup>

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<sup>1</sup> Application Serial No. 75/362,796, filed September 25, 1999, based upon applicant's bona fide intention to use the mark under

**Ser. No. 75,362,796**

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

It is the Examining Attorney's position that the mark shown on the drawing of this application -- AHL -- does not match the mark on the specimens filed with applicant's amendment to allege use, shown below.

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Section 1(b) of the Act, 15 USC § 1051(b). Applicant subsequently filed an amendment to allege use asserting first use "since about 1990."

The Examining Attorney contends that the mark on the drawing is an incomplete representation of the mark or marks shown on applicant's acceptable specimens of record, wherein these letters appear only as a part of unitary marks. Because these letters are assertedly an inseparable part of the marks AHLSTROM and AHLSORTER and do not project a separate and distinct commercial impression, it is the Examining Attorney's position that the mark sought to be registered is a "mutilation" of the mark or marks shown on the specimens of record. The Examining Attorney maintains that applicant may not register a non-separable component which is never used as a separate mark and does not have a separate and distinct commercial impression.

Furthermore, the Examining Attorney argues that the fact that applicant uses these letters as a prefix in a number of marks does not entitle applicant to register the prefix alone without proof that the prefix creates a separate commercial impression. While the Examining Attorney concedes that some of applicant's marks support its assertion that the letters AHL are used with descriptive or generic terms, the Examining Attorney argues that these unitary marks have separate and distinct commercial impressions such that these letters are inseparable, even when combined with descriptive or generic

matter. Because applicant has not submitted specimens showing the asserted mark AHL used in such a manner as to create a distinct and separable commercial impression, the Examining Attorney has made final her requirement for substitute specimens.<sup>2</sup>

Even with respect to the mark *AHLSelect* (shown below),

the Examining Attorney maintains that that mark is unitary as well. In addition to noting that the asserted mark *AHLSelect* is being used on promotional material not appropriate as trademark specimens, the Examining Attorney points to the fact that the italicized word "Select" is in similar size type on the same line and that this mark appears as one word because there is no space between the prefix AHL and the word "*Select*."

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<sup>2</sup> This is so, according to the Examining Attorney, because applicant cannot amend the drawing to conform to the display of

Applicant, on the other hand, argues that the letters AHL project a distinct commercial impression in its marks. Applicant points to the fact that AHL is a prefix which is "commonly" used with a descriptive or generic word.

Applicant's marks are just like there was a hyphen between the "AHL" and the other words, and because the other words are typically generic terms they are recognized as distinctly different from the "AHL".

Appeal brief, 3. Applicant has also argued that where there is a family of marks, the prefix (or suffix) is registrable even if that prefix is used with other elements. Applicant has in particular pointed to the AHLSelect mark which applicant contends would be viewed as two different marks because of the "vast differences" in type styles in this mark. Finally, applicant asks us to resolve any doubt in this case in its favor.

The issue in this case is whether the asserted mark as it appears on the drawing is a "mutilation," or an incomplete representation, of the mark actually used, as evidenced by the specimens submitted with applicant's amendment to allege use. In other words, does the mark on the drawing create a separate and distinct commercial

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the mark on the specimens. If that is done, the character of applicant's mark would be materially altered, she argues.

impression so that these letters are separately registrable?

Trademark Rule 2.51(a)(2) provides, in part, that "Once a statement of use ... has been filed, the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods[.]" The fact that two or more elements form a composite mark does not necessarily mean that those elements cannot be registered separately. In this regard, it is well established that an applicant may apply to register an element of a composite mark only if that element, as shown in the record, 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, for example, *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *Institut National des Appellations D'Origine v. Vintners International Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992); *In re Miller Sports Inc.*, 51 USPQ2d 1054 (TTAB 1999); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983); and *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969). See also Trademark Manual of Examining Procedure, Sections 807.14 and 807.14(b), and authorities discussed therein. Where

the mark shown on the specimens of record depicts a unitary mark which creates a single commercial impression, the attempt to separate part of that mark, as noted above, is termed a "mutilation" of the mark.

In determining whether the element sought to be registered creates a separate and distinct commercial impression, one must look to the specimens of record. *In re Audi NSU Auto Union AG*, 197 USPQ 649, 650 (TTAB 1977). The issue thus becomes whether the specimens of record establish use of the mark shown on the drawing of the application. This is necessarily a somewhat subjective determination based upon the impact of the asserted mark on potential purchasers. *See In re Wendy's International, Inc.*, 227 USPQ 884 (TTAB 1985).

Upon careful consideration of this record and the arguments of the attorneys, we conclude that the asserted mark AHL is not a substantially exact representation of the marks (AHLSTROM and AHLSORTER) used on the goods, as evidenced by the specimens of record. The specimens show use of these letters only as part of a unitary mark and do not show the asserted mark as it appears on the drawing. Because the asserted mark is always used in unitary marks, we cannot say that these letters alone create a separate and distinct impression such that they are separately

registrable as a trademark for applicant's goods. Therefore, the letters AHL shown in the drawing of the mark are a mutilation of the marks shown on the specimens of record. In order for applicant to register these letters, applicant must file specimens showing use of these letters *per se*, or at least demonstrating that this part of applicant's marks forms a separate and distinct commercial impression.

Applicant's argument that the specimens show use of these letters by themselves is unavailing. Nor is applicant's argument that its marks should be considered as if the letters AHL were separated from the remaining elements of its mark by a hyphen. Aside from the fact that this is not the way applicant's marks are portrayed on the specimens, this Office has long considered hyphenated marks to be unitary marks. See TMEP § 1213.04(b) and authority cited there.

Moreover, we have no evidence on which we could base a finding that these letters are separately recognized by consumers. *Cf. In re Chemical Dynamics, supra*, at 1830 (Vice president's conclusory statement that element of a mark created a distinct commercial impression held insufficient; absence of facts from which customer recognition could be inferred also held significant);

*Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 n. 8 (CCPA 1977) (In distinguishing another case, Court noted that the applicant in that case had used "look for" advertising to promote customer recognition); and *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1383 (TTAB 1988) (Applicant offered no evidence to show promotion of its background designs "in a way that would set those designs apart from the word mark for which they serve as background.").

Applicant's reliance upon the *Institut National des Appellations D'Origine* case is unavailing. Rather than omitting a geographically descriptive adjective which appeared on applicant's wine labels in smaller print and on a different line from the applied for mark, in the case before us the asserted mark comprises the initial letters of various word marks, all shown on the same line and in the same size type.

With respect to the *AHLSelect* mark shown on applicant's Selection Guide, we agree with the Examining Attorney that those brochures are merely advertising and do not suffice under Trademark Rule 2.56 as acceptable specimens of use. See *In re Bright of America*, 205 USPQ 63 (TTAB 1979); *In re Ultraflight*, 221 USPQ 903 (TTAB 1984); and TMEP §§ 905.05 and 905.07. Accordingly, while we agree

that even this showing does not support applicant's attempt to register the letters AHL by themselves, these brochures do not show proper trademark use.

Finally, we note that the Court of Appeals for the Federal Circuit has held that a mark with a "phantom" element is unregistrable. See *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999). In that case, the Court noted that under Section 22 of the Trademark Act, 15 USC § 1072, registration serves as constructive notice to the public of the registrant's ownership of the mark and thus precludes another user from claiming innocent misappropriation as a trademark infringement defense. To make constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce. The Court stated that "phantom" marks with missing elements encompass too many potential combinations and permutations to make a thorough and effective search possible and, therefore, the registration of these marks does not provide adequate notice to competitors and the public. *Id.* at 1367-68, 51 USPQ2d at 1517-18. Some may view applicant's proposed mark as one which contains a "phantom" element because the mark as used contains an element(s) that would not be revealed in any search of the register of the letters AHL. Thus,

registration of applicant's proposed mark may run counter to *International Flavors*.<sup>3</sup>

Decision: The refusal of registration is affirmed.

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<sup>3</sup> We also note our familiarity with *In re ECCS, Inc.*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996), *In re Dekra e.V.*, 44 USPQ2d 1693 (TTAB 1997), and recently amended Trademark Rule 2.72, but need not consider their applicability to this case.