

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: September 13, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re RCPI Landmark Properties, LLC

Serial No. 75516355

Kerry D. McIlroy of Milbank, Tweed, Hadley & McCoy LLP for
RCPI Landmark Properties, LLC.

Sharon A. Meier, Trademark Examining Attorney, Law Office
112 (Angela Wilson, Managing Attorney).

Before Drost, Cataldo and Taylor,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by RCPI Landmark Properties,
LLC to register the mark shown below on the Principal

Register for the following goods and services, as amended:

"metal key chains" in International Class 6;

"hand tools, namely, spoons made of precious metal" in
International Class 8;

"decorative magnets" in International Class 9;

"electric night lights" in International Class 11;

"ornamental pins" in International Class 14;

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"paper goods, namely, calendars, Christmas cards, gift cards, greeting cards, note cards, picture postcards" in International Class 16;

"picture frames" in International Class 20;

"house wares and glass, namely, beverage glassware, cups, coffee cups, mugs, glass mugs" in International Class 21;

"multi-purpose cloth bags" in International Class 22;

"clothing, namely, caps, sweat shirts, polo shirts, golf shirts, knit shirts, sports shirts, t-shirts, headgear" in International Class 25;

"Toys and playthings, namely manipulative puzzles, toy boxes, christmas tree ornaments, christmas tree decorations" in International Class 28;

"staple foods, namely, cookies" in International Class 30;

and "real estate services, namely leasing of office space; leasing of real property, leasing of shopping mall space, rental of office space" in International Class 36.¹



The trademark examining attorney initially required applicant to submit substitute specimens that show use of

¹ Application Serial No. 75516355 was filed July 9, 1998, based on applicant's assertion of a bona fide intent to use the mark in commerce. Applicant's description of the mark presently reads as follows: The mark consists of the depiction of the mythological figure Atlas holding an armillary sphere. In its subsequently filed Statement of Use, applicant asserted November 2003 as a date of first use of the mark anywhere, and December 2003 as a date of first use of the mark in commerce in connection with the goods and services.

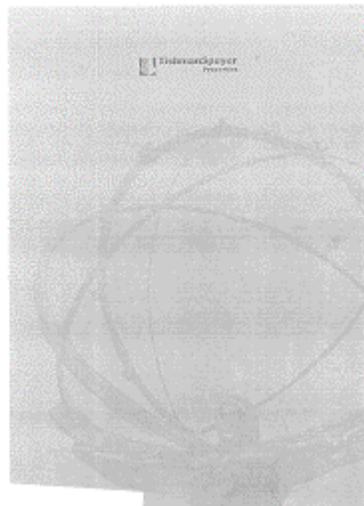
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the mark as it appears in the drawing. When the requirement was made final, applicant appealed. Applicant and the examining attorney filed main briefs on the issue under appeal.

The specimens submitted in connection with the Class 14 goods are reproduced below. These specimens are essentially identical to the specimens submitted in connection with the goods in all of the International Classes recited above:



The specimens submitted in connection with the services recited in International Class 36 are reproduced below:



Applicant argues that although it previously amended the description of its mark to a "three-dimensional depiction of the mythological figure of Atlas holding an armillary sphere," it should be allowed to amend the description of its mark back to a two-dimensional mark as noted above. Applicant further argues that such an amendment will not materially alter the character of its mark, but will result in the specimens agreeing with the mark as it appears in the drawing. Applicant contends that the "specimens contain the essence of the original mark and convey the same commercial impression" (brief, p. 8). Applicant further contends that the specimens for its goods are adhesive labels consisting of "a photograph of the famous three-dimensional 'Atlas' sculpture at Rockefeller Center, New York. The background of the photographic labels includes the surrounding buildings" (*Id*). Applicant contends in addition that the only difference between the drawing of the mark and the specimens is the presence of the buildings in the background of the latter, and that "such minute differences are not sufficient to amount to a material alteration" (*Id*). Applicant further asserts that "[t]he photographic labels do not contain any elements that distract, add or otherwise alter the central element of the mark, which is the Atlas statue" (brief, p. 9). As a

result, applicant asserts, "the specimens are consistent with the original drawing and description" of the mark (*Id*).²

The examining attorney maintains that the mark as shown in the specimens of record is not a substantially exact representation of the mark as it appears in the application drawing page. Specifically, the examining attorney contends that the specimens of record for the applied-for goods display the mark with the addition of the design element of a building. The examining attorney argues that, as a result, the "presentation of the mark in the drawing is an unacceptable mutilation of the applicant's mark because the applicant seeks registration of something less than the totality of its trademark as depicted in the specimens for the goods" (brief, p. 4). The examining attorney further argues that "[w]ith respect to the specimens for the services, the mark depicted on the specimen simply does not match the complete depiction of

² In addition, applicant states that "the mark has been in continuous use on goods in the above-referenced classes since November 2003. Thus, the mark is eligible for registration under Section 2(f) of the Trademark Act" (brief, p. 1-2). We note, however, that the issue of acquired distinctiveness of applicant's mark is not before us in this proceeding. As a result, applicant's statement to that effect will be given no further consideration.

the Atlas figure holding an armillary, it only depicts a portion of the mark" (*Id*).

The matter on appeal in this case concerns (1) the design of a building in the specimens for the goods that is not present in the drawing of the mark; and (2) the display in the specimen for the services of only a portion of the drawing of the mark. The question is whether the mark sought to be registered is a substantially exact representation of the mark as it appears on the specimens of use submitted in connection with the recited goods and services.

Display of the Mark on the Specimens for 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.*, 839 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. *See, e.g. In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

As noted by our primary reviewing Court in *Chemical Dynamics, supra* at 1829, quoting 1 J. T. McCarthy, *Trademarks and Unfair Competition* §19:17 (2d ed. 1984), 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."

We agree with the examining attorney that the mark as it appears on the specimens for applicant's goods consists of the design of a statue depicting an Atlas figure holding an armillary sphere in front of a building. We are not persuaded that the design of Atlas holding a sphere creates a commercial impression that is separate and distinct from the building design. *Cf. Institut National des Appellations D'Origine, supra*. That is to say, the design of the figure of Atlas holding a sphere does not comprise a trademark that is separate from the building design. Nor are we persuaded that because applicant's mark depicts the statue of Atlas in Rockefeller Center, New York, individuals encountering the specimens for its goods will recognize that its mark consists only of the Atlas figure and armillary sphere. On the contrary, individuals viewing

the specimens for applicant's goods will see that the mark consists of a statue of Atlas holding a sphere in front of a building. Finally, we are not persuaded by applicant's argument that the presence of the building design does not "distract, add or otherwise alter" the Atlas figure and sphere. The building design clearly adds an element to applicant's mark which alters its overall commercial impression.

The mark as it is displayed in applicant's drawing omits a salient feature of the mark as it is used by applicant on the specimens for its goods, namely, the building design. As a result, the drawing of the mark is an impermissible mutilation of the mark as used on or in connection with the goods. *See In re Miller Sports Inc, supra.*

Display of the Mark on the Specimen for the Services

The drawing of a mark in an application filed under Section 1(b) of the Trademark Act such as the one under consideration herein is governed by Trademark Rule 2.51(b), which provides as follows:

In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the

drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

See Trademark Rule 2.51. See also *In re Hacot-Columbier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997). In this case, the specimen filed by applicant with its statement of use in support of its services displays a portion of the Atlas figure as well as a portion of the armillary sphere comprising the mark as depicted in the drawing above. Specifically, the mark as it appears in the specimen displays the majority of the armillary sphere, but only the torso, arms and head of the Atlas figure. This contrasts sharply with the mark in the drawing which displays the entire armillary sphere as well as the entire Atlas figure standing atop a square column. Thus, it is readily apparent that the mark in applicant's service mark specimen displays only a portion of the mark as shown in the drawing.

We are not persuaded by applicant's assertion that the "specimens contain the essence of the original mark" (brief, p. 8). In this case, the service mark specimen displayed above contains approximately half of the applied-for mark. This is not a situation in which there exists some minor, inconsequential variation between the mark as it appears on the drawing page and in the service mark

specimen. See *In re Hacot-Columbier, supra*. Rather, the display of only half of the mark as shown in the drawing on the service mark specimen is a major, significant difference. As a result, we agree with the examining attorney that the mark shown on applicant's drawing is not a substantially exact representation of the mark as used on the service mark specimen.

Finally, we note that applicant requests leave to amend the description of its mark to indicate that it seeks registration of a two-dimensional mark. However, such an amendment will not overcome the differences between the mark as shown in applicant's drawing and in its specimens of use. In short, such an amendment will not resolve the issue under appeal. Accordingly, applicant's request to amend the description of its mark is moot and will be given no further consideration.

Summary

In view of the foregoing, we find that the mark shown in the drawing (1) is a mutilation of the mark as shown on applicant's specimens for its goods; and (2) is not a substantially exact representation of the mark shown on the specimen for its services.

Decision: The refusal to register on the ground that the mark in applicant's drawing does not match the mark as

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displayed on the specimens submitted with applicant's
statement of use is affirmed.