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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pennsylvania State Police

Serial No. 76087228

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Pennsylvania State Police.

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Before Simms, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

The Pennsylvania State Police [applicant], an agency
of the state of Pennsylvania, seeks to register the mark
set forth below for goods in six different classes:



The application was filed based on applicant's allegation of its intent to use the mark in commerce for the various goods.¹ After applicant and the examining attorney agreed to certain amendments, including a disclaimer of PENNSYLVANIA, the application was approved and the mark was published for opposition. A notice of allowance issued and applicant filed a statement of use alleging use of the mark for all the goods listed in the notice of allowance. The specimens included certain photographs of some of the goods and certain sales flyers or similar material, which include photographs of other goods.

Following review of the statement of use, the examining attorney refused registration of applicant's mark, on the ground that, as used, the proposed mark in fact functions only as ornamental matter. In addition, the examining attorney refused registration on the ground that the specimens of use do not show use of the mark in the drawing submitted with the application. Specifically, the specimens show use of the mark with the word TROOPER just

¹ The goods are "metal key chains," in Class 6; "watches," in Class 14; "collectable trading card sets," in Class 16; "drinking glasses, shot glasses, mugs, coffee cups, travel mugs, commemorative and collectable plates," in Class 21; "hats, jackets, shirts, shorts, sweatshirts, sweatpants," in Class 25; and "miniature model vehicles, sports balls, and Christmas tree ornaments," in Class 28.

below the eight-pointed crest design in the middle of the mark. In regard to the latter ground for refusal, the examining attorney also noted that applicant could not amend the drawing to add the word TROOPER, because that would result in an impermissible material alteration of the mark as applied for.

The application was reassigned to a new examining attorney who withdrew the ornamentation refusal but repeated and made final the specimen refusal. The new examining attorney reiterated that applicant could not amend the mark to add the word TROOPER² and could overcome this refusal only by submitting appropriate substitute specimens, i.e., specimens showing use of the mark devoid of the word TROOPER.

A notice of appeal was filed and applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing. We affirm the refusal.

The examining attorney argues that the mark shown in an application based on use of the mark in commerce must be a "substantially exact representation of the mark as used on or in connection with the goods or services, as shown by

² Applicant did not at any time offer to add the word TROOPER to the mark and, therefore, the question whether it could do so is not an issue for this appeal.

the specimens," citing as support therefore 37 C.F.R. §§ 2.51(a)(1) and 2.51(b)(1). Brief, unnumbered p. 3. While acknowledging that an "element of a composite mark... may be [separately] registrable... if that element presents a separate and distinct commercial impression," the examining attorney contends that the mark in the application drawing is an incomplete mark because it is missing essential and integral subject matter that appears in the mark on the specimens. *Id.* Finally, the examining attorney argues that all of the exhibits submitted by the applicant to overcome the ornamentation refusal show use of the mark with the words PENNSYLVANIA STATE POLICE TROOPER and that applicant "has not presented any evidence that PENNSYLVANIA STATE POLICE (and design) is used separate from the word TROOPER, as to create its own distinct impression in the minds of consumers." Brief, unnumbered p. 4.

Applicant argues that the mark shown in the application drawing "is depicted in unaltered form in the specimens" and "was not extended, enlarged, lengthened, or otherwise modified to permit inclusion of the word 'TROOPER.'" Brief, p. 3. Applicant also asserts that specimens need not exactly match the drawing of the mark and, looking at the question from the other side, argues

that the drawing need only be a substantially exact representation of the mark shown by the specimens. *Id.*

Applicant's explanation of the absence of the word TROOPER from the mark in the application drawing is that TROOPER is not a part of the mark to be registered because it "is essentially a grade or rank designation included within the field of the mark for informational purposes." Brief, pp. 3-4.³ Further, applicant argues that the "entire and exact" mark in the drawing is illustrated in the specimens, none of the elements of the mark in the drawing are missing in the mark shown by the specimens, and the addition of the word TROOPER, "for informational purposes," does not materially alter the commercial impression created by the mark in the drawing. Brief, p. 4.

Applicant does not explicitly state, either by declaration of its counsel or any officer, that the patches and emblems on the state police uniforms, cruisers, report covers, etc. sometimes include the word TROOPER, but in other instances will include other designations of rank, e.g., CAPTAIN, LIEUTENANT, or the like. In fact, following

³ Applicant further explains, at pp. 8-9 of its brief: "Typically, Applicant's mark is worn as an embroidered patch on the clothing of its law enforcement officers. ... When Applicant's mark is utilized on certain of the clothing [items] recited in the present application, the embroidered patch, with the informational term 'TROOPER' or some other term, is typically sewn onto the piece of clothing."

a thorough review of the 28 exhibits submitted to overcome the ornamentation refusal, we have found only two instances where some term other than TROOPER appears in applicant's mark. Specifically, on pages 30 and 31 of exhibit 27, showing a child's t-shirt and a child's sweatshirt, respectively, the words JUNIOR TROOPER appear in place of the word TROOPER. Moreover, there are numerous exhibits which show officers of applicant, including Commissioner Paul J. Evanko, Captain Jeffrey R. Davis, Lieutenant Colonels Thomas K. Coury and Joseph H. Westcott, Sergeant John F. Ferraro and Corporal James F. Rottmund, wearing a patch on their uniforms, with each patch including the word TROOPER rather than the officer's actual rank.⁴

In addition, there are numerous examples among the exhibits, where the PENNSYLVANIA STATE POLICE TROOPER patch or shield design [TROOPER emblem] is used on items other than on uniforms or on the collateral merchandise items listed in the identification of the involved application. For example, exhibits 1-4 are annual reports, each of which includes a frontispiece displaying the TROOPER emblem and the Pennsylvania State Police's "Call to Honor"; exhibits 6, 7 and 13-15 are recruitment brochures or posters that

⁴ Other exhibits show photographs of unidentified individuals whose uniforms carry insignia of officers, but "trooper" patches.

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all display the TROOPER emblem; numerous exhibits show the TROOPER emblem on state police cruisers, helicopters and other vehicles; and the TROOPER emblem is on the letterhead of the Office of Chief Counsel for the Pennsylvania State Police and on the Pennsylvania State Police web site.

Still other exhibits illustrate uses of the TROOPER emblem that actually stress the term TROOPER, for example, helicopters (both real ones and toys) not only bear the emblem, but also bear the word TROOPERS in large lettering; the Pennsylvania State Police sell stuffed bears called TROOPBEARS, which clearly calls to mind and focuses on the term TROOPER; and a child-sized "Trooper" robot apparently used in community service activities is named "Trooper B. Smart."

In short, there is no evidence to support applicant's inference that TROOPER is replaced on certain patches or emblems used by the Pennsylvania State Police with other designations of rank. Moreover, many uses of the TROOPER emblem reinforce public recognition of the term TROOPER as an integral term in defining the public image of the Pennsylvania State Police. Accordingly, we agree with the examining attorney that TROOPER is a significant element of the mark shown on the specimens and contributes to the

overall commercial impression created by the PENNSYLVANIA STATE POLICE TROOPER emblem.

Applicant and the examining attorney have made reference to certain prior decisions of this Board and of our principal reviewing court and its predecessor, to support their respective arguments. We find each of the cases on which applicant relies to be distinguishable on its facts.

We consider first two decisions of the Court of Customs and Patent Appeals, predecessor of the Court of Appeals for the Federal Circuit. In the pre-Lanham Act decision of *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (CCPA 1950), the CCPA reversed a decision by the Commissioner of Patents refusing applicant's attempt to register SERVEL alone as a mark for a biweekly periodical for employees of applicant, because the publication was published under the title SERVEL INKLINGS. However, the court specifically noted that SERVEL was the applicant's primary and technical trademark and, over the course of 25 years, had itself been registered in ten different classes in the Patent Office for use on a wide variety of articles. In addition, the applicant had submitted specimens showing use of SERVEL as the common term in each of various other marks for publications, specifically, THE SERVEL SALESMAN,

SERVEL NEWS, and SERVEL REFRIGOGRAMS. In the case at hand, we do not have any evidence that the PENNSYLVANIA STATE POLICE emblem, sans the word TROOPER, is the primary or technical mark of applicant and in widespread use; nor is there evidence supporting applicant's inference that the emblem is used with other words taking the place of TROOPER.

In another CCPA case, *In re Schenectady Varnish Co., Inc.*, 280 F.2d 169, 126 USPQ 395 (CCPA 1960), the applicant sought registration of a cloud and lightning flash design for "synthetic resins," but was found by the Board to have always used the word SCHENECTADY in large letters overlaid onto the cloud and lightning flash design, for such goods. Thus, the Board concluded that the design was mere background and could not be separately registered. The CCPA, however, noted that the mark had already been registered for other goods and there was evidence that the design had acquired distinctiveness.⁵ The case at hand is unlike *Schenectady Varnish*, in that applicant is not seeking to register its entire design without the words overlaid onto it, but is seeking to register its entire

⁵ The CCPA stated that it did not need to determine whether the cloud and lightning flash design was inherently distinctive, because of the evidence of acquired distinctiveness.

design and only some of the words used in conjunction therewith. Nor is there a question in this case regarding whether the design element of applicant's composite mark is distinctive in its own right.

The case of *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988), relied on by the examining attorney to support the refusal in this case, is in harmony with the *Schenectady Varnish* decision. In *Chemical Dynamics*, the Federal Circuit affirmed the Board's refusal to allow applicant to register the portion of its composite word and design mark that consisted of a medicine dropper and droplet. In the composite mark, the dropper and droplet were suspended over a watering can, with the dropper intersecting the handle of the can. The term 7 DROPS appeared on the side of the can. The Federal Circuit affirmed the Board's holding that the dropper and droplet design were not separable from the watering can design and the composite could not, therefore, provide support for an application to register the dropper and droplet alone. Significantly, the decision explains that the applicant had already obtained separate registrations for the wording 7 DROPS and for the composite design of the watering can, dropper and droplet.

Considering *Schenectady Varnish* and *Chemical Dynamics* together, we see that in many cases the design component of a composite word and design mark may be viewed as creating a separate commercial impression than the words, so that the words and design portions can be registered separately even when used as parts of a composite mark. It does not follow, however, that the various elements comprising the design can themselves be broken out and registered separately. See *Chemical Dynamics, supra*; see also *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993) (Board refused to allow registration of the line drawing of a coffee cup and saucer in profile when that design was actually used with a sunburst design emanating from the cup). Likewise, while an applicant may be able to seek registration of the words alone that are used in a composite word and design mark, applicant does not cite to any persuasive precedent that would allow registration of some, but not all, of the words in such a composite, when all the words contribute to a unified commercial impression.

We now turn to consider two cases in which some, but not all, of the wording on certain labels was held registrable. In *Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 954 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992), the Federal Circuit

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affirmed the Board's decision to dismiss an opposition, one ground for which had been that the applicant had mutilated the mark CALIFORNIA CHABLIS WITH A TWIST by seeking to register only CHABLIS WITH A TWIST. The Federal Circuit agreed with the Board's holding that CALIFORNIA was not an integral part of the mark and noted that, as a geographically descriptive word it was wholly devoid of trademark significance. In *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989), the Board allowed an applicant to register TINEL-LOCK when it appeared on labels within the designation TRO6AI-TINEL-LOCK-RING. The Board reversed an examining attorney's refusal of registration for TINEL-LOCK alone, finding that the designation TRO6AI was a part or stock number and RING was a generic term for the goods.

We do not find either of the foregoing cases to aid applicant in this case. In the *Vintners* case, the Federal Circuit noted that the term CALIFORNIA was required to be on the wine label, to comply with BATF regulations, but that this had nothing to do with the question "what is the mark." In *Raychem*, as in the *Servel* case with which we began our discussion of relevant case law, there was evidence of use of the only matter sought to be registered as a mark, which is not the same as the case at hand. Moreover, in *Raychem*, the Board held that the part number

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and generic term played no source identifying roles in distinguishing the applicant's goods from those of others. In the case at hand, however, we find that TROOPER, while certainly not an arbitrary term when used in conjunction with a state police organization, is nonetheless an integral part of the overall commercial impression formed by applicant's PENNSYLVANIA STATE POLICE TROOPER and design emblem.

Decision: The refusal to register on the basis that none of the specimens show use of the mark in the application is affirmed.