

THIS OPINION IS  
NOT A PRECEDENT  
OF THE TTAB

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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 Pharma Cosmetix Research, L.L.C.

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Serial No. 76269152

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Lisa M. Krizan of LMK PLC for Pharma Cosmetix Research, L.L.C.

Christopher L. Buongiorno, Trademark Examining Attorney, Law  
Office 102 (Karen Strzyz, Managing Attorney).

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Before Holtzman, Drost and Taylor, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Pharma Cosmetix Research, L.L.C. (applicant), seeks to register the mark ENVIRONMENTAL PROTECTION FACTOR (in standard character form) as a certification mark for goods ultimately identified as "health products, medicinal products, meeting registrant's efficacy protection standards"<sup>1</sup> in Class A. The

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<sup>1</sup> We point out that the identification of goods in a certification mark application should be limited to the goods themselves and should not, as it does here, include any reference to the standards or what the mark certifies about the goods. See TMEP §1306.06(f). Nevertheless, the examining attorney has accepted the identification as written and this requirement is not before us on appeal.

wording ENVIRONMENTAL PROTECTION is disclaimed. It is stated in the application that the certification mark, as used by persons authorized by applicant, certifies that products bearing the mark signify a certain level of protection from the deleterious effects of various environmental factors and contaminants.

The application was filed on June 8, 2001 based on applicant's assertion of a bona fide intention to use the mark in commerce. Following publication of the mark for opposition and issuance of a notice of allowance, applicant, on December 4, 2004, filed a statement of use together with the required specimen, alleging dates of first use of the mark and first use in commerce on September 15, 2004.

The examining attorney then refused registration of the mark essentially on the ground that the mark shown in the drawing is not a substantially exact representation of the mark as used on the specimen under Trademark Rule 2.51(a).

When the refusal was made final, applicant appealed. Briefs have been filed.

The specimen submitted by applicant consists of packaging for the certified goods. The wording ENVIRONMENTAL PROTECTION FACTOR as it appears on the specimen is part of a composite shown below.



The examining attorney argues that, as depicted on the specimen, ENVIRONMENTAL PROTECTION FACTOR appears with other elements projecting a special form mark; that the proposed mark is integrated with other elements creating a composite whole; and that ENVIRONMENTAL PROTECTION FACTOR does not make a separate and distinct commercial impression apart from the other elements. The examining attorney contends that the wording ENVIRONMENTAL PROTECTION FACTOR "simply defines the EPF portion" of the mark and that consumers are likely to view the wording "as simply reinforcing the meaning of the letters 'EPF' and not as a source indicator." It is the examining attorney's position that "because of this interrelationship between the proposed mark and the letters EPF, it is unreasonable to conclude that the wording...conveys a separate commercial impression as a source indicator." The examining attorney acknowledges that the EPF portion of the mark was permitted to register (Registration No. 2931109) based on the same specimens as the present application.

However, the examining attorney maintains that EPF is "the one element in the mark that is likely to capture the attention of consumers and be perceived as a source indicator"; and further that the letters EPF and the numeral 95 "are clearly the dominant elements of the composite whole."

Trademark Rule 2.51(a) provides that once a statement of use 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." The question is whether the mark sought to be registered is a "mutilation" or an incomplete representation of the mark that is actually used. See, e.g., *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

It is well settled that an applicant may seek to register any element of a composite mark if that element presents a commercial impression separate and distinct from the other elements of the mark, and in itself performs the function of a mark, in this case a certification mark.<sup>2</sup> See *Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (CCPA 1950);

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<sup>2</sup> We find nothing in the statute, rules or case law to indicate that the requirements pertaining to drawings for certification marks differ from those pertaining to trademarks or that the analysis with respect to these marks would differ.

In re Berg Electronics, Inc., 163 USPQ 487 (TTAB 1969); In re Tekelec-Airtronic, 188 USPQ 694 (TTAB 1975); and In re Lear Siegler, Inc., 190 USPQ 317 (TTAB 1976). 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. 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." *Chemical Dynamics*, supra at 1829, quoting 1 J. T. McCarthy, Trademarks and Unfair Competition §19:17 (2d ed. 1984).

We agree with applicant that the wording ENVIRONMENTAL PROTECTION FACTOR creates a separate commercial impression apart from the other elements in the mark. As shown above, the composite mark consists of a circular design containing a number of different elements. A band of (mostly illegible) wording curves along the inside edge of the circle. The letters "EPF" with a "tm" notation and the wording "Environmental Protection Factor" form an inner circular shape. The numeral "95" appears in the center of the circle superimposed on what appears to be a design of orbiting electrons. The phrase ENVIRONMENTAL PROTECTION FACTOR is part of the overall circle design, but it is not physically connected to EPF or any of the other elements in the design. In addition, the letters EPF and the phrase

ENVIRONMENTAL PROTECTION FACTOR are separated visually by the size and style of lettering of each term, as well as by the electron design in the center of the circle. While EPF and ENVIRONMENTAL PROTECTION FACTOR together form a circular shape, the shape itself is not particularly unique or distinctive and the two terms are not so bound together by that design that they cannot be regarded as separable elements. Compare, e.g., *In re Mango Records*, 189 USPQ 126, 127 (TTAB 1975) (typed word MANGO not separately registrable "in view of the unique juxtaposition of the word with the pictorial elements of the composite.")

Nor are the two terms EPF and ENVIRONMENTAL PROTECTION FACTOR so merged together in meaning that they cannot create separate impressions. EPF is obviously an abbreviation for the phrase ENVIRONMENTAL PROTECTION FACTOR. However, the phrase also has its own meaning, apart from the abbreviation. See, e.g., *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1043 (TTAB 1985) (noting that while the pictorial representation of Pegasus, "may reinforce the word [Pegasus]," the word also created its own separate commercial impression). The overall commercial impression is of two discrete components, the abbreviation EPF and the phrase ENVIRONMENTAL PROTECTION FACTOR.

We note in this regard, as the examining attorney acknowledges, that Registration No. 2931109 issued for the EPF component alone based on the same specimens submitted in the

present application. The examining attorney explains that EPF was registrable because it is the "dominant" part of the mark; however, we do not see that as a distinction. The mere fact that EPF may be more prominent, or even a dominant, feature of the composite mark does not necessarily mean that a less prominent feature cannot also be perceived as a mark. A component does not have to create the dominant commercial impression in the composite in order to be registrable, it only has to create a separate commercial impression. We find that ENVIRONMENTAL PROTECTION FACTOR creates a separate commercial impression as one of applicant's marks, apart from EPF and the other elements in the composite mark.

In view of the foregoing we find that the mark shown in the drawing is a substantially exact representation of the mark shown on the specimens.

**Decision:** The refusal to register is reversed.