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Mailed: February 6, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Debowa Polska De Chêne Polska

Serial No. 76612005

Horst M. Kasper, Esq. for Debowa Polska De Chêne Polska.

Vivian Micznik First, Trademark Examining Attorney, Law
Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Walters and Kuhlke, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Debowa Polska De Chêne Polska filed an application to
register on the Principal Register the mark shown below for
"alcoholic beverages, namely vodka," in International Class
33.¹

¹ Serial No. 76612005, filed September 13, 2004, based on use of the
mark in commerce, alleging first use as of May 27, 2002, and use in
commerce as of July 11, 2003.



Applicant included the following statements in the application as filed:

- The wording "De Chêne" is in color bronze, the wording "Debowa Polska" is in color navy blue with outlines in color beige. The design of the tree is in colors bronze and beige.
- The colors bronze, navy, blue and beige are claimed as a feature of the mark.
- The mark consists of the wording "Debowa De Chêne Polska" and the design of a tree.

Applicant added the following statements to the application by amendment:

- The English translation of the wording "Debowa De Chêne Polska" in the mark is "Oak Poland," and the translation of "Polska" is "Poland."
- The word POLSKA is disclaimed apart from the mark as a whole.
- The stippling shown in the drawing is a feature of the mark.

The examining attorney has issued a final refusal to register based on applicant's alleged failure to comply with several requirements, as explained below.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

The drawing filed with the application is the black and white drawing shown above, although the application as filed included a claim of color and a description of the mark including reference to color, as noted above. In the first office action dated April 11, 2005, the examining attorney required that, inter alia, applicant either delete the claim of color or submit a color drawing, noting that color was not material to the commercial impression of the mark and, therefore, the statements relative thereto could be deleted. The examining attorney also required applicant to submit a specimen evidencing use of the mark on the identified goods, noting that the application, based on use in commerce, did not include a specimen of use.

In its response dated October 14, 2005, applicant stated, inter alia, that it was submitting a revised drawing showing the mark in color; however, the response did not include a revised drawing. Applicant also stated that it would submit a specimen of use and a supporting declaration in its next communication.

On November 9, 2005, the examining attorney issued a final refusal to register based on (1) applicant's failure to comply with the requirement to submit a specimen showing use of the mark and a supporting declaration, and (2) applicant's failure to comply with the requirement to either submit a drawing depicting the mark in color or to delete its color claim and description.

With its notice of appeal, filed on May 12, 2006, applicant requested reconsideration of the final refusal and submitted, *inter alia*, a specimen showing use of the mark on a label, supported by the required declaration, and a substitute drawing, in black and white, of the mark as shown on the specimen.

In her action of July 12, 2006, denying the request for reconsideration, the examining attorney concluded that the substitute drawing is unacceptable on the grounds that the mark shown therein is a material alteration of the mark shown in the original drawing; that the drawing depicts the mark in black and white and applicant did not delete its color claim and description; and that the drawing is unclear and will not reproduce properly. The examining attorney also concluded that the specimen is unacceptable because it depicts a mark materially different from the mark in the original drawing. The examining attorney concluded that applicant must either (1) "submit a new drawing of the mark

that agrees with the mark as it appears on the specimen and that is not a material alteration of the original mark,"²

(2) "submit a substitute specimen that shows use of the mark as it presently appears on the drawing" with the required declaration, or (3) "amend the application basis to intent-to-use under Section 1(b), and satisfy all the requirements for this new basis."

In its brief in this appeal, applicant states simply that its prior amendment should have put the application in allowable form and requests reversal of the refusal. While applicant also states that it "is in the process of preparing the additional documents and materials which soon will be submitted to the [USPTO]" (brief, p. 4), no such submission has been received, nor would it be timely at this point in applicant's appeal.

In her brief, the examining attorney restates the final requirements as follows:

- (a) submit a clear drawing of the mark;
- (b) either submit a color drawing or delete the color claim; and
- (c) submit a drawing that matches the specimen or a substitute specimen that matches the drawing.

² It is not clear what kind of drawing the examining attorney would find acceptable, i.e., one that is not a material alteration of the original drawing but also conforms to the mark shown in the specimen of record.

The examining attorney contends that the substitute drawing is unacceptable because (1) the lines are not clean, sharp and solid; (2) it omits the words DE CHÊNE POLSKA and, as such, materially alters the mark shown in the original drawing by changing the appearance sound and meaning of the drawing; and (3) the application contains a color claim which is unacceptable because both the original and proposed amended drawings are in black and white. The examining attorney also contends that the specimen is unacceptable because it shows the mark as it appears in the proposed amended drawing, which is a material alteration of the mark as shown in the original drawing.

Analysis

The mark shown in the proposed amended drawing is identical to the mark depicted on the label submitted as a specimen of use.

original drawing



proposed amended drawing



The label submitted as a specimen includes, in the text below the design mark, the phrase "vodka with black elder flower and oak sliver," and is shown below:



The relevant portions of the pertinent rules are shown below:

§2.51 Drawing required.

(a) In an application under section 1(a) of the Act, 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.

§2.52 Types of drawings and format for drawings.

A drawing depicts the mark sought to be registered. The drawing must show only one mark. The applicant must include a clear drawing of the mark when the application is filed. There are two types of drawings:

...
(b) *Special form drawing.* Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must submit a special form drawing. The drawing must show the mark in black on a white background, unless the mark includes color.

(1) *Color marks.* If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where

the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.

...
(5) *Description of mark.* If a drawing cannot adequately depict all significant features of the mark, the applicant must also describe the mark.

§2.54 Requirements for drawings submitted on paper.

The drawing must meet the requirements of §2.52. In addition, in a paper submission, the drawing should:

...
(d) Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

(e) Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

SPECIMENS

§2.56 Specimens.

(a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.

...

2.72 Amendments to description or drawing of the mark.

(a) In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if:

(1) The specimens originally filed, or substitute specimens filed under §2.59(a), support the proposed amendment; and

(2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the

description or drawing of the mark filed with the original application.

First, regarding whether the proposed amended drawing is clear, we find that it is sufficiently clear to comply with the rule and, in fact, it is clearer than the original drawing. Thus, we reverse the examining attorney's requirement for a new drawing on this ground.

However, we agree with the examining attorney that the application must be refused because both the original and proposed amended drawings are black and white and, contrary to Trademark Rule 2.52, the application includes a color claim and a description of the mark that includes color. Thus, we affirm the examining attorney's refusal on the ground that the drawing is black and white and the application improperly includes a claim of color.

Finally, we consider whether the mark, which is the same both in the proposed amended drawing and on the label submitted as the specimen of record, is a material alteration of the mark as originally shown. Comparing the two drawings, the horizontal word "POLSKA" is moved to the right in the proposed amended drawing and specimen so that it is directly beneath the new wording "FLAVORED VODKA"; the design of the tree is significantly lighter and much of the contrast providing the definition of the tree has been deleted; and the wording forming the left side of the drawing, "DE CHÊNE POLSKA," has been deleted. The term

"FLAVORED VODKA" describes the type of vodka; and "POLSKA" describes the source of the vodka. We note from applicant's specimen that it describes its vodka as "vodka with black elder flower and oak sliver." However, in view of the translation statement provided by applicant, "[t]he English translation of the wording 'Debowa De Chêne Polska' in the mark is 'Oak Poland,'" we do not view "De Chêne" as a merely descriptive term. As used in the mark, and according to applicant's translation statement, the commercial impression of "De Chêne" is that it modifies "Poland," rather than vodka.³ In this case, the number and nature of the changes made to the mark lead us to the conclusion that the mark shown in the proposed amended drawing and the specimen is materially different in appearance, connotation and commercial impression from the mark shown in the original drawing. Thus, the examining attorney correctly required that applicant submit a substitute specimen that conforms to the mark in the originally-submitted drawing, and the refusal to register on this ground is affirmed.

Decision: The refusal to register is affirmed on the grounds that the drawing of record is black and white and applicant failed to delete its claim of color; and that the mark in the proposed amended drawing and specimen are

³ Even if we were to regard "De Chêne" as being merely descriptive of one of the ingredients or flavors of the vodka, the addition or deletion

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materially different from the mark in the originally-submitted drawing. However, the refusal based on the conclusion that the proposed amended drawing is insufficiently clear is reversed.

of descriptive matter is not necessarily inconsequential, especially when the mark is in special form.