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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Green U.O.D., Inc.

Application Serial No. 76615858

William J. Lehane of Drinker, Biddle & Reath LLP, for Green U.O.D., Inc.

Angela Micheli, Examining Attorney, Law Office 101, (Ronald R. Sussman, Managing Attorney).

Before Holtzman, Rogers, and Mermelstein, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

U.O.D., Inc. filed an application for registration of the mark URBAN RENEWAL (in standard characters) for "antique furniture" in International Class 20.[1]

Following publication for opposition and issuance of a notice of allowance, applicant filed a statement of use pursuant to Trademark Rule 2.88. Upon examination of the statement of use, the examining attorney found that the drawing was not a substantially exact representation of the mark as used on the specimens. Trademark Rule 2.51(a). Inasmuch as the drawing could not be altered to resolve the

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[1] Filed October 8, 2004, alleging a *bona fide* intent to use the mark in commerce under Trademark Act § 1(b); 15 U.S.C. § 1051.

discrepancy without material alteration, Trademark Rule 2.72(b)(2), the examining attorney issued and ultimately made final a requirement for substitute specimens.[2]

The specimen of use filed by applicant is reproduced below:[3]

It is the examining attorney's contention that the mark used on the specimen is URBAN RENEWAL AT HOME, and not the mark in the drawing, URBAN RENEWAL:

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[2] The examining attorney objected to material attached to applicant's brief, which had not been made of record prior to appeal. Applicant responds: "With all respect to the Examining Attorney, it is this Board's prerogative to decide what matters it will consider." Reply Br. at 2. To the extent applicant implies that it was improper for the examining attorney to object, it is mistaken. The objection is sustained, Trademark Rule 2.142(d), and the attachments will not be considered.

[3] Applicant identifies the specimen as a hang tag, printed on white paper (here against a dark background), which is affixed to

> Firstly, the AT HOME has the same type font and color as the URBAN RENEWAL portion, and the wording is in close proximity to each other. Secondly, the font size for URBAN RENEWAL and HOME is the same which creates a visual unitary phrase rather than two separate and distinct elements. Thirdly, the phrase flows together, suggesting that urban renewal starts at home by purchasing the applicant's goods, used furniture[,] which is emphasized by the other wording on the specimen "This item was previously owned."

Ex. Att. Br. at 3.

Applicant disagrees, arguing that the words URBAN RENEWAL create a separate commercial impression from the other matter on the specimen – here, the words AT HOME. Applicant argues that

> In this case, the mark URBAN RENEWAL is not only capable of functioning but does, in fact, function as a valid mark for the identified goods and distinguishes applicant's goods from all others. [The examining attorney] has focused on whether the inclusion and positioning of the words "at" and "HOME" on the specimen somehow detract from and even destroy the obvious registrability of the mark.... While it is certainly part of the Examining Attorney's duties to review submitted specimens, neither the statute, nor the Rules of Practice, nor the cases grant the Examining Attorney the prerogative to negate the Applicant's choice of its mark. On the contrary, the statute, the rules and the case law support Applicant's right to seek and secure registration of this mark regardless of the other wording on the specimen.

Appl. Br. at 4.

We reject applicant's statement that "the real issue is whether the trademark owner seeks to register a valid mark...." Appl. Br. at 3 n.2. To be clear, there is

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the goods.

nothing "invalid" about either the mark depicted in the drawing or the mark as used on the specimens, however it is construed. The question is only whether the mark on the drawing appears as the same mark, or substantially so, on the specimen. Although couched as a rejection of the specimens, the examining attorney's refusal is actually a rejection of the drawing, on the ground that it is not a substantially exact depiction of the mark as actually used. The right to registration follows the right to use and not the other way around. The examining attorney's argument is not that applicant is <u>using</u> the wrong mark, but rather that the mark in the <u>drawing</u> is not the mark which applicant uses. This usually appears to be a specimen issue, first, because it is not manifest until the specimens are filed and second, because the refusal can usually be overcome only by new specimens, as the drawing may not be materially altered.

Nor do we see the examining attorney as trying to "negate the Applicant's choice of a mark." Before an applied-for mark may be registered under Trademark Act § 1, it must be in use. The examining attorney must examine the specimens to determine if the mark in the drawing is the one in use, and if not, to refuse registration. This is not a prerogative, it is a statutory requirement.

Turning to the merits of the matter, we begin with the remarks of the Court of Customs and Patent appeals:

> Most trade mark cases may be distinguished from one another without much difficulty because of the usual difference in facts. The citation of a case or an array of cases is therefore of little value, except for whatever may be contained therein with respect to the statement or application of a principle of trade mark law.

In re Servel, Inc., 181 F.2d 192, 85 USPQ 257, 260-61 (CCPA 1950). The Court made its observation in reviewing the same type of refusal we now consider. These cases are nuanced, highly fact-specific and, to a large extent, subjective.[4]

"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...." Trademark Rule 2.51(a). If the drawing is not a complete representation of the trademark, *i.e.*, if the drawing includes less than the mark which is actually used, registration must be refused. *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 807.12(d) (5th ed. 2007). But this principle raises an obvious question: what mark is applicant actually using? The answer is sometimes not clear, because it is not at all unusual for specimens to comprise multiple trademarks, artwork, and other matter, whether registrable or not.

[4] We have reviewed the cases cited by applicant and the examining attorney. As suggested by the Court, however, we will not belabor this opinion with an exegesis on each case and the marks involved therein. We concentrate instead on basic principles and the facts of this case.

Needless to say, it is up to the applicant to choose what it seeks to register. But what applicant wants to register must not only be in use, it must make a distinct commercial impression as used.[5] That is, the applied-for mark as actually used must not be so entwined (physically or conceptually) with other material that it is not separable from it in the mind of the consumer. *In re Chem. Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988). In this case, the question is whether URBAN RENEWAL, as used on applicant's specimens, makes a separate impression from the words "AT HOME," which follow immediately thereafter, or whether the mark would necessarily (and only) be seen to be URBAN RENEWAL AT HOME.

This is admittedly a close case. The examining attorney makes valid points regarding the general consistency of the wording in appearance and its continuity, both visually and conceptually. Nonetheless, we find that there is at least some doubt involved, and that it is appropriate to resolve such doubt in applicant's favor.

As noted by the examining attorney, the wording URBAN RENEWAL and HOME are depicted on the same visual plane and in generally the same size and style of lettering. However, URBAN RENEWAL and HOME are separated on the specimen by the

[5] "[I]t 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...." *In re 1175856*

word "AT," which is displayed in smaller, lowercase letters. Moreover, "AT" in this case is not on the same visual plane as URBAN RENEWAL and HOME, and thus provides both a visual and conceptual separation between them.

Rather than implying that "urban renewal" (which to us, connotes large public projects aimed at rejuvenating blighted city neighborhoods) "begins at home," the mark seems to convey another idea, namely that URBAN RENEWAL (the brand) will provide goods for your home. Under our interpretation, the wording "at home" would thus suggest where the URBAN RENEWAL goods could be used. But the purchaser will likely see "at home" as just one place where applicant's goods are used; "at home" could be replaced by other locations, such as "at work" or "at play." With that conception of the mark, "URBAN RENEWAL" takes on a separable meaning from AT HOME.[6]

Conclusion

After careful consideration, we find that the term URBAN RENEWAL, used as on the specimens of record, creates a distinct commercial impression from the other matter used on

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Ontario Ltd., 81 USPQ2d 1446, 1448 (TTAB 2006).

[6] We need not and do not comment on whether applicant could have (or could still) apply for registration of URBAN RENEWAL AT HOME using the same specimens as its evidence of use. "[I]n a § 1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes." TMEP § 807.12(d) (5th ed. 2007)

the specimen. As such, we conclude that the drawing is a substantially exact representation of the mark as used.

Decision: The refusal to register is accordingly reversed.