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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jen USA, Inc.

Application Serial No. 76652688

Myron Amer of Myron Amer, PC, for Jen USA, Inc.

Ingrid Eulin, Examining Attorney, Law Office 111, Craig D. Taylor, Managing Attorney.

Before Hohein, Bucher, and Mermelstein, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Jen USA, Inc. filed an application for registration of the mark shown below



in International Class 3 for goods ultimately identified as follows:¹

Color cosmetics, namely, lipsticks, lipstick liners, lip gloss, eyeliners, eye shadows,

¹ Filed December 30, 2005, alleging a *bona fide* intent to use the mark in commerce under Trademark Act § 1(b); 15 U.S.C. § 1051(b). Applicant has disclaimed the exclusive right to use "aromatherapy" apart from the mark as shown.

blushers, face powders, foundation, mascaras, nail polishes, eyebrow pencils; skin treatment products, namely, cleansers, toners, moisturizers, eye creams, hand and body lotions, body and shower gels, and facial soap, nail care preparations, and nail polish removers; fragrance products, namely, cologne, perfume, toilet water, scented soaps, body powders, bath oils; sun screen preparations; hair care products, namely, hair coloring, hair bleaches, hair lighteners, highlighting preparations; shampoos; conditioners, hair color stain removers, hair gels, mousses, hair sprays and styling lotions; and hair care preparations, namely, hair body and root lift gels; bath sets comprised of bath gels, bath foams and bath oils.

On March 2, 2007, 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. Trademark Rule 2.51(a). Applicant did not argue the substance of the examining attorney's refusal, but instead submitted the following proposed amended drawing to bring it into conformity with the specimens of use:

The image shows a handwritten logo. The words "great moods" are written in a large, cursive, black ink font. Below them, the word "aromatherapy" is written in a smaller, simpler, black ink font.

The examining attorney issued and ultimately made final a requirement for substitute specimens, and a refusal to accept applicant's proposed amendment to the drawing, pursuant to Trademark Rule 2.72(b)(2).

Applicant and the examining attorney have filed briefs. We affirm.

I. Issue on Appeal

Continuing its position during examination, applicant does not argue that its original drawing is a substantially exact representation of the mark as used, but rather contends that the examining attorney erred in refusing to accept the proposed amended drawing. By failing to address the agreement of the specimens with the original drawing, applicant has waived that issue. We accordingly do not address whether the examining attorney's rejection of the specimens of record was correct, but rather confine our analysis to the question of whether applicant's amended drawing was properly rejected.

II. Applicable Law

Pursuant to the Trademark Rules:

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

- (1) The specimens filed with an amendment to allege use or a statement of use, or substitute specimens filed under § 2.59(b), 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.

Trademark Rule 2.72(b).

For an amended drawing to be acceptable,

[t]he modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

Visa Int'l Serv. Ass'n v. Life-Code Syst., Inc., 220 USPQ 740, 743-44 (TTAB 1983); cited in *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (material alteration in applications filed under Trademark Act § 44). "As a general rule, the addition of any element that would require a further search will constitute a material alteration." TMEP § 807.14 (5th ed. 2007) (citing *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986)). Moreover, it is well-settled that a material alteration can result from deletions, as well as additions to a mark. *In re Dillard Dep't Stores Inc.*, 33 USPQ2d 1052 (Comm'r Pat. 1993). Non-distinctive matter may be deleted from a mark, but only "if the overall commercial impression is not altered." TMEP § 807.14(a).

III. Discussion

Applicant argues that it inadvertently² erred in submitting the original drawing in its application, but that

² Whether applicant's error was inadvertent or not is irrelevant.

the examining attorney also erred in "conclud[ing] that applicant's correction of the error is a material change in applicant's trademark." App. Br. at 2. As noted in its reply brief

the sole difference is the absence of the bamboo illustration in the right version, or stated otherwise, the display solely of the word portion in the right version. It should be readily apparent that the word portion is the more dominant because, as known from common experience, it is used in calling for the trademark-identified product by phone or at a point-of-sale retail store display.

App. Rep. Br. at 1.

Applicant is correct that the literal portion of a mark is often considered dominant for likelihood of confusion purposes. But the issue before us is material alteration, not likelihood of confusion, and the applicable rule does not permit deletion of material from a mark simply because it creates a weaker impression than what would remain.

Here, applicant seeks to amend the mark to delete the depiction of several stalks of bamboo which appear to the left of the stylized wording GREAT MOODS AROMATHERAPY. While the bamboo design is not physically integrated with the wording in the mark, we cannot say that it lacks distinctiveness. There is no argument that the bamboo

The applicant's intent is not a factor in considering whether an amendment would materially alter the mark in the drawing. We likewise find no relevance in applicant's Registration No. 3489183, for the same (original) drawing and different goods.

design is generic or descriptive of the goods or would otherwise be seen as having no source-identifying function.

We further note that the bamboo design in the original drawing was coded by the USPTO, and was in fact included in the examining attorney's search of the applied-for mark. It is thus clear that her search and analysis in this application would have been different if the original drawing had not included the bamboo design. As noted by the examining attorney, the amendment proposed by applicant would essentially broaden the scope of the application because it removes a distinctive element from the mark. Applicant's amendment would thus require a new search to determine if there is a conflict with any registration or prior-filed application without considering the distinctive bamboo design. For the same reason, republication would be necessary, as deletion of this distinctive element may affect the decision of any third party to oppose.

Conclusion

After careful consideration, we find that applicant's proposed amended drawing is unacceptable because it would constitute a material alteration of the mark as originally filed. Trademark Rule 2.72(b). As noted, applicant does not dispute that its original drawing is not a substantially exact representation of the mark as used in commerce.

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Decision: The refusal to register under Trademark Rule 2.51(b) is accordingly affirmed.