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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spring Café Realty LLC

Serial No. 78536106

Lisa A. Pieroni of Kirschstein, Ottinger, Israel & Schiffmiller, P.C. for Spring Café Realty LLC.

Erin M. Falk, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).¹

Before Walters, Zervas and Wellington, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On December 21, 2004, Spring Café Realty LLC ("applicant") filed an application for registration of the mark BARMACHÉ (in standard character form) for "restaurant and catering services" on the Principal Register under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The specimen of use, a menu, displayed the mark as BARMARCHE.

¹ The current examining attorney was not the original examining attorney in this application.

On January 13, 2005, before the examining attorney had issued her first action, applicant filed a preliminary amendment seeking to amend the mark to BARMARCHÉ (also in standard character form). The examining attorney issued her initial Office action on August 2, 2005, in which she, inter alia, denied entry of the preliminary amendment on the ground that "it would materially alter the essence or character of the mark" which applicant identified in its application, i.e., BARMACHÉ, citing Trademark Rule 2.72, 37 C.F.R. § 2.72. She also required substitute specimens showing the mark depicted in the application, a translation of all foreign wording in the mark and required that applicant indicate whether "BAR, MACHE or BARMACHE has any significance," pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b).

In response, applicant argued that the preliminary amendment was made at the earliest possible time to correct a typographical error, well before the issuance of the first Office action. Applicant did not provide a translation or identify the significance of the mark, and, at p. 4 of its response, indicated that the examining attorney, in requesting a specimen showing BARMACHÉ, was requesting a specimen "for a mark that is not used in commerce."

In a final Office action, the examining attorney maintained the refusal and the requirements and did not accept the preliminary amendment. After applicant filed an appeal, both applicant and the examining attorney filed briefs.

The "drawing depicts the mark sought to be registered." Trademark Rule 2.52, 37 C.F.R. § 2.52. If an amended drawing is submitted in connection with an application based on use in commerce, the applicant may amend the description or drawing of the mark only if "(1) the specimens originally filed ... 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. See also *In re Who? Vision Systems Inc.*, 57 USPQ2d 1211, 1217-18 (TTAB 2000) ("[U]nder the new rules, any and all proposed amendments are subject to the material alteration standard, and no amendment is permissible if it materially alters the mark sought to be registered, i.e., the mark depicted on the drawing").

In determining whether a proposed amendment to a mark is material, "[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." *Id.*, quoting *Visa International Service Assn. v. Life-Code Systems*, 220 USPQ 740, 743 - 744 (TTAB 1983). (Emphasis in the original.) "[T]he new and old forms of the mark must create essentially the same commercial impression." *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988).

In the present case, the specimens originally filed support the proposed amendment, but the mark in the proposed amendment is a material alteration of the mark depicted in the original drawing. Changing BARMACHÉ to BARMARCHÉ changes the commercial impression and meaning of the mark. *Cassel's French Dictionary*, Macmillan Publishing Co. (1991) defines "marché" as "market."² The inclusion of MARCHÉ in BARMARCHÉ suggests that applicant's establishment in which it provides its restaurant and catering services has a market component.³ Thus, even though BARMACHÉ and BARMARCHÉ both have BAR as their initial components, we

² We take judicial notice of this definition. The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ Applicant's point at p. 3 of its brief that "if the typographical error did not result in an actual other word, that the Preliminary Amendment would have resulted in the Examiner's

find that the commercial impression of BARMACHÉ is not essentially the same as the commercial impression of BARMARCHE.

We are not persuaded by applicant's arguments in support of registration. First, that applicant submitted its preliminary amendment months before the examining attorney performed her initial search and before the first Office action issued is irrelevant. The timing of the proposed amendment does not enter into the determination as to whether the amendment is a material alteration. Second, that BARMARCHE appears in the specimen is of no moment. Under *In re ECCS Inc.*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996), if there was an "internal inconsistency" between the mark shown in the drawing and the one shown in the specimen, one would look to the specimen to determine what the mark actually was. However, subsequent to the *ECCS* decision, Trademark Rule 2.52 was changed to provide that the "drawing depicts the mark sought to be registered." The stated purpose for this amendment was "to prohibit amendments that materially alter the mark on the original drawing." 64 Fed. Reg. 48900, 48902 (Sept. 8, 1999). Thus, if an application is filed with a drawing

conclusion that the change was material" is speculation and does not reflect the situation before us.

page showing a mark which differs from the mark in the written application or the specimen, the drawing controls, and the drawing may not be amended if the amendment is a material alteration of the mark shown on the drawing page.

We find that it would be a material alteration to change the mark from BARMACHÉ to BARMARCHÉ. Therefore, the examining attorney correctly did not allow the drawing to be amended as proposed by applicant. Also, because the mark shown on the specimen submitted with the application does not agree with the mark shown on the drawing, the requirement for a substitute specimen which does agree with the drawing is proper.

Decision: The examining attorney's refusal on the ground that the mark on the specimen does not agree with the mark in the drawing and her refusal to accept the amendment to the drawing are affirmed. The requirement for specimens which show the mark sought to be registered used in connection with the services set forth in the application is also affirmed.⁴

⁴ Because we have affirmed the examining attorney's refusals and requirement, we need not and do not reach the additional refusal based on applicant's asserted failure to comply with the examining attorney's requirement for submission of information under Trademark Rule 2.61(b).