Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

RE: TRADEMARK REGISTRATION OF JOHN LABATT LIMITED
Registration No. 1,324,918
July 31, 1992
***1** Petition Filed: December 11, 1991

For: JL JOHN LABATT'S EXTRA STOCK and Design
Issued: March 12, 1985

Attorney for Petitioner

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Assistant Commissioner for Trademarks

On Petition

John LaBatt Limited has petitioned the Commissioner to overrule the decision of the Trademark Applications Examiner in the Post-Registration Section, and allow amendment of the above-captioned mark pursuant to Section 7 of the Trademark Act. Trademark Rule 2.176 provides appropriate authority for the requested review.

The subject registration issued on March 12, 1985 for the mark JL JOHN LABATT'S EXTRA STOCK and Design. Pursuant to Section 8 of the Trademark Act, registrant was required to file an affidavit or declaration of continued use or excusable nonuse between the fifth and sixth year after the registration date, i.e., between March 12, 1990 and March 12, 1991. On March 23, 1990, the registrant timely filed a combined Section 8 and 15 declaration. By letter dated June 26, 1990, the Trademark Examining Attorney rejected the combined declaration because the specimen did not show use of the registered mark.

On November 26, 1990, the registrant filed a request for amendment of the registration under Trademark Act 7(e), seeking to change the drawing to comport with the rejected specimen. [FN1] The registered mark and the mark currently in use are shown below:

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

By letter dated February 13, 1991, the Trademark Applications Examiner refused the request on the ground that the registrant sought to add new words and design elements to the registration, which were never searched or published for opposition. On August 7, 1991, the registrant filed a request for reconsideration of the refusal, arguing that the essential elements of the mark remained the same, and the new elements had been searched and published in conjunction with another of

the registrant's marks, Registration 1,423,165.

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

By letter dated October 15, 1991, the refusal to amend the mark was continued. The Trademark Applications Examiner noted that the proposed amendment represented a material alteration to the character and consumer impression of the mark, that the visual impression was dramatically different, and that the registrant had so redesigned the mark as to create a new mark. The examiner further noted that, since each case must be decided on its own merits, the registrant's other registration could not be used as a guideline to refuse or allow the proposed amendment. This petition was timely filed on December 11, 1991.

Trademark Rule 2.146(a)(3) permits the Commissioner to invoke his supervisory authority in appropriate circumstances. However, the Commissioner will reverse the action of an Examiner in a case such as this only where there has been a clear error or abuse of discretion. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats.1974); Ex parte Peerless Confection Co., 142 USPQ 278 (Comm'r Pats.1964).

***2** Section 7(e) of the Trademark Act permits the Commissioner to accept an amendment to a registration provided that the amendment does not materially alter the character of the mark. Petitioner argues that the dominant features of the registered mark "are the words JOHN LABATT'S EXTRA STOCK and the stylized letters JL", and that these dominant features, "except for the word JOHN are present in the amended mark". As to the differences in the design elements, the petitioner refers to its ownership of a registration incorporating the same design, and cites cases holding that designs are subordinate to words in creating the dominant commercial impression of the mark.

There is an exception to the material alteration rule wherein the Office has permitted the addition of the applicant's registered mark to a mark sought to be registered. Florasynth Laboratories, Inc. v. Mulhens, 122 USPQ 284 (Comm'r of Patents 1959) (applicant permitted to change application from ELAN to 4711 ELAN where mark 4711 already registered). The rationale is "[t]he addition of applicant's well-known registered mark to the mark sought to be registered ... is not a material change which would require republication of the mark." Accord In re Nationwide Industries Inc., 6 U.S.P.Q.2d 1882 (TTAB 1988) (addition of registered matter refused where goods in application not the same as those in registration). [FN1] Here, the applicant does not seek to merely add an element from one registration to another. Rather, the applicant seeks to eliminate its original mark, and substitute another. The exception to the material alteration rule clearly does not encompass cases where the original mark disappears.

Whether republication would be required is only one consideration in the determination of whether a mark has been materially changed. Moreover, the test for whether a mark has been materially altered does not depend on whether the dominant portion of the original mark is still present in the amended form. The question is whether the proposed mark has a different commercial impression.

Contrary to the petitioner's argument, the number and nature of the

changes to the mark, in both the literal and the design elements, are such to support the Applications Examiner's conclusion that the petitioner has created a new mark with a different commercial impression. The mark as registered features a dark oval against a square label, with the letters JL filling most of the oval, and the words EXTRA STOCK superimposed, in smaller letters, over the JL. Across the top of the oval, in letters less than half the size of the EXTRA STOCK, are the words JOHN LABATT'S. Appearing on the bottom of the oval is a circular emblem showing a cabin.

The proposed amendment to the mark eliminates the dark oval, the square label, the large letters JL, the word JOHN, and the circular emblem featuring a cabin. The addition of Registration 1,423,165 not only introduces new design elements, but changes the presentation of the words EXTRA STOCK, and alters the formerly unobtrusive display of the surname to make LABATT'S the most striking portion of the mark. In these circumstances, the Trademark Applications Examiner cannot be said to have erred or abused her discretion in refusing to allow the amendment.

***3** The petition is denied. The registration file will be forwarded to the Post-Registration Section for action in accordance with this decision.

FN1. The request for amendment was accompanied by a request to suspend action on the Section 8 filing pending the outcome of the request for amendment.

FN1. Because the mark subject to this petition is used with "malt beer", and Registration 1,423,165 features "alcoholic brewery beverages, specifically ale and lager", which fit within the broader term "malt beer", the identity of the goods is not in issue here.

25 U.S.P.Q.2d 1801

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