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

RE: TRADEMARK REGISTRATION OF DEWITT INTERNATIONAL CORPORATION
Registration No. 508,644
October 17, 1991
***1** Petition Filed: March 20, 1991

For: DE WITT'S
Renewed: April 12, 1969
Issued: April 12, 1949

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On Petition

DeWitt International Corporation has petitioned the Commissioner to review the action of the Post Registration Affidavit-Renewal Examiner denying renewal of the above identified registration. Trademark Rules 2.146(a)(2) and 2.184(b), 37 C.F.R. § § 2.146(a)(2) and 2.184(b), provide authority for the requested review.

Facts

The above registration issued on April 12, 1949, and was renewed on April 12, 1969. Pursuant to Section 9 of the Trademark Act, an application for second renewal of the registration was due to be filed within the six months preceding April 12, 1989, or, on payment of a late fee, within the three month grace period following that date.

On June 3, 1989, petitioner filed an application for renewal of the registration, stating that the mark is still in use in interstate commerce on the goods recited in the registration, and that the attached specimen showed the mark as currently used. The registered mark and the mark currently in use are shown below:

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE
Registered Mark
Mark Currently Used

On July 13, 1989, petitioner filed a request to amend the mark pursuant to Section 7(d) of the Trademark Act. [FN1] The certificate of registration and a new drawing of the proposed amended mark were submitted with the request for amendment, as is required by Trademark Rule 2.173(a). The mark shown in the proposed amended mark was identical to the mark shown on the specimen submitted with the renewal application. In a letter mailed November 9, 1989, the Post Registration Examiner notified petitioner that the proposed amendment could not be accepted, because it constituted a material alteration of the mark as registered. Petitioner was given six months from the mailing date of the letter in which to file a response. Petitioner elected not to respond to the refusal of the Section 7 request for amendment. By letter dated July 6, 1990, the Post Registration Examiner notified petitioner that the request for amendment under Section 7 was abandoned. The certified copy of the registration was returned to petitioner.

By letter dated July 24, 1990, the Post Registration Affidavit-Renewal Examiner notified petitioner that renewal was withheld because the identification of goods in the renewal application was unclear. [FN2] Petitioner was required to amend the application to set forth the goods on which the mark is being used as they are identified in the registration. Petitioner was advised that if a response to the refusal of renewal was not filed within six months from the mailing date of the letter, the application for renewal would be considered abandoned. By letter dated January 3, 1991, the Affidavit-Renewal Examiner notified petitioner that her letter of July 24, 1990 was written in error, and that the registration would be forwarded for abandonment based on the refusal to amend the mark under Section 7. On January 24, 1991, petitioner filed a response to the Affidavit-Renewal Examiner's letter of July 24, 1990. [FN3] This petition was filed March 20, 1991, in conjunction with a request for reconsideration of the Examiner's action.

Decision

***2** Trademark Rule 2.146(a)(3) permits the Commissioner to invoke 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 Company, 142 USPQ 278 (Comm'r Pats.1964). For the reasons given below, the present circumstances do demonstrate clear error by the Affidavit- Renewal Examiner.

Renewal of trademark registrations is governed by Section 9 of the Trademark Act, while amendment of registrations is governed by Section 7 of the Act and Trademark Rules 2.171 through 2.176.

Section 7(e) permits the Commissioner to accept an amendment to a registration, provided that the amendment does not materially alter the character of the mark. Rule 2.176 provides that if a registrant does not respond to an adverse action of an examiner within six months, the request for amendment will be considered abandoned. However, neither

the statute nor the rules provide for abandonment of a renewal application or cancellation of a mark because a request for amendment is denied under Section 7 or because a registrant fails to respond to an Office action denying such a request. Accordingly, the Affidavit-Renewal Examiner clearly erred in forwarding the registration for abandonment based on the refusal to amend the mark under Section 7.

It is assumed that the Affidavit-Renewal Examiner's decision to abandon the renewal application was based upon a determination that the renewal specimen showed use of a mark which differed materially from the registered mark, although this was not clearly articulated in the letter of January 3, 1991.

Trademark Manual of Examining Procedure § 1605.07 states that "[t]he standard used to determine whether a difference is material on renewal is the same as the standard used to determine whether ... a registered mark may be amended under Section 7(d) of the Trademark Act." The Affidavit-Renewal Examiner apparently concluded that, since the mark which was the subject of the Section 7 request was deemed to be a material alteration of the registered mark, it automatically followed that a renewal specimen which showed use of the proposed amended mark would be insufficient to show current use of the registered mark. This is not so. It is true that a specimen showing a mark that differs materially from the mark as registered cannot be accepted as evidence of current use of the registered mark under Sections 8 and 9 of the Trademark Act. However, the question of whether a specimen supports a claim of current use of a registered mark is different from the question of whether an amendment to a mark is permissible under Section 7. [FN4] Although the two issues are somewhat interrelated, they must be analyzed and decided separately, in light of the specific circumstances of the issue presented. Inaddition to material alteration, a determination as to the sufficiency of a renewal specimen often requires consideration of whether the registered mark is a separable element of a composite mark currently in use. It does not appear that this was considered in the instant case.

The Proposed Section 7 Amendment

***3** While the propriety of the refusal to accept petitioner's request for amendment under Section 7 is not the subject of this petition, some analysis of the decision on the proposed amendment is necessary, since it was the basis for the Examiner's refusal of the renewal application.

Section 7 permits amendment of a registered mark if the character of the mark is not materially altered. The general test of whether an alteration is material is whether the new mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is so different from another as to require republication, it is tantamount to a new mark appropriate for a new application. Trademark Manual of Examining Procedure § 1607.02(a).

In the instant case, the registered mark consists of the word DE WITT'S (stylized), while the proposed amended mark consists of the word DE WITT with a globe design inserted into the letter "D." The

proposed amendment would add a new element to the mark. Such an addition would require republication in order to provide notice and an opportunity to oppose to competitors who may have rights in similar globe designs. Thus, even though the use of the globe design was supported by a specimen, its addition to the mark at this point cannot be permitted, because this would expand the scope of protected rights and could prejudice the rights of third parties who are entitled to notice by publication for opposition. Accordingly, the denial of the proposed Section 7 amendment on the ground that it materially alters the character of the registered mark was proper.

Specimen of Current Use of The Mark

Although the design element cannot be added to the mark under Section 7, it does not necessarily follow that a specimen showing use of a composite mark comprised of both word and design elements is insufficient to show current use of the registered mark for purposes of renewal. Where the registered mark is currently used as one of several elements of a composite mark, the decision as to the sufficiency of the renewal specimen requires consideration of whether the registered mark makes an impression apart from the other elements of the mark now in use. If the display of the composite is such that the essence of the registered mark does make a separate impression, then the specimen may be sufficient to support the renewal application.

It is settled that an element of a composite mark may be registered separately, provided that it makes a distinct commercial impression, apart from the other elements of the mark. See In re Sperouleas, 227 USPQ 166 (TTAB 1985); In re Library Restaurant, Inc., 194 USPQ 446 (TTAB 1977); In re Lear Siegler, Inc., 190 USPQ 317 (TTAB 1976); In re Tekelic-Airtronic, 188 USPQ 694 (TTAB 1975); In re Schecter Brothers Modular Corp., 182 USPQ 694 (TTAB 1974); In re Berg Electronics, Inc., 163 USPQ 487 (TTAB 1969); In re Servotronics, Inc., 156 USPQ 592 (TTAB 1968); In re Barry Wright Corp., 155 USPQ 671 (TTAB 1967); In re Omni Spectra, Inc., 143 USPQ 458 (TTAB 1964); In re Sterno, Inc., 137 USPQ 328 (TTAB 1963). In many cases, word elements are severable from design elements, since words tend to dominate in forming a commercial impression.

***4** While the reported decisions dealing with the registration of separable elements of composite marks relate to applications for registration of marks under Section 1 of the Trademark Act, there is no logical reason not to apply the same analysis when assessing specimens submitted in support of a Section 8 affidavit or a renewal application. If a trademark owner may register a severable element of a composite mark, it follows that the owner may maintain a registration of such an element.

The registered mark in this case consists of the word DE WITT'S (stylized), while the mark currently used, as evidenced by the renewal specimen, consists of the word DE WITT plus a globe design. The acceptability of the specimen turns upon the question of whether the essence of the registered mark [FN5] makes an impression apart from the other elements of the composite mark now in use. If the registered mark is so merged with the other elements that it does not make a separate

impression, then the specimen cannot be accepted. On the other hand, if the registered mark does make a separate impression, then the specimen may be accepted as evidence that the registered mark is still in use in commerce.

The decision as to whether a renewal specimen supports a claim of current use of a registered mark rests with the Examiner. In the instant case, the record indicates that the Examiner's refusal was based solely upon the refusal of the Section 7 amendment, rather than upon a separate analysis which included consideration of the question of whether the registered mark is a severable element of the composite mark currently used. Accordingly, the application for renewal is hereby remanded to the Examiner for reconsideration in accordance with this decision.

The petition is granted. The Office action of January 3, 1991 is vacated, and the renewal application is remanded to the Examiner for reconsideration of the sufficiency of the renewal specimen. The Examiner will also consider the merits of petitioner's January 24, 1991 response to the Office action dated July 24, 1990.

The registration file will be forwarded to the Post Registration Section for action in accordance with this decision.

FN1. Effective November 16, 1989, Section 7(d), 15 U.S.C. § 1057(d), was redesignated 7(e), 15 U.S.C. § 1057(e), but the text remains unchanged.

FN2. This issue is not the subject of this petition and shall not be considered herein.

FN3. This response has not yet been considered by the Affidavit-Renewal Examiner.

FN4. To the extent that Trademark Manual of Examining Procedure § § 1603.09 and 1605.07 suggest otherwise, it is suggested that they be revised.

FN5. In this regard, the use of the singular rather than the possessive form of the name DE WITT is not deemed to be a material alteration of the registered mark, as it does not significantly alter the term's meaning or impression. See Hess's of Alentown, Inc. v. National Bellas Hess, Inc., 169 USPQ 673 (TTAB 1971).

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