

This Response is submitted in reply to the Office Action dated February 2, 2021, in which the Examining Attorney issued a refusal under Sections 1 and 45, stating that the mark on the drawing did not match the mark on the specimen. As demonstrated by the arguments and relevant case law provided below, Applicant requests that the Section 1 and 45 refusal be withdrawn, and the application be approved for publication.

THE MARK ON THE DRAWING MATCHES THE MARK ON THE SPECIMEN

The standard for whether a mark on a drawing matches a mark on a specimen requires that the mark be “complete.” When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as a “mutilation” of the mark. This term indicates that **essential and integral** subject matter is missing from the drawing. (Emphasis added.) *See In re Chem. Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Semans*, 193 USPQ 727 (TTAB 1976).

The Examining Attorney notes that the mark as displayed on the specimen of record shows the term “PLATINUM™” to the right of the wording “POLYCOR™.”



However, an applicant may obtain registration of one element of a composite mark if that element presents a separate and distinct commercial impression:

[A]n 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.** An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen, i.e., the element performs a trademark function in and of itself.

TMEP § 807.12(d) (boldness added; citing *In re Univ. of Miami*, 123 USPQ2d 1075, 1079 (TTAB 2017)).

Courts have long recognized this right to registration of one part of a composite mark. *See In re Servel, Inc.*, 181 F.2d 192, 982 (CCPA 1950) (“The courts in a proper case may recognize the right to registration of one part of an owner’s mark consisting of two parts”). Under this principle, “an applicant’s use of its corporate name or house mark along with another trademark or trade name does not create a unitary mark.” *In re Royal Bodycare, Inc.*, 83 USPQ2d 1564 (TTAB 2007). In other words, seeking to register a single mark that is part of a composite mark

is not impermissible “mutilation” if the separate portion of the mark creates a separate and distinct impression. *Univ. of Miami*, 123 USPQ2d 1075. And, mere proximity of the marks does not necessarily render them a unitary mark. *Dena Corp. v. Belvedere Int’l Inc.*, 960 F.2d 1555, 1561 (Fed. Cir. 1991).

Accordingly, the proper test for whether a mark is “mutilated” in a drawing requires that the elements be inseparable, essential, and integral to each other. As reinforced by the relevant case law discussed below, the terms “POLYCOR” and “PLATINUM” are neither inseparable, integral, nor essential to each other. Each word stands alone as its own trademark, which understanding is reinforced by the fact that the trademark symbol “™” appears after each separable term.

In the above mentioned *In re Univ. of Miami* case, the TTAB ruled that the literal elements included on the specimen of record were separable from the design of an ibis, and that the drawing and specimen were substantially exact:



The TTAB noted that despite the letter “U” appearing on the hat, the word “MIAMI” on the shirt, and the pinstriping on the shirt, the drawing and specimen matched. This is particularly relevant as the stylized word MIAMI is a trademark and the orange and green “U” logo is a registered trademark (Reg. Nos. 4977032, 3564647 & 1752939) of the University of Miami.

In a similar precedential case, *In re Big Pig, Inc.*, 81 USPQ2d 1436 (TTAB 2006), the Board held that PSYCHO creates a separate commercial impression apart from additional wording and background design that appears on the specimen, despite being overlaid directly on it:

PSYCHO

vs.

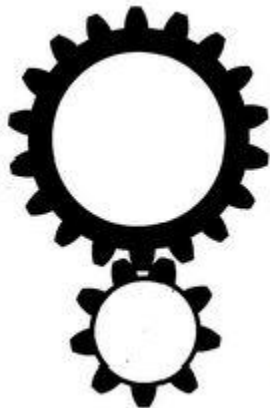


Similarly, the TTAB in *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446 (TTAB 2006) held that the drawing for WSI and Design matched the specimen for WSI and Design, despite the fact that the specimen had a curving arc underlaying the lettering, while the drawing did not:



Other precedential TTAB decisions in which the Board held that the drawing and specimen matched include the following:

In re Nat'l Inst. For Auto Serv. Excellence, 218 USPQ 744, 745 (TTAB 1983):



vs.



and *In re Sterno, Inc.* 137 USPQ 328 (TTAB 1963):



vs.



Additionally, examples of non-precedential cases where the TTAB held the drawing and specimen matched include *In re Enterprise Holdings, Inc.*, Serial No. 85675437 (TTAB 2014):



vs.



In re ITT Industries, Inc., Serial No. 78456701 (TTAB 2006):



vs.



and *In re Jordan Outdoor Enterprises, Ltd.* (TTAB 2006):

REALTREE HARDWOODS GREEN HD vs.



Notable in all of the above cases is that the additional wording and design elements are overlaid or interwoven with each other, yet the TTAB ruled the matter to be separable in each case.

In the present application, the terms “POLYCOR” and “PLATINUM” are even more separated than in the cases listed above. The terms do not touch each other, are not overlaid or underlaid on one another, and do not intersect or intertwine with themselves in any manner. In addition, there is clearly a space between the terms, AND the “™” also serves to indicate to consumers that each term is its own separate trademark. Both the space and the “™” serve to separate the two marks to a sufficient degree that consumers can clearly perceive a separate and distinct commercial impression of “PLATINUM” mark apart from any other matter with which the mark is used on the specimen. The element performs a trademark function in and of itself. Further, “POLYCOR” is not integral to “PLATINUM,” and thus fails to meet the standard for a mutilation refusal established by the case law listed in TMEP §807.12(d).

It is common practice for multiple trademarks to appear together either in co-branding situations or in the case of house marks combined with subsidiary trademarks. While Applicant’s PLATINUM mark is used in the present case adjacent the POLYCOR mark, proximity alone does not create a single unitary mark. *E.g. Royal Bodycare*, 83 USPQ2d 1564. In the composite POLYCOR™ PLATINUM™, the PLATINU mark conveys a separate and distinct commercial impression from the POLYCOR mark. *See* TMEP § 807.12(d); *In re Univ. of Miami*, 123 USPQ2d 1075, 1079 (TTAB 2017); *In re Royal Bodycare, Inc.*, 83 USPQ2d 1564 (TTAB 2007). Further, Applicant’s customers and those familiar with the flexible pipe industry as a whole recognize PLATINUM to be a separate and distinct mark apart from the POLYCOR mark. Accordingly, the submitted specimen showing the use of POLYCOR™ PLATINUM™ on Applicant’s pipe product is therefore proper.

CONCLUSION

Because the terms do not touch in any way, and have a clear space *and* “™” separating them, the two marks are not integral to one another, and create separate and distinct commercial impressions on their own. Further, because TMEP §807.12(d) grants an applicant latitude in what it wants to register, as the case law on separability clearly demonstrates, the specimen refusal under Sections 1 and 45 of the Trademark Act should be withdrawn. The arguments set forth in this response are believed to fully address the Examining Attorney’s concerns and the application is believed to be in condition for publication, which action is respectfully requested.

If a telephone conference would assist in resolving any issues, please contact the undersigned attorney.

Respectfully submitted,

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