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

RE: TRADEMARK REGISTRATION OF DILLARD DEPARTMENT STORES, INC.
93-151
August 9, 1993
***1** Petition Filed: May 3, 1993

For: IN VEST MENTS and Design
Registration No. 1,207,354
Issued: September 7, 1982

Robert M. Anderson

Acting Assistant Commissioner for Trademarks

On Petition

Dillard Department Stores, Inc. has petitioned the Commissioner, pursuant to Trademark Rule 2.146, to grant its request to amend the mark of the above registration.

Facts

Registration No. 1,207,354 issued on September 7, 1982 for the design mark presented below for "pants, skirts, blazers, sweaters, and blouses" in Class 25. On April 12, 1988, petitioner timely filed a combined declaration under Sections 8 and 15 of the Trademark Act, 15 U.S.C. § § 1058 and 1065, which the affidavit/renewal examiner accepted on September 21, 1988.

On May 14, 1992, petitioner filed a request to amend the mark pursuant to Section 7(e) of the Trademark Act, 15 U.S.C. § 1057(e). The original mark and the proposed amended mark are shown below:

Mark as Registered

Proposed Amended Mark

In a letter dated July 27, 1992, the post-registration examiner notified petitioner that, among other things, the amendment of the mark was not acceptable because it constituted a material alteration of the mark, prohibited by Section 7(e).

On January 27, 1993, petitioner filed a response in which it argued for acceptance of the proposed amendment. On February 26, 1993, petitioner filed a certified copy of the registration, as required by Trademark Rule 2.173.

In a letter dated March 4, 1993, the post-registration examiner notified petitioner of the continuation of the refusal to accept the amendment to the mark and, also, that petitioner's recourse was to petition the Commissioner to review the decision. The subject petition followed on May 3, 1993.

Decision

Section 7(e) of the Trademark Act authorizes the Commissioner, for good cause, to permit a registration to be amended, provided that the amendment does not materially alter the character of the mark. See also Trademark Rule 2.173(a) and Trademark Manual of Examining Procedure (TMEP) § 1607.02 et seq. Requests for an amendment are handled in the first instance by an examiner in the Post Registration Section of the Patent and Trademark Office (the Office). Trademark Rule 2.176.

An amendment to a registered mark may be accepted only if the modified mark is essentially the same as the registered mark. Deleting or changing a feature of a registered mark is permitted only if the feature is not an integral part of the mark, such that its elimination or change will not materially alter the character or commercial impression of the mark. Eliminating or changing a prominent feature often results in a material alteration prohibited by Section 7. In re Richards-Wilcox Manufacturing Co., 181 USPQ 735 (Comm'r Pats. 1974); Ex parte Black & Decker Mfg. Co., 136 USPQ 379 (Comm'r Pats.1963); and Ex parte Kadane-Brown, Inc., 79 USPQ 307 (Comm'r Pats.1948). See also Holland America Wafer Company, 737 F.2d 1015, 222 USPQ 273 (Fed.Cir.1984); In re E.M. Townsend & Co., 143 USPQ 318 (Comm'r Pats.1964); TMEP § 1207.02(a); and Examination Guide 2-89, titled "Drawings of Marks," which issued on March 12, 1990.

***2** Petitioner seeks to amend the registered mark by eliminating features, such as: (1) the overall triangular appearance, (2) the syllabication in which syllables are separated by dots and appear on different lines, in a step fashion, and (3) a series of 30 dots which form a 90-degree wedge that frames the syllables, completing two sides of the triangle. Petitioner's new drawing presents a mostly rectangular mark which has a solid border and the singular term, "investment," in a new type style.

Petitioner argues the following:

> [T]hat the current mark as registered is one hyphenated word with a minimal background framing design. The amendment at issue merely removes the hyphens in the registered mark and maintains the commercial impression of one word-- the word "investments." As amended no change is made in the meaning of the wordmark.

However, consideration of only the terminology contained in a mark is not the test to determine whether a proposed amendment constitutes a material alteration, as discussed above. Contrary to petitioner's

assertion of "a minimal background framing design," clearly the registered mark contains salient design features apart from the word portion. Moreover, the manner in which the mark presents syllables on separate lines, instead of a singular term, is also significant in creating the commercial impression of the mark. With respect to meaning alone, for example, the syllabication and unique layout could lead someone to view the mark as a play on the terms "in" and "vestments," especially when considering that the recited goods are garments. Petitioner acknowledges this connotation. [FN1]

Trademark Rule 2.176 permits a registrant to petition the Commissioner for review of an adverse action by an examiner on a request for amendment of a mark. 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) and Ex parte Peerless Confection Company, 142 USPQ 278 (Comm'r Pats.1964). In the instant case there is no showing of clear error or abuse of discretion on the part of the examiner. Instead, the proposed changes eliminate prominent features of the mark and, thus, it was reasonable for the post- registration examiner to concluded that the commercial impression of the amended mark was materially different from the mark as registered. [FN2]

Accordingly, the petition is denied. The registration file will be returned to the Post Registration Section for further processing.

FN1. Petitioner also argues that the amendment should be permitted since Office correspondence and search data bases have referred to the mark as "IN.VEST.MENTS and Design." However, a general listing of a mark, which is merely intended to provide verbatim terminology and indicate the format of the drawing, is irrelevant to determining whether a proposed amendment constitutes a material alteration of a mark. The mark is what is actually depicted in the drawing, not the information provided in a brief description.

FN2. Petitioner also appears to argue that because the Office previously accepted its combined Sections 8 and 15 declaration, wherein a specimen bearing the new mark was submitted, the Office should also permit the subject proposed amendment to the mark under Section 7. 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. Although a significant design element in a mark cannot be changed 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 support a claim of use in commerce for purposes of renewal. In re DeWitt International Corp., 21 U.S.P.Q.2d 1620 (Comm'r Pats.1991).

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