

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
September 16, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re 3P Learning Pty Ltd.
—

Serial No. 85641327
—

Mark Andrew Goldstein of SoCal IP Law Group LLP for 3P Learning Pty Ltd.

Toby E. Bulloff, Trademark Examining Attorney, Law Office 119 (J. Brett Golden,
Managing Attorney).

—
Before Quinn, Kuhlke and Gorowitz, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, 3P Learning Pty Ltd., filed an application to register on the
Principal Register the mark shown below

learn grammar and languages and for educating, entertaining and amusing children” in International Class 42.¹

The application also includes the following description of the mark:

The mark consists of a circle divided in half, on the left side of the circle is a picture of the western hemisphere of the globe and on the right side of the circle shows college ruled paper; on the second line of the paper is the word "litarasy" with scribbled lines through the word; on the third line of the paper is the word "literasey" with a line through the word; on the fourth line of the paper is the word "literacy" with the tip of a feathered pen resting on the end on the "y" of the word "literacy"; spaced round the world are smiling figures with hats that have the 12 different countries flags in the front of the figures; in between each figure are ", ; ? & * 's ing - ! : and ed"; located at the bottom of the image is the wording "WORLD LITERACY DAY" in bold with a shadowed background.

Registration has been refused under Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b), on the ground that Applicant’s mark consists of or comprises the flags of various foreign countries.²

When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed the refusal. We reverse the refusal to register.

Section 2(b) of the Trademark Act prohibits registration of a mark if it “[c]onsists of or comprises the flag or coat of arms or other insignia of the United

¹ Application Serial No. 85641327, filed on June 1, 2012, under Section 44(e), 15 U.S.C. § 1126(e), asserting priority based on an Australian application under Section 44(d), 15 U.S.C. § 1126(d).

² The application was approved for publication on January 28, 2013. On February 11, 2013, it was withdrawn from publication due to indefinite wording in the Class 42 recitation of services (not an issue on appeal) and for this refusal under Section 2(b).

States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 U.S.C. § 1052(b). The Trademark Manual of Examining Procedure (TMEP) provides the following guidance in determining whether or not a mark falls within the proscription:

Marks containing elements of flags in a stylized or incomplete form are not refused under § 2(b). ... If the flag design fits one of the following scenarios, the examining attorney should not refuse registration under § 2(b): The flag design is used to form a letter, number, or design. The flag is substantially obscured by words or designs. The design is not in a shape normally seen in flags. The flag design appears in a color different from that normally used in the national flag. A significant feature is missing or changed.

TMEP § 1204.01(b).

In maintaining the refusal, the Examining Attorney argues that:

[T]he flags remain in their usual rectangular shape with the same proportions and designs of their countries [sic] usual flags. Applicant’s own mark description indicates that the drawing includes “12 different countries’ flags.” Moreover, the flags are easily recognizable, especially in light of the “world” or international theme of the mark. These flags are not distorted or obscured. Rather, they overlay other matter in the mark, and their appearance is clearly that of “12 different countries’ flags,” as noted in the applicant’s own mark description. ... [E]ach rectangular flag is prominently superimposed over a human figure design, and each country’s flag is readily apparent as each country’s formal emblem. None of the flag stripes or images are highly stylized or changed so as to blur or alter the traditional flag design of each country. Even portrayed in black and white, the flags are easily recognizable as representations for each country, e.g., United Kingdom, United States, Canada, Australia, etc. ... In this case, the mark contains supporting evidence that each black-and-white flag represents a certain country around the world as each figure is meant to represent a certain country based on skin color, choice of

hat or headdress, etc. Also, the figures are positioned around a globe and with the wording “WORLD LITERACY DAY,” reinforcing the notion that the literacy project is held around the world and in many different countries.

Ex. Att. Br. p. 8.

In support of her position, the Examining Attorney submitted excerpts from The World Fact Book retrieved from the Central Intelligence Agency’s website, displaying various countries’ flags, including the United Kingdom, United States, Canada, Australia and South Africa. While the Examining Attorney argues the mark includes 12 countries’ flags she only identifies the United Kingdom, United States, Canada, Australia and South Africa. The flags of these countries can be identified and compared to the flags shown in the excerpt from www.cia.gov submitted by the Examining Attorney. However, the specifics of the remaining flags are not clear or distinct enough to be matched to any of the pictures in the excerpt. Because the Examining Attorney has not specified any flags other than those of the United Kingdom, United States, Canada, Australia and South Africa as having been incorporated into the mark, we view the refusal as asserting only impermissible use of those flags. Our analysis, however, focuses on the composite mark and whether the composite makes impermissible uses of those particular flags.

Applicant argues that its mark “has been registered in two Paris Convention countries that, like the United States, prohibit marks containing flags of member countries. Just as the mark was allowed to be registered in Australia and the United Kingdom, so should the mark be allowed to obtain registration in the United

States. Moreover, the overall design shows the flags are integrated into the mark as torsos to form multicultural persons, embellished with traditional cultural hats and head coverings, arranged around a globe interspersed with punctuation further enhanced with text and a feather pen.” App. Br. p. 1.

We first address Applicant’s argument based on registrations for the same mark in other countries that are also members of the Paris Convention.³ “Article 6ter of the Paris Convention provides protection for national symbols (such as flags and armorial bearings) of countries as well as the armorial bearings, flags, abbreviations, and names of international intergovernmental organizations. ... The other member states agree to refuse to register, cancel any registration of, and prohibit the use without authorization of marks that incorporate such designations ... if the offending mark misleadingly suggests to the public that a connection exists.” See *International Finance Corp. v. Bravo Company*, 64 USPQ2d 1597, 1602 (TTAB 2002). See also Paris Convention, art. 6ter(1)(a).

Article 6ter(1)(a) provides a baseline for protection, but it does not impose a cap on how restrictive a country may be in prohibiting registration of national symbols, including flags. Article 6ter(1)(c) of the Paris Convention provides that “The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or

³ International Convention for the Protection of Industrial Property, Mar. 20, 1883, as revised at Stockholm on July 14, 1967 (“Paris Convention”), available at http://www.wipo.int/treaties/en/ip/paris/trtdocx_wo020.html.

if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.” While this provision in the Paris Convention contemplates registration of such matter where it does not suggest a connection to the flags, etc., it also does not prohibit a more restrictive approach to such matter.

Differences that may exist between jurisdictions in their treatment of national symbols and flags do not violate the United States’ obligations under the Paris Convention as long as the USPTO complies with the minimum requirements of Article 6*ter* and treats domestic and foreign applicants in the same manner. “[T]he Paris Convention is essentially a treaty between the various member countries by which each member country accords to citizens of the other contracting countries the same trademark and other rights accorded to its own citizens by its domestic law. The underlying principle is that foreign nationals should be given the same treatment in each of the member countries as if they were citizens of that country. The Paris Convention is not premised upon the idea that trademark laws of each member nation shall be given extraterritorial application, but on exactly the converse principle that each nation’s law shall only have territorial application.” *International Finance Corp. v. Bravo Company*, 64 USPQ2d at 1601-02; *see also* Paris Convention art. 2 (“Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws not grant, or may hereafter grant, to nationals”); and art. 6(1) (“The conditions for the filing and registration of

trademarks shall be determined in each country of the Union by its domestic legislation.”).

In view thereof, how other jurisdictions apply Paris Convention Article 6*ter* under their domestic laws, in any particular case, is not instructive. *In re District of Columbia*, 101 USPQ2d 1588, 1596 (TTAB 2012), *aff'd*, *In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013) (Paris Convention does not “prohibit signatory states from adopting different or more restrictive rules not inconsistent with it.”).

Moreover, as the Examining Attorney noted, prior decisions and actions of other trademark examining attorneys have little evidentiary value and are not binding on the Board, in particular when the “examinations are done in foreign countries.” *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

The question before us then is whether the flags appearing in Applicant’s mark fall within the proscription of Section 2(b). Applicant argues that

[T]he overall impression of Applicant’s design is of a group of multicultural citizens around the globe. The overall impression rather than the design’s constituent elements should be considered in determining the protectability of the mark. Applicant’s design includes specific text, punctuation, a globe and flags integrated as torsos to form persons to evoke the international aspects of the mark and the services for which it stands. [] Applicant’s design also includes the phrase “world literacy day” and a memorable feather pen which serves to further establish the overall impression of the mark. ... Further, stylized designs that include flags are not refused under § 2(b). Because Applicant’s design uses flags in a stylized manner as torsos of persons with arms, legs and heads

embellished with culturally appropriate hats and head coverings that form individual persons around a globe interspersed with punctuation further enhanced with text and a memorable feather pen, we submit that the mark including the stylized use of flags is entitled to registration Simply put, the flags are not used as, nor would they be interpreted as flags per se.

In the Applicant's design mark individuals are represented by torsos having hats, heads, arms and legs in which the torsos include images that are not true flags but serve to individually indicate their nationality and collectively indicate the international flavor and nature of the Applicant's services. That each "flag" has arms, legs and a head evocative of various cultures and ethnicities shows that the torsos are not used as flags in the traditional sense to indicate an association with a particular nation state. Because the flags are included in shapes – that is, as portions of people – not normally associated with flags, the shapes form a protectable design, namely a ring of multicultural individuals around a globe. We submit that the representations of flags are not separately distinguishable from the overall design.

App. Br. pp. 3-4.

The Examining Attorney notes that the flags in this mark are "easily recognizable"; however, that is also the case in the examples of registrable marks displayed in the TMEP at Section 1204.01(b), shown below:



In addition, while the flags in Applicant's mark are not "highly stylized or changed so as to blur or alter the traditional flag design of each country," (Ex. Att. Br. p. 8) their use as the torso of each figure is use "to form a design." TMEP § 1204.01(b).

Relying on examples where refusals are indicated in the TMEP, due in part to the fact that a word in the design emphasizes that it is a simulation of the flag,



e.g., **SWISS GUARD**, the Examining Attorney argues that the globe and the wording "WORLD LITERACY DAY," reinforce the notion that the literacy project is held around the world and in many different countries. However, in *In re Waltham Watch Company*, 179 USPQ 59, 60 (TTAB 1973), the Board observed that the mark



"would be regarded as nothing more than a conglomeration of

nondescript flags utilized to symbolize the significance of the globe design and the slogan “TIMING THE WORLD” appearing thereon.” Similarly, we find that the globe and the wording “WORLD LITERACY DAY” rather than emphasizing the individual country flags, serves to minimize their individual impact and emphasizes the international aspect of the applied-for goods and services. We acknowledge that the flags in Applicant’s mark are not “nondescript,” but rather have, as the Examining Attorney states and Applicant’s description provides, the appearance of “12 different countries’ flags.” In addition, they are not stylized in such a manner to blur the flag design. However, the use of the flag in a manner that serves as the torso of the individuals is not a traditional flag design and while they may be generally recognizable, as incorporated in this mark, they do not have the commercial impression of national flags but rather as designations of individuals from various nations.⁴

In determining whether or not a mark falls within the proscription of Section 2(b) we must consider “the commercial reaction that it imports to viewers.” *Knorr-Nahrungsmittel Aktiengesellschaft v. Havland International, Inc.*, 206 USPQ 827, 832 (TTAB 1980) (“[T]he proof is the actual mark itself as used on the specimens submitted with the application and the commercial reaction that it imports to viewers.”) The example provided by the Examining Attorney where the flag is

⁴ We note that although the description of the mark does not specifically state that the mark comprises “stylized flags,” see TMEP § 1204.01(d), it is the drawing that depicts the mark to be registered. Trademark Rule 2.52, 37 C.F.R. § 2.52. Similarly, while the description refers to the flags as being “in front of the figures,” they are not being held by the figures and in one case the flag is under the figure’s collar, all of which gives the impression that they are part of the design of each individual.

Serial No. 85641327

attached to a guitar functioning as the flag pole and the mark emphasizes use of a flag as a flag is very different from the case here where the flags are not being displayed as flags, but rather are incorporated into the design as torsos of individuals. In this case, where each flag forms the torso of individuals positioned in a circle around a globe signifying the international aspect of Applicant's goods and services we find that it is not barred by Section 2(b).

Decision: The refusal to register under Section 2(b) of the Trademark Act is reversed.