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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carl Walther GmbH

Serial No. 77096523

Karen A. Brennan of Winthrop & Weinstine, P.A. for Carl
Walther GmbH.

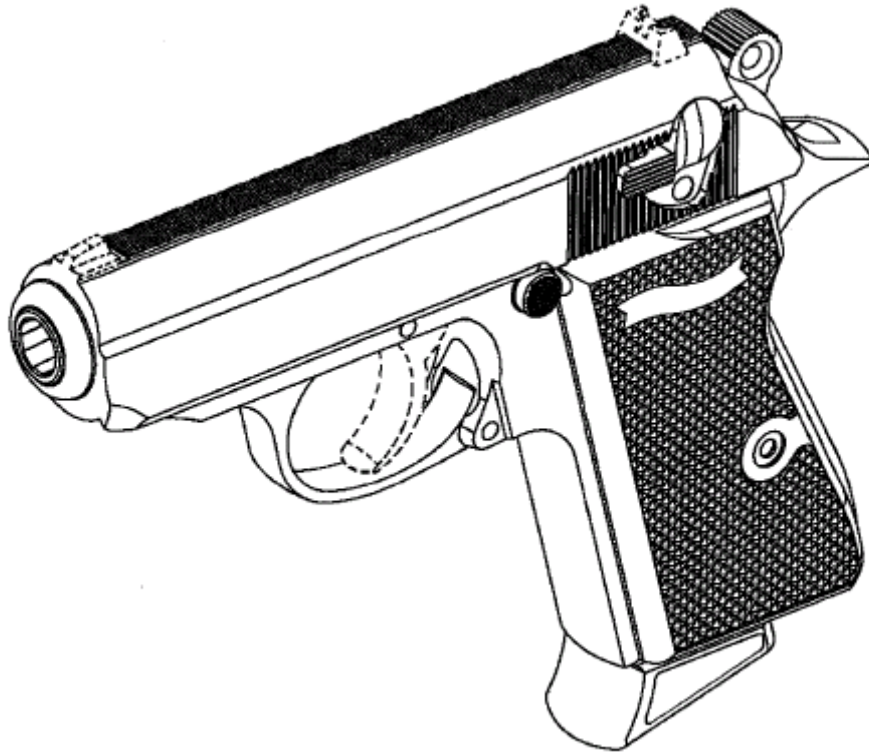
Seth A. Rappaport, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Kuhlke, Cataldo and Wellington,
Administrative Trademark Judges.

Opinion by Wellington:

On February 1, 2007, Carl Walther GmbH filed an
application to register as a trademark on the Principal
Register the product configuration design shown below for
"firearms; pistols; and air soft guns" in International
Class 13.¹

¹ Serial No. 77096523, filed under Section 1(a) of the Trademark
Act based on an allegation of first use anywhere and in commerce
on June 30, 1969.



Applicant subsequently amended the application to seek registration under Trademark Act Section 2(f). The mark is described as follows:

The mark consists of the three-dimensional configuration of a pistol. The mark includes the overall size and shape of the pistol and the external accents and features of the pistol. The mark includes the relative proportions of the external accents and features of the pistol. The mark includes the lines and ridges along both sides of the slide, barrel, and frame indicating grooves and ridges on the surface of the pistol; the vertical and angular lines on the rear of the slide indicating ridges on the surface of the pistol; the pattern on the hand grip; the shape and location of the magazine release lever; the shape and appearance of the trigger guard; the exterior shapes and designs on the hand grip or other portions of the pistol and the placement or position of those shapes; the shape and proportion of the barrel, and the shape,

proportion, and position of the accessory rail. The dotted lines indicate features that are not claimed as a part of the mark including: the shape of the front sight and rear sight; and the shape of the trigger.

The trademark examining attorney has finally refused registration under Trademark Act Sections 1, 2, and 45 on the ground that the design sought to be registered (hereinafter "PPK handgun design"²) is not inherently distinctive and that applicant has not established acquired distinctiveness.³

Applicant filed a request for reconsideration which was denied by the examining attorney. Applicant and the examining attorney then filed briefs.

Since applicant seeks registration under Trademark Act Section 2(f), the only issue before us is whether applicant has established that the PPK handgun design has acquired distinctiveness.

In its brief and in arguing that its PPK handgun design has acquired distinctiveness, applicant initially contends that the handgun, itself, has a "definite aura" and "mystique" surrounding it, mainly as a result from being known as "James Bond's gun" and through years of

² "PPK" is the model designation of applicant's handgun bearing the design attributes that constitute the proposed mark which applicant asserts has acquired distinctiveness.

³ We note that the examining attorney raised and subsequently withdrew a functionality refusal to registration of the mark.

"extensive use and the repeated appearance of the PPK design in popular culture." Brief, p. 1. Applicant then argues that the evidence it has submitted is "substantial, indeed almost overwhelming" in support of its contention that the handgun design has acquired distinctiveness. Brief, p. 2. As for direct evidence, applicant relies on a consumer recognition survey that it commissioned as well as declarations from individuals attesting to the "distinctiveness and notoriety" of the PPK handgun design. In addition, applicant relies on circumstantial evidence such as its use of the PPK handgun design for over forty years, sales, unsolicited media coverage, and advertising and promotional efforts, to establish that its proposed mark has become distinctive of applicant's handguns.

The examining attorney takes the position that applicant's PPK design mark is "a commonly used configuration of pistols" (brief, (unnumbered) p. 7) and that evidence submitted in support of the final Office action establishes that "other pistols contain the same placement of the elements that make up applicant's mark." Brief, (unnumbered) p. 8. He argues that "[t]his evidence clearly shows that the applied-for mark is nearly identical to many pistol designs in the marketplace." Furthermore, the examining attorney was not persuaded by applicant's

direct and circumstantial evidence. In particular, he contends that there is "nothing in the applicant's advertising materials that inform the consumer of how to identify the applicant's goods and distinguish them from similar goods in the marketplace." Brief, (unnumbered) p. 13. He points to the absence of any "look for" advertisements. As to the survey, the examining attorney acknowledges that "many of the respondents...stated that they believed the silhouette or outline of the Walter PPK is recognizable as a trademark"; however, he argues that this just shows that "applicant's goods have achieved a level of fame" and "does not show that consumers recognized the configuration of the pistol as a mark that identifies the applicant as the source of the goods." Brief, (unnumbered) pp. 14-15. The examining attorney also takes issue with the survey because it used a random sample from subscribers to certain magazines and thus "only survey[ed] consumers with extensive knowledge of handguns" rather than the "public." Brief, (unnumbered) p. 15. And, as to the declarations of individuals, the examining attorney states that applicant "merely surveyed individuals who have superior knowledge about the applicant's goods based on their substantial and continuous involvement in the field of handguns." *Id.* Ultimately, the examining attorney

concludes that applicant has failed to show that the PPK handgun design has acquired distinctiveness.

In its reply brief, applicant asserts that the examining attorney improperly dismissed or disregarded applicant's evidence, and attacked it in piecemeal fashion rather than considering all evidence in its entirety. Applicant, in particular, takes issue with the examining attorney's attacks on the probative value of the consumer recognition survey and the declarations and, ultimately, failed to rebut applicant's evidence.

There is no question that the burden of proving acquired distinctiveness in an ex parte proceeding rests with applicant. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1576, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); citing *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1405, 222 USPQ 939, 942 (Fed. Cir. 1984); see also, *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). There is no clear standard as to the amount of evidence necessary for allowing a mark to register under Section 2(f); indeed, as our primary reviewing court noted:

...the statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.

As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Yamaha Int'l Corp., 6 USPQ2d at 1008. Nevertheless, it has been observed that an applicant faces a heavy burden in cases such as the one before us where applicant is attempting to establish the distinctiveness of a product design. *Id.*; see also, *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000).

Ultimately, to establish acquired distinctiveness, an applicant must show that the product configuration is perceived by consumers as not just the product but, rather, that the design identifies the producer or source of the product. This may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and

advertising, and any similar evidence showing wide exposure of the mark to consumers. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 15:30 (4th ed. Updated 2010).

After careful consideration of the evidence submitted in this case and the arguments made, we are persuaded that applicant has, at least, made a prima facie case that its mark has acquired distinctiveness and the examining attorney has not sufficiently rebutted this showing.

Applicant's direct evidence that the PPK handgun design has acquired distinctiveness primarily consists of a consumer recognition survey.⁴ Applicant commissioned a blind, online survey of individuals (over 18 years old) who "own a handgun or plan on purchasing a handgun in the near future" and have not previously worked for a gun manufacturer. The eligible individuals were instructed "we are going to show you four different images of pistol shapes and then ask you to respond to some questions about

⁴ A declaration, with exhibits, of Riva Kupritz, a Principal of Outsource Marketing, a Minnesota company, was attached as Exhibit 4 to applicant's Request for Reconsideration (filed on August 10, 2009). In her declaration, Ms. Kupritz describes the pistol configuration survey and results that Outsource Marketing conducted on behalf of applicant. The exhibits to the declaration include copies of Ms. Kupritz's curriculum vitae and various printouts involving the survey. Applicant also submitted the declaration of Karen Brennan, an attorney with the law firm representing applicant, in support of the consumer survey.

each pistol shape." The participants were then shown the images and asked whether or not they were able to identify each pistol "based on [their] shape[s]" and, if so, to identify the "company or companies that make a pistol with this shape." Applicant's PPK handgun design was among three other handguns from various manufactures shown to the survey participants.⁵ Approximately 54% of the participants who completed the survey stated that they were able to identify who makes applicant's PPK pistol based on the shape of the pistol; and 33% of survey participants correctly identified applicant, or its licensee, as the maker. That is, over half of the survey participants associated PPK handgun design with a single source and approximately one-third of the participants were able to correctly identify the source. These percentages are not out of line with previous cases where secondary meaning or acquired distinctiveness in a mark has been established. *Cf., In re Owens-Corning Fiberglas Corp.*, 774 F.2d 116, 227 USPQ 417, 424 (survey showing 41% and 50% recognition, submitted together, found sufficient to establish acquired distinctiveness of trade dress); *Zatarains, Inc. v. Oak*

⁵ A second survey was conducted in the same manner but substituting a slightly different model of handgun of applicant's for the PPK. We only rely on the results of the first survey, involving the PPK handgun design.

Grove Smokehouse, Inc., 698 F.2d 786, 217 USPQ 988 (5th Cir. 1983) (23-28% correct responses sufficient to establish secondary meaning); and *In re Jockey Int., Inc.*, 192 USPQ 579, 581 (TTAB 1976) (survey showing 51.6% recognition found sufficient to establish acquired distinctiveness for trade dress). We do not find these survey results, alone, to be conclusive in establishing that the PPK handgun design has acquired distinctiveness; rather, the survey is one piece of persuasive evidence that is considered in conjunction with the entire record before us.

As noted, the examining attorney attacks the survey's probative value. However, in doing so, he appears to contradict himself by stating that "[m]any of the respondents...stated that they believed the [PPK handgun design] is recognizable as a trademark" and later, in the same paragraph, that the survey "does not show that consumers recognize [PPK handgun design] as a mark that identifies the applicant as the source of the goods." Brief, (unnumbered) p. 15. If consumers recognize the PPK handgun design as a trademark, then by definition, they are viewing the PPK design as a source identifier. We also disagree with the examining attorney's reasoning that the survey is flawed because the participants were subscribers

to publications in the field of handguns. The examining attorney asserts that "by only surveying consumers with extensive knowledge of handguns, the applicant has not shown that the *public* recognizes that [the PPK handgun design] identifies the source of the goods." Brief, at (unnumbered) p. 15 (*emphasis* added). First, applicant need only show that the mark has become distinctive as a source identifier in the minds of consumers or prospective consumers of handguns, and not the "public" at large. Second, we have no reason to believe that merely because someone is a subscriber to a handgun publication that he or she has "extensive knowledge" of handguns. Rather, as previously noted, the survey results were obtained only from participants who stated that they owned a handgun or were in the market to purchase one, and have not worked for a gun manufacturer.

In addition to the survey, applicant submitted other direct evidence that its PPK handgun design has become distinctive. Mr. S.P. Fjestad, an author and publisher of authoritative books on handguns, states that consumers do consider the design of a handgun when choosing to purchase and "[w]hile there have never been more configurations of semi-automatic handguns available, there are certain handgun configurations that are more recognizable and stand

out as trademarks from the crowded field of handguns in the market. One of the most recognizable handgun configurations among handgun consumers is the Walther PPK." Fjestad dec., para. 4.⁶ Mr. Fjestad describes in his declaration the reasons why he believes the PPK handgun design is now "unique and identifiable and as coming from a single source." *Id.*, para. 5. Inasmuch as Mr. Fjestad is extremely knowledgeable about handguns, he cannot be considered a typical consumer of handguns. Nevertheless, his declaration makes it clear that he is just as knowledgeable about the marketplace for handguns and, in particular, how and why consumers make their purchasing decisions regarding certain handguns. In this respect, his declaration is persuasive.

As to circumstantial evidence, applicant has submitted declarations and other evidence showing that it has made substantial efforts in promoting the PPK handgun since it

⁶ Mr. Fjestad's declaration was submitted as Exhibit 7 to applicant's Request for Reconsideration (filed on August 10, 2009). In his declaration, Mr. Fjestad states he is an author and publisher of several books on firearms, including the *Blue Book of Gun Values* that contains "nearly 2,300 pages of detailed pricing and information on thousands of modern and antique firearms" and has a circulation of over 1.3 million copies worldwide. Mr. Fjestad has over twenty-five years experience in the field of compiling information on handguns and has "had extensive exposure to almost every type and brand of handgun currently manufactured or discontinued, including the Walther PPK."

was first introduced for sale in the United States in 1968.⁷ Applicant advertises the PPK handgun extensively in trade publications, on websites and in various magazines featuring firearms. For the period 2004-2007 alone, applicant spent approximately \$ 920,000 for such advertisements. By way of these advertisements, applicant often presents the PPK handgun with a full pictorial representation and touts the "sleek, elegant lines have excited shooters from the moment it was created over 75 years ago."⁸

Applicant has clearly benefited from extensive unsolicited media exposure as a result of the PPK handgun being used as a prop in nearly all of the James Bond films for approximately forty years and, indeed, the handgun is frequently referred to as "James Bond's weapon of choice." The record includes printouts from various James Bond film advertisements prominently displaying the PPK handgun as well as various other media references mentioning the connection between James Bond and the PPK handgun,

⁷ Applicant submitted the declaration of Wulf-Heinz Pflaumer, Chairman of the Advisory Board of applicant and Managing Partner of applicant's mother company, as Exhibit 2 to applicant's response (filed January 26, 2009) to an Office action. Copies of applicant's advertisements are also attached as various exhibits to the same response.

⁸ Exhibit 10 attached to applicant's response (filed January 26, 2009) to an Office action.

including an online encyclopedia reference that "[t]he PPK pistol is the trademark gun of fictional secret agent James Bond in books and films. The pistol is prominently featured in opening sequences and film art, hence it is culturally popular."⁹ Also, in this regard, the record includes evidence that the PPK handgun has been recognized by its configuration after being displayed or used as a prop in films. Applicant submitted numerous printouts from various websites (usually in the form of chat or blog sites) indicating that viewers of movies (usually James Bond films) saw a pistol in the movie and recognized it (or believed they did) as applicant's PPK handgun.¹⁰ We are careful to avoid any immediate conclusion that because the PPK handgun design has been recognized by filmgoers, it has become distinctive amongst consumers of handguns. It has not been shown that the persons recognizing the handgun in films or shows are consumers of the identified goods. Thus, this evidence does not necessarily indicate the degree of recognition amongst the relevant consumers. Nevertheless, such evidence does help show a certain level

⁹ From online encyclopedia, Wikipedia, at www.en.wikipedia.org/wiki/Walther_PPK, printout attached as Exhibit 4 to applicant's response (filed January 26, 2009) to an Office action.

¹⁰ Submitted as Exhibit 2 to applicant's response (filed January 26, 2009) to an Office action.

of notoriety or fame that can be attributed to the PPK handgun design. And, more importantly, we do find that the James Bond films have clearly influenced handgun consumers and their recognition of the PPK handgun design; this is demonstrated by some of the responses to the consumer survey commissioned by applicant. Several of the survey participants mentioned "James Bond" in their reasons for recognizing the PPK handgun design as source identifier for handguns.

The popularity of the PPK handgun design is further reflected in the fact that it is imitated, under license, through replica products such as air pistols. Applicant submitted the declaration of Justin Biddle, a Marketing Manager for Umarex USA, a related company of applicant and a manufacturer of replica products, including replicas of the PPK handgun and other brands of handguns.¹¹ Mr. Biddle states that Umarex USA obtains licenses "to create and sell replicas of the specific gun configurations used" and that it is "generally understood in the firearm industry" that such licenses are "required in order to create a replica when the shape indicates source and the firearm product configuration functions as a separate trademark." Biddle

¹¹ Submitted as Exhibit 6 to applicant's Request for Reconsideration (filed on August 10, 2009).

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dec., paras. 5-6. Mr. Biddle further avers that the PPK handgun design has been a "very successful design for replicas" and that over 25,000 "PPK replica products" were sold in the United States with sales over \$ 900,000 in the three-year period 2006-2008. *Id.*, para. 7. Samples of advertisements featuring Umarex's PPK handgun design replicas are attached to Mr. Biddle's declaration.

The fact that the PPK handgun design is sought after and licensed to a maker of replica products has been recognized as one type of evidence that helps establish that a configuration or trade dress mark has become distinctive. *See, e.g., Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 169 (2d Cir. 1991) (intentional copying of another party's mark constitutes "persuasive evidence of consumer recognition"); *see also, Hartford House Ltd. v Hallmark Cards Inc.*, 647 F.Supp. 1533 (D.Colo. 1986) (the fact that a party licenses its greeting card trade dress for different goods "demonstrate[s] that the distinctive look is recognized in the market as having a value separate from the [greeting] cards"). It simply stands to reason that a party would only attempt to replicate another party's trade dress or product configuration, under license or not, if that trade dress or

product configuration is perceived by the consumers as distinctive.

Finally, we address the evidence submitted by the examining attorney consisting of printouts showing various handguns that, on their face, appear similar to the PPK handgun. While this evidence is certainly relevant, it does not rise to the level necessary to rebut the direct and circumstantial evidence presented by applicant. There is no evidence as to the degree of consumer exposure to the third-party pistols or whether they are actually in production. Thus, the third-party pistols depicted may have only limited exposure and, in which case, would have limited probative value. Furthermore, even if certain features found in applicant's PPK handgun design are common to other pistol designs, this does not necessarily establish that handgun consumers are unable to perceive the *overall* appearance of applicant's PPK handgun as distinctive. We would be remiss if we did not acknowledge that the examining attorney is somewhat handicapped inasmuch as he does not have access to the same evidentiary resources as counsel for applicant or that of a party in an *inter partes* proceeding.¹²

¹² Our conclusion in this *ex parte* appeal would not, of course, preclude the Board from reaching a different result in a

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In summary, based upon consideration of all the evidence of record, we conclude that applicant has established a prima facie case that the PPK handgun design involved in the application before us has acquired distinctiveness within the meaning of Section 2(f) of the Trademark Act. The evidence and arguments of the examining attorney, taken together, do not rebut that showing.

Decision: The refusal to register is reversed. The application will be forwarded for publication for opposition.

subsequent *inter partes* proceeding brought against this same application by a competitor of applicant, if the competitor was able to present evidence showing that the PPK handgun design has not acquired distinctiveness.