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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Furniture Mart Land Holdings I, LLC

Serial Nos. 77323885 and 77323944

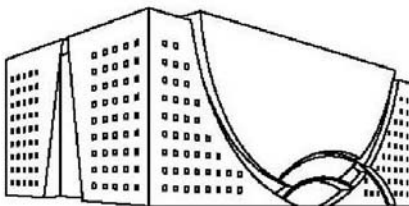
Gregory P. Gulia of Duane Morris for Furniture Mart Land Holdings I, LLC.

Regina C. Hines, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Seeherman, Quinn and Lykos,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Furniture Mart Land Holdings I, LLC filed, on November 7, 2007, two applications to register the mark shown below.



The applications include the following statement: "The mark consists of a trade dress of a three-dimensional building, with a rectangle façade that, when viewed from the front, is dissected by the lower half of a half-semicircle, and two arch-shaped indentures, the matter illustrated by the lines does not indicate color, but is a feature of the trade dress, which is the basis of this application." The services are identified as follows:

arranging, organizing, and conducting trade exhibitions, trade conventions, and trade shows in the field of home and hospitality furnishings, furniture, home décor and interior design; promoting the goods and services of others through the display and exhibition of goods and manufacturers in the fields of home and hospitality furnishings, furniture, home décor and interior design who display wares at our exhibition and showroom facilities and the distribution of printed and audio promotional material (in International Class 35); and

leasing trade and showroom exhibition space to manufacturers of goods in the fields of home and hospitality furnishings, furniture, home décor and interior design; real estate services, namely, providing and operating marketplaces and trade showrooms for sellers of goods and/or services (in International Class 36).¹

Applicant states in both applications that its proposed mark is inherently distinctive, but in the alternative, applicant states

¹The Class 35 services are in application Serial No. 77323885 and the Class 36 services are in application Serial No. 77323944; both applications are based on a claim of first use anywhere and first use in commerce on April 1, 2001.

that its proposed mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).²

The examining attorney refused registration in each application under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1052 and 1127, on the ground that the matter sought to be registered is not inherently distinctive. The examining attorney also found the Section 2(f) evidence of acquired distinctiveness to be insufficient for registration on the Principal Register.³

When a final refusal in each application issued, applicant appealed. Applicant and the examining attorney filed briefs.⁴

The appeals involve common issues of law and fact, and the records are very similar. Accordingly, the Board will decide the appeals in this single opinion.

Before turning to the merits of the appeal, we first direct our attention to a procedural matter. A more detailed review of

² See discussion on procedural matter, *infra*.

³ An earlier final refusal in each application was based on the assertion that the proposed mark, as shown by the specimen, does not function as a service mark because the specimen did not show the building design "used in a manner that clearly projects to purchasers the source of applicant's services as to be perceived as a mark identifying those services." In the Office action responding to applicant's request for reconsideration of that refusal, the examining attorney made no mention of the "failure to function" refusal, and therefore we deem this refusal to have been withdrawn.

⁴ After applicant filed its brief, the Board granted a request for remand to allow applicant to submit additional Section 2(f) evidence. The examining attorney was not persuaded by the evidence, and the final refusal was maintained. Applicant was allowed an opportunity to file a supplemental brief, but no such brief was filed. We also note that applicant appointed new counsel to represent it in this appeal at that time; however the new attorney never requested time for additional briefing. The examining attorney's brief was mailed to new counsel. Applicant's new counsel did not file a reply brief.

the relevant prosecution history referenced above helps to explain the development of the specific issues on appeal as framed by applicant and the examining attorney in their briefs.

The examining attorney originally issued a final refusal of registration on the ground that the matter sought to be registered, as used on the specimens, did not function as a service mark. In response to applicant's request for reconsideration of that refusal, the examining attorney, in the next Office action, essentially withdrew this refusal and raised a new refusal, namely, that applicant's proposed mark comprised nondistinctive trade dress that would not be perceived as a service mark but only as decoration or ornamentation. The examining attorney also noted applicant's remark that its proposed mark had acquired distinctiveness, but she stated that she "does not find that applicant has shown acquired distinctiveness sufficient enough to create a connection between the trade dress design of the mark and the services being rendered there." In response, applicant filed a paper that begins by stating that the application "has been amended," followed by a Section 2(f) claim that the mark has become distinctive of the services based on at least five years of substantially exclusive and continuous use; applicant made no mention of inherent distinctiveness. The examining attorney then issued an Office action wherein she stated that applicant's

response was incomplete "because the applicant did not provide the necessary evidence to show acquired distinctiveness under Section 2(f)." Applicant responded by stating that it "previously claimed acquired distinctiveness" based on use for more than five years, and that its assertion of use constitutes "evidence"; applicant also accompanied this response with additional Section 2(f) evidence. Applicant argued that it established acquired distinctiveness and "requests the Examiner accept its application for publication." Applicant made no mention of inherent distinctiveness; in other words, applicant did not make its claim of acquired distinctiveness in the alternative. Nonetheless, in the next Office action, the examining attorney began by indicating that "[t]he Nondistinctive Trade Dress for Services [i.e., the decoration or ornamentation] Refusal and requirement for proof of Acquired Distinctiveness [are] now made FINAL." The examining attorney reiterated her finding that "the applied-for mark is not inherently distinctive because the applicant has not shown how the special configuration of the building conveys an immediate commercial impression that consumers seek the services of the applicant because of the design of the building as represented by the mark. The applicant, therefore, claims 2(f)....the examining attorney does not find that the applicant has shown acquired distinctiveness sufficient enough...." Applicant filed

a request for reconsideration of this final refusal, maintaining that its mark had acquired distinctiveness and submitting a declaration with additional information; applicant again did not mention inherent distinctiveness. The examining attorney denied the request for reconsideration: "As incorporated by reference herein, the Non-distinctive Trade Dress refusal remains relevant...[and] the examining attorney finds that the 2(f) claim of acquired distinctiveness is unsubstantiated."

Applicant then filed its appeal brief, along with a request to suspend the appeal and remand the application to the examining attorney for consideration of additional Section 2(f) evidence. In the brief, applicant argued both that its trade dress is inherently distinctive and "alternatively" that the trade dress has acquired distinctiveness. The examining attorney agreed to a remand, and she considered the additional evidence. In denying the request for reconsideration and adhering to her positions, the examining attorney stated as follows: "The FINAL refusal based on the Non-distinctive Trade Dress for Services refusal is MAINTAINED and incorporated by reference herein"; and "The FINAL refusal for the requirement for sufficient proof of Section 2(f) Acquired Distinctiveness is also MAINTAINED." After the appeal was resumed, the examining attorney filed her brief wherein she recounted the prosecution history, culminating in the following: "[T]he refusal to

register under Trademark Act Sections 1, 2 and 45 for Nondistinctive Trade Dress of packaging and denying the claim for registration on the principal register under § 2(f) acquired distinctiveness was made final and this appeal ensued." The examining attorney also set forth the issues on appeal: "The issues on appeal are whether the applicant's trade dress of the building design is inherently distinctive and can be registered on the Principal Register and if not, whether the applicant has shown that the mark has acquired distinctiveness under Trademark Act Section 2(f)." The examining attorney went on to discuss both issues in her brief.

We are perplexed by the fact that inherent distinctiveness remains an issue in this appeal. For procedural purposes, a claim of distinctiveness under Section 2(f), whether made in the application as filed or in a subsequent amendment, may be construed as a concession that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney may rely on this concession alone. Once an applicant has claimed that the matter has acquired distinctiveness under Section 2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. See,

e.g., *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); and *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990).

Claiming distinctiveness in the alternative, however, is not an admission that the proposed mark is not inherently distinctive. Unlike the situation in which an applicant unequivocally amends its application to seek registration under Section 2(f), an amendment and claim of acquired distinctiveness made in the alternative does not constitute a concession that the matter sought to be registered is not inherently distinctive. See *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011); and *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992). When an applicant claims acquired distinctiveness in the alternative, the examining attorney must treat separately the questions of: (1) the underlying basis of refusal (in this case, the asserted lack of inherent distinctiveness); and (2) assuming the matter is determined to be at least registrable on a showing of acquired distinctiveness, whether acquired distinctiveness has been established. In the event of an appeal on both grounds, the Board will use the same analysis, provided the evidence supporting the Section 2(f) claim is in the record and the alternative grounds have been considered and finally decided by the examining attorney. *In re Harrington*, 219 USPQ 854, 855 n.1

(TTAB 1983). See TBMP § 1215 (3rd ed. 2012); and TMEP § 1212.02(c) (8th ed. 2011). It is the applicant's responsibility to make clear that it is taking alternative positions. TBMP § 1215, and cases cited at note 2.

In the present case, applicant's original amendment to claim acquired distinctiveness clearly was not made in the alternative, but rather was an unconditional Section 2(f) claim. At that point, the examining attorney could have considered the amendment to be a concession that the proposed mark is not inherently distinctive. Rather than follow this well-established practice, however, the examining attorney inexplicably continued to maintain that the mark was not inherently distinctive, setting forth both a lack of inherent distinctiveness and a lack of acquired distinctiveness as two separate refusals. And, while applicant, after amending its application to claim the benefits of Section 2(f), did not mention inherent distinctiveness again until its appeal brief, the examining attorney continued to discuss both issues as if the Section 2(f) claim were made in the alternative (even though clearly it was not).

Although applicant did not originally assert its Section 2(f) claim in the alternative, the examination history reveals that the examining attorney essentially treated the claim as an alternative one. That is, the examining attorney did not treat

applicant's claim of acquired distinctiveness as a concession that the matter sought to be registered is not inherently distinctive. See TMEP § 1212.02(c). Because of the way applicant and the examining attorney handled the issue, especially given their mutual characterization and discussion of both issues in the briefs, we will consider the claim of acquired distinctiveness to be one made in the alternative. We frankly do this with some reluctance, but the parameters of this appeal were dictated by applicant's and the examining attorney's actions, and in particular, by the examining attorney's decision to not treat the Section 2(f) amendment as a concession that the building design is not inherently distinctive. See *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (although applicant did not couch his Section 2(f) claim of acquired distinctiveness in the alternative when he argued against surname refusal, because applicant and the examining attorney treated the claim as an alternative one, the Board did as well); and *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1195 n.3 (TTAB 1998) (Board considered registrability on both Principal and Supplemental Registers even though applicant's amendment to the Supplemental Register was originally not made in the alternative, noting that the examining attorney continued to refuse registration on both registers, and subsequent papers of both applicant and examining attorney, including request for reconsideration and decision on

that request, discussed the amendment as being in the alternative).

We now turn to the merits of the issues on appeal, namely inherent distinctiveness and acquired distinctiveness. Applicant claims that its proposed mark is inherently distinctive because it is not a common basic shape or design, but rather is "outlandish" and unique in its field; the proposed mark is not a commonly adopted and well-known form of ornamentation for applicant's type of services as no other buildings like applicant's exist; and because of the unique and unusual design of the proposed mark, it is capable of creating a commercial impression distinct from the accompanying words WORLD MARKET CENTER.⁵ In the alternative, applicant argues that its proposed mark has acquired distinctiveness in the minds of the relevant purchasing public. In support of this alternative Section 2(f) claim, applicant submitted the declarations (and accompanying exhibits) of its attorneys, wherein certain facts about applicant's facility and applicant's promotional efforts are set forth. Among the exhibits is a "survey" completed by over 1,000 visitors to applicant's facility. Applicant also submitted excerpts of its website showing photographs of the

⁵ Applicant's ownership of several registrations of marks such as WORLD MARKET CENTER LAS VEGAS, WMC, LAS VEGAS MARKET and LAS VEGAS DESIGN CENTER is irrelevant to the registrability of the matter now sought to be registered.

building, and copies of third-party registrations of marks comprising building designs.⁶

The examining attorney maintains that applicant's building design is a rather commonplace rectangle design that fails to create a unique or unusual commercial impression for a showroom and trade show facility. According to the examining attorney, the proposed mark, consisting of a conventional building in a rectangle shape with a large semi-circle design on the front, is a mere refinement of a well-known architectural form for trade show and convention center facilities. The examining attorney also points to the prominent display of the words "World Market Center" on the building and in advertising, contending that the design of the building does not create a commercial impression separate from the accompanying words. As to the alternate Section 2(f) claim, the examining attorney states that while applicant's World Market Center may be known for its home furnishing expos and trade shows, this association is not based upon the architectural design of the building.

We start with the premise that a building's façade may function as a mark. *See generally* J.T. McCarthy, McCarthy on Trademarks and Unfair Competition § 7:100 (4th ed. 2012). And,

⁶Only one of the registrations, namely Reg. No. 2048586, was timely made of record. The remaining three registrations were not submitted until their attachment to applicant's appeal brief. The examining attorney, in her brief, objected to the untimely submission. The objection is sustained. Trademark Rule 2.142(d); and TBMP §§ 1203.02(e) and 1207.01.

of course, the Supreme Court has ruled that trade dress other than product design may be inherently distinctive. *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). Thus, we first focus our attention on whether applicant's building design as shown in its drawing is inherently distinctive for applicant's services.

In determining whether a design is arbitrary or distinctive, the Board considers the following factors:

Whether the subject matter sought to be registered is a "common" basic shape or design;

Whether the subject matter sought to be registered is unique or unusual in a particular field;

Whether the subject matter sought to be registered is a mere refinement of a commonly-adopted and well-known form or ornamentation for a particular class of goods or services viewed by the public as a dress or ornamentation for the goods; and

Whether the subject matter sought to be registered is capable of creating a commercial impression distinct from the accompanying words.

Seabrook Foods, Inc. v. Bar-Well Foods Limited, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977). See also *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010); and *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997).

"Whether an asserted mark is inherently distinctive involves both a legal question as to the correct standard to apply and a factual determination. 'The issue of inherent distinctiveness is a factual determination made by the Board.'" [citations omitted]. *In re Chippendales USA Inc.*, 96 USPQ2d at 1683-84. "It is well established that the PTO has the burden to establish a *prima facie* case of no inherent distinctiveness." *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1630 (Fed. Cir. 2003). On appeal, we must consider whether the examining attorney has made a *prima facie* case that the subject matter sought to be registered is not inherently distinctive and, if so, whether applicant has submitted sufficient evidence to rebut that *prima facie* case. *Id.* at 1631. The question of inherent distinctiveness rests on whether the public in the relevant market would view the building design as a source-identifier for applicant's services. The burden on the examining attorney, in meeting a *prima facie* case, is to establish a "reasonable predicate" for the position that the subject matter is not inherently distinctive. *Id.*

Here is the totality of the examining attorney's argument on this issue:

First, the application's three dimensional drawing, mark description and advertisements portray the building as a common rectangular shape for a showroom or trade complex. Second, the applicant's specimens and

website evidence show the World Market Center Las Vegas as a large building. However, the building's design is rather commonplace and does not create a unique or unusual commercial impression for a showroom and trade complex. In order to be inherently distinctive, the unusual and unique nature of the applicant's building façade should be so prominent that purchasers readily identify the source of applicant's services. The commercial impression created by the overall design and façade of the applicant's building lacks uniqueness. The mark is of a conventional building in a rectangular shape with a large semi-circle design on the front of the building. Thus, the building is a mere refinement of a commonly adopted and well-known architectural form for trade complexes or convention centers and would not be inherently regarded as a source indicator as identified in the third *Seabrook* factor. [citations omitted]. Lastly, the architectural design of the building does not show how it creates a commercial impression for the source of the applicant's services distinct from the accompanying words "World Market Center." The applicant's advertisements and website show that the wording "World Market Center" is prominently displayed on the building and frequently highlighted in relation to the building. Since the building does not appear inherently distinctive for its architectural design, the dominance of the persuasive advertising combined with wording "World Market Center" creates the commercial impression for this venue. Thus, it is the wording in the applicant's advertising in relation to the building that provides the connection to the services at the "World Market Center Las Vegas" and not the image of the building itself.

(Brief, unnumbered pp. 6-7).

At the outset it needs to be pointed out that the examining attorney did not submit a single piece of evidence in support of her position that the proposed mark is not inherently distinctive. In applying the *Seabrook* test for inherent distinctiveness, the examining attorney's mere argument, without any supporting evidence, fails to make out a *prima facie* case that consumers would not perceive and rely on the building design at issue as an indication of source for applicant's services. Specifically, the record is devoid of any evidence to show that the subject matter sought to be registered is a common design, that the building design is not an unusual one, that the design is simply a refinement of a well-known design or ornamentation, or that the proposed mark fails to function as a mark without the accompanying words "World Market Center."

In reaching this decision, we fully recognize and appreciate the Federal Circuit's observation that "the PTO is an agency of limited resources." *Id.* at 1632. However, mere opinion or argument is no substitute for evidence. *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) ("arguments unsubstantiated by record evidence are suspect at best"). So as to be clear, there is not even a single piece of evidence bearing on the *Seabrook* factors in support of the examining attorney's position that the proposed mark is not inherently distinctive.

Accordingly, the examining attorney has failed to make a *prima facie* showing that the building design sought to be registered is not inherently distinctive. In view of this failure, we need not reach the issue of acquired distinctiveness.

Decision: The refusal to register in each application is reversed.