

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Hearing:
May 31, 2011

Mailed:
September 27, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Johnson Controls, Inc.

Serial Nos. 77612039 and 77612049¹

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Baker & Hostetler LLP for Johnson Controls, Inc.

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117 (Brett Golden, Managing Attorney).

Before Bucher, Wolfson, and Lykos, Administrative Trademark
Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Johnson Controls, Inc. filed, on November 11, 2008,
two applications to register the designations shown below:

¹ While the cases have not been consolidated, they present common questions of law and fact. Accordingly, we have treated them in a single decision, but where appropriate, we have taken into account any relevant factual differences in the cases.

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for "electromechanical temperature control device for HVAC systems" in International Class 9. A copy of the specimen submitted with each application is reproduced below.

² The application is based on an allegation of first use and first use in commerce as of 1981. The description of the mark reads as follows: The mark consists of a three dimensional knob and display configuration and a bracket forming part of a temperature control device and the shape of the temperature control device. The knob and display configuration appears in the top center of the drawing. The bracket sits on top of the device horizontally and through the coils, which is not a claimed feature of the configuration. The matter shown in broken lines is not part of the mark and serves only to show the position or placement of the mark.

³ The application is based on an allegation of first use and first use in commerce as of 1981. The description of the mark reads as follows: The mark consists of a three dimensional knob and display configuration forming part of a temperature control device. The knob and display configuration appears in the top center of the drawing. The accompanying drawing shows the mark in solid lines as it is oriented on the device depicted in broken lines. The matter shown in broken lines is not part of the mark and serves only to show the position or placement of the mark.

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The product at issue in this case is a temperature control device. The design features of the device make up the trade dress of the product. In each application, trademark rights are claimed in the knob/window display design. In the application under Serial No. 77621039, rights are also claimed in the additional trade dress features of the bracket and the rectangular shape of the device itself.

As grounds for refusal, the examining attorney alleges that the marks are inherently nondistinctive features of a product design under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1052, 1127, and that applicant has

⁴ It appears that the same device was photographed for each case.

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not provided sufficient proof of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).⁵ We affirm.

The Record

The record consists of the examining attorney's evidence of third-party use of rotary knobs, coil brackets, and rectangular shapes for temperature control devices; media controllers with rotary knobs; and rotary control dimmer switches for lighting. Applicant has submitted copies of printouts from third-party websites purporting to show alternative design options for temperature controllers; and the declaration of George Rudich, Engineering Manager, Refrigeration Products, together with "examples of [applicant's] advertising of goods under its [marks] over the years."⁶

Product Features Are Not Inherently Distinctive

Trade dress of the type described in the applications for registration (i.e., "product-design trade dress") may not be registered on the Principal Register without a

⁵ The examining attorney initially refused registration of the marks as being merely functional under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), and Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c). The functionality refusals were withdrawn upon consideration of applicant's requests for reconsideration and newly submitted evidence, including Mr. Rudich's declaration.

⁶ Rudich Dec., para. 17. It has been somewhat difficult to discern the nature of applicant's evidence, as no attempt was made to identify the material other than generally, as advertising.

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showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000) ("In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs -- such as a cocktail shaker shaped like a penguin -- is intended not to identify the source, but to render the product itself more useful or more appealing"); *In re Charles N. Van Valkenburgh*, 97 USPQ2d 1757, 1764 (TTAB 2011); *see also* TMEP § 1202.02(b)(i). Neither mark is considered to be a product *packaging* mark. *Cf. Wal-Mart*, 54 USPQ2d at 1068 (predominant function of product packaging "remains source identification"). In the cases at hand, additional features, which have not been claimed, form part of the overall packaging for the device, so that the marks do not make up the entire packaging for the goods. In any event, to the extent either of applicant's marks were to present a "hard case at the margin" of drawing the line between product-design and product-packaging trade dress, we "err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." *Wal-Mart Stores*, 54 USPQ2d at 1070.

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Accordingly, proof of acquired distinctiveness is a necessary element for registrability in each case.

Burden of Proof

The burden of proving a prima facie case of acquired distinctiveness in an ex parte proceeding rests with the 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). Likewise, it is the applicant who carries the ultimate burden of persuasion (proof at trial) to establish that its mark has acquired distinctiveness. See *Yamaha*, 6 USPQ2d at 1004 (applicant "seeking to register its configurations/designs under Section 2(f), [bears] the burden of establishing acquired distinctiveness in ex parte proceedings before the PTO"); see also *Van Valkenburgh*, 97 USPQ2d at 1765 (product design features registrable only with a showing of acquired distinctiveness). An applicant faces a heavy burden in establishing the distinctiveness of a product design. *Yamaha*, 6 USPQ2d at 1008. As explained in *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000):

To establish acquired distinctiveness, applicant must show that the primary significance of the product configurations in the minds of consumers is not the product but the producer. Acquired distinctiveness 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*, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. 1999).

Evidence of Acquired Distinctiveness

Applicant contends that the product design features shown in its applications have acquired distinctiveness as trademarks for a temperature control device. In support of its position, applicant relies upon the declaration of Mr. Rudich, as well as advertising evidence. Mr. Rudich makes the following averments as establishing distinctiveness.⁷

1. *Exclusivity, Length, and Manner of Use.*

Applicant alleges that it has used each design mark in a "substantially exclusive and continuous [manner] as a trademark and service mark for decades, believed to date back at least as early as the 1940's."⁸

2. *Established Market Share*

Applicant alleges that it holds "the overwhelming majority of market share for the types of temperature

⁷ Applicant submitted a declaration and compilation of evidence in each case. The declarations are identical but for their captions and descriptions of the marks, and the evidence is the same.

⁸ Rudich Dec., para. 2.

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control devices that are subject of [these applications], believed to exceed 70% and perhaps closer to 80%.⁹

3. *Sales Figures*

Applicant states that "[f]rom 2000 through 2009, [applicant's] sales under [the marks] exceeded \$130 million in the United States alone." In his declaration, Mr. Rudich detailed yearly sales figures from 2000 through 2009. Each year, applicant sold between \$13 million and \$15 million worth of products under the purported marks.

4. *Sales: Numbers of Units Sold*

As for the quantity of units sold, Mr. Rudich states that "[s]ince 2000 alone, [applicant] has sold well over 6 million devices"¹⁰ and that "[a]t any given time over the years, there is likely to be upwards of 20 million of the temperature control devices that are the subject of [these applications] in the marketplace in the United States."¹¹

5. *Use of the Marks on Product Bulletins, in Catalogs, and in Advertising*

Applicant contends that it has advertised and promoted its goods under the marks. Applicant has provided samples of advertising and other materials, such as product

⁹ *Id.*, para. 4.

¹⁰ *Id.*, para 18.

¹¹ *Id.*, para. 5.

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bulletins, catalogs and technical bulletins as proof of acquired distinctiveness.

The type of circumstantial evidence that is most persuasive in a product design case is "look for" advertising and consumer declarations. "Look for" advertising points to the design features of the product so as to set them apart from other features of the product and to highlight their design attributes. That way, consumers may be conditioned to view the design features as source-indicating. See *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1927 (TTAB 2011), citing *Stuart Spector Designs v. Fender Musical Instruments*, 94 USPQ2d 1549, 1572 (TTAB 2009) ("Look for" advertising refers to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non source-identifying manner.").

Likewise, declarations from consumers stating that they recognize the claimed features as a trademark may be considered strong evidence of the success of a party's efforts to create the requisite public recognition of the designs as source-indicating. It is not, however, "the

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sheer number of statements (or affidavits or declarations) that determine how probative they are." *In re Lorillard Licensing Company, LLC*, 99 USPQ2d 1312, 1320-21 (TTAB 2011). Conclusory statements made without particularity as to how consumers are exposed to the alleged marks, or where the record does not reveal the extent of the applicant's potential customer base and whether the declarations are sufficiently representative of most potential purchasers, are of less value. A smaller number of personal statements from consumers, with particular reasons as to why they view the design as a trademark, is far more probative than "form declarations."¹²

No customer declarations or "look for" advertising has been presented in this case. On the other hand, the lack of either "look for" advertising or consumer declarations does not *a fortiori* establish that a mark has failed to acquire distinctiveness. As noted above, circumstantial evidence, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers, may be sufficient to establish consumer association of the mark with its source.

Mr. Rudich's declaration informs the record as to

¹² Compare *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 (TTAB 1997) (declarations considered probative) with *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1916 (TTAB 1996) (declarations given little weight).

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applicant's asserted use, sales and market share. We now examine applicant's evidence supporting the declaration.

Product Bulletins; Installation Instructions

Applicant has submitted a substantial number of product bulletins describing two temperature control devices that appear to include the claimed design features of the marks: Model A19 and Model A28. The earliest bulletin is dated 1979. Other years represented are 1988, 1991, 2003 and 2009. The majority of the bulletins show depictions of the Model A19 controller, while the depiction of the Model A28 appears only in an undated product information sheet. Photographs of both the A19 and A28 model show a rectangular device with rounded corners and a knob/window display; however, except for a rendition of the product that is contained in a 1988 product bulletin, there are no photographs that show the claimed bracket feature.¹³

In addition to the product bulletin from 1979, as noted there are other bulletins from different years between 1988 and 2009. In these, a photograph of the device typically is included on the first page, followed by specifications and line drawings of the several components

¹³ The bracket is apparently designed to hold a coil unit in place. Some photographs do show the mounted coil unit but the bracket, if indeed it is existent on the device, is hidden from view. While the 1979 bulletin includes a statement that a "mounting bracket" is "optional at no extra cost," it is not visible in the picture.

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of the device with installation instructions. References are made to the knob adjustment, display window and the compact nature of the control device. However, in none of the bulletins does the description of the design features set any of these features apart, or tout them in such a way that they would be perceived as source-indicating features.

For example, Fig.2 in the 1979 bulletin is captioned "space thermostat with Style 3 coiled bulb and finger-tip adjusting knob." The design or appearance of the knob is not mentioned. In another example, reference is made to a "visible scale,"¹⁴ and a "visible scale cover,"¹⁵ which appears to be a reference to the display window, but again there is no mention of any unique design feature of the display window. Another example where reference is made to the window display without referring to any special or uncommon design feature comes in the flyer marked "Installation Instructions," wherein the description of the adjustment function simply advises the user of the location of the knob/window display: "Knob adjustment ... is supplied on the range screw. Dial pointer is located on adjustment stop bracket on knob ... adjustment models."¹⁶ Finally, the description of the A19 Series from a 2009 specification

¹⁴ *Product Bulletin 12/91.*

¹⁵ *Lit-1927010, p. 2.*

¹⁶ *Installation Instructions 4/03.*

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sheet indicates one of the features of the device is its "compact enclosure," a reference to the product's shape. Again, this does not highlight the design as source-indicating.

Product Catalogs; Promotional Materials

Applicant submitted copies of product catalogs, one of which is dated "Rev 12/01"; the others are undated. None of the catalogs specifically refer to any of the design features claimed to comprise applicant's marks although in the photographs, the knob/window display design features are shown in the photographs of the A19 model controller, and the shape of the device is shown as a rectangular box with rounded corners. The photographs in the catalogs do not show the bracket design feature. Additional advertising in the nature of promotional contest materials make no mention of any of the features of the controller, but simply include a photograph of the device in a collage of photos on the front of the contest brochure. Likewise, the copies of pages from applicant's website, www.johnsoncontrols.com, do not describe the device or any of its features but simply include a photograph of the controller on the same page as a listing of links to other pages in the website (none of which were included). We also note that applicant did not introduce any unsolicited

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publicity for its control device that identified any of the product design features as forming a trademark. See *Van Valkenburgh*, 97 USPQ2d at 1767 ("Such publicity would have been probative that readers, authors, and others in the [applicant's] field identified the design of the [applicant's product] as a trademark.").

Third-Party Use

Turning to the evidence of third-party use of similar devices, we find that round-shaped knob adjustments for controllers, display windows for reading the temperature, and a square or rectangular-shaped device are not uncommon design features of temperature control devices. The examining attorney introduced, for example, a photograph of an "electromechanical relay for high temperature alarm" from the www.deltat.com website showing a circular knob; another model temperature controller from the same website having a display window; a photograph from www.chromalox.com, showing a circular knob and rectangular-shaped electromechanical thermostat; and the photograph of a temperature control device from the www.grainger.com website showing a rectangular-shaped electronic temperature control with a display window. In addition, applicant's own materials include photographs of its other models of temperature controls showing that round knobs, rectangular

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shapes, and display windows are not uncommon. While none of these elements are in the identical configuration as make up the appearance of applicant's marks, that fact does not tip the balance in favor of applicant.

The materials cited above do not establish that either of applicant's marks has become distinctive. Although Mr. Rudich's declaration attests to long usage, high market share, and significant sales, we simply cannot give Mr. Rudich's self-serving statement that "customers in the relevant industry have come to recognize the trademark[s] as solely designating [applicant] as the source of [applicant's] goods" much probative value absent sufficient direct or circumstantial evidence corroborating the assertion. See *In re The Outdoor Recreation Group*, 81 USPQ2d 1392, 1399 (TTAB 2006) ("Applicant's long use suggests that applicant has enjoyed a degree of business success. Nonetheless, this evidence does not demonstrate that its customers have come to view the designation OUTDOOR PRODUCTS as applicant's source-identifying trademark.").

Accordingly, even assuming substantially exclusive and continuous use of the product designs since the 1940's, the manner of such use as demonstrated on this record fails to prove applicant's claims of acquired distinctiveness. The

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evidence fails to show that consumers have been conditioned to perceive the particular combinations of design features claimed in each application as source-indicating trademarks.¹⁷ The evidence is lacking with respect to the knob and window display mark; the evidence is even less compelling with respect to the combination of knob, window display, bracket, and rectangular product shape design, because the bracket appears to have been visible in only one depiction of the mark.

We note that on a different record, such as one where "look for" advertising, or customer averments were submitted, we might well reach a different conclusion. As it stands, we would need to see a great deal more evidence (especially in the form of direct evidence from customers) than that which applicant has submitted.

Decision: The refusal to register under Sections 1, 2 and 45 is affirmed.

¹⁷ The absence of customer declarations is puzzling in light of the long period of claimed use and high percentage of market share.