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PRECEDENT OF THE TTAB

Mailed: September 28, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elesa S.p.A.

Serial No. 77782897

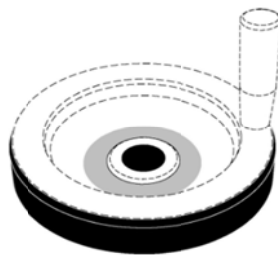
Una L. Lauricia of Pearne & Gordon LLP for Elesa S.p.A.

John Kelly, Trademark Examining Attorney, Law Office 117 (Brett Golden, Managing Attorney).

Before Zervas, Kuhlke and Kuczma, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Applicant filed a use-based application to register a design feature of its handwheel product shown below:



for “machine elements, namely, handwheels” in International Class 7.¹

¹ Application Serial No. 77782897 was filed on July 16, 2009, under § 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon actual use of the mark in commerce at least as early as December 31, 1972 .

Applicant claimed the color gray as a feature of the applied-for mark and described its applied-for mark as follows:

The mark consists of a specific design feature of a handwheel, namely, a metallic ring in the color gray positioned around a center portion of the handwheel. The mark does not include the areas bounded by broken lines or the center portion of the handwheel inside of the ring, or any portion of the handwheel that is outside of the ring. The white and black portions of the drawing are not claimed as a feature of the mark and are only included to depict positioning and placement of the mark on the goods.

The Trademark Examining Attorney issued a final refusal to register the applied-for mark under §§ 1, 2 and 45 of the Trademark Act on the ground that it consists of a nondistinctive product design feature that has not acquired distinctiveness under § 2(f) of the Trademark Act.² Applicant does not contest that the applied-for mark is a product design feature.

Because the applied-for mark consists of a specific design feature of a handwheel,³ namely, a metallic ring in the color gray positioned around a center portion of the handwheel, it is not inherently distinctive and may not be registered on the Principal Register without sufficient evidence of acquired distinctiveness

² In the Office Actions of November 3, 2009, July 15, 2010 and February 11, 2011, the trademark examining attorney advised applicant of the option to register the applied-for mark on the Supplemental Register. To date, applicant has not elected to pursue registration on the Supplemental Register.

³ As explained in applicant's May 3, 2010 Response to Office Action, "[h]andwheels are wheel-shaped or round components typically secured to a machine that allows an operator to manipulate a corresponding component of the machine by rotating the wheel-shaped component with his hand, similar to operation of a steering wheel. For instance, a handwheel on a sewing machine allows an operator to manually move the sewing needle up and down."

under § 2(f) of the Trademark Act. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1067, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006). Applicant and the examining attorney concur that the sole issue on appeal is whether applicant's evidence is sufficient to prove that the applied-for mark has acquired distinctiveness under § 2(f) of the Trademark Act.

The type and amount of evidence necessary to show that a designation has acquired distinctiveness in relation to the goods or services in connection with which it is used depends on the nature of the designation and the circumstances surrounding its use. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988); *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); and *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (CCPA 1960). An applicant faces a heavy burden in establishing the distinctiveness of a product design. *Yamaha Int'l*, 6 USPQ2d at 1008; *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009); and *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000).

In its May 3, 2009 response to the initial Office Action, applicant amended its application to include a statement of acquired distinctiveness based on substantially exclusive and continuous use of the applied-for mark in commerce for at least the five preceding years and submitted evidence pertaining to the (1) exclusivity, length and manner of use, (2) amount and manner of advertising, and (3) amount of sales.

Subsequently, applicant submitted six declarations and copies of translations of Italian court decisions as well as additional product literature.

Section 2(f) provides that “proof of substantially exclusive and continuous use” of a designation “as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made” may be accepted as *prima facie* evidence that the designation has acquired distinctiveness as used with the applicant’s goods or services in commerce. 15 U.S.C. § 1052(f); TMEP § 1212.05 (8th ed. 2011). However, for matter such as the applied-for mark that is not inherently distinctive because of its nature, evidence of five years’ use is not generally sufficient to show acquired distinctiveness. In such cases, actual evidence that the matter is perceived as a mark for the relevant goods or services is required to establish distinctiveness. *See generally, In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984) (8 years use not sufficient evidence of acquired distinctiveness for configuration of pistol grip water nozzle for water nozzles); *Ennco Display Systems*, 56 USPQ2d at 1286 (evidence of use from 7 to 17 years for various forms of eyeglass lens and frame display holders was insufficient to prove secondary meaning); *In re Chevron Intellectual Property Group LLC*, 96 U.S.P.Q.2d 2026, 2031, (TTAB 2010) (T-shaped gasoline station structure was “a mere refinement of the commonly used pole spanner design in the automobile service station industry.” In view of the “relatively heavy burden” to prove acquired distinctiveness, evidence of 22 years use was not sufficient); *Nextel Communications, Inc. v. Motorola, Inc.*, 91

USPQ2d 1393, 1401 (TTAB 2009) (“the evidence required is in proportion to the degree of nondistinctiveness of the mark at issue” in relation to a sound mark emitted by cellular telephones); *In re The Black & Decker Corp.*, 81 USPQ2d 1841, 1844 (TTAB 2006) (applicant successfully established acquired distinctiveness for the design of a key head for key blanks and metal door hardware, where evidence included twenty-four years of use in commerce and significant evidence regarding industry practice, such that the evidence showed that “it is common for manufacturers of door hardware to use key head designs as source indicators”); and TMEP § 1212.05(a).

The evidence necessary to establish acquired distinctiveness includes “evidence of the trademark owner’s method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.” *Owens-Corning*, 227 USPQ at 422. Accordingly, while applicant’s 40 years of use of the applied-for mark is impressive and a factor to be considered, we must look to the additional evidence submitted by applicant to determine whether its use of the applied-for mark over the years has caused the purchasing public to identify it with applicant.

Pursuant to Trademark Rule 2.41(a), 37 C.F.R. § 2.41(a), an applicant may submit affidavits or declarations in accordance with Rule 2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and letters or statements from the trade and/or

the public, or other appropriate evidence tending to show that the mark distinguishes such goods or services.

In support of the distinctiveness of the applied-for mark, applicant notes that “since 1972 when [it] introduced the handwheel configuration at issue, sales have totaled about \$2.5 million dollars.”⁴ Applicant has spent about \$27,000 per year on average, promoting its products, which amounts to more than \$1 million in “promotional expenditures” since it began selling its design in the U.S.⁵ Other than the sampling of catalogs and advertisements in the Thomas Register submitted by applicant, we do not know how these expenditures were utilized to promote applicant’s products. Nor do we know how much of applicant’s sales and promotional expenditures were made in the U.S. Recognizing that applicant’s products are not consumer products and that we do not have any comparative evidence concerning the size of the handwheel market, its advertising expenditures and sales appear relatively modest for a period of nearly 40 years. More seriously, there is no indication whether these sales and promotional expenditures were for all of applicant’s products or solely for products embodying the applied-for mark.

Applicant also participated in 14 expositions from August 2001-November 2009, and argued in its Appeal Brief that it displayed its products at more than 100 expositions since 1972, providing images of various booths it utilized at some of these expositions in 1981, 1984, 1990, 2004 and 2008.⁶ The evidentiary value of this

⁴ See applicant’s May 3, 2010 Response to Office Action.

⁵ See applicant’s May 3, 2010 Response to Office Action.

⁶ See Exhibit B to applicant’s May 3, 2010 Response to Office Action.

evidence is minimal. Applicant, an Italian company, offered no information regarding whether the expositions were held in the U.S., the size of the expositions or their attendees. Moreover, its exhibition booths display many of its products with no special emphasis on products bearing the applied-for mark or anything to draw attention to the gray ring on its handwheels.

Applicant submitted copies of ads it ran in the Thomas Register in 1999-2002.⁷ These ads feature images of applicant's handwheel having the gray metallic ring as well as several of its other products. There is no text or any other indicia in these ads that call attention to the trademark significance of the gray ring. As such, these ads do not support the acquired distinctiveness of the applied-for mark.

Applicant argues that language used in product literature and promotional materials by applicant and its distributors directs the purchaser's attention to the applied-for mark and serves to identify the handwheels as applicant's products.⁸ A closer inspection of these materials demonstrates that the meaning conveyed by the directive language is ambiguous at best. For example, the websites elesa-ganter.com/en/e/sp/7689/2/.../eg/ and elesa.com/scheda_us_20_7689_19_4 feature images of applicant's VD Solid Handwheels and contain the following language:⁹

Ring

Matte anodised aluminium (ELESA original design). For VD.50 and VD.63 a matte anodised aluminium centre disc, instead of the ring, is supplied due to their small dimensions.

⁷ See Exhibit A to applicant's May 3, 2010 Response to Office Action.

⁸ Applicant's Appeal Brief p. 5.

⁹ See Exhibit C attached to applicant's May 3, 2010 Response to Office Action and Exhibit A to applicant's August 17, 2011 Request for Reconsideration.

Ring

Matte anodised aluminium (ELESa original design).

Webpages from <http://www.medibix.com/runsearch.jsp...> feature an image of applicant's handwheel with the following language:¹⁰

- Elesa® Original design
- Steel hub is black oxide
- Matte anodized aluminum ring for customizing
- Finger grips on both front and rear of rim
- Replacement handles from stock

Pages from monroeengineering.com are titled "Solid Plastic Handwheel With Revolving Handles," contain the phrase "*Elesa® Registered Design" at the bottom of the last page, and feature an image of applicant's handwheel adjoining the language below:¹¹

- Material - High Strength Reinforced Duroplast
- Black Oxide Steel Hub
- Matte Anodized Aluminum Trim Ring for Beauty
- Revolving Handle Duroplast
- Rim has Rear Finger Grips
- Hub: Blank

The webpages from jwwinco.com feature an image of applicant's handwheel with the following text:¹²

¹⁰ See Exhibit C attached to applicant's May 3, 2010 Response to Office Action.

¹¹ See Exhibit C attached to applicant's May 3, 2010 Response to Office Action.

¹² See Exhibit C attached to applicant's May 3, 2010 Response to Office Action.

Specification

Handwheel body: Special high-impact strength technopolymer plastic, black matte finish
Hub: Steel, black oxide finish, molded in
Locking retractable handle: Technopolymer plastic hand piece, zinc-plated steel threaded spindle
Cover disk: Black technopolymer plastic, push-fit, can be removed by pressing on outer edge
Aluminum ring, anodized, matte finish



Call our sales staff for pricing and delivery on your modification requirements.



Information

Elesa® original design technopolymer plastic solid disk handwheels.
Designed for applications where it is necessary for the handle to return back to starting position after operation for safety reasons or lack of space.
These handwheels have the distinguishing features where the handle and the retracting mechanism are completely encased within the rim of the wheel.
In the operating position, the handle is secured by a taper detent. To fold it down, it is drawn out from the tapered recess. A compression spring secures the handle in either position.
Handwheel features rear finger grips.
Resistant to solvents, oils, grease and other chemical agents.
Countersunk washers for handwheel retention, see GN 184.
Special inch and metric bores available upon request.
Other modifications such as keyways, set screw holes, etc. available upon request.

Contrary to drawing attention to the applied for mark, the jwwinco.com pages mention the distinguishing retracting handle feature: “Elesa® original design technology plastic solid disk handwheels . . . These handwheels have the distinguishing features where the handle and the retracting mechanism are completely encased within the rim of the wheel.” Tellingly, there is no mention of any distinguishing aspect of the gray metallic ring.

Applicant’s advertising and product literature display nothing more than images of products being offered for sale. There is no evidence showing that the forgoing materials focused customers’ attention on the trademark significance of the gray ring. Accordingly, customers are unlikely to view the gray ring as a trademark; rather, they will view the ring as one feature of applicant’s product.

Even if the foregoing websites constituted “look for” advertising, i.e., advertising that promotes the gray ring as a trademark, the probative value of the advertising is minimal. The website excerpts from elesa-ganter and monroeengineering.com are dated May 3, 2010, the date they were submitted to the

USPTO, and the jwwinco.com and medibix.com excerpts indicate they were last updated 8/24/2009 and 4/13/2010 respectively. The excerpt from elesa.com is dated August 17, 2011. These dates provide the only insight into the length of time applicant's products have been advertised in this manner.

Notably, applicant's 1982 catalog draws no attention to the gray ring, with the text (shown below) referring only to the "Anodized aluminum trim ring" and the "Matte anodized aluminum decorative ring" along with other product features:¹³

• Modern "square" styling. • Anodized aluminum trim ring. No handle available on special order. • Revolving handle standard. • Solid construction prevents injury to hands.

A heavy duty solid wheel with steel molded-in hub. Material is high strength reinforced thermosetting plastic. Fold-A-Way handle snaps into use by pulling it up and is folded away by pulling handle and pressing it toward center of wheel. Matte anodized aluminum decorative ring. Finger grips on both front and rear of rim.

Similarly, the 1998 catalog of distributor Jergens, Inc., which features applicant's handwheels, makes no mention of the gray ring. Instead, it promotes the "Elesa Original Design" in connection with applicant's entire handwheel:¹⁴

Plastic Solid Handwheel
ELESA Original Design

- Material: High Strength Reinforced Duroplast
- Finish: Black Bright
- Hub: Black Oxide Steel
- Resistant to Solvents, Oils, Greases, and other Chemical Agents



¹³ See Exhibit A to applicant's August 17, 2011 Request for Reconsideration.

¹⁴ See Exhibit A to applicant's August 17, 2011 Request for Reconsideration.



The foregoing evidence reveals that applicant's pre-2008 advertising did not promote the gray ring feature of its handwheels as an "Elesa Original Design" or otherwise. Some of the more recent advertising over the past two or three years generally refers to the matte anodized aluminum ring as an "Elesa original design" for "customizing" or "beauty." The term "Elesa Original Design" as used by applicant and its distributors creates an ambiguous message as to what constitutes the "original design." In some instances, the phrase "Elesa Original Design" is closely associated with an image of the entire handwheel product; other times, it stands alone. Even when this phrase follows language describing the ring feature, it is not clear that the "Elesa Original Design" is the actual gray ring rather than its composition of "matte anodized aluminum." Moreover, the fact that the ring is for "beauty" or "customizing" does not direct customers' attention to a trademark significance. Used in these contexts, the advertising does not provide a basis for us to conclude that such advertising directed customers' attention to the significance of the gray ring feature.

Given the number of years that applicant has been selling its product, its advertising expenditures and sales are relatively small and the limited extent to which applicant's promotional materials are directed to the promotion of the

applied-for mark as a trademark militate against the finding of distinctiveness. *See Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142, 1146 (TTAB 1990) citing to *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975).

In an attempt to show that the result of its promotional efforts and sales have directed customers' attention to the gray ring such that it has become recognized as a trademark, applicant submitted six "form" declarations, i.e., declarations that contain virtually identical contents, with its August 17, 2011 Request for Reconsideration. The declarations, which have been executed by distributors of applicant, are deficient for several reasons.¹⁵ First, only one of the declarants identifies the name of the company for which he works. None of the declarants reveal their position in the company, nor do they provide any information indicating their experience in the industry. Without such information, it is impossible for us to assess the credibility of the declarants, or even whether they represent six different distributors or all work for the same distributor. Second, the language used in the form declarations to refer to the applied-for mark, namely, "handwheels sold by Elessa under the part numbers VD.FP-VDO.FP (herein the 'Elessa handwheel mark')," does not show the declarant's understanding that the mark is limited to the gray metallic ring portion of the handwheel. Thus, the declarations are not persuasive of the distinctive nature of the applied-for mark.

Applicant argues that the difference in appearance between applicant's handwheels incorporating the gray metallic ring around the center portion and

¹⁵ We note that there is no evidence as to whether end-customers identify or recognize the gray ring as a trademark.

those sold by other companies is striking.¹⁶ In support of its position, applicant submitted copies of a couple of webpages showing various handwheel designs of other entities, insisting that purchasers accustomed to the typical spoked handwheels would certainly notice the differences and would likely inquire as to the purpose of the metallic ring.¹⁷ A review of the third-party handwheels submitted by applicant demonstrates there are a variety of handwheel styles, including handwheels such as applicant's, which have no spokes. More importantly, the third-party handwheels show that the colors black, and gray or metallic, are used for most handwheels regardless of their source. Thus, the designs of third-party handwheels do not support the distinctiveness of the applied-for mark.

Arguing that evidence of copying is compelling evidence that the copied mark is distinctive, applicant submitted translated portions of two Italian court decisions where the courts found that competitors offered "slavish imitations" of applicant's design.¹⁸ As the record lacks information concerning the circumstances of the copying involved in the Italian decisions, i.e., whether the copying related specifically to the gray ring portion of applicant's product and/or whether the parties' products are even sold in the U.S., these decisions are not relevant to our consideration of the registrability of applicant's mark. We have consistently held that information and decisions relative to trademark disputes in foreign jurisdictions are not controlling on a determination of a party's right to register in

¹⁶ See Applicant's Appeal Brief pp. 5-6.

¹⁷ See Exhibit D to applicant's May 3, 2010 Response to Office Action.

¹⁸ See attachments to applicant's January 18, 2011 Response to Office Action.

the United States. *See Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999); *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 USPQ 848, 850 (TTAB 1983); *Beck & Co. v. Package Distributors of America, Inc.*, 198 USPQ 573, 575 n. 4 (TTAB 1978). Additionally, where the proposed mark is a product design, the copiers may be attempting to exploit a desirable product feature, rather than seeking to confuse customers as to the source of the product. *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 (TTAB 2011). Applicant itself recognizes that the desirable product feature may be related to the function, manufacturing costs and/or consumer appeal of the product.¹⁹

Conclusion

Applicant's use of the applied-for mark since 1972, while indicative of the commercial success of its handwheel products, is not conclusive or persuasive of recognition of its applied-for mark given the nature of the subject matter. In considering the totality of the evidence submitted by applicant, including the modest amount of advertising and sales in nearly 40 years of alleged use of the applied-for mark and the lack of advertising promoting the applied-for mark as a trademark, more direct evidence of distinctiveness is required to show recognition of its gray ring product feature as a trademark. Applicant's contention that it was the first and only one in its field to use this type of gray ring design is not persuasive. *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990). In view of the foregoing, we

¹⁹ Applicant's Appeal Brief p. 7.

find that the evidence is insufficient to show that the applied-for mark has acquired distinctiveness.

Decision: The refusal to register the subject matter sought to be registered on the grounds that it is a nondistinctive feature of a product design under §§ 1, 2, and 45 of the Trademark Act, and that applicant's evidence is insufficient to show acquired distinctiveness under § 2(f), is affirmed.