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PRECEDENT OF THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ingram Micro Inc.

Serial Nos. 78321253, 78321254¹

Grant R. Clayton of Clayton Howarth & Cannon PC for Ingram
Micro Inc.

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(J. Brett Golden, Managing Attorney).

Before Quinn, Kuhlke and Bergsman , Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Ingram Micro Inc. has filed applications to register
as a trademark on the Principal Register the background
design shown below for services ultimately identified as
"communication services, namely, providing on-line
electronic bulletin boards for transmission of messages

¹ Inasmuch as most of the issues raised by the above-listed
appeals are similar, the Board is addressing them in a single
opinion. Citations to the briefs refer to the briefs filed in
application Serial No. 78321253, unless otherwise noted; however,
we have, of course, considered all arguments and evidence filed
in each case.

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among computer users concerning computer networking, wireless communications, security, home entertainment, point-of-sale POS/automated-identification-and-data-collection AIDC/bar code technology, electronic storage devices, software, imaging devices and computer systems" in International Class 38² and "consultation services, namely, technical consultation services in the field of computer hardware and software; providing technical information to others in the field of computer hardware and software; providing temporary use of on-line non-downloadable software in the field of configuration, marketing and servicing of computer hardware, software and digital devices" in International Class 42.³



² Application Serial No. 78321253, filed on October 30, 2003, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b), 15 U.S.C. §1051(b).

³ Application Serial No. 78321254, filed on October 30, 2003 based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b), 15 U.S.C. §1051(b).

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Both applications include a description of the mark, which was ultimately amended to the following:

The mark consists of a rearwardly positioned rectangle that is outlined in the color blue with a left rectangular pane and a right rectangular pane. The left pane is in the color white and the right pane is in the color blue.

At one point during prosecution of the applications, applicant described the mark as "a background rectangle." See, e.g., App. '253 Resp. p. 2 (July 28, 2005).

Regardless of the description, it is clear from the specimens of use reproduced *infra* and applicant does not dispute, that the applied-for mark is a background design.

The applications also include the following color claim:

The color(s) white and blue is/are claimed as a feature of the mark.

In the first Office actions issued in 2004, the examining attorney included the following advisory statement:

In view of the nature of the proposed mark, the applicant is advised that, upon the examining attorney's consideration of an amendment to allege use or statement of use, registration may be refused under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the proposed mark is merely background matter and, thus, does not function as a service mark.

In determining whether the public would perceive the proposed mark as a service mark, i.e., an

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indicator of the source of the services, or merely as a decorative or ornamental feature, factors considered by the examining attorney include the commercial impression created by the display of the subject matter on the specimen, any prior registrations of the same or similar matter for similar goods, promotion of the subject matter as a service mark, and the practice of the relevant trade.

First Office Action (App. No. '253, June 14, 2004), (App. No. '254, June 10, 2004).

This advisory statement is in compliance with Office procedure at that time. We take judicial notice⁴ of the following excerpt from the third edition of the Trademark Manual of Examining Procedure (TMEP):

Generally, the issue of ornamentation is tied to the use of the mark as evidenced by the specimens. Therefore, no ornamentation refusal will be issued in an intent-to-use application until the applicant has submitted specimens of use with either an amendment to allege use under §1(c) or (d).

TMEP §1202.03(e) (3d ed. 2d rev.).

On December 5, 2009, applicant filed Statements of Use in each application. Set forth below are examples of how the mark appears in the specimens of use:

⁴ The Board may take judicial notice of standard reference works and commonly known facts. See *In re Tokutake Industry Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1566 n.5 (TTAB 2005).



Upon review of the Statements of Use in Application Serial Nos. 78321253 and 78321254, the examining attorney refused registration on the ground that "the proposed mark as used on the specimens of use appears as non-distinctive background matter and thus fails to function as a trademark pursuant to Trademark Act 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052 and 1127." Br. p. 1. In Application Serial No. 78321253, the examining attorney refused registration on the additional ground that "the specimens fail to show the applied-for mark in use in commerce as a service mark for any of the identified services under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127." Br. pp. 1-2.

When the refusals were made final, applicant appealed and the appeals have been fully briefed.

In its briefs, applicant argues against the refusals based on failure to function and asserts that the refusals are untimely. Applicant does not address the second

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refusal in Application Serial No. 78321253 that the specimen did not evidence use for the applied-for services.

Untimely Refusal

We begin by addressing applicant's argument that the failure to function refusal is untimely. Specifically, applicant quotes the following entry in the TMEP:

Generally, in examining the statement of use, the Office will only issue requirements or refusals concerning matters related to the statement of use. The Office will not issue any requirements or refusals concerning matters that could or should have been raised during initial examination unless the failure to do so in initial examination constitutes a clear error. Clear error means an error that, if not corrected, would result in issuance of a registration in violation of the Act. The failure to make a refusal is a clear error if reasonable minds could not differ as to the propriety of the refusal.

TMEP §1109.08 (5th ed. 2007).

This quote appears to be from the 2007 5th edition of the TMEP; however, it was the 6th edition revision 1 which was in place on December 5, 2009, when applicant filed its Statements of Use and December 18, 2009, when the examining attorney issued the refusals. Section 1202.03(e) of the Sixth edition provides that, "unless the ornamental nature of the mark is clearly apparent from the drawing and description of the mark, no ornamentation refusal will be issued in an intent-to-use application until the applicant

has submitted specimen(s) of use with an allegation of use under §1(c) or §1(d), 15 U.S.C. §1051(c) or (d)."

Applicant argues that:

Applicant gave clear notice of the appearance of its applied for mark as comprising a left pane colored white, in which a commonly owned mark would be displayed and a right pane colored blue. ... In addition, ... the Trademark Senior Attorney stated that "it appears that the applicant is claiming the rectangle design and colors that are used as background for the mark in Reg. No. 1620552. The applicant should indicate in its description that the design and colors are background matter." Thus, the Trademark Senior Attorney herself addressed the issue of the design functioning as background. Hence, the distinctiveness issue could and should have been raised in response to Applicant's December 14, 2004 Amendment A or at the time of the January 27, 2005 Office Action. It was not, and cannot be raised now.

In addition, the Office Actions have not asserted that failure to raise the lack of distinctiveness issue at this time would constitute clear error. Hence, as a procedural matter, the Office Action does not meet the burden of establishing that raising the lack of distinctiveness issue, at this very late date, is timely. In view of the lack of any record in the post-Statement of Use Office Actions that failure to raise the current issue would be a matter of clear error, Applicant asserts that the refusal in the most recent Office Action must be withdrawn.

Br. pp. 9-10.

As noted above, at the time the first refusals were made and the advisory statement provided in 2004, the 3rd edition of the TMEP was in place and the examining attorney followed appropriate procedure by deferring issuance of a

failure to function refusal until specimens were submitted. The fact that procedure altered somewhat by the time applicant filed its Statements of Use does not provide applicant with a windfall.

Moreover, in general, questions of procedural missteps are not matters for Board consideration. In particular, with regard to applicant's arguments as to "clear error," it is well established that "questions involving the applicability of the 'clear error' standard are the subject matter of a petition to the Director, and are not proper for consideration by way of an appeal to the Board." In re Jump Designs, LLC, 80 USPQ2d 1370, 1373 (TTAB 2006). As stated in In re Sambado & Son Inc., 45 USPQ2d 1312, 1314-15 (TTAB 1997):

[T]he question of whether the clear error standard was properly applied is a procedural one arising out of examination practice. The Examination Organization makes the determination of "clear error," which determination ultimately is properly reviewable on petition to the Commissioner. The Board's determination on appeal is to be limited to the correctness of the underlying substantive refusal to register. The Board will not second guess the Examining Organization's procedural determination, that is, the latter's application of the "clear error" standard. As noted, the application of the "clear error" standard is, in this context, a procedural decision (one that answers the question, "Should a new refusal be made and defended by the Examining Attorney?").

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See also Trademark Rules 2.63 and 2.146, 37 C.F.R. §§ 2.63, 2.146.

Thus, the Board will not consider the merits of applicant's argument that the refusal is procedurally improper. *Jump Designs*, 80 USPQ2d at 1373.

Failure to Function

A background design that is not sufficiently distinctive to create a commercial impression separate from the word marks with which it is used may be registered only with proof of acquired distinctiveness as provided under Section 2(f). TMEP §1202.11 (8th ed. 2011). "[C]ommon geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as backgrounds for the display of word marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the background design alone." *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1216 (TTAB 1998), citing, *In re E.J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958). Further, the addition of a color to the background design "does not change the standard by which these types of marks are judged." *Id.* On the other hand "where the background design of a composite mark is not commonplace, but is unique or unusual in a particular field of endeavor" it may be considered to be inherently

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distinctive. In re Nat'l Inst. for Auto Serv. Excellence, 218 USPQ 744, 745 (TTAB 1983).

The examining attorney contends that applicant "has not articulated any commercial impression apart from the white and blue rectangle used as a background." Br. p. 5. Rather, the examining attorney argues that the "overall rectangular shape adds very little visual impact other than to stage the wording." In support of his position, the examining attorney submitted several third-party registrations that have marks with similar background designs registered on the Supplemental Register, indicating similar background designs have not been considered to be inherently distinctive. See, e.g., Reg. No. 2938999 (the mark is described as "a solid red background with a green upper right corner"), and Reg. No. 3203130 (mark is described as "a label characterized by a grey rectangle containing rows of small grey squares, on which a thin white-colored band and a broader red-colored band are superimposed. The label has a central rectangular hole and three parallel bands which are symmetrical to its central hole, the first band being red, the second yellow in the left portion and green in the right portion, and the third one green. There is a small, white vertical line inside

the left portion of the red band and a white circle inside the left portion of the third band.”)

In traversing the refusals, applicant argues that “when color is applied to a defined shape or pattern, or when several colors are combined in a pattern, courts have long held and viewed such color added to shapes and patterns as overall designs are candidates for trademark or trade dress rights ... [and that] [m]eeting this standard requires that colors be combined with shapes, patterns or symbols in such a manner as to become distinctive designs.” Br. p. 6.

Applicant contends that its mark meets this standard because its “design comprises three rectangles. One rectangle is colored blue and one rectangle is colored white. Those two rectangles are then combined to create a large, bicolor rectangle outlined in the color blue. In addition, the design incorporates an asymmetry in its design in that the white rectangle is larger than the blue rectangle.” Br. p. 7.

We find that applicant’s proposed mark is a background design and that it does not create a separate commercial impression sufficient to permit registration absent a showing of acquired distinctiveness. It is a simple geometric design. To the extent separate rectangles would

be perceived, they are not joined or juxtaposed in a way that would be distinctive. Moreover, use of the two background colors, white and blue, do not combine in a way to make this simple geometric background design inherently distinctive.

Applicant's reliance on *Quabaug Rubber Co. v. Fabiano Shoe Co., Inc.*, 567 F.2d 154, 195 USPQ 689 (1st Cir. 1977) and *Hygienic Products Co. v. Coe*, 85 F.2d 264, 29 USPQ 458 (DC Cir. 1936) do not persuade us of a different result. The mark in issue in *Quabaug*, was an elongated, yellow octagon. The court noted that the plaintiff's advertising had made the mark "more distinctive," and that the defendant had not challenged the validity of plaintiff's registration for the yellow elongated octagon and, therefore, the court found that *Quabaug's* registration was "prima facie evidence that such mark *has become* distinctive of the goods in commerce." *Id.* at 694 (emphasis added). This is not a definitive statement that the mark was considered inherently distinctive; in fact, it implies the opposite ("has become distinctive").⁵ Similarly, in *Hygienic* we note that the language in the decision sounds

⁵ *Quabaug's* registration file is not of record and there is nothing in the decision discussing the prosecution of the registration, i.e., whether registrant was required to show acquired distinctiveness.

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similar to a finding of acquired distinctiveness. See, e.g., "There are of record copies of applicant's advertising material which prominently feature colored illustrations of the bags ... and there are also of record affidavits of officials of a number of applicant's customers attesting to the fact that to them the striped markings on applicant's bags serve both to distinguish applicant's goods from similar goods of others, and to differentiate between the various types of abrasives which it sells."

In any event, we must make our determination based on the proposed mark before us and it is clear from applicant's specimens of use that applicant's mark does not make a separate impression. Moreover, as the examining attorney notes, applicant's specimen of use shows other background material within the large rectangle, namely, the red rectangle serving as background for the word MICRO. As the examining attorney states "not only is applicant claiming background design as a service mark, it is only claiming a portion of the overall background design. It seems unreasonable to expect consumers to recognize and pull out the white-and-blue rectangle as a service mark, yet be unaffected by the red rectangle featured in the overall design." Br. p. 7.

Specimens Fail to Show Use with Recited Services

Finally in Application Serial No. 78321253, the examining attorney asserts that the specimens do not show the applied-for mark in use in commerce as a service mark for the identified electronic bulletin board services. As noted above, applicant did not address this refusal in its brief.

Applicant submitted manuals and printouts from its website as specimens of use. As noted by the examining attorney "there must be something which creates in the mind of the purchaser an association between the mark and service activity." Br. p. 12, quoting, *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997).

Upon review of the specimens, the proposed mark only appears on the cover pages. The examining attorney states that the specimens reveal no reference to the identified electronic bulletin board services. Specifically, the examining attorney states that "whereas the identification recites a public message board for general consumption, applicant's specimens identify highly organized and directed dispatch and management solutions for handling and routing incoming service requests to specific end-user members to increase such member's income opportunities." Br. p. 14.

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We agree with the examining attorney's assessment. The specimens showing the proposed mark on the cover of the manuals and on the first page of the website do not show a proper nexus with the identified services. Moreover, the only services that could possibly be considered electronic bulletin board services, described in the manual on page 18 and on pages 2 and 3 of the website are too attenuated from the proposed mark and are described under different terms, "Clarify" and "IMOnsite."

Decision: The refusals to register the rectangular designs in each application on the grounds that they fail to function as marks are affirmed. Further, the refusal to register the mark in Application Serial No. 78321253 is also affirmed on the ground that the specimen of use does not show use of the mark in connection with the applied-for services.