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Mailed:
May 30, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Barrette Outdoor Living, Inc.

Serial Nos. 85389360 and 85389763

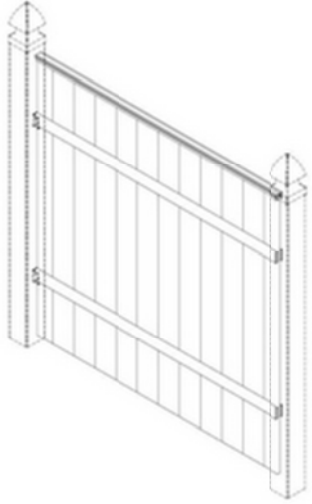
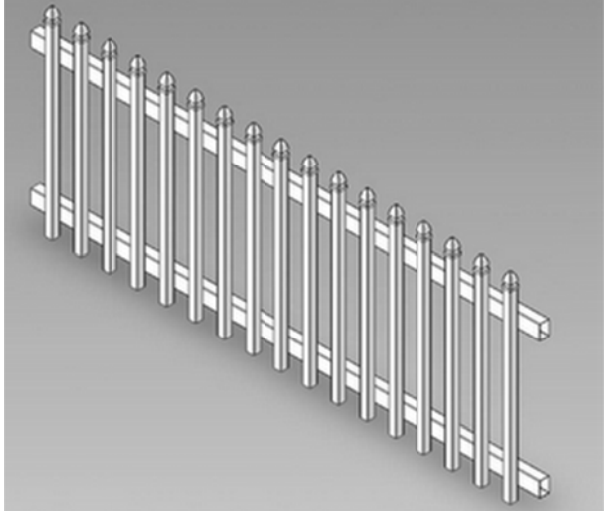
Matthew M. Googe and Robert O. Fox of Luedeka Neely Group, P.C. for Barrette Outdoor Living, Inc.

Linda M. King, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Quinn, Taylor and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Barrette Outdoor Living, Inc. (“applicant”) seeks Principal Register registrations for the following two alleged product configuration marks for “Pre-assembled plastic fence panels,” under Section 2(f) of the Act:

| <u>Mark</u> | <u>Description of Mark</u> |
|-------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|  | <p>The mark consists of a three-dimensional configuration of an assembled fence panel consisting of a horizontal fancy top rail centered on the top edge of the vertical fill boards, with a pair of upper and lower horizontal cross-pieces on each face of the panel, the upper horizontal cross-pieces being spaced below the fancy top rail a distance of about one-quarter of the distance from the top rail to the bottom of the fill boards, and the lower horizontal cross-pieces spaced above the bottom of the fill boards about one quarter of the distance from the top rail to the bottom of the fill boards, the vertical posts featured in the drawings and delineated with dotted lines are not claimed as part of the mark and serve to show the placement of the fence panel (the “360 Application”).¹</p> |
|  | <p>The mark consists of a three-dimensional configuration of an assembled fence panel consisting of vertical pickets with fanciful tops defined thereon and a pair of spaced apart horizontal rails, with the pickets being offset on the rails (the “763 Application”).²</p> |

¹ Application Serial No. 85389360, filed August 4, 2011, alleging first use dates of September 1, 2004.

² Application Serial No. 85389763, filed August 4, 2011, alleging first use dates of March 1, 2004.

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The examining attorney originally refused registration of applicant's alleged marks on the ground that they consist of non-distinctive product designs which would not be perceived as trademarks under Sections 1, 2 and 45 of the Act, and applicant's showing of acquired distinctiveness under Section 2(f) of the Act is insufficient. After these refusals became final, applicant appealed and filed motions for reconsideration which were denied. Applicant then filed its appeal briefs, following which the examining attorney requested and was granted remands for the purpose of issuing additional refusals on the ground that applicant's alleged marks comprise functional designs for the goods and are thus unregistrable under Section 2(e)(5) of the Act. After those refusals became final, applicant filed additional briefs addressing this issue, following which the examining attorney filed her briefs, and applicant filed reply briefs.

Appeals Consolidated

The appeals involve common questions of law and fact and the records are substantially similar. Accordingly, we decide both appeals in this single decision. *See, In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TBMP § 1214 (3d ed. rev. 2 2013).

Whether the Alleged Marks are Non-Distinctive Product Designs Which Have Not Acquired Distinctiveness

Applicant's alleged marks comprise the product designs for its pre-assembled plastic fence panels. It is settled that "design, like color, is not inherently distinctive." *Walmart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). Therefore, product configurations such as applicant's

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alleged marks in this case “are entitled to registration on the Principal Register only upon a showing of acquired distinctiveness under Section 2(f).” *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279, 1282-83 (TTAB 2000); *see also, Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (“Configurations of products are not inherently distinctive and may only be registered as marks upon a showing of acquired distinctiveness.”).

Applicant bears the burden of establishing that its marks have acquired distinctiveness under Section 2(f) of the Act. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). In determining whether applicant has met this burden, “the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source),” though “no single factor is determinative.” *Id.*

In considering applicant’s evidence of acquired distinctiveness in this case, we must keep in mind the nature of its alleged marks. As the Supreme Court stated in *Walmart Stores*, “[i]n the case of product design, as in the case of color, we think consumer predisposition to equate the [claimed] 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.” *Walmart Stores*, 54 USPQ2d at 1069. Moreover, as a matter of policy, “[c]onsumers should not be deprived of the benefits of competition with

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regard to the utilitarian and esthetic purposes that product design ordinarily serves ...” *Id.*³ It should not be surprising, therefore, that applicant’s burden to establish the requisite acquired distinctiveness “is heavier in this case because it involves product configurations.” *In re Ennco*, 56 USPQ2d at 1284; *see also*, *Yamaha Intern. Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (party seeking to establish acquired distinctiveness of product design bears “unusually heavy burden”). We find that applicant has not met its “heavy burden.”

Applicant’s evidence of acquired distinctiveness consists of samples of advertising for its pre-assembled plastic fence panels, and the declarations of André Lavigueur, its Corporate Controller, submitted with applicant’s Office Action responses of June 5, 2012 in the ‘360 Application (“Lavigueur ‘360 Dec.”) and June 4, 2012 in the ‘763 Application (“Lavigueur ‘763 Dec.”). According to Mr. Lavigueur, the goods identified in the ‘360 Application have been sold since “at least as early as 2004,” and since that time applicant has: (1) sold at least 3,035,000 “sections of the product bearing the mark;” (2) derived at least \$130,600,000 in revenue from sales of the product; and (3) spent at least \$1,300,000 on advertising for the product. Lavigueur ‘360 Dec. ¶¶ 3-6. The goods identified in the ‘763 Application have also been sold since “at least as early as 2004” and since that time applicant has: (1) sold at least 2,975,000 “pieces of the product bearing the mark;” (2) derived at least \$93,100,000 in revenue from sales of the product; and (3) spent at least \$1,350,000

³ Furthermore, while there is no dispute in this case that applicant’s alleged marks constitute product design, “[t]o the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Walmart Stores*, 54 USPQ2d at 1070.

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on advertising for the product. Lavigueur ‘763 Dec. ¶¶ 3-6. The products identified in both applications “have been sold at retail stores including both Lowe’s® and The Home Depot® throughout the United States,” and the alleged marks are “also promoted by virtue of annual or biannual store manager’s events, which have been held since 2004” at chain stores including Lowe’s®, The Home Depot® 84 Lumber, Carter Lumber and True Value Company, a/k/a Ace Hardware. Lavigueur ‘360 Dec. ¶¶ 7,9; Lavigueur ‘763 Dec. ¶¶ 7,9.

Applicant’s evidence of acquired distinctiveness is insufficient in this case. While applicant’s sales and advertising figures are certainly impressive by any measure, and “may demonstrate the growing popularity of the products,” these “mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source.” *Stuart Spector Designs*, 94 USPQ2d at 1572.⁴ That is, “the critical question is the effectiveness of the advertisements in creating a consumer association between the product configuration and the producer.” *In re Ennco*, 56 USPQ2d at 1285. Here, there is no evidence of record that applicant’s successful product sales are the result of the claimed features of its alleged marks, or that its advertising creates a consumer association between either product’s design and its source. *See, In re ic! Berlin brillen GmbH*, 85 USPQ2d 2021, 2024 (TTAB 2008).

⁴ Significantly greater levels of sales and advertising expenditures have been found insufficient to establish secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenue and \$2,000,000 in annual advertising expenditures insufficient); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 in sales revenue and 740,000 tires sold insufficient).

To the contrary, applicant's advertisements for the products identified in its applications tout the specific measurements of the fence panels, the vinyl they are comprised of, the available colors and the hardware sold therewith, none of which are claimed in the drawings or descriptions of the marks in either application. Office Action response of June 4, 2012 in the '763 Application; Office Action response of June 5, 2012 in the '360 Application. Moreover, applicant's advertisements for the fence panel identified in the '763 Application refer to it as "Classic Gothic" and promote its "classic styling." Office Action response of June 4, 2012 in the '763 Application. A "classic" product configuration or styling would likely be understood by consumers as a "standard" or perhaps "typical" product configuration or styling, or at best as including standard or "classic" features, rather than as identifying a unique source. In addition, several of applicant's advertisements for the fence panel identified in the '360 Application promote it as a "privacy," "low maintenance" fence under the word mark WINDHAM, but do not promote or highlight any of the features specifically claimed in the application. Office Action response of June 5, 2012 in the '360 Application; *see, In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967) ("there is nothing to indicate that the container has been promoted separate and apart from the word mark 'MOGEN DAVID.'"). "Advertising that touts a product feature for its desirable qualities and primarily as a way to distinguish the producer's brand is not only not evidence that the feature has acquired secondary meaning, it directly undermines such a finding." *Stuart Spector Designs*, 94 USPQ2d at 1573 (quoting

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Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 36 USPQ2d 1065, 1071 (7th Cir. 1995)).

In other words, while applicant's sales and advertising expenditures are impressive, "the more important question is how is the alleged mark being used, i.e., in what manner have consumers been exposed to the alleged mark so that we can impute consumer association between the configurations and the product producer." *Stuart Spector Designs*, 94 USPQ2d at 1572. Here, there is no evidence of "look for" advertising, which "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." *Id.*; *In re ic! Berlin*, 85 USPQ2d at 2023 ("we are not persuaded that the earpiece design sought to be registered has become distinctive of applicant's eyewear. The chief reason is the absence of evidence of the advertising and/or promotion by applicant of the earpiece design as a trademark.").

Furthermore, applicant's product configurations are not particularly unique. A number of third parties offer fence panels comprised: (1) like the product identified in the '360 Application, of vertical panels with little or no space between them with two horizontal cross-pieces, with a few having cross-pieces in approximately the same position as those on applicant's product; and (2) like the product identified in the '763 Application, of vertical pickets with fanciful tops and a pair of spaced apart horizontal rails. Applicant's Office Action response of August 19, 2013 in the '360 Application Ex. A; Office Action of June 6, 2013 in the '763

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Application (printouts from “diynetwork.com” and “longfence.com”); Office Action of June 28, 2012 in the ‘360 Application (printouts from “wayfair.com,” “dmvdeckandfence.com,” “lowes.com” and “homedepot.com”); Office Action of December 6, 2011 in the ‘360 Application (printouts from “alaska-fence.com”). This is evidence that applicant’s use of most or all of the claimed features of its alleged marks is not in fact “substantially exclusive.” *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); *see also, Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1840 (TTAB 1994).

Furthermore, applicant’s reliance on its continuous use of the alleged marks since 2004 is misplaced in this case. In fact, the alleged marks are so non-distinctive, and most or all of the claimed features of the alleged marks are so extensively used by third parties, that applicant’s use of its mark for 10 years is insufficient to establish acquired distinctiveness. *Yamaha*, 840 F.2d at 1576, 6 USPQ2d at 1008; *In re Ennco*, 56 USPQ2d at 1286 (while Board may consider evidence of continuous use for more than five years, “the language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case”).⁵

⁵ Applicant’s reliance on *In re Hershey Chocolate and Confectionary Corp.*, Serial No. 77809223 (Dec. 8, 2011) is misplaced. Not only is that case unpublished, but the applicant’s

Conclusion

After careful consideration of all of the evidence and argument presented, including evidence and argument not specifically discussed herein, we find that applicant has not met its heavy burden to establish acquired distinctiveness, and therefore affirm the refusals to register because applicant's alleged marks are non-distinctive product designs. We need not reach the functionality refusals under Section 2(e)(5) of the Act.

Decision: The refusals to register applicant's alleged marks under Sections 1, 2 and 45 are affirmed.

showing of acquired distinctiveness was significantly stronger, as it included a consumer survey, significantly longer use of the mark (over 40 years), significantly greater sales and advertising expenditures (in excess of \$4 billion and \$186 million, respectively) and intentional copying.