

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
September 10, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Portland Pedal Power, LLC*

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Serial No. 85396037

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Jeffrey J. Armistead of Jeffrey Armistead LLC for Portland Pedal Power, LLC.

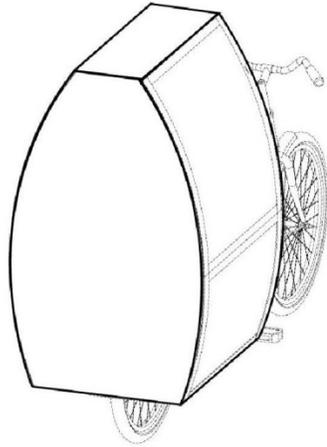
Jaclyn Kidwell Walker, Trademark Examining Attorney, Law Office 112 (Angela Bishop Wilson, Managing Attorney).

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Before Grendel, Taylor, and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Portland Pedal Power, LLC (“applicant”) seeks to register the mark set forth below for “advertising and promotional services rendered on, or provided in connection with, a bicycle enclosure; advertising and marketing services, namely, promoting the goods and services of others rendered on, or provided in connection with, a bicycle enclosure; advertising, marketing and promoting the goods and

services of others using bicycle enclosures; providing advertising space on bicycle enclosures; rental of advertising space on bicycle enclosures” in Class 35:<sup>1</sup>



The applied-for mark is described in the application as:

The mark consists of trade dress for advertising, marketing, and promotional services rendered on, or provided in connection with, a bicycle consisting of an enclosure attached and connected to a bicycle wrapped around a frame to form convex sides of which the matter depicted in broken lines being a bicycle and the flaps are not claimed as a feature of the mark.

Registration was refused pursuant to Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127 on the ground that the applied-for mark consists of nondistinctive trade dress that would not be perceived as a service mark but only as decoration or ornamentation. The refusal was made final on June 14, 2012. Thereafter on January 4, 2013, applicant filed both a request for reconsideration

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<sup>1</sup> Application Serial No. 85396037, filed August 11, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming dates of first use anywhere and first used in commerce, at least as early as May 15, 2009.

and a notice of appeal. The request for reconsideration was denied and this appeal followed.

The sole question in the case at bar is whether applicant's bicycle enclosure is inherently distinctive and thus would be perceived as a service mark.

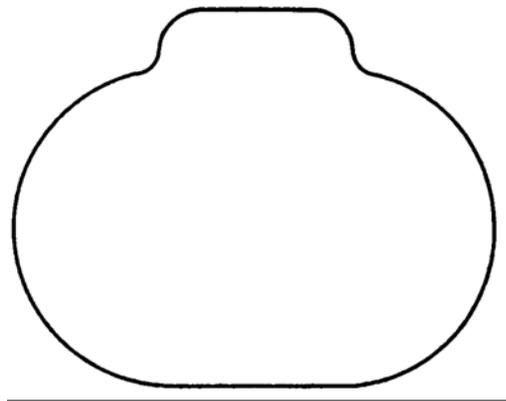
"[A] mark is inherently distinctive if '[its] intrinsic nature serves to identify a particular source.'" *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000), quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081, 1083 (1992). It "should be displayed with such prominence as will enable easy recognition" and "the average consumer will regard it as an unmistakable, certain, and primary means of identification pointing distinctly to the commercial origins of such product." *In re Swift & Co.*, 223 F.2d 950, 106 USPQ 286, 289 (CCPA 1955). "[U]ltimately 'the focus of the [inherent distinctiveness] inquiry is whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive.'" *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1685 (Fed. Cir. October 1, 2010), quoting *Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994).

In determining whether a design is arbitrary or distinctive [the CCPA] has looked to [1] whether it was a "common" basic shape or design, [2] whether it was unique or unusual in a particular field, [3] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or [4] whether it was capable of creating a

commercial impression distinct from the accompanying words.

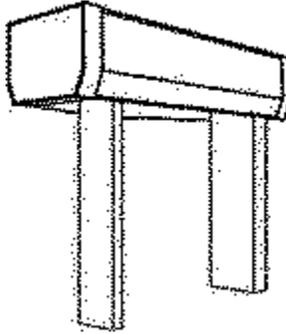
Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 196 USPQ 289, 291 (CCPA). “A finding that any one of these factors is satisfied may render the mark not inherently distinctive.” *Chippendales*, 96 USPQ2d at 1687. The fourth factor, whether the trade dress was capable of creating a commercial impression distinct from the accompanying words, is not applicable.

The examining attorney contends that the applied-for mark is a common shape or design since it is “merely an enclosure with convex sides and can be said to be nothing more than a modified rectangular box with slanted sides.” Examining Attorney’s Brief, p. 4. Applicant relying on *In re Proctor & Gamble*, 105 USPQ2d 1119, 1122 (TTAB 2012), responds by stating “[t]he Board has indicated that a common shape is a ‘common geometric shape such as a circle, oval, square or triangle.’” Applicant’s Brief, p. 9. Applicant’s reliance on the *Proctor & Gamble* case is misplaced as the Board did not define a common shape, but merely indicated examples of common shapes, i.e. letters or geometric shapes. *Proctor & Gamble*, at 1122. To the contrary the Board has found the following to be common shapes:



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*In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992) (common shape for floor mats); and



*In re Chevron Intellectual Property Group LLC*, 96 USPQ2d 2026 (TTAB 2010) (common shape for a pole spanner sign).

Applicant relies on five decisions (two of which are not precedential) to support its position that its bicycle enclosure is not a common shape. We have considered the decisions, however, we do not find them helpful in evaluating applicant's applied-for mark since the facts and the marks in each case differ from the facts and the applied-for mark in this case.

The specimen submitted by applicant is:



The examining attorney contends that while the applied-for mark is not a single geometric shape, it is a common shape, which the average consumer will not regard as the primary means of identification of applicant's services. In support of this position, in the Office action dated November 19, 2011, the examining attorney

submitted photographs of various bicycle enclosures used for advertising, all of which vary to some extent in their appearances:



(1) [www.postercity.de](http://www.postercity.de)



(2) [www.mobilebillboards.co.uk](http://www.mobilebillboards.co.uk)<sup>2</sup>

**Bike Advertising Services**

- Unique eye-catching design
- Zero carbon emission (although the rider does have to breathe!)
- Large 6 sheet posters
- Audio capability



(3) [www.lowrydersadvertising.com](http://www.lowrydersadvertising.com)

<sup>2</sup> These photographs are from a German website ([www.postercity.de](http://www.postercity.de)) and a UK website ([www.mobilebillboards.co.uk](http://www.mobilebillboards.co.uk)). While we generally do not consider information from foreign websites relevant, since these photographs were addressed by applicant in its brief, we consider any objection to them waived and we have considered the photographs in this decision.



(4) [www.sarasotabicycleleads.com](http://www.sarasotabicycleleads.com)



(5) [www.marquis-media.com](http://www.marquis-media.com)

In addition to the evidence submitted by the examining attorney, the applicant submitted an example of “an advertising bicycle” as an exhibit to its request for reconsideration dated December 13, 2012. The enclosure on the advertising bicycle, which is depicted in the photograph below, is rectangular.



Advertising bike.

Photo from Wikipedia article entitled “Billboard bicycle.”

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. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003). The burden on the Examining Attorney is to establish a

“reasonable predicate” for her position that the subject matter is not inherently distinctive. *Id.* The evidence of record illustrating advertising enclosures on bicycles establishes that bicycle enclosures vary in appearance, but are similar in that they are all attached to the backs of bicycles and include large areas for placement of one or more advertisements.

The applicant claims that the following features of its bicycle enclosure differ from the bicycle enclosures set forth above, thus establishing that its bicycle enclosure is inherently distinctive: “1) the substantially convex curvature of the side panels; 2) a rectilinear top panel not present in the triangular examples; 3) a rectangular bottom panel wider than the top panel and 4) front and back panels that have a shape that can’t be described by any word known to Applicant.”<sup>3</sup> Appeal Brief, p. 10. While the convex curvature of the side panels in applicant’s bicycle enclosure is different from the examples of other bicycle enclosures, rectilinear top and bottom panels are present in the enclosures depicted above as Number 2, which is located at [www.mobilebillboards.co.uk](http://www.mobilebillboards.co.uk), Number 5, which is located at [www.marquis-media.com](http://www.marquis-media.com) and in the advertising bike submitted by applicant. Moreover, in the photographs numbered 2 and 5, the rectangular bottom panel is wider than the top panel.

To support its position that the design of the enclosure is inherently distinctive, applicant submitted the Declaration of Ken Wetherell, principal of

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<sup>3</sup> Applicant’s inability to describe the shape of the side panels of its enclosure is irrelevant to our decision.

applicant and designer of the “applied for bicycle enclosure services mark.”<sup>4</sup> In his declaration, Mr. Wetherell states that the enclosure design was created independently and that the cost of manufacturing the enclosure is “many times greater than they would be with a design utilizing straight sides.”<sup>5</sup> These factors, however, are not relevant to a determination of inherent distinctiveness. Therefore, we give little, if any weight, to the Wetherell declaration.

The primary difference between applicant’s bicycle enclosure and the other bicycle enclosures of record is the convex shape of the sides of applicant’s enclosure. As such, our determination regarding the inherent distinctiveness of the applied-for mark is contingent on whether the convex shape of the sides of the enclosure is sufficient to establish that the enclosure would immediately be perceived as a service mark. While the shape of most, but not all, of the enclosures of record, is concave, we do not find that the convex-shaped sides of applicant’s enclosure are sufficiently different from the other shapes commonly used for bicycle enclosures to establish that consumers will immediately rely on it to differentiate applicant’s services from those of its competitors, particularly since consumers are familiar with bicycle enclosures that have different shapes. Applicant’s enclosure’s convex sides merely are rounded like a sphere as opposed to being inwardly rounded like a bowl or flat as are the sides in the other enclosures. Thus, the evidence of record establishes that the applied-for mark is not an uncommon shape for bicycle enclosures on which advertisements are placed. Accordingly, the examining

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<sup>4</sup> Witherell Decl. par. 1 (Exhibit to May 21, 2012 Response to Office Action.)

<sup>5</sup> Wetherell Decl. pars. 2 and 4.

attorney has established a reasonable predicate on which to base her conclusion that applicant's applied-for bicycle enclosure mark is not inherently distinctive.

The burden now shifts to the applicant to establish that the applied-for mark has acquired distinctiveness. Applicant has submitted no evidence to establish its mark has acquired distinctiveness, e.g., that the design of the enclosure is promoted as a service mark, or that anyone other than applicant considers the shape of its bicycle enclosure to be a service mark. Accordingly, we find that the applied-for mark has not acquired distinctiveness.

As fully discussed above, the examining attorney has met the Office's burden of establishing that applicant's bicycle enclosure is not inherently distinctive. Further, applicant has not established acquired distinctiveness.

*Decision:* The refusal to register pursuant to Sections 1, 2, 3, and 45 of the Trademark Act on the ground that the applied-for mark is nondistinctive trade dress that would not be perceived as a service mark but only as decoration or ornamentation, is affirmed.