

**This Opinion is Not a  
Precedent of the TTAB**

Hearing:  
December 10, 2015

Mailed:  
April 7, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re William D. Hober, Inc.*  
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Serial No. 85643266  
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Stephen R. Baird, Martha J. Engel and Wesley D. Anderson of Winthrop &  
Weinstine for William D. Hober, Inc.

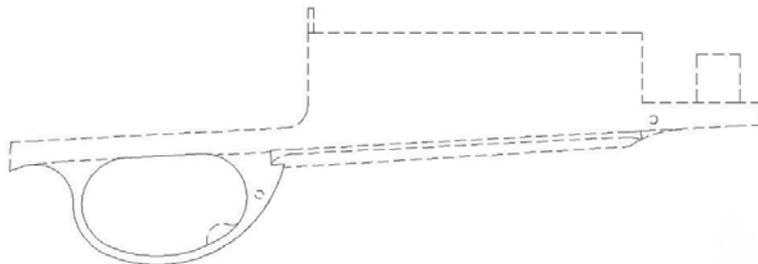
Dominic R. Fathy, Trademark Examining Attorney, Law Office 104,  
Chris Doninger, Managing Attorney.

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Before Quinn, Wolfson and Shaw,  
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

William D. Hober, Inc. (“Applicant”) seeks registration on the Principal Register  
of the proposed mark shown below



for “gun parts, namely, bottom metal for custom guns that incorporates a trigger guard shape” in International Class 13.<sup>1</sup> The matter shown in broken lines is not claimed as part of the mark. The application includes a description of the mark as follows:

The mark consists of a three-dimensional product design of a distinctive trigger guard profile shown in solid lines. The dotted lines indicate features that are not claimed as a part of the mark and are shown merely to indicate the position of the mark. The distinctive trigger guard profile has a concavely curved portion on the outer surface at a first end and a convexly curved portion on the outer surface extending from the concavely curved portion towards a second end. The inner surface of the distinctive trigger guard profile defines an asymmetrical mostly-curved opening having a generally straight portion at the top of the opening, transitioning to a first curved portion near a first end of the opening, transitioning to a second curved portion at the bottom of the opening, transitioning to a third curved portion near a second end of the opening. The first curved portion has a radius less than the radius of the second curved portion and a radius greater than the radius of the third curved portion.

The specimen of record is reproduced below.



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<sup>1</sup> Application Serial No. 85643266, filed June 5, 2012 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging dates of first use anywhere and first use in commerce of 1964.

The Trademark Examining Attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that the matter sought to be registered is functional; and under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1052, 1127, on the ground that the matter sought to be registered is a non-distinctive product design and that Applicant has failed to establish acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

When the refusals were made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, Applicant and the Examining Attorney filed briefs. Applicant's counsel and the Examining Attorney appeared at an oral hearing held before this panel.

We affirm the refusals to register.

## **FUNCTIONALITY**

Applicant argues that the Examining Attorney has failed to establish a *prima facie* case that its proposed mark as a whole is functional, asserting the Examining Attorney overlooked the "limited nature of the mark to be registered as set forth in the mark's description, instead erroneously relying on dictionary evidence defining a 'trigger guard.'" (7 TTABVUE 5). Applicant goes on to argue that even if the Examining Attorney is found to have made a *prima facie* case, Applicant's undisputed evidence has rebutted it, demonstrating that the proposed mark is not functional. Applicant urges that while all trigger guards provide a general function for a gun or rifle (*i.e.*, to protect against accidental discharge), this does not mean that a distinctive trigger guard profile is unregistrable *per se* as being functional. To this

point, Applicant highlights that different manufacturers use different designs to accomplish the general function of a trigger guard. More specifically, Applicant points to the absence of any utility (or design) patent covering its goods; the absence of advertisements employed by Applicant touting the utilitarian advantages of Applicant's trigger guard configuration; the availability to competitors of functionally equivalent alternative designs; and the absence of evidence to establish that Applicant's design results in a comparatively simple and cheap manufacturing method. According to Applicant, its trigger guard neither protects a trigger any more effectively than other available designs, nor does it provide any other functional advantages over other designs; that is, Applicant's trigger guard is not superior in function to alternative trigger guard designs utilized on other custom rifles. Applicant's argument may be summarized as follows: "The totality of the evidence of record provided by both the Examining Attorney and the Applicant shows that the claimed configuration provides no real utilitarian advantages to the user over other designs, and it is simply one of many equally feasible, efficient and competitive designs, and therefore registration of the mark should not be refused on the basis of functionality." (7 TTABVUE 12). Applicant submitted portions of its website, excerpts of third-party websites, and declarations.

The Examining Attorney contends that an oval shape is the superior shape for a trigger design and, while the curvature of an arch may differ from one design to the next, the overall availability of alternative designs of a trigger guard is extremely limited; and that Applicant's design is an indiscernible variation of a fundamental

oval trigger guard design that functions to protect against accidental discharge of a firearm. As pointed out by Applicant, this factor in considering the functionality of a product design — the availability of alternative designs — is the only factor upon which the Examining Attorney bases the functionality refusal. The Examining Attorney introduced dictionary, Wikipedia and internet evidence relating to trigger guards, as well as excerpts of a dozen third-party websites showing various trigger guard designs.

Section 2(e)(5) of the Trademark Act provides that registration of a product design may be denied if it “comprises any matter that, as a whole, is functional.” A product feature is functional and cannot serve as a trademark “if the feature is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982))). To afford registration to functional designs would inhibit legitimate competition by, in effect, granting a monopoly to a non-reputation related, or nonsource-identifying, feature of a product. *Qualitex*, 34 USPQ2d at 1163-64; *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985) (“If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its *de facto* purpose, it follows that competition is hindered.”). “To support a functionality rejection in proceedings before the Board, the PTO Examining Attorney must make a *prima facie* case of functionality, which if established must be

rebutted by ‘competent evidence.’” *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) (quoting *In re Teledyne Indus.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982)).

The Federal Circuit, our primary reviewing court, looks at four factors when it considers the issue of functionality:

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;
- (3) the availability to competitors of functionally equivalent designs; and
- (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

*Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir.2002) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982)). These are known as the “*Morton-Norwich* factors.”

Upon consideration of these factors, our determination of functionality is ultimately a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng'g*, 61 USPQ2d at 1424; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997). *See generally*, TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1202.02(a)(iv) (October 2015). “[O]ne object of the *Morton Norwich* inquiry is to weigh the elements of a mark against one another to develop an understanding of whether the mark as a whole is essentially functional and thus non-registrable.” *In re Becton, Dickinson and Co.*, 102 USPQ2d at 1376.

Furthermore, our primary reviewing court has instructed that “[w]henver a proposed mark includes both functional and non-functional features ... the critical question is the degree of utility present in the overall design of the mark.” *Id.* Functionality “means that the product is in its particular shape because it works better in this shape ... where a mark is composed of functional and non-functional features, whether ‘an overall design is functional should be based on the superiority of the design as a whole, rather than on whether each design feature is ‘useful’ or ‘serves a utilitarian purpose.’” *Id.*, (citing *Textron, Inc. v. Int’l Trade Comm’n*, 753 F.2d 1019, 224 USPQ 625, 630 (Fed. Cir. 1985)). “[A] mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.” *Id.* Furthermore, it is not required that all four factors be proven in every case, nor do all four factors have to weigh in favor of functionality to support a refusal. See *Valu Eng’g, Inc. v. Rexnord Corp.*, 61 USPQ2d at 1427; *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833 (TTAB 2013); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009).

With respect to the first *Morton-Norwich* factor, Applicant does not own a patent covering its trigger guard. The fact that the proposed mark is *not* the subject of a utility patent, however, does not establish that the proposed mark is nonfunctional. *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 58 USPQ2d at 1006-07; *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.3 (TTAB 2001).

As for the second *Morton-Norwich* factor, namely whether advertising touts the utilitarian advantages of Applicant’s design, there is little evidence in the record of

Applicant's advertising. (Ex. A, Response, Jan. 28, 2013). What sparse evidence there is does not show Applicant engaging in such activity.

With respect to the fourth factor, Applicant contends that its trigger guard design does not result in a comparatively simple or cheap method of manufacturing such goods. Rather, as shown by the record, Applicant's trigger guards generally cost more than other trigger guards. However, even if Applicant's design for custom guns is more expensive or more difficult to make, that does not establish that the design is not functional. *In re Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) (“[E]ven at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially... a superior quality wheel.”); *In re Pingel Enter. Inc.*, 46 USPQ2d 1811, 1821 (TTAB 1998) (“That applicant, despite the inherent advantages of a design which is simple and less expensive to manufacture than other petcocks, has, however, deliberately chosen a more complex and expensive manner in which to manufacture its product does not mean that the configuration thereof is not de jure functional.”). *See In re Am. Nat'l Can Co.*, 41 USPQ2d 1841, 1844-45 (TTAB 1997).

So as to be clear, as highlighted by Applicant and confirmed by the Examining Attorney, the functionality refusal in the present application is based primarily on the third *Morton-Norwich* factor, namely the availability to competitors of functionally equivalent alternative designs.

We accordingly turn to the primary factor at issue in this functionality refusal. The Federal Circuit has indicated that competition “is the crux of the functionality inquiry.” *Valu Eng'g*, 61 USPQ2d at 1427 (internal citations omitted). The

availability of alternative designs is relevant to show that the design sought to be registered will “preserve competition by ensuring competitors the right to compete effectively.” *Id.*; *In re Morton-Norwich Prods., Inc.*, 213 USPQ at 13. “[W]here the evidence shows that the specific product or container configuration at issue provides no real utilitarian advantages to the user, but rather is simply one of many equally feasible, efficient and competitive designs, then the mark may be registrable.” *Id.* at 16.

The Federal Circuit has noted, however, that the mere fact that other designs are available does not necessarily mean that an applicant’s design is not functional. *In re Bose*, 227 USPQ at 5-6 (“That another type of [design] would work equally as well does not negate that this [design] was designed functionally to enhance or at least not detract from the rest of the system ... If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its de facto purpose, it follows that competition is hindered. *Morton-Norwich* does not rest on total elimination of competition in the goods.” See *In re Van Valkenburgh*, 97 USPQ2d 1757, 1763 (TTAB 2011).

We begin our analysis with a dictionary definition of “trigger guard”: “a semicircular band of metal that encloses vertically the trigger of a firearm.” (www.merriam-webster.com, Office action, March 28, 2014). The record includes additional information about a “trigger guard”: “a loop surrounding the trigger of a firearm and protecting it from accidental discharge.” (Wikipedia, Office action, July 26, 2012). Other information states:

A trigger guard is a simple innovation, but an important one. Most gun triggers are fairly delicate, and aren't built nearly as ruggedly as other exposed portions of the firearm. This makes it desirable to protect triggers from damage, using a trigger guard. A trigger guard also helps prevent the trigger from being accidentally bumped or nudged, which may cause the gun to fire at a time when that might not be the best thing.  
(www.hunting.about.com, Office action, July 26, 2012).

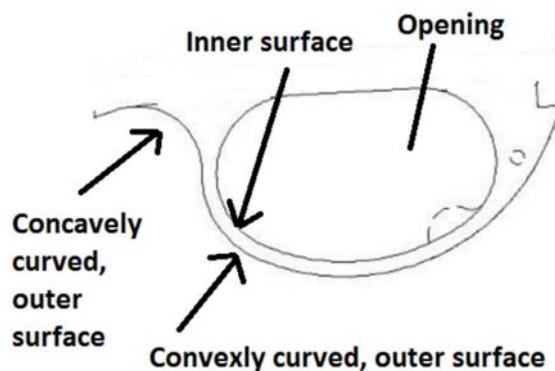
Applicant's trigger guards are components used for custom-made rifles; these guns are generally priced in the \$3,000-\$10,000 range. Some of the guns exceed \$10,000. The trigger guards themselves are priced at \$360-\$420. (Ex. B, Responses, Jan. 28, 2013, Aug. 19, 2013; Ex. C, Response, Jan. 28, 2013). In this connection, Applicant highlights the relevant classes of purchasers to whom its goods are directed:

[I]t is clear that discernible differences exist [among various trigger guards], especially in the mind of the relevant consumer for these gun parts. The design differences between these trigger guards are notable from the prospective consumers who desire a custom-rifle gun and are aware of the broad selection of trigger guards available for custom-designed guns and base purchasing decisions, at least in part, on "looks" and the differences in those designs. Each manufacturer utilizes different curves, angles and exterior design features which easily allow consumers in this market to identify the source of the goods. Thus, while an average person who is not a consumer of these products and therefore is not knowledgeable about custom gun parts may not appreciate the design differences, it is the differences (even subtle ones) that allow consumers of these products to identify the source. Because there are alternative product designs, the claimed configuration shown in the drawing of Applicant's mark does not appear to be essential to competition.  
(4 TTABVUE 7)

The mark sought to be registered is described in the application as being comprised of the following elements:

- a concavely curved portion on the outer surface at a first end;
- a convexly curved portion on the outer surface extending from the concavely curved portion towards a second end;
- and
- an inner surface that defines an asymmetrical mostly-curved opening having:
  - a generally straight portion at the top of the opening;
  - a first curved portion near a first end of the opening;
  - a second curved portion at the bottom of the opening;
  - a third curved portion near a second end of the opening;
  - and
  - the first curved portion with a radius less than the radius of the second curved portion and a radius greater than the radius of the third curved portion.

Applicant offered, in its request for reconsideration, the following depiction of its mark as described above in the application:



(4 TTABVUE 5). The latch release and pin, shown in broken lines, are not part of Applicant's proposed mark. *See* TMEP § 807.08.

In addition to the specimen photograph appearing earlier in this decision, the photographs below of Applicant's goods incorporating the claimed trigger guard mark are of record (Ex. B, Response, Jan. 28, 2013):



The Examining Attorney “for purposes of this appeal” focuses on the exhibits attached to his final refusal dated March 28, 2014. The Examining Attorney highlights an excerpt from a third-party’s website, also attached to the brief as Exhibit 1. ([www.pacifictoolandguage.com](http://www.pacifictoolandguage.com)). The excerpt is reproduced below:

Oberndorf style bottom metal has the latch release lower in the trigger bow than standard Remington bottom metal.



The Examining Attorney claims that Applicant's design comprises an Oberndorf style trigger guard, "and draws attention to this detail to show a commonality between the applicant's design and the design of competing Oberndorf style trigger guards" that were introduced as exhibits attached to the final refusal. (9 TTABVUE 8).<sup>2</sup>

The Examining Attorney submitted during examination the following examples of third-party trigger guards (which include bottom metals), including Oberndorf guards, that he views as designs similar to Applicant's design:



(Office action, March 28, 2014: Jerry Fisher for Winchester, [www.midwayusa.com](http://www.midwayusa.com))

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<sup>2</sup> The Examining Attorney specifically references five of the designs. Two of the five examples highlighted by the Examining Attorney are trigger guard designs that, according to the website, have been "discontinued." (Williams Firearms Oberndorf Trigger Guard for Remington, [www.midwayusa.com](http://www.midwayusa.com); and Sunny Hill Trigger Guard for Mauser, [www.midwayusa.com](http://www.midwayusa.com)). Because these trigger guards are no longer manufactured, we decline to consider them to be alternative designs. In any event, these designs are Oberndorf style guards, and the examples are merely cumulative of the evidence already of record.

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(Office action, March 28, 2014: Badger Ordnance Model M4, [www.midwayusa.com](http://www.midwayusa.com))



(Office action, February 19, 2013: [www.midwayusa.com](http://www.midwayusa.com))



(Office action, February 19, 2013: [www.midwayusa.com](http://www.midwayusa.com))



(Office action, February 19, 2013: [www.gunauction.com](http://www.gunauction.com))



(Office action, July 26, 2012: [www.millerrodandgun.com](http://www.millerrodandgun.com))



(Office action, July 26, 2012: [www.williamsfirearms.com](http://www.williamsfirearms.com))

The Examining Attorney views Applicant's trigger guard design as a basic, common shape of a trigger guard, more specifically, an Oberndorf trigger guard. We agree. The Examining Attorney states that "while fundamental shapes can be dissected and described in great, lengthy detail, the drawing of the applied-for mark categorically shows an overall oval or loop." (9 TTABVUE 5). Applicant's trigger guard widens out at the two parts where the guard meets the gun bottom; each of these widened features function like a fillet, that is, to distribute stress over a broader area to effectively make the guard more durable. By adding surface area to these two points of contact, the guard is stronger. The front portion of the guard appears to be wider to accommodate the hinge pin and lower release mechanism found in Oberndorf guards. The guard is flat at the top where it meets the gun, and the bottom is rounded. The outer surface is concave at one point, and convex at another. All of these characteristics of trigger guards appear to be virtually universal in the firearm industry, especially in Oberndorf guards. There is nothing in the description of the mark that elevates the functional design or shape of Applicant's trigger guard into a non-functional source indicator; rather, Applicant's trigger guard has its shape because the trigger guard works better in this shape.

Given that it is beyond debate that the basic oval or loop shape of a trigger guard is functional, Applicant's proposed mark describes a very narrow range of features that it claims to be non-functional. The inclusion of a few arbitrary features in the design (*e.g.*, the radii of the curved portions) does not appreciably detract from the overall functionality of the design as a whole. *See In re Becton, Dickinson and Co.*, 102 USPQ2d at 1376 (where a mark is composed of functional and non-functional features, whether an overall design is functional should be based on the superiority of the design as a whole, rather than on whether each design feature is useful or serves a utilitarian purpose). "A mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional." *Id.* We view Applicant's trigger guard to be in the nature of an Oberndorf design (or one that is very similar thereto) with some non-functional features that are so subtle or insignificant that the design remains functional as a whole and, as such, a design that may not be appropriated for exclusive use. The photos of the various Oberndorf trigger guards of record show that each may be incrementally different from the others, but the slight differences do not impact the degree of functionality of each trigger guard. Granting a registration to Applicant would give it a competitive advantage in the firearm industry. Because the description of the claimed trademark essentially describes the essence of a trigger guard, with only minor variations in the radii of the curved portions and the concaved and convexed-shaped outer portions, the design is one of very few that are necessary for superior function of a trigger guard. *In re Gibson Guitar Corp.*, 61 USPQ2d at

1950. That is to say, the evidence showing that Applicant's design is one of a few superior designs available supports a finding of functionality. Moreover, the fact that Applicant's trigger guard design may give, as Applicant claims, a gun a unique, custom look does not necessarily mean that the design is not functional.

In connection with its argument that there are many equally feasible, efficient and competitive designs, Applicant submitted photographs and website excerpts of what it considers to be alternative designs for trigger guards. (Ex. B, Response, Jan. 28, 2013). In this connection, Applicant also has reproduced pictorial representations wherein it overlaid its applied-for design over several third-party trigger guards. (Response, Sept. 29, 2014, pp. 9-12). Although Applicant claims that the lack of a perfect match shows the existence of a variety of alternative designs, we view the representations, in each instance, as slight variations of a basic oval-shaped trigger guard, especially as compared to other Oberndorf style guards. Further, the alternative designs relied upon by Applicant appear to be, at least to our eyes, slightly off in terms of perspective. Thus, rather than showing alternative designs, we find that most simply show an oval design with incremental differences, if any. Further, we recognize that while some trigger guard designs may be square or in a similarly shaped geometric design, the evidence persuades us that an oval loop, as utilized in Applicant's trigger guard, is one of a small number of superior designs.

In support of its position, Applicant also introduced seven third-party registrations, all issued under Section 2(f), to show that firearm configurations are registrable: Registration Nos. 2731436; 2807745; 2807747; 2939065; 3924411;

3936156; and 3936157. (Response, Jan. 28, 2013, Ex. E). Each of these registered marks comprises an overall three-dimensional configuration of a pistol; the descriptions of the marks include “the shape and appearance of the trigger guard” among several other features of each mark. Inasmuch as the marks comprise the overall configurations of various pistols, and not a trigger guard standing alone, we are not persuaded by Applicant’s reliance thereon. In any event, each case must be decided on its own facts, and the Board is not bound by the prior actions of the Office. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Applicant also submitted the declaration of its president, William D. Hober. Mr. Hober, in relevant part, states the following regarding functionality:

The distinctive Blackburn trigger guard design does not provide any functional advantages. The distinctive Blackburn trigger guard design does not protect a trigger any more effectively than other available designs, nor does it provide any other functional advantages over other available designs. The distinctive Blackburn trigger design is not superior in function to alternative trigger guard designs utilized on other guns or rifles.

The distinctive Blackburn trigger guard design is one of many equally feasible, efficient and competitive alternatives for trigger guards.  
(Ex. A, Response, Aug. 19, 2013)

We are not persuaded by Applicant’s evidence. Rather, we find that Applicant’s rather ordinary, oval-shaped trigger guard design is one of a very few alternative designs for trigger guards. Accordingly, we conclude that the applied-for design is functional. As our primary reviewing court has stated:

That another type of [design] would work equally as well does not negate that this [design] was designed

functionally to enhance or at least not detract from the rest of the system ... If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its de facto purpose, it follows that competition is hindered.

*In re Bose*, 227 USPQ at 5-6.

In making our determination, we keep in mind the guidance from the Supreme Court that “[t]he functionality doctrine ... protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely their inability reasonably to replicate important non-reputation-related product features.” *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 34 USPQ2d at 1165. To afford registration to functional designs would inhibit legitimate competition by, in effect, granting a monopoly to a non-reputational, or non-source-identifying, feature of a product. *Id.*, 34 USPQ2d at 1163-64. As emphasized in *Morton-Norwich*, which sets out the analytical factors, “the effect on competition ‘is really the crux of the matter,’” and a balance must be struck “between the ‘right to copy’ and the right to protect one's method of trade identification.” *In re Morton-Norwich*, 213 USPQ at 15-16.

Based on all of the record evidence and arguments in relation to the *Morton-Norwich* factors, we find that the overall design of Applicant's configuration is “essential to the use or purpose of the article.” *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 58 USPQ2d at 1006. Thus, we find that the trigger guard design as a whole is functional and is not registrable on that basis.

The refusal under Section 2(e)(5) is affirmed.

## ACQUIRED DISTINCTIVENESS

In the event that Applicant ultimately prevails with its contention that the mark sought to be registered is not functional, we now turn to consider the refusal of non-distinctiveness and the issue of acquired distinctiveness. We agree with the Examining Attorney that the proposed mark is not inherently distinctive.

Applicant's resort to the benefits of acquired distinctiveness under Section 2(f) is deemed to constitute a concession that the design sought to be registered is not inherently distinctive as a source indicator of its goods and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 132, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). *See generally* TMEP § 1212.02(b) ("For the purposes of establishing that the subject matter is not inherently distinctive, the Examining Attorney may rely on this concession alone. Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness.").

In seeking registration of a mark under Section 2(f), Applicant bears the ultimate burden of establishing acquired distinctiveness. *See In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("There is no doubt that Congress intended that the burden of proof under [Section 2(f)] should rest upon the applicant for registration...."). *See also Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Applicant's burden is to prove acquired

distinctiveness by a preponderance of the evidence. *See In re Noon Hour Food Prods. Inc.*, 88 USPQ2d 1172, 1181 (TTAB 2008).

The record includes, as noted above, the declaration of Mr. Hober. With respect to acquired distinctiveness, Mr. Hober states, in relevant part, the following:

I believe that the profile of the Blackburn trigger guard design is a distinctive and recognizable trademark because it clearly identifies, distinguishes and indicates the source of the trigger guard sold under the Blackburn word mark. The Blackburn trigger guard design is one of the most recognizable trigger guard profiles. Consumers of custom gun parts are capable of recognizing a trigger guard design having the shape [as shown in the proposed mark] as being a genuine Blackburn trigger guard.

I regularly attend annual trade shows in the gun industry, and attendees have communicated their shared beliefs that the Blackburn trigger guard design is iconic, unique and distinctive among available trigger guard designs within the industry.

I believe that the Blackburn trigger guard design is among the most distinctive trigger designs in the United States. I would consider the trigger guard profile to be an iconic trademark.

(Ex. A, Response, Aug. 19, 2013)

Also of record is the declaration of Ted Blackburn, original designer of the trigger guard design at issue. Mr. Blackburn assigned his rights in the trigger guard design now sought to be registered to Applicant on May 17, 2011. Mr. Blackburn states, in relevant part:

Since at least as early as 1964 I began selling visually distinctive gun parts that I personally designed in order to differentiate my gun parts from those made and/or offered by others. These visually distinctive gun parts consist of a unique trigger guard configuration and a unique floorplate assembly.

Since at least as early as 1988, I have been marking and stamping my gun part products with a © notice to put others on actual notice of the exclusive rights in my gun part designs.

Based upon my decades of experience in the firearms industry, it is my firm belief that the shape and configuration of the unique trigger guard and floorplate assembly designs, both designed and created by me, function as trademarks because consumers in the firearm industry view them as actually identifying Blackburn as the source of the goods, and further view them as differentiating genuine Blackburn gun parts from the competing gun parts offered by others.

For decades, the firearm industry has respected my dominion over the look and appearance of these gun part configurations and the underlying common law intellectual property rights in my designs, never attempting to reproduce them without my express permission.

Over many decades of the substantially exclusive use of not only my Blackburn surname as a trademark, but also the unique Blackburn trigger guard and floorplate assembly configuration trademarks, it is my firm belief that the word Blackburn and the unique look and appearance of the Blackburn trigger guard and floorplate assembly truly have become distinctive of these goods in the marketplace. In fact, it is my understanding that customers in the firearm industry are able to associate the Blackburn name and trademark with my trigger guard and floorplate assembly designs and configurations by their shapes and silhouettes alone, even when the Blackburn name and mark are not visible.

As a result of my efforts – over several decades – to promote awareness and recognition of my distinctive gun part shapes and designs, as well as my established reputation in the firearm industry, consumers of Blackburn goods have naturally recognized, identified, and associated Blackburn distinctive gun part designs as strong indicators of Blackburn being the source of those goods.

I am intimately familiar with the use of the marks. I remain convinced that competitors and customers associate the marks as coming from a single source.  
(Ex. F, Response, Jan. 28, 2013)

A third-party wrote about Applicant's trigger guard as follows: "The distinctive profile of [Applicant's] bottom metal has attracted top custom gun makers for nearly 50 years. The floorplate is hidden, no unsightly visible latch, making it ideal for engraving. Additionally, the sculpted lines of [Applicant's] clean design are completely in tune with that unique and special creation we call an American classic custom rifle." (Ex. A, [www.americanrifleman.org](http://www.americanrifleman.org), Response, January 28, 2013).

Applicant's advertising includes the following statements:

In 1964, Ted Blackburn created what has become the unequaled gold standard in bottom metal for custom rifles. With its sleek, distinctive TRIGGER BOW PROFILE, it has become an industry icon and the trademark of a truly custom built rifle. For decades this recognizable trigger bow design has signified the finished look of a custom rifle. (emphasis in original).

[Applicant] is proud to have acquired this great trademark and is equally as proud to continue the tradition of bringing this iconic design to gun makers all over the world.

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The Blackburn trigger guard bow profile is recognized as a trademark and the sign of a true custom gun. Everything else is just an imitation.  
(Ex. A, Response, Jan. 28, 2013).

Applicant's website includes the following statements:

Craftsmanship in this beautifully sculptured bottom metal is unequaled in design and reputation. Metal tolerances are extremely tight and move like a fine watch. Designed by Ted Blackburn in 1964. The Blackburn trigger guard

bow profile is recognized as a trademark and the sign of a true custom gun. This profile has attracted custom rifle makers for almost 50 years.

(Ex. A, Response, Aug. 19, 2013)

The record also includes 35 form declarations from gunsmiths, custom gun purchasers and gun industry professionals. Each declaration sets forth the declarant's name, and the number of years he has been involved in the gun industry. Further, each declarant states that he has not been compensated for signing the declaration, and each declaration includes a reproduction of a drawing showing the proposed mark sought to be registered herein. Each declarant has "been exposed to many different trigger guard designs available for use in manufacturing custom guns, including the Blackburn bottom metal trigger guard design." The declarations further read in relevant part as follows:

As a purchaser of custom guns and custom gun parts, I consider the look of the trigger guard profile when making purchasing decisions. While there are many trigger guards available on the market that serve the same useful purpose of protecting the trigger, there are certain trigger guard designs which are more recognizable and stand out as trademarks from the crowded field of gun components for custom gun manufacturing. One of the most recognizable trigger guard profiles is the Blackburn bottom metal trigger guard design.

I believe that the profile of the Blackburn bottom metal trigger guard is a distinctive and recognizable trademark because it clearly identifies, distinguishes and indicates the single source of the trigger guard sold under the Blackburn word mark.

As a consumer of custom gun parts, even absent seeing the Blackburn trademark, I am able to recognize a trigger guard having the shape [of Applicant's trigger guard

design] as being a genuine Blackburn bottom metal trigger guard.

I believe that the Blackburn bottom metal trigger guard design is among the most distinctive trigger guard designs in the United States. I would consider the trigger guard profile to be an iconic trademark.  
(Ex. A, Response, March 10, 2014)

Finally, as part of the evidence to support its claim of acquired distinctiveness of the trigger guard design, Applicant claims ownership of the mark registered on the Principal Register as shown below



for “gun parts” in International Class 13.<sup>3</sup> The registration includes the following description: “The mark consists of a distinctive trigger guard design.” Applicant also owns the mark registered on the Principal Register as shown below



(“CUSTOM GUN METAL” disclaimed) for “gun parts” in International Class 13.<sup>4</sup> The registration includes the following description:

The mark consists of the stylized word “BLACKBURN” in the color white and outlined in black, a distinctive black and silver trigger guard suggests the letter “U” in the word “BLACKBURN” which appears to be resting on the letters “CKB” and the letters “RN” in the word “BLACKBURN”; below are the words “CUSTOM GUN METAL” in the color silver; the stylized word “SWIFT” in the color red is above

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<sup>3</sup> Registration No. 4246049, issued November 20, 2012.

<sup>4</sup> Registration No. 4246958, issued November 20, 2012.

the letters “BLA” in the word “BLACKBURN,” a space divides the letters “SWIFT” simulating the bullet went through the word “SWIFT.”

The following statement also appears in the registration: “The color(s) silver, red, white and black is/are claimed as a feature of the mark.”

Given that the proposed mark essentially is a product configuration, we find that the Section 2(f) evidence falls short of establishing acquired distinctiveness of the trigger guard design. The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (CCPA 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729, 730 (TTAB 1985).

The declarations of Messrs. Hober and Blackburn are entitled to limited probative value on this issue. Their statements about the trigger guard design being “distinctive” are self-serving, carrying little weight on the ultimate question of whether purchasers perceive the design as a trademark. *See In re Chem. Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (finding conclusory declaration from applicant’s vice-president insufficient without the factual basis for the declarant’s belief that the design had become distinctive); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (finding affidavit of applicant’s counsel expressing his belief that the mark has acquired secondary meaning of “no probative value whatsoever” because, among other reasons, the statement is subject to bias).

We recognize that Applicant began using the proposed mark in 1964. However, long and continuous use alone does not necessarily establish that the term has acquired distinctiveness as a mark. *See In re Gibson Guitar Corp.*, 61 USPQ2d at 1952; *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1158 (TTAB 2009); *Flowers Indus. Inc., v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987). Further, while absolute exclusivity is not required for a Section 2(f) registration, see *L.D. Kitchler Co. v. Davoli, Inc.*, 192 F3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999), the widespread use of Oberndorf trigger guards that are virtually indistinguishable from Applicant's guard is inconsistent with Applicant's claim of acquired distinctiveness. Applicant's use of a trigger guard design, which is virtually indistinguishable from competing guards in the industry, falls short of being "substantially exclusive" as required by the statute. *See 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."); *Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Service*, \_\_\_USPQ2d\_\_\_ (TTAB, Opp. No. 91211014, Mar. 31, 2016).

Moreover, the record is devoid of evidence regarding sales revenue and advertising expenditures under the proposed mark; in the absence of such evidence, we are unable to gauge with any degree of accuracy the extent of exposure of the trigger guard design to the relevant purchasing public. In any event, even if the

numbers were impressive, compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. *See In re Boston Beer Co., L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 sales revenues and 740,000 tires sold insufficient to show acquired distinctiveness of tire tread design).

With respect to Applicant's advertising, it falls short of qualifying as "look-for" promotional language. Applicant's statements refer to the proposed mark as "iconic" and as a "trademark"; however, there is nothing to indicate that Applicant highlighted the purported features comprising its mark. That is, none of the advertising emphasizes, let alone even mentions the various claimed features that comprise the mark and purportedly serve to distinguish it from the similar oval trigger guard designs of others in the trade. Simply put, there is nothing in the record showing that Applicant promotes its design in a way that would imbue it with source-identifying significance. *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1574 (TTAB 2009); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1285-86 (TTAB 2000). We are unable to conclude that consumers would view the trigger guard design as Applicant's trademark merely because it is the trigger guard portion of a firearm. *See In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2024 (TTAB 2008).

That brings us to the only direct evidence of acquired distinctiveness, namely the declarations of 35 customers of Applicant's trigger guard. This evidence is relevant in establishing acquired distinctiveness.<sup>5</sup> In determining what weight to give this evidence, we do not agree with the Examining Attorney's view that the weight is diminished by the fact that the declarations are from "very sophisticated purchasers" rather than "the community of purchasers at large." (9 TTABVUE 17-18). We say this because the identification of goods indicates that Applicant's trigger guards are for "custom guns," and the record shows that these guns can cost thousands of dollars. Thus, the relevant purchasing public would comprise consumers who are knowledgeable about custom guns, and are willing to pay an appreciable amount of money for them.

We find, nevertheless, that the declarations fall short. In reviewing the declarations, we are struck by how many times each declarant views the design as "distinctive" and "recognizable," but without ever explaining why. Other than a mere reference to the "look" of Applicant's trigger guard, no reference is made to any of the elements of the proposed mark as described in the application. That is, the declarants do not set forth a specific factual basis for their belief that the design at issue has become distinctive as a trademark. *See In re Udor U.S.A. Inc.*, 89 USPQ2d at 1987; *In re Chem. Dynamics Inc.*, 5 USPQ2d at 1830; *In re Petersen Mfg. Co.*, 2 USPQ2d 2032, 2035 (TTAB 1987) (finding declarations from customers which stated that

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<sup>5</sup> The identical wording of the form declarations does not detract from their significance to the Section 2(f) issue. *See, e.g., In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396, 399 (CCPA 1972); *In re Pingel Enter.*, 46 USPQ2d 1811, 1822 (TTAB 1988).

designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not persuasive).

Finally, Applicant's registrations showing a silhouette of its trigger guard design are of little probative value in assessing the distinctiveness of the present design shown in a three-dimensional configuration. Simply put, the proposed mark is not the "same mark" as that shown as a portion of the marks already registered. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). *See also In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1423 (TTAB 2010) (finding three-dimensional product packaging trade dress mark is not the legal equivalent of a two-dimensional design logo).

In view of the above, the evidence supporting Applicant's claim of acquired distinctiveness is insufficient.

**DECISION:** The refusal of registration under Section 2(e)(5) on the basis of functionality is affirmed. The refusal of registration on the basis that the proposed mark is a non-distinctive design, and that the Section 2(f) claim of acquired distinctiveness is insufficient is affirmed.