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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87604697

MARK:



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** SafeRack, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

51031-26

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant appeals the trademark examining attorney's Final refusals to register under Trademark Act Section 2(e)(5), and Trademark Act Sections 1, 2, and 45. 15 U.S.C. §1052(e)(5), and §§1051-1052, 1127.

Registration was refused because the applied-for color yellow mark, as applied to the goods, is functional for such goods incapable of identifying source or origin. Also, registration was refused

because the applied-for color yellow mark is not inherently distinctive and acquired distinctiveness has not been proven.

### **STATEMENT OF FACTS**

On September 12, 2017, Applicant, SafeRack, LLC, filed an application under Trademark Act Section 1(a), 15 U.S.C. §1051(a), claiming acquired distinctiveness under Section 2(f), 15 U.S.C. §1052(f), for the color yellow as applied to, “bolt-on stair rails, handrails, ladders, made of metal, as components of a larger pre-manufactured and configurable product system, made of metal.”

On November 8, 2017, the examining attorney issued an Office action refusing registration under Trademark Act Section 2(e)(5), and Trademark Act Sections 1, 2, and 45, denying Applicant’s claim of acquired distinctiveness.<sup>1</sup>

On May 8, 2018, Applicant responded by arguing against the refusals to register, and denial of the claim of acquired distinctiveness.<sup>2</sup>

On June 5, 2018, registration was Finally refused because the applied-for yellow mark, as applied to, “metal bolt-on stair rails, handrails for ladders, and guardrails, available individually and as configurable component”, is functional for such goods incapable of identifying source under Trademark Act Section 2(e)(5). In addition, registration was refused under Trademark Act Sections 1, 2, and 45, because the applied-for color yellow mark is not inherently distinctive and acquired distinctiveness had not been proven under Trademark Act Section 2(f).

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<sup>1</sup> A requirement for information, and requirements for clarification of the description of the mark and identification of goods was also issued.

<sup>2</sup> The incoming communication satisfied the requirement for information, and requirements for clarification of the description of the mark and identification of goods.

On December 5, 2018, Applicant filed a notice of appeal to the Trademark Trial and Appeal Board (Board), and a Request for Reconsideration of the final refusals, and denial of the claim of acquired distinctiveness. The Request for Reconsideration presented additional arguments and evidence against the refusals to register, and claim of acquired distinctiveness under Trademark Act Section 2(f).

On January 10, 2019, after consideration of the arguments and all evidence of record, the examining attorney denied the request for reconsideration, and issued a second final refusal under Trademark Act Section 2(e)(5), and Trademark Act Sections 1, 2, and 45, denying the claim of acquired distinctiveness under Trademark Act Section 2(f).

On February 28, 2019, the Board resumed the appeal, on April 29, 2019, Applicant filed his Appeal brief, and on May 2, 2019, the application was remanded to the examining attorney for briefing.

#### **ISSUES ON APPEAL**

- 1. Applicant's color yellow mark is functional as applied to the goods incapable of indicating source or origin under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).**
- 2. Applicant's color yellow mark should be refused registration under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127.**
- 3. Applicant's color yellow mark has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f).**

#### **PRELIMINARY EVIDENTIARY ISSUE**

Applicant objects to the evidence included in the January 10, 2019, Office action because of an inadvertently included response clause indicating that he had 6 months to respond. However, Applicant

was afforded the proscribed time for a denial of a Request for Reconsideration that fails to present new issues or new evidence significantly different from that previously submitted.

Trademark Manual of Examining Procedure Section 715.04(b) states that where a Request for Reconsideration containing new evidence has been filed, that “The examining attorney may also introduce additional evidence directed to the new evidence submitted by the applicant.” TBMP §1207.04; TMEP §715.03.

The January 10, 2019, Office action, acknowledged the request for reconsideration and new evidence, indicated which refusals were maintained, and explained why. As for advising Applicant that the Board would be notified to resume the Appeal, the Board itself took this initiative in the Notice of Appeal Proceeding issued February 28, 2019, indicating that the six month response clause was inadvertent. Notwithstanding, the additional evidence submitted in this Office action was not of a significantly different type from that previously attached, and includes webpages from Applicant’s own website.

Although non-precedential, a similar situation was recently presented in *In re Fair Isaac Germany GmbH* (Serial No. 87424333), TTAB opinion May 28, 2019, that is instructive. In that case, the Board considered evidence attached to a denial of a Request for Reconsideration over Applicant’s objection as to the timelines and ability to review it. As in *In re Fair Isaac Germany*, Applicant could have requested remand of its application to address this additional evidence, the additional evidence was not of a different nature or type than that previously included, and Applicant was able to, and did, present arguments in response to this evidence in his Appeal brief.

## **ARGUMENTS**

### **A. APPLICANT’S COLOR YELLOW MARK IS FUNCTIONAL AS APPLIED TO THE GOODS**

Registration is refused because the applied-for mark, which consists of the color yellow as applied to handrails and guardrails, appears to be functional for such goods. Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); see TMEP §1202.02(a)-(a)(ii). A feature is functional if it is “essential to the use or purpose of the [product]” or “it affects the cost or quality of the [product].” *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995)); *Inwood Labs., Inc., v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982); TMEP §1202.02(a)(iii)(A).

A determination of functionality normally involves consideration of one or more of the “Morton-Norwich factors.” *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374-75, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982). However, there is no requirement that all four of the *Morton-Norwich* factors weigh in favor of functionality to support a refusal. See *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002) (“once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs”); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (affirming the functionality refusal of “a round disk head on a sprayer nozzle” where the third and fourth factors showed that applicant’s competitors manufactured and marketed spray nozzles with similar features, the shape was preferred in the industry, and it appeared efficient, economical, and advantageous, even though applicant’s utility patent and advertising did not weigh in favor of functionality); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006) (holding orange flavor for pharmaceuticals to be functional based on applicant’s touting of the utilitarian advantages of the flavor and the lack of evidence of acceptable alternatives, even though there was no patent or patent application and there was no evidence that the flavor affected the cost of the product).

With regards to color marks, functionality has been found where use of the color yields a utilitarian or functional advantage, such as yellow or orange on safety signs being more visible, or if it provides competitive advantages. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) (holding the color black functional for outboard motors because it provides competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1446-48 (TTAB 2007) (holding the color dark purple functional for sand paper because color serves a myriad of functions in the coated abrasives industry, including maintaining a uniform appearance of the product and color coding for grit size or coarseness); *In re Ferris Corp.*, 59 USPQ2d 1587 (TTAB 2000) (holding the color pink functional for use on surgical wound dressings because the actual color of the goods closely resembles Caucasian human skin); *See* TMEP §§1202.02(a)(viii), 1202.05(b); *cf. Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1983).

A color that is functional for specific goods is not registrable on the Principal Register under Trademark Act Section 2(f) or on the Supplemental Register, regardless of evidence of acquired distinctiveness. TMEP §1202.05(b); *see Brunswick Corp.*, 35 F. 3d at 1534, 32 USPQ2d at 1125.

The applied-for color yellow mark serves a utilitarian functional purpose. The color yellow is functional when placed on the goods because it is one of the few high visibility “safety colors” available to caution or warn people, and is the primary color used on handrails and guardrails in manufacturing and industrial environments for this purpose.<sup>3</sup> For example:

- Sherwin Williams’ *Safety Color Guide*, states that the color yellow is used to caution of physical hazards and specifically on handrails;

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<sup>3</sup> See Exhibit A from the January 10, 2019, Office action.

- *The Engineering Toolbox* states that the color yellow is a cautionary color used on guardrails and handrails;
- *The Color of Safety*, asserts the color yellow is cautionary and used on handrails;
- *EHS Today* states that, “surfaces colored safety yellow are the ‘most visually detectable’ according to the U.S. Access Board Research”;
- The *Occupational Safety and Health Administration* of the UNITED STATES DEPARTMENT OF LABOR indicates that the color “yellow” is a basic designating color for tripping and falling hazards;
- *Safety Color Codes*, by Gary Weidner, explains that OSHA has only two mandatory colors, namely, red and yellow, that these colors may be displayed in any shade thereof, and that yellow in particular is used as cautionary for tripping and falling hazards because it is the most visible of all colors, attention-compelling and universally recognized;
- *Performance Industrial* states that OSHA generally does not make mandatory requirements, but instead makes recommendation for industry standards, with yellow being used to caution against “tripping, falling and striking hazards”, and examples of use being on, “handrails and guardrails”; and
- *SafetySigns.com* states that both ANSI and OSHA use yellow to caution against tripping and falling hazards<sup>4</sup>

This evidence plainly shows that yellow is a functional color when used on handrails and guardrails in industrial settings because it is essential to the use or purpose of the goods. The high visibility of the color yellow alerts or warns of potential tripping or falling in a dangerous potentially life threatening

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<sup>4</sup> See also Exhibit A from the January 10, 2019, Office action, *Safety Signs and Signals*, The Health and Safety (Safety Signs and Signals) Regulations 1996, showing that the color yellow is used to caution people overseas as well.



environment, and having railing that is bright with greater visibility makes it easier to see as they are being used.

Applicant repeatedly refers to its goods as safety products, and its own advertising touts this utilitarian function of the color yellow when used on handrails. For example:

- *ErectaStep Prefabricated Metal Stairs* advertising shows yellow on handrails attached to stairs, with statement, “ANSI yellow handrails and midrails for high visibility and safety”<sup>5</sup>,
- *Aluminum Handrail* advertising shows yellow on handrails with statements, “Each aluminum handrail section is powder coated in ANSI yellow for extra durability and longer service life”, “Because ErectaStep’s aluminum handrail are pre-engineered, in-stock and ready to ship, you’ll get your safety rails project completed a lot sooner.”, and “The product is powder-coated in ANSI safety yellow for a safe and durable finish”<sup>6</sup>,
- *Industrial Stair Systems* advertising shows the color yellow on handrails attached to stairs with phrases, “Always OSHA compliant”, and “choose from IBC or OSHA compliant models”, and defines the applicable OSHA regulations to include, “Yellow shall be the basic color designating caution and for marking physical hazards such as striking against, stumbling, falling, tripping, and ‘caught in between’”<sup>7</sup>,
- *Industrial Stairs* advertising shows yellow on handrails attached to stairs with phrases, “Powder Coated Aluminum Industrial Stairs”, and “Always OSHA Compliant Metal Stairs”<sup>8</sup>, and
- “As a company, we put our hearts into what we build, and we believe our products are essential to the safety and productivity of your employees.”<sup>9</sup>, “Designed for work, built for safety.”<sup>10</sup>

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<sup>5</sup> See Exhibit C from January 10, 2019, Office action at page 71 in TMNG.

<sup>6</sup> See Exhibit C from January 10, 2019, Office action at page 73 in TMNG.

<sup>7</sup> See Exhibit C from January 10, 2019, Office action at pages 63 and 66 in TMNG, and Applicant’s May 8, 2018 response at pages 21-22 in TMNG.

<sup>8</sup> See Exhibit C from January 10, 2019, Office action at page 67 in TMNG.

<sup>9</sup> See Applicant’s May 8, 2018 response at page 19 in TMNG.

<sup>10</sup> See Exhibit C from January 10, 2019, Office action at page 62 in TMNG, and Applicant’s May 8, 2018 response at page 23 in TMNG.

The present case is similar to *In re Orange Commc'ns, Inc.*, 41 USPQ2d 1036 (TTAB 1996), and *In re Howard S. Leight & Assocs.*, 39 USPQ2d 1058 (TTAB 1996).

In *In re Orange*, the applicant applied to register the colors yellow and orange for public telephones and telephone booths. Registration was refused on the grounds that the color yielded a utilitarian or functional purpose. The Board upheld the refusal because the evidence showed common usage as a “safety color” that the color provides greater visibility under all lighting conditions in the event of an emergency.

In *In re Howard S. Leight*, the applicant applied to register the color coral for earplugs. Registration was refused on the grounds that the color yielded a utilitarian or functional purpose. The Board upheld the refusal stating that the brightly colored earplugs were more readily visible, and that such visibility aids in monitoring for employee compliance with health and safety regulations, even though the earplugs themselves may also be functional.

In the present case, as in *In re Orange*, and *In re Howard S. Leight*, the color yellow serves a utilitarian function, namely, it is used for the high visibility it provides, especially as it pertains to ensuring safety in a dangerous setting. Yellow provides greater visibility making it easier to see, focus on, and grab onto to avoid trips and falls. In industry it is regarded as a “safety color” because of its visibility and use on handrails and guardrails is recommended, if not required. As in *In re Howard S. Leight*, that the goods themselves are also intended to offer a degree of safety does not change the utilitarian nature of the color as used on the goods. Instead, the evidence in this case, as in *In re Orange*, and *In re Howard S. Leight*, shows there is a utilitarian function to the color yellow when placed on the goods, namely, the high visibility draws attention to it and makes it easier to see and use for safety reasons.

Applicant argues that the mark is not functional because no utility patent exists for the color yellow applied on the goods, its advertising does not extol any utilitarian feature of the color yellow on the goods, and there are a multitude of alternative colors which may be placed on the goods. However, this argument is unconvincing.

As stated above, these “*Morton-Norwich factors*” are for consideration when relevant to the mark as applied to the goods. When the mark is for color, functionality has been found where use of the color yields a utilitarian or functional advantage. Here, the color yellow serves a utilitarian functional purpose because it is one of the few high visibility “safety colors” available to caution or warn people, and is the primary color used on handrails and guardrails in manufacturing and industrial environments for this purpose. *Id.*

Relying upon *Vaughan Mfg. Co. v. Brikam Intern., Inc.*, 814 F2d 346, 1 USPQ2d 2067 (7th Cir. 1987), and *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F3d 206, 103 USPQ2d 1937 (2nd Cir. 2012), Applicant argues that the mark is not functional because there are alternative colors available, and that the specific nature of the goods has not been adequately considered. However, these decisions are nonbinding on the Board as they were decided by the Seventh and Second Circuits, not our reviewing Federal Circuit, and they are not illustrative because the issue of utilitarian functionality was not decided.

Even so, if the Board were to consider these cases, the decisions and reasoning in *Vaughan Mfg. Co.* and *Christian Louboutin* support a refusal in this case.

In *Vaughan Mfg. Co.*, the Appellate Court upheld a decision that the mark was not functional reasoning that it was highly unlikely for someone to arrive at the same color combination in the same locations for folding tables, unless that someone was copying registrant’s color trade dress. Employing this reasoning to the current case, it is highly likely that third parties would arrive at using the color

yellow on similar goods given that it is widely known as a “safety color” and industry standard in industrial settings.

In *Christian Louboutin*, the Appellate Court reiterated that a mark serves a utilitarian function when it is essential to the purpose and use of these goods. Here, the applied-for color yellow mark serves a utilitarian functional purpose in industrial settings because it is required by regulations to be used on handrails and guardrails. The high visibility warns or alerts of potential hazards that may cause physical harm, and the color makes it easier to see the handrails and guardrails as they are being used. The specific nature of the goods and mark used thereupon has been carefully considered. That applicant’s particular goods are configurable or are easier to assemble or disassemble does not change the visibility of the color nor indication as a “safety color” in industry.

Referring to *In re Hudson News Corp.*, 39 USPQ2d 1915 (TTAB 1996), Applicant argues that his conclusion that the color yellow is not functional should be accorded conclusive weight because the specific industry or market is indeterminate, and he is in the best position to ascertain functionality. However, *Hudson News Corp.* does not stand for this proposition, and instead supports the conclusion that the color yellow is functional in this case.

In *Hudson News Corp.*, the applicant applied for a blue motif comprising the color blue on carpet, lighting, and shelving for newsstand services. Registration was refused on the grounds of functionality, and lack of acquired distinctiveness. The Board reversed the refusal on functionality grounds reasoning that although each individual component may have a functional use, the combined elements as a whole did not, that there was no evidence of utility for blue in retail stores, and that there would be no hindrance to competition if permitted registration. However, the Board affirmed the refusal based upon the applied-for mark not having acquired distinctiveness, despite sworn statements to the contrary from Applicant. See *In re Hudson News Corp.*, 39 USPQ2d at 1924 (stating, “Although

applicant argues that its trade dress is “striking”, this assertion is supported by neither evidence nor reasons).

In the present case, unlike *Hudson News Corp.*, the type of goods and intended use is clear and unambiguous. Applicant provides handrails and guardrails that may be used in industrial environments with the entire surface in the color yellow. The utility of the color yellow on these goods is clearly shown by the industry guidelines that require “safety yellow”, and supported by applicant’s own advertising touting compliance with these standards.

**B. APPLICANT’S COLOR YELLOW MARK SHOULD BE REFUSED REGISTRATION UNDER TRADEMARK ACT SECTIONS 1, 2, AND 45**

Registration is refused because the applied-for color yellow mark, consisting of one color used on the surface of the goods, is not inherently distinctive. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166, 34 USPQ2d 1161, 1164 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1121-23, 227 USPQ 417, 420-21 (Fed. Cir. 1985); TMEP §1202.05(a). Such marks are registrable only on the Supplemental Register or on the Principal Register with sufficient proof of acquired distinctiveness. See *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 n.4 (TTAB 2017) (citing TMEP §1202.05(a)).

Attached to the November 8, 2017, and January 10, 2019, Office actions refusing registration is substantial evidence demonstrating that use of color on handrail and guardrails is common, that consumers are familiar with viewing the color yellow on the goods as functional matter, and that numerous third parties are currently offering similar goods in the color yellow. Where the use of color is common in a particular field or industry, customers are more accustomed to recognizing color as a product feature that may enhance the attractiveness of the goods. See *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d at 1441. For that reason, an applicant in such a case has a difficult burden demonstrating that

purchasers recognize a color as distinctive of applicant's goods. *See Saint-Gobain Corp.*, 90 USPQ2d at 1441; TMEP §1202.05(a).

Applicant did not argue against this refusal, instead filing the application with a claim of acquired distinctiveness. A claim of distinctiveness is a concession that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1403 (TTAB 2018); TMEP §1212.02(b). However, Applicant's Section 2(f) claim is not supported by the evidence, and thus the refusal is maintained and made final.

**C. APPLICANT'S COLOR YELLOW MARK HAS NOT ACQUIRED DISTINCTIVENESS UNDER TRADEMARK ACT SECTION 2(f), 15 U.S.C. §1052(f).**

When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). The burden of proving that a color mark has acquired distinctiveness is substantial. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (holding the color pink used on fibrous glass residential insulation to have acquired distinctiveness based on evidence of twenty-nine years' use, extensive affidavit and documentary evidence, surveys, and extensive media advertising expenditures); *In re Am. Home Prods. Corp.*, 226 USPQ 327 (TTAB 1985) (holding combination of colors pink, white and yellow used on an analgesic/muscle relaxant tablet to have acquired distinctiveness based on evidence of more than twenty years' use, extensive advertising, and sales of over two billion tablets from 1960-1980); *cf. In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998). Applicant must provide evidence demonstrating that the purchasing public has come to view the proposed color yellow as an indicator of source or

origin for the goods; a mere statement of long use is not sufficient. TMEP §1202.05(a); *see* TMEP §1212.06.

In the present case, Applicant claims acquired distinctiveness based upon a combination of evidence, namely, the duration and exclusivity of use of the mark in commerce, expenditures on advertising and revenue generated from sales, sample advertisements from a campaign, nine consumer declarations, and a declaration from the CEO of Applicant. However, the totality of the evidence fails to show that the applied-for color yellow mark has acquired distinctiveness. Applicant's submission fails to show a concerted effort, or success therefrom, to educate the consumer to view the color yellow as applied to the goods as identifying a source or origin for the goods.

First, Applicant's claimed continuous and exclusive use in commerce since 2010 while relevant is of little persuasiveness, and is rebutted by the evidence. The length of use of the mark does not show that consumers have become accustomed to seeing an otherwise non-distinctive color as a source identifier for the goods. *See, e.g., In re Benetton Group S.p.A.*, 48 USPQ2d at 1216-17 (despite long use, record devoid of any evidence that the green rectangular background design has been used, promoted, or advertised as a mark); TMEP § 1202.05(a). Moreover, the exclusivity of use of the color yellow on handrails and guardrails is questionable given that the evidence shows over fifteen third parties currently offering similar goods in commerce in the color yellow.<sup>11</sup> For example,

- *WireCrafters* discusses their ability to provide OSHA compliant industrial handrails for safety and shows a picture of the hand railing in the color yellow while describing it as a, "safety yellow powder coat finish",
- *Amezz.com* manufactures and sells industrial stairs and handrails for industrial applications and shows pictures of the finished products in use with the handrails in the color yellow,

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<sup>11</sup> See Exhibits A, B and D from the January 10, 2019, Office action.

- *Southern Metal Fabricators* manufactures and sells OSHA compliant industrial stairs, particularly for curved buildings and structures, and includes two pictures of the goods, one at the factory floor and the other installed as a finished product around a curved structure with the handrails in the color yellow,
- *Panel Built* sells OSHA compliant stairs and includes pictures of the goods with the railing in the color yellow,
- *Lapeyre Stair* manufactures and sells stairs for industrial applications and includes a picture of the goods with the railing in the color yellow,
- *Dakota Safety* offers a variety of modular handrail safety systems showing a picture of the finished goods with the handrails in the color yellow, stating that railing is “powder coat painted finish in safety yellow”,
- *Omega* manufactures and sells a variety of industrial stairways and platforms and shows pictures of them, all with the handrails in the color yellow,
- *Grainger* sells modular railing in the color yellow,
- *Simplified Safety* offers handrails in the color yellow and shows pictures of railing in use in the color yellow,
- *Kenway Composites* manufactures and sells handrail systems in a “yellow safety color”,
- *Strongwell* offers industrial railing systems in a “standard safety yellow color”,
- *MF* offers safety railing in the color yellow,
- *IndustrialProducts.com* offers a variety of industrial stairs with pictures showing the handrails in a “powder coat yellow finish”,



- *NWL* manufactures industrial platforms and shows prior work products with the handrails in the color yellow,
- *Global Industrial* offers a variety of industrial mezzanines for sale with pictures of the goods showing the handrails in the color yellow, and
- *Spika* manufactures and sells a variety of modular OSHA/ANSI compliant work platforms and includes pictures of the goods, all of which show the handrails in the color yellow

Given this lack of exclusivity, the length of use becomes even less significant. See *In re Ferris Corp.*, 59 USPQ2d at 1592 (“Finally, with respect to applicant’s length of use, given the nature of the involved mark (i.e., a single color applied over the entire product which is very similar to colors used by competitors), we are unable to conclude that consumers have come to recognize applicant’s color ‘pink’ as an indication of source based upon this length of use.”); see also *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042 (TTAB 2013).

Second, Applicant’s sample advertisements show a lack of effort at educating the consumer to view the color yellow as a source for the goods. More specifically, the advertisements merely show that the goods may be arranged in a variety of configurations under a variety of conditions necessary in industrial environments. Nowhere on these advertisements is there information or wording addressed to the consumer to see the color yellow appearing on the goods as a source indicator for the goods, known as “Look for” advertising. “Look for” advertising directs the potential consumer in no uncertain terms to look for a certain feature, in this case the color yellow, to know that the goods are from that source. See *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d at 1572. Instead, every advertisement merely shows the goods in various arrangements and configurations with the color yellow appearing thereon, and additional wording, such as ERECTaSTEP, “Quality That Stands

The Test of Time”, “The 8<sup>th</sup> Wonder of the World.”, and “Built for Safety.”<sup>12</sup> The average consumer viewing these advertisements is more likely to consider these slogans and additional wording as a source for the goods given the ability to pronounce and call for the goods that words provide. *Cf., Grote Indus, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1213 (TTAB 2018) (where advertising prominently used word mark, consumers are more likely to associate the word mark rather than the design with the source of the goods); *see also, In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (advertising displaying the design at issue along with word marks lacked the “nexus” that would tie together use of the design and the public’s perception of the design as an indicator of source); *In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967) (where a container design appeared with a word mark, any alleged association of the design with the company “was predicated upon the impression imparted by the [word] mark ... rather than by any distinctive characteristic of the container per se.”). The pictures showing various configurations of stairs with yellow handrails merely suggests the many different arrangements and durability that is provided by configurable stairs and handrails, which are necessary for safety railing in industrial environments. Accordingly, Applicant’s advertisements are not very probative because they do not demonstrate a concerted effort to educate the prospective purchasers to view the color yellow as an indicator of source or origin.

Third, Applicant’s assertion of advertising expenditures and revenue while relevant is of little persuasiveness. No specific information about the color yellow and Applicant’s efforts to educate the consumer to associate yellow with a source identifying function may be gleaned from these figures. The amount expended does not indicate which part is attributable to advertising the goods themselves versus advertising the mark as a source for the goods. Given the sample advertisements in this application, it is questionable what, if any, amount of the aggregate number has been targeted at

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<sup>12</sup> See Exhibit C from the January 10, 2019, Office action comprising additional examples of Applicant’s advertising.

educating the consumer about the mark, rather than a feature or use of the goods. Similarly, the revenue generated is an indication of the success of Applicant's business endeavor. It is not proof that consumers recognize the color yellow as a mark for the goods. See *In re Ferris Corp.*, 59 USPQ2d at 1592 ("Although the sales and advertising figures are not insignificant, given the fact that the applied-for mark is merely a single color, and further that very similar colors have been used by competitors for wound dressings, this evidence does not rise to the level necessary to support a finding of acquired distinctiveness in this case. We cannot conclude from these figures that consumers recognize the 'pink' colored wound dressings as indicating origin with applicant."); see also *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed Cir. 1999).

Fourth, Applicant's nine consumer statements while relevant are of little persuasiveness because they are self-supporting and prefabricated form declarations. More specifically, it appears each statement was solicited by Applicant to a customer of theirs using a prefabricated template for [insert party] to [fill out], and refers to evidence not in the record, namely, use of the tagline "Look for the Yellow Handrails." These type of prefabricated form declarations are conclusory, and of little persuasiveness. See *In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) ("Because these affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer for paints perceives the words 'PAINT PRODUCTS CO.' in conjunction with paints and coatings."); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) (finding sixteen declarations of little persuasive value, as they were nearly identical in wording and only one of the declarants was described as an end consumer); see also *FTD*, 106 USPQ2d at 1794 n.9; *In re Pohl-Boskamp*, 106 USPQ2d at 1052. Because all the statements stem from customers of Applicant in which a regular business relationship exists it is only logical to conclude that these customers would recognize the color yellow on the goods as being from Applicant. Moreover, all the statements were collected using a prefabricated

form and refers to evidence not in the record. Finally, there may also be a self-interest in part from some of the customers to please/maintain good relations with a business associate.

Fifth, Applicant's declaration is of little persuasiveness because it is subject to bias and self-serving. See *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); Further, the statements contained therein refer to evidence not in the record and are inaccurate. See *In re Chem. Dynamics Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (finding conclusionary declaration from applicant's vice-president insufficient without the factual basis for the declarant's belief that the design had become distinctive). More specifically, reference is made to "Look for" sample advertisements that shows how applicant educates the consumer to view the color yellow as applied to safety railing as a source identifier for Applicant, however, nothing has been submitted to substantiate these claims. In addition, it contains inaccurate statements, such as claiming exclusivity of use in commerce when the evidence demonstrates differently, and referring to the goods as "prefabricated modular platforms and stairs", when the applied-for goods are handrails and guardrails for these items.

In sum, Applicant has not proven that the applied-for color yellow as applied to handrails and guardrails has acquired distinctiveness as a source identifier in the mind of the average consumer.

### **CONCLUSION**

Applicant's applied-for yellow mark is functional when used on handrails and guardrails, and acquired distinctiveness has not been proven.

For the foregoing reasons, the refusals to register Applicant's yellow mark under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5), and Trademark Act Sections 1, 2, and 45. 15 U.S.C. §§1051-1052,

1127, and denial of the claim of acquired distinctiveness, Trademark Act Section 2(f), 15 U.S.C. §1052(f), should be affirmed.

Respectfully submitted,

/VJ/

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