

This Opinion is not a  
Precedent of the TTAB

Mailed: July 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Solberg Mfg., Inc.*

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Serial No. 88456147

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James Conte of Conte Law Group LLC,  
for Solberg Mfg., Inc.

Michael L. Engel, Trademark Examining Attorney, Law Office 107,  
Leslie Bishop, Managing Attorney.

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Before Zervas, Heasley and Dunn,  
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Solberg Mfg., Inc. (“Applicant”) seeks registration on the Principal Register of the proposed mark 377 in standard character form for “Machine part, namely, air intake filter element as a part of vacuum pumps, air compressors or blowers” in International Class 7.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88456147, filed on June 2, 2019. The dates of use are discussed below.

The application stands rejected under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, because Applicant's mark, as used on the specimens of record, merely identifies a model designation and fails to function as a trademark. For the reasons discussed below, we affirm the refusal to register.

## I. Background

The application as originally filed claimed first use and first use in commerce at least as early as the year 2005 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and included the following specimen:



The Examining Attorney refused registration of Applicant's proposed mark under Sections 1, 2 and 45 because the proposed mark merely identified a model designation. Applicant argued against the refusal, but the Examining Attorney was not persuaded by Applicant's arguments, and maintained the refusal in a first Final Office Action. Applicant then filed a request for reconsideration in which it amended its application to seek registration under the provisions of Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The USPTO then published the application for opposition in the Official Gazette.

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Six months after the issuance of a Notice of Allowance, Applicant filed a Statement of Use, claiming first use and first use in commerce on December 1, 2015, and submitted a multi-page specimen (“hereinafter Second Specimen”), including the following two pages:<sup>2</sup>

6/15/2021

**SOLBERG®**

Polyester Media Filter Elements | Solberg Filtration



MODEL #

**377P™**

**\$304.00 / each**

Please order in case or box quantities.

A \$100.00 net minimum order is required. Thank you.

<https://www.solbergmfg.com/replacement-elements/polyester-elements/377p>

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<sup>2</sup> June 15, 2021 specimen.

**Specifications**

MODEL	377P
FLOW (SCFM)	1825
MEDIA	Polyester
MICRON RATING	5
O.D. (IN.)	14.62
I.D. (IN.)	9.00
HEIGHT (IN.)	14.50
SURFACE AREA (SQ FT)	50.00
ENDCAP STYLE	GN
QUANTITY PER BOX	1
CASE QUANTITY	1

**Features**

- Temp (continuous): min -15° F (-26° C) max 220° F (104° C)
- Filter change out differential: 15-20" H<sub>2</sub>O (37-50 mbar) over initial delta P
- Moisture resistant
- 99%+ removal efficiency @ 1, 4, 5, 10, 25, 100 micron

<https://www.solbergmfg.com/replacement-elements/polyester-elements/377p>

The Examining Attorney refused registration because the applied-for mark shown in the Second Specimen merely identifies a model designation. Applicant argued against the refusal, but the Examining Attorney was not persuaded by Applicant’s arguments and issued a second Final Office Action.<sup>3</sup>

Applicant next filed a request for reconsideration of the second Final Office Action along with the following specimen (hereinafter “Third Specimen”):

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<sup>3</sup> Dec. 26, 2021 Final Office Action.



The Examining Attorney denied the request for reconsideration and maintained the Section 1, 2 and 45 refusal of the Second Final Office Action, stating that the applied-for mark as used on the Third Specimen merely identifies a model designation.

Applicant then appealed to this Board. Both Applicant and the Examining Attorney filed briefs.

## **II. Evidence Submitted**

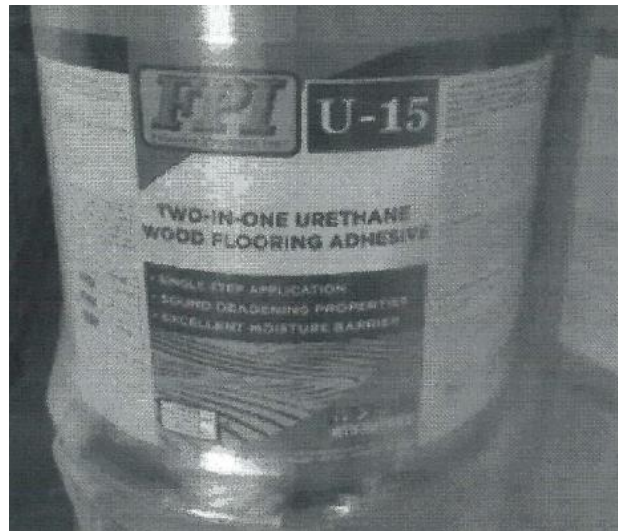
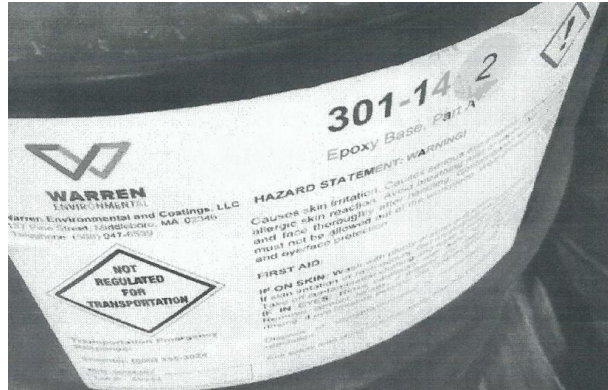
To support acceptance of its specimens of use, Applicant submitted what it says are samples of third-party specimens of use that have been accepted by the USPTO, stating that Applicant's specimen shows its number mark more distinctively than the

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<sup>4</sup> The writing at the bottom of the label is illegible.

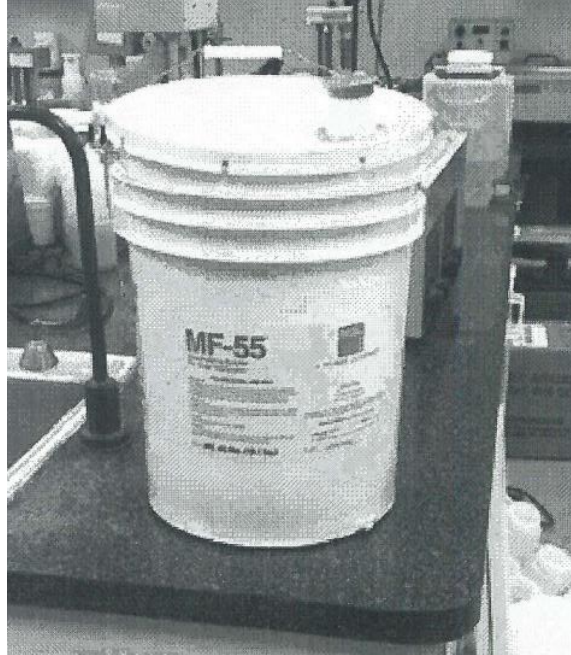
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number marks on the accepted specimens of use. Among the samples submitted by Applicant are the following:<sup>5</sup>



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<sup>5</sup> June 14, 2022 Req. for Recon., TSDR 2-11.



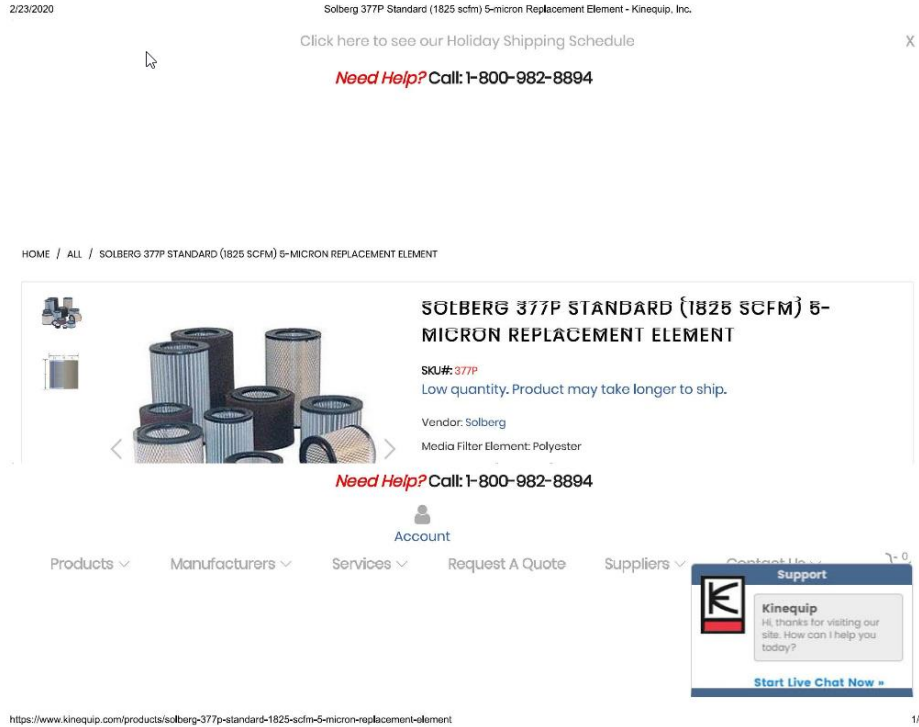
Applicant provided no information regarding the third-party registrations corresponding to the third-party specimens, such as their registration numbers or even the identity of the registered marks or the goods with which they are used, nor did it submit any other filings from the third-party registration records. There are also differences in the terms displayed on those specimens and Applicant’s proposed mark – some of the terms in the third-party specimens are alpha-numeric terms, whereas Applicant’s term is a simple number. For these reasons, the third-party specimens have very limited probative value.

In addition to the third-party specimens, Applicant submitted a webpage from a “reseller,” and states that the “prominent display of 377 by the reseller indicates the reseller believes 377 operates as a brand for Applicant. The P stands for polyester and does not alter the prominence of the 377”:<sup>6</sup>

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<sup>6</sup> Feb. 23, 2020 Resp. to Office Action, TSDR 3.

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Applicant also provided screen shots of the results of a search on the [www.autozone.com](http://www.autozone.com) website for “Custom Air Filters.”<sup>7</sup> According to Applicant, the results show that filter resellers use alpha or numerical code with the wording “part number”; that they operate as a model number; and that they do not constitute just a number, such as the number “377”; and “[t]he brevity of Applicant’s designation, in contrast to the lengthy designations ... indicates the 377 makes a unique impression to a purchaser.”<sup>8</sup>

The Examining Attorney did not submit evidence.

<sup>7</sup> February 23, 2020 Resp. to Office Action, TSDR 13-16.

<sup>8</sup> *Id.*, TSDR 3.



### III. Failure to Function Refusal/Model Designation

“It is well settled that terms used merely as model, style, or grade designations are not registrable as trademarks because they do not serve to identify and distinguish one party’s goods from similar goods manufactured and/or sold by others.” *In re Dana Corp.*, 12 USPQ2d 1748, 1749 (TTAB 1989). “This is so because such a designation serves as a description of the product, informing one of the quality, size or type of the particular product, rather than serving as an identifier of the source of the goods.” *Id.* The determination of whether a proposed mark is unregistrable because it is a model, style, or grade designation is a question of fact. *Id.*

“[T]he central question in determining whether Applicant’s proposed mark functions as a [trademark] is the commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the [goods]).” *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017). In this regard, we consider the stylization of the display, the size of the proposed mark, and the physical location of the proposed mark on a specimen. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §§ 1202.16(b)(i), (i)(A), (i)(B), and (i)(C) (July 2022).

Each specimen submitted by Applicant is discussed in turn below.

A. First Specimen



The proposed mark is without stylization, is ordinary, and is the same font, size and line as other matter which is not part of the proposed mark.<sup>9</sup> The number sign next to the number “377” suggests that the proposed mark is a model designation, as Applicant states on its webpage. The entire specimen is in black and white – the number “377” is not distinguished from other matter on the label.<sup>10</sup> Additionally, the close proximity of the number “377” to the “#” and to the bar code makes the proposed mark more likely to be considered, not as a source indicator, but as a model designation. TMEP § 1202.16(b)(i) states, “A proposed mark that appears in close proximity to ... informational matter (such as the common or class name for the goods, net weight, bar code...) is less likely to be perceived as a mark because it will be viewed ... as merely conveying information about the model of a particular product

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<sup>9</sup> The Examining Attorney submitted a definition of “number sign” (defined in part as “#”) with his brief and requested that we take judicial notice of the definition of this symbol. 12 TTABVUE 8. We grant the Examining Attorney’s request and take judicial notice of this symbol. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

<sup>10</sup> TMEP § 1202.16(b)(i) states, “[w]here the stylization is minimal, the proposed mark may be more likely to be perceived as merely a model designation.”

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line.” In view of the foregoing, we find that First Specimen does not display the proposed mark as a source indicator, and hence it does not function as a mark.

## B. Second Specimen

6/15/2021

Polyester Media Filter Elements | Solberg Filtration

**SOLBERG®**



MODEL #

**377P™**

**\$304.00 / each**

Please order in case or box quantities.

A \$100.00 net minimum order is required. Thank you.

<https://www.solbergmfg.com/replacement-elements/polyester-elements/377p>

**Specifications**

MODEL	377P
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**Features**

- Temp (continuous): min -15° F (-26° C) max 220° F (104° C)
- Filter change out differential: 15-20" H<sub>2</sub>O (37-50 mbar) over initial delta P
- Moisture resistant
- 99%+ removal efficiency @ 1, 4, 5, 10, 25, 100 micron

<https://www.solbergmfg.com/replacement-elements/polyester-elements/377p>

The Second Specimen does not display the proposed mark – it displays the designation “377P.” The letter “P” does not form a commercial impression separate from “377P” because it appears in the same font and the same bold lettering as the number “377,” and is not separated from “377.” In addition, “377P” appears directly under the term “Model #” on the first page and next to the word ‘Model’ on the second page, as single term in the URL, and as part of a list of specifications for the goods. The potential consumer is told that the term “377” is a model number.

We find that the Second Specimen does not demonstrate use of the applied-for mark as a source indicator but rather is a model designation.

C. Third Specimen



The Third Specimen displays a label with the “TM” designation next to the proposed mark on a plain cardboard box. The label contains the term “Solberg” and a design element, in addition to some other wording that is not legible and hence is given no further consideration.

TMEP § 904.03(a) states as follows regarding labels: “[i]n most cases, if a trademark is ordinarily applied to the goods or the containers for the goods by means of labels, a label affixed to the goods is an acceptable specimen”; and “[s]hipping or mailing labels may be accepted if they are affixed to the goods or to the containers for the goods and if proper trademark usage is shown.” (citing *In re A.S. Beck Shoe Corp.*, 161 USPQ 168 (TTAB 1969); *Elec. Comm’ns, Inc. v. Elec. Components for Indus. Co.*, 443 F.2d 487, 170 USPQ 118 (8th Cir. 1971)).

We find that the Third Specimen does not demonstrate use of the applied-for mark as a source indicator, but rather as a model designation. Again, the messaging in Applicant's website indicates that "377" designates a model designation. In addition, (i) the label is in plain, black, simple font, essentially the same font as the term "Solberg" on the label; (ii) it is placed on a plain brown cardboard box without any description of the contents of the box, suggesting that the term is a model number for the goods; and (iii) the "TM" symbol does not transform any designation into a trademark.<sup>11</sup>

In sum, we find that each of the specimens demonstrate that the number 377 is a model designation for Applicant's goods.<sup>12</sup>

Next, we address Applicant's statement that a "numeric designations can perform a dual role, indicating model, part, or grade, while at the same time serving as a source indicator."<sup>13</sup> If, by this argument, Applicant intends to contend that its

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<sup>11</sup> Applicant points to use of the "TM" symbol in support of its claim that 377 functions as a source indicator. 10 TTABVUE 14. Applicant's "mere intent that a term function as a trademark [however] is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark." *In re Aerospace Optics Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006) (quoting *In re Manco Inc.*, 24 USPQ2d 1938, 1941 (TTAB 1992)); see also *In re Empire Tech Dev. LLC*, 123 USPQ2d 1544, 1556 n.23 (TTAB 2017); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) ("[T]he use of the 'TM' does not, ipso facto, make a trademark or service mark out of the term or expression in connection with which it is used.").

<sup>12</sup> Applicant refers in its briefs to a prior registration it obtained for the mark "19." This registration is not of record; we cannot determine how similar its record is to the present record. And even if it were of record, it would not be persuasive. It is settled law that "[e]ach application for registration must be considered on its own merits." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.* 828 F.2d 1567, 4 USPQ 1141, 1143 (Fed. Cir. 1987) (citing *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985)); see also *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) ("It has been said many times that each case must be decided on its own facts.") (internal citations omitted).

<sup>13</sup> Reply brief, 13 TTABVUE 5.

proposed mark acquired distinctiveness through Applicant's promotion and use, Applicant, however, has submitted no evidentiary support for its argument. *Cf., In re Peterson Mfg. Co.*, 229 USPQ 466, 468 (TTAB 1986) (“[A]pplicant has submitted evidentiary material in the nature of declarations from customers which is relevant to support applicant's claim that the various designations are perceived as trademarks.”); *In re Waldes Kohinoor, Inc.*, 124 USPQ 471, 472 (TTAB 1960) (“These documents do not show that the numerals, for which applicant seeks registration, have been promoted by applicant as trademarks for its goods; they fail to show use of the numerals by either applicant, its customers or prospective customers, or by anyone else in the trade as anything other than as type designations to differentiate one type of applicant's retaining rings from its other types; and there is nothing therein from which it can be concluded that purchasers recognize these numerals as trademarks to distinguish applicant's goods from similar goods manufactured or sold by others.”).

In view of the foregoing, we find the specimens submitted by Applicant do not demonstrate that the number 377 when used in connection with the goods identified in the application functions as a source indicator. *Id.* (“These documents ... fail to show ... that purchasers recognize these numerals as trademarks to distinguish applicant's goods from similar goods manufactured or sold by others.”).

**Decision:** The Section 1, 2 and 45 refusal to register is affirmed.