

This Opinion is Not a
Precedent of the TTAB

Mailed: March 2, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Wood-Mizer, LLC
v.
Norwood Industries Inc.

—
Cancellation No. 92067329

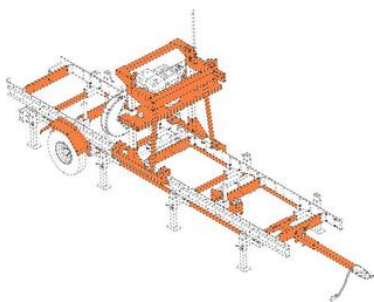
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Harold C. Moore of Maginot Moore & Beck LLP
for Wood-Mizer, LLC.

Nadya M. Sand and Holly Hawkins Saporito of Alston & Bird
for Norwood Industries Inc.

—
Before Wellington, Heasley and Hudis, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Petitioner, Wood-Mizer, LLC, seeks to cancel Registration No. 4891113, owned by Respondent, Norwood Industries, Inc., for the mark shown below (“orange color mark”):



for “portable band sawmills; portable chainsaw sawmills” in International Class 7. Respondent’s registration issued on the Principal Register on January 26, 2016, with a claim of acquired distinctiveness under Trademark Act (“the Act”) Section 2(f), 15 U.S.C. § 1052(f). The mark is described in the registration as consisting of “the color orange applied to cross bunks of log deck, fenders, sawmill carriage, sawhead, sawmill carriage support posts, log deck rails, sawmill carriage base, and tow bar on portable sawmills.”¹

Petitioner alleges the registration should be canceled on the grounds of lack of distinctiveness and fraud.²

Respondent, in its Answer, as amended, denies Petitioner’s allegations.³

The cancellation proceeding has been fully briefed by the parties.

¹ The broken lines in the drawing merely show the shape of the goods, which is not claimed as a feature of the mark.

² Amended Petition to Cancel filed November 7, 2017 (12 TTABVUE). Petitioner also pleaded a claim of likelihood of confusion; however, it did not argue this claim in its trial brief. Respondent, in its brief, asserts that Petitioner did not pursue this claim. 90 TTABVUE 23 (note 7). Petitioner did not respond to this assertion in its reply brief and is therefore considered to have waived this claim. *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (opposer’s pleaded claims not argued in its brief deemed waived), *aff’d*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015).

Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

³ 14 TTABVUE. Respondent also asserted the affirmative defense of contractual estoppel; however, this defense was dismissed by the Board (see 94 TTABVUE).

I. The Record and Evidentiary Objections

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's involved registration.

In addition, Petitioner submitted:

- Declaration of Deanna Bunten, Petitioner's Corporate Director—Marketing, with exhibits;⁴
- Petitioner's Notice of Reliance on, *inter alia*, printed publications, printouts third-party websites, printouts from Petitioner's website, including archived webpages, printouts from Respondent's website, including archived webpages, and copies of Respondent's responses to Petitioner's first set of interrogatories;⁵ and
- Testimony deposition transcript (submitted during Petitioner's rebuttal period) of "Cross-Examination" of Ashlyne Dale, Respondent's President.⁶

Respondent filed a Notice of Reliance on the following materials:

- Petitioner's responses to Respondent's first set of interrogatories Nos. 2-3, 6-12, 18, 23-24;⁷
- Testimony deposition transcript of Deanna Bunten, with exhibits that include her January 13, 2021 declaration;⁸

⁴ 40-41 TTABVUE and 42 TTABVUE ("confidential").

⁵ 43-44 TTABVUE.

⁶ 87 TTABVUE.

⁷ 52 TTABVUE (redacted copy identified in N. of Reliance as "Exhib. 1"); 58 (copy designated "confidential").

⁸ 52, 71-73 TTABVUE (redacted copy identified in N. of Reliance as "Exhib. 2"); 58, 74-78 TTABVUE (entire deposition transcript and certain exhibits designated "confidential").

- Testimony deposition transcript of Darryl Floyd, Petitioner’s President, with exhibits;⁹ and
- Printouts of email correspondence;¹⁰ and
- Testimony affidavit of Ashlynn Dale, with exhibits.¹¹

Several of the parties’ evidentiary submissions, or portions thereof, have been designated “confidential” and filed separately under seal.¹² However, some of that evidence is clearly not confidential, but still was filed under seal.¹³ To the extent either party improperly designated testimony and evidence as confidential, we are not bound to maintain the asserted confidential designation. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”); *see also Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *12 (TTAB 2022) (“If a party over-designates material as confidential, the Board will not be bound by the party's designation, and will treat as confidential only

⁹ 52, 69 TTABVUE (redacted copy identified in N. of Reliance as “Exhib. 3,” only certain exhibits made public); 59, 70 TTABVUE (entire deposition transcript and certain exhibits designated “confidential”).

¹⁰ 52 TTABVUE (identified in N. of Reliance as “Exhib. 4”); 59 TTABVUE (copy designated “confidential”).

¹¹ 52-56 TTABVUE (identified in N. of Reliance as “Exhib. 5”); 59-68 TTABVUE (certain exhibits designated “confidential”).

¹² 42 TTABVUE (Petitioner’s evidentiary submissions designated “confidential”); 58-68, 70, and 74-77 TTABVUE (Respondent’s evidentiary submissions designated “confidential”).

¹³ For example, entire testimony deposition transcripts have been designated confidential (see Notes 9 and 10) when testimony regarding the deponent’s background and other general information provided during the depositions are clearly not confidential and a redacted copy of the transcript should have been proffered that included the non-confidential information. Trademark Rule 2.126(c) (“A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.”).

testimony and evidence that is truly confidential and commercially sensitive trade secrets.”); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (citing *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016)).

Respondent’s Motions to Strike

Respondent filed two motions to strike. By way of the first motion, Respondent objects to certain evidentiary submissions proffered by Petitioner as “untimely” because they “should have been produced in response to [Respondent’s discovery requests]” and that Petitioner, “however, failed to produce a single document during discovery or its trial period, instead dumping over 1100 pages of documents on [Respondent] two days after the close of its trial period.”¹⁴

Respondent is essentially moving for application of the estoppel sanction, which provides that when a party fails to properly provide responsive documents or information in discovery, it may be precluded from using the documents or information as evidence at trial, “unless the failure was substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1). *See also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013); *Panda Travel, Inc. v. Resort Option Enters., Inc.*,

¹⁴ 46 TTABVUE 2-3. Respondent specifically objects to “Paragraphs 9-11, 13-16, 18-22, 23-30, 50-59, and 65-70 of the Declaration of Deanna Bunten, and all documents cited in support thereof (TTABVUE 40-41)” and “Exhibits E-R of Wood-Mizer’s Notice of Reliance (TTABVUE 43-44).” *Id.*

94 USPQ2d 1789, 1791-92 (TTAB 2009) (documents not produced until after the start of trial stricken).

There is no dispute as to the relevant timeline and factual circumstances. As last reset by the Board, discovery was scheduled to close on October 15, 2020, and Petitioner's 30-day testimony period was to end on January 13, 2021.¹⁵ On October 8, 2020, Respondent filed a motion requesting, inter alia, that the close of discovery be extended until December 14, 2020, and Petitioner's 30-day trial period end on March 14, 2021.¹⁶ The Board, regrettably, did not take action on this motion and the parties proceeded on the existing discovery and trial schedule. Counsel for the parties, however, did agree to extending the deadline for their discovery responses until December 21, 2020—or, as Petitioner's points out, approximately one week into Petitioner's trial period as last reset by Board. On that date, December 21, 2020, the parties exchanged discovery responses; Petitioner did not produce the objected documents but stated that it would produce the documents.

Given the aforementioned circumstances, we find the late service of discovery responses and production of documents to have been harmless, and do not find the estoppel sanction is warranted. Indeed, in this case, Respondent does not appear to have been put at any more of a disadvantage than Petitioner. That is, Petitioner did not receive Respondent's discovery responses until **well after** the opening of Petitioner's trial period, whereas Respondent ultimately received Petitioner's

¹⁵ See Board order issued on September 17, 2020 (37 TTABVUE).

¹⁶ 39 TTABVUE.

discovery responses and produced documents **before** Respondent's trial period opened. Moreover, Respondent does not argue how it has been prejudiced by any belated service of discovery responses or production of documents. Accordingly, **Respondent's first motion to strike is denied.**

Respondent's second motion to strike involves Petitioner's cross-examination of Ashlynn Dale taken by Petitioner under Trademark Rule 2.124.¹⁷ Petitioner provided a list of numbered questions on which it sought to cross-examine Ms. Dale in live testimony. Respondent "specifically challenges cross-examination Question Nos. 18-24, 26-31, 35-39, 41-46, 48-53, 55-60, 62-68, 70-76, 78-90, 96-97, and 104-106" because they "exceed the scope of Ms. Dale's direct trial testimony and are improper under the Rules."¹⁸

After reviewing the objected-to cross-examination questions posed by Petitioner in conjunction with the testimony affidavit of Ms. Dale, and accompanying exhibits, we do not find that the cross-examination questions fall outside the scope of the matters brought forward by Petitioner in Ms. Dale's testimony affidavit. Nearly all of the questions involve information provided by Ms. Dale in her affidavit and or relate to exhibits accompanying her affidavit and to which she testified help show Respondent's use or promotion of the color orange on or in connection with

¹⁷ 83 TTABVUE (Petitioner's second amended notice of taking cross-examination by written questions, with a copy of the questions to be asked of the witness purportedly attached to the service copy); 81 TTABVUE (Respondent's motion to strike, with a copy of the questions, and objections thereto, attached as an exhibit at 81 TTABVUE 26-58); and 87 TTABVUE (copy of the cross-examination testimony transcript).

¹⁸ 81 TTABVUE 2.

Respondent's portable sawmills. Indeed, many of the exhibits identified on cross-examination of Ms. Dale are the same as exhibits introduced via Ms. Dale's testimony affidavit.

In addition, as Petitioner points out, Ms. Dale avers in her affidavit that Respondent "began using its Norwood Orange color as a source identifier for its sawmills and related goods in 1993"¹⁹ and that "[a]ll of the sawmill equipment and forestry products that Norwood has sold since 1993 have been painted Norwood Orange."²⁰ These considerably broad statements by Respondent's witness regarding Respondent's use of the color orange on or in connection with its portable sawmills opens the door for a fairly-wide scope of cross-examination as to extent and particulars of Respondent's use of the color orange since 1993. Nearly all, if not all, of the objected-to cross-examination questions involve Respondent's portable sawmills and the extent to which the color orange was applied to them during that time period. Should any of Petitioner's questions on cross-examination of Ms. Hale exceed the scope of Ms. Hale's testimony affidavit, the Board is capable of discerning admissible and relevant trial testimony from non-admissible trial testimony, including the permissible scope of cross-examination. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017); *Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011) ("[T]he Board is capable of weighing the relevance and strength or weakness of the objected-

¹⁹ 52 TTABVUE 142 (Dale Aff. ¶ 17).

²⁰ *Id.*, Dale Aff. ¶ 12.

to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.”).

Accordingly, we overrule Respondent’s objections on the basis that certain cross-examination questions are beyond the scope of testimony in Ms. Hale’s affidavit and give the cross-examination testimony the appropriate probative weight it deserves.

Respondent’s second motion to strike is denied.

In sum, the record consists of the pleadings, the file of Respondent’s involved registration, and all evidence submitted by the parties during their assigned testimony periods.

II. Petitioner’s Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may seek to cancel a registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by the continued registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a

reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

There is no dispute that Petitioner and Respondent are competitors in the portable sawmill industry. Respondent describes itself as “one of the Biggest Sellers of Portable Sawmills in the United States,”²¹ and Petitioner’s witness describes Petitioner as “a top five industry leader in portable sawmills.”²² As a competitor in the portable sawmill industry, Petitioner is entitled to petition to cancel Registrant’s mark for goods that include portable sawmills. *Books on Tape, Inc. v. The Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (competitor had entitlement to petition to cancel the registration BOOKTAPES issued on the Supplemental Register); *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1553 (TTAB 2009) (competitors have entitlement to oppose registration based on alleged genericness and lack of distinctiveness of product configuration); *Plyboo Am., Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999) (entitlement to petition to cancel based on descriptiveness of the mark PLYBOO for bamboo laminate flooring and bamboo plywood based on petitioner’s status as competitor and petitioner’s use of the term “plyboo” in connection with bamboo flooring products, bamboo sheets and bamboo panels).

²¹ 90 TTABVUE 10.

²² 40 TTABVUE (Bunten Dec. ¶ 48).

III. Lack of Acquired Distinctiveness

Under Sections 1, 2, and 45 of the Act, a mark may not be registered on the Principal Register unless it is distinctive and distinguishes goods (or services) from those of others by indicating the source of the goods.²³ 15 U.S.C. §§ 1051, 1052, and 1127. “[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached.” *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976).

Where a mark is registered under Section 2(f) of the Act based on a claim that it has acquired distinctiveness, as is the case here, the question of whether the mark is inherently distinctive is a nonissue because there is a presumption that it is not. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive “). It is also settled law that marks consisting of a single color applied to the product itself, as is also the case here, are not inherently distinctive and can only be registered upon a showing of acquired distinctiveness (or secondary meaning). *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1162-63 (1995)). *See also In*

²³ Section 1 of the Act concerns the requirements for filing a trademark application; Section 2 lists grounds on which the USPTO may refuse registration; and Section 45 provides the definition of a “trademark,” requiring it “identify and distinguish [an applicant’s] goods ... from those manufactured or sold by others and to indicate the source of the goods”

re Thrifty, Inc., 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). *Cf. In re Forney Indus., Inc.*, 955 F.3d 940, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020) (Multi-color “marks can be inherently distinctive when used on product packaging, depending upon the character of the color design.”).

Thus, we need only determine if Respondent’s registered mark has acquired distinctiveness. Petitioner, as plaintiff, has the initial burden of showing that Respondent’s mark has not acquired distinctiveness. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (a party challenging the sufficiency of an applicant’s § 2(f) showing “must have at least the initial burden of challenging or rebutting the applicant’s evidence of acquired distinctiveness made of record during prosecution which led to publication of the proposed mark”). Should Petitioner meet its initial burden challenging the sufficiency of Respondent’s proof of acquired distinctiveness, the Board may then consider additional evidence and argument from Respondent to rebut Petitioner’s showing and to establish that its mark has indeed acquired distinctiveness. *Id.* at 1005. In this regard, the ultimate burden of persuasion on the issue of acquired distinctiveness is on Respondent. *Id.* at 1006.

Acquired distinctiveness means that the relevant public has come to understand the primary significance of the mark as identifying the source of a product or service rather than the product or service itself. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *see also Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012). That is, in the context

of this case, we need to decide whether purchasers of portable sawmills have come to understand the primary significance of Respondent's orange color mark as an identifier of source for sawmills rather than as merely an ornamental or safety feature of the sawmills. *See Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *19 (TTAB 2019) (in a case of an alleged color mark on a product, the question is whether the "primary significance of the ... mark to the relevant public ... is as a source-indicator" or simply as "ornamentation") (citing, *inter alia*, *Wal-Mart v. Samara*, 54 USPQ2d at 1069), *civil action filed*, No. 1:20-cv-00902-RGA (D. Del. Feb. 3, 2020); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142, 1145 (TTAB 1990) (same); *see generally Steelbuilding.com*, 75 USPQ2d at 1422 ("To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.").

Acquired distinctiveness may be demonstrated by direct or circumstantial evidence. *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018) ("The Board and courts have recognized that both direct and circumstantial evidence may show secondary meaning.") (citation omitted); *In re Ennco Display Sys.*, 56 USPQ2d 1279, 1283 (TTAB 2000). Direct evidence includes testimony, declarations or surveys of consumers expressing their state of mind. *Id.* Circumstantial evidence, on the other hand, is evidence from which we may infer a consumer association, such as years of use, prior registrations, extensive sales and advertising, unsolicited media coverage, and any similar evidence showing wide

exposure of the mark to consumers. *Id.*; see also *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) (listing, as examples of circumstantial evidence, advertising, sales figures, and intentional copying by competitors).

Our determination is based on all of the evidence, considered as a whole, and guided by weighting the following factors set forth by the Federal Circuit:

- (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys);
- (2) length, degree, and exclusivity of use;
- (3) amount and manner of advertising;
- (4) amount of sales and number of customers;
- (5) intentional copying; and
- (6) unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. Int'l Trade Comm'n, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018). See also *In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1004-05 (TTAB 2018). We keep in mind, though, that no single factor is determinative and “[a]ll six factors are to be weighed together in determining the existence of secondary meaning.” *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *3 (TTAB 2020) (quoting *Converse*, 128 USPQ2d at 1546).

Length, Degree, and Exclusivity of Respondent’s Use

We begin our analysis with the length of time and degree to which Respondent has exclusively used the color orange on its portable sawmills. In this regard, Respondent has been selling portable sawmills painted with what it calls its “unique

blended orange color” since the company’s founding in 1993.²⁴ Respondent asserted in the prosecution of its application that matured into the subject registration that:²⁵

color is widely used in connection with forestry products. In addition to the previously submitted photos (attached again here as Exhibit 2) showing how blue is used in connection with Baker portable sawmills and various shades of red are used in connection with TimberKing, HudSon, and Wood-Mizer portable sawmills ...

Clearly, consumers view the color orange, when applied to forestry products, as an indication of source or origin, identifying the applicant exclusively.

The referenced exhibit attached to Respondent’s response, purportedly depicting Petitioner’s [Wood-Mizer’s] use of the color red on its portable sawmills, appears as follows:



²⁴ 90 TTABVUE 10-11; see also 52 TTABVUE (Dale Affidavit ¶¶ 4, 12, 16-17).

²⁵ Reg. 4891113 file: Response filed January 26, 2015, TSDR p. 2.

²⁶ *Id.*, TSDR p. 70.

Petitioner argues Respondent “did *not* have exclusive use of the color orange on portable sawmills at any time, and certainly not in the five years before December, 2013.”²⁷ Petitioner bases this argument primarily on its contention that it has “extensively marketed orange sawmills, and has sold more orange portable sawmills, for a longer time, than [Respondent].”²⁸ To support the claim of its own “extensive” use of the color orange on portable sawmills, Petitioner submitted the declaration of its Corporate Director for marketing, Deanna Bunten, who avers:²⁹

5. Wood-Mizer has brought its orange portable sawmills to more than 150 trade shows annually since 2009, excluding 2020 due to the international pandemic.

6. Since at least 1984, Wood-Mizer has painted various elements of its portable sawmills orange, including the cross bunks of the log deck, the fenders, the sawmill carriage, the sawhead, sawmill carriage support posts, log deck rails, sawmill carriage base, and tow bar on portable sawmills. Although the exact combination of parts painted orange has varied over the years, all of Wood-Mizer's portable sawmills have orange as the primary paint color since 1984. The nonorange elements include some black painted elements, and unpainted chrome or grey elements.

45. Wood-Mizer has invested substantially in the color orange as part of its brand since at least 1984, and has sold an average of nearly 1500 orange portable sawmills in the United States annually from 2006 to 2018, and at least 2000 orange portable sawmills since 2016.

46. Third parties have long associated orange with Wood-Mizer portable sawmills.

²⁷ 88 TTABVUE 21. Petitioner focuses on the December, 2013 this is when Respondent made its claim acquired distinctiveness during the prosecution of the underlying application for registration.

²⁸ *Id.*

²⁹ 40 TTABVUE.

47. Wood-Mizer has never sold a portable sawmill that did not have a primary paint color of orange.

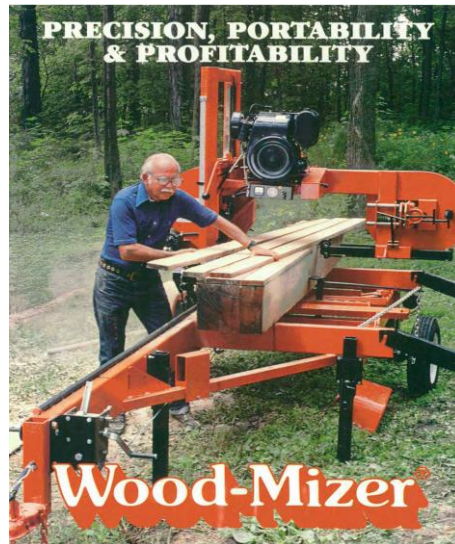
48. In general, Wood-Mizer is a top five industry leader in portable sawmills.

49. Upon information and belief, Wood-Mizer was the primary seller of orange portable sawmills in the United States for at least every year from 2006-2018.

Attached as exhibits to Ms. Bunten's declaration are copies of Petitioner's catalogs for the years "from about 1984 to 2011," each "illustrating [Petitioner's] portable sawmills, which are primarily painted orange."³⁰ To wit,

³⁰ *Id.* (Bunten Dec. ¶ 9).

“1984 or 1985” catalog:³¹



³¹ *Id.* (Bunten Dec. ¶ 10; Bunten Exhib. 1).

2005 catalog:³²

LT15

Compact and Versatile



NEW In and Out Blade Guide Arm Control... quick and hassle free ease of adjustment.

NEW Up and Down System... quick ratio adjustment, with gas piston power assist. Also **NEW** Feed and Return Controls!

If you're a wood hobbyist or craftsman, you don't need to buy boards from the lumberyard anymore. You can cut your own accurate dimensional lumber on the Wood-Mizer LT15.

The LT15 is manually operated for easy operation. The super-compact design allows you to easily transport the mill to different job sites. You can simply load it onto the back of a standard-size pickup truck, or you can elect to tow the mill with the optional trailer package.

And just because it's our smallest mill doesn't mean you have to lay off those long logs. You can add as many 6'8" bed extensions as you like. There's no real limit to log length! Talk about versatility!

The LT15 can be shipped factory-direct on one single pallet. (Very little assembly is required, and a free video is supplied to make it even easier. Start assembly after breakfast and start sawing before lunch.)

LT15 Performance Specifications

Log Capacity	28" dia. x 11'
Log Handling	Manual (Cant Hook)
Head Drive	Manual Crank
Operator Location	Walk
Production/Hr.*	75-125 bd.ft./hr.
Power Options	13 HP recoil gas engine 15 HP gas engine with electric start 10 HP electric (single or three-phase) 10 HP diesel

Optional Bed Extensions increase cutting length by 6'8" each. (No practical limit to maximum length.)

* Due to many variables, actual production figures may vary. Call for details.

-and-

³² *Id.* (Bunten Dec. ¶ 19; Bunten Exhib. 10).

DECISIONS, DECISIONS

11 Things to Consider Before Buying a Sawmill



- 1 See it in action.** You wouldn't buy a car without a test drive. The same principle applies to sawmills.
- 2 Get a reference.** Talk to someone who owns the mill you're interested in. Ask about the quality of the mill and about the company's customer service and support after the sale.
- 3 Ask about expertise.** Find out how many band sawmills the company has made. There's no substitute for experience in designing a quality sawmill.
- 4 Ask about manufacturing.** A lot of people can throw some steel together, stick a blade in there somewhere and call it a mill (and many do). There are also some companies that don't even manufacture the mills they sell. Good luck getting service from them.
- 5 Insist on a refundable deposit.** Things happen. People change their minds. Make sure you can get your money back if you happen to be the one changing your mind.
- 6 Insist on a money-back guarantee.** If you find out you bought something you really don't want, you'll be far happier dealing with a company that will give you a full refund.
- 7 Compare warranties.** You're buying machinery. Parts will wear out over time. Make sure you're covered well.
- 8 Compare resale values.** The day may come when you'll want to sell your mill (possibly because you want to upgrade your operation). It would be good knowing what you can get for it. Look in some of the industry's classified magazines to see what the various brands of used mills are selling for. Then you'll see which mills told their value.
- 9 Compare models and engines.** Don't get stuck with the wrong mill. Make sure you have plenty of options so you can get the machine that will do what you need done.
- 10 Ask about service locations.** If you're in Oregon and the company's only location is out east... It's just much easier when the service team is nearby.
- 11 Make sure it's orange.** Then you'll know you made the right decision.

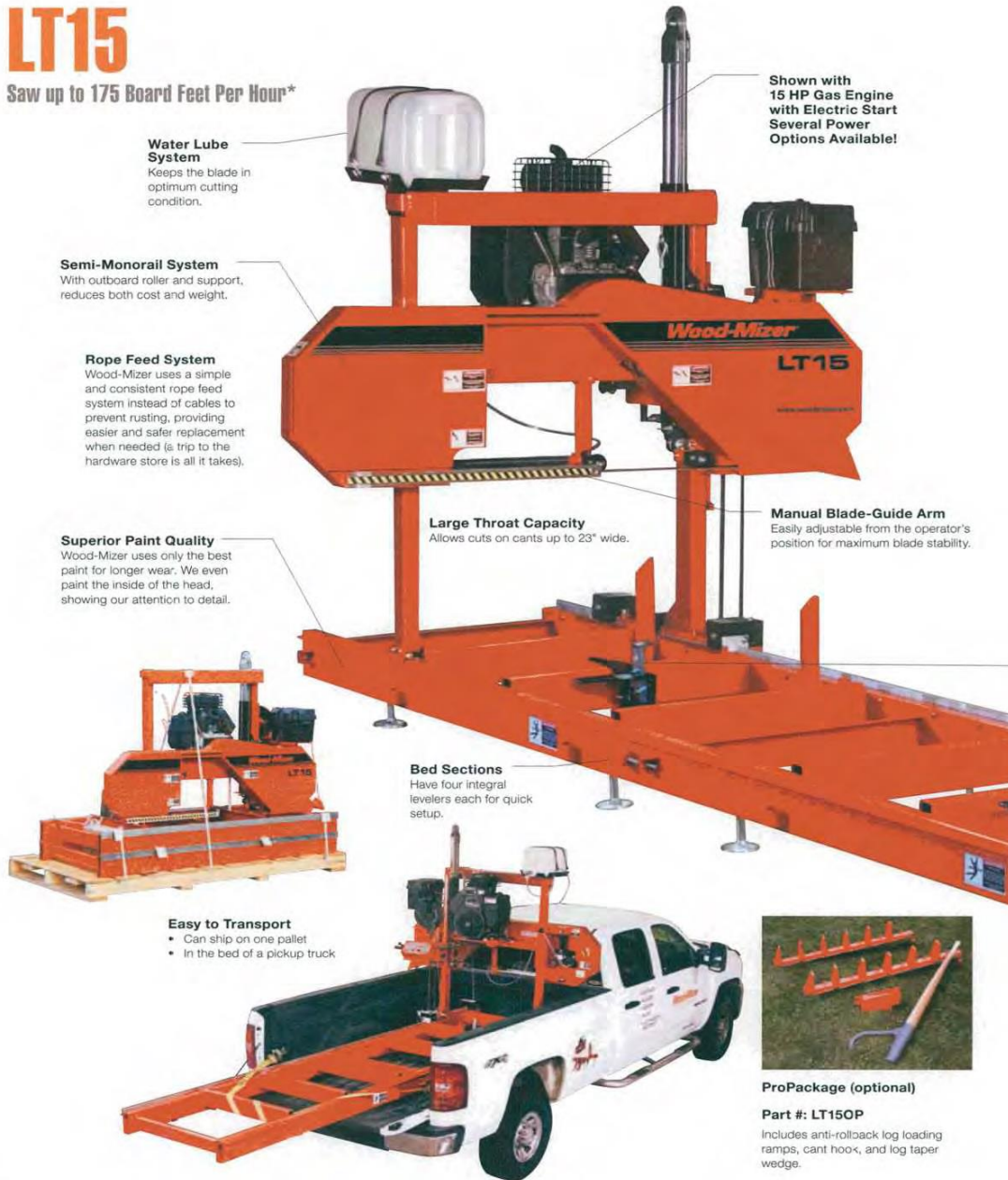


TRUST.
Wood-Mizer

[emphasis provided above with red arrow].

LT15

Saw up to 175 Board Feet Per Hour*



With regard to the photograph of Petitioner's sawmill that Respondent submitted during the prosecution of its application, Bunten recognizes it to be a "still capture of a video" that Petitioner made publicly available, including on YouTube website (www.youtube.com) since "at least 2011."³⁴ Bunten contends that the photograph, as submitted by Respondent, "has been altered to have an unnatural reddish tint" that is "apparent on the arms of the technician."³⁵ Bunten further comments on the same video:³⁶

65. At approximately [1:45 into the video], the narrator begins describing the painting process in the production of Wood-Mizer sawmills, starting with the audible statement "Now, it's time to get ready for the orange."

66. At approximately [2:00 into the video], the narrator describes that the painter applies a primer first, "and then, the recognizable Wood-Mizer orange."

Petitioner claims that, prior to 2013, its "use of orange for its portable sawmills was notorious."³⁷ Petitioner also points to an industry publication article where the writer, in the context of 2013 competition involving various manufacturers and models of sawmills, states that "[i]t's easy to spot the Wood-Mizer teams with their

³³ *Id.* (Bunten Dec. ¶ 22; Bunten Exhib. 13).

³⁴ *Id.* (Bunten Dec. ¶¶ 59-62).

³⁵ *Id.* (Bunten Dec. ¶ 64).

³⁶ *Id.* (Bunten Dec. ¶ 64).

³⁷ 88 TTABVUE 16.

bright orange mills.”³⁸ As Petitioner further points out, Respondent has prominently advertised its sawmills on the following (facing) page.³⁹

Respondent argues that Petitioner does not use the color “orange” on its portable sawmills, but rather “paints its portable sawmills a proprietary color blend meant to approximate the color [confidential], known as red orange, as closely as possible.”⁴⁰ Respondent argues that “**red** is a dominant color in [Petitioner’s] custom blend [and Petitioner’s] sawmills often appear as red in [Petitioner’s] own advertising.”⁴¹ Respondent contends that “[b]y failing to submit sufficient evidence that [Petitioner] even uses the color orange, [Petitioner] has not met its burden with respect to its lack of substantial exclusivity argument.”⁴² In support, Respondent points to the deposition testimony of Ms. Bunten, who testified, in part, as follows regarding Petitioner’s use of color on portable sawmills:⁴³

Q. Okay. So if we want to be as precise as possible, Wood-Mizer doesn't simply use the color orange for the portable sawmills, does it?

A. Wood-Mizer's brand color is orange. We do not refer to it as red orange.

Q But if we're going to be precise, the color Wood-Mizer uses isn't, say, for example, [color code designated “confidential”], pure orange, is it?

³⁸ 44 TTABVUE 155 (Bunten Exhib. J). Independent Sawmill & Woodlot Management, “No. 122 Dec 2013/ Jan 2014” issue.

³⁹ *Id.* at 156.

⁴⁰ 90 TTABVUE 22. The approximate color code designated “confidential” is from the RAL primary color matching system that, as Respondent explains, is “akin to the Pantone system used in the United States.” *Id.* at 11, N. 3.

⁴¹ *Id.* at 36.

⁴² *Id.* at 37.

⁴³ 74 TTABVUE (Bunten Dep. Although the entire Bunten deposition testimony is designated “confidential,” Respondent included certain portions of the testimony in its publicly available brief (at 90 TTABVUE 35-36).

A For paint, no.

Q Yes. For paint. For the portable sawmill paint, thank you, to be accurate. Wood-Mizer doesn't use [color code] RAL 2004, pure orange, for its portable sawmills, does it?

A No.

Q Wood-Mizer uses [RAL color code] red orange for its portable sawmills; isn't that right?

A Yes.

Q So the most accurate way to describe the color Wood-Mizer uses for its portable sawmills would be to say that Wood-Mizer uses RAL [] or red orange for the portable sawmills, right?

...

A Wood-Mizer refers to our portable sawmills as being orange, not red orange, simply because there are too many variations to distinguish.

...

Q If we want to be as accurate as possible, Wood-Mizer doesn't use the generic orange color. To be as specific as possible, Wood-Mizer actually uses the color RAL 2001, otherwise known as red orange; isn't that correct?

...

A That's correct.

Based on the record before us, with a particular close review of Petitioner's use of color on its portable sawmills, we do not find Respondent's use of the color orange, as applied to portable sawmills, has been substantially exclusive. Indeed, although Respondent admittedly does not use a "generic orange color," but instead uses red orange, this remains a shade of orange. Moreover, and as discussed above, the actual color of paint applied to Respondent's portable sawmills is presented to the public, e.g., in its catalogs and in the video, as simply "orange." Perhaps more importantly, as demonstrated in the above-mentioned industry publication, Respondent and its goods have been described as "[Respondent's] team with their bright orange mills."

We also keep in mind that Respondent’s registration identifies the “color orange,” as applied to its sawmills, to be its mark and without delineating any particular shade.⁴⁴ *See In re Int’l Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999) (registration must accurately provide notice to the public of the mark as used in commerce). Respondent states the color orange that it applies to its portable sawmills “does not match up to any [commercial color code],”⁴⁵ but providing the following swatch (to the left of its actual mark, as shown in the registration) which it states is the color applied to its goods alongside the registered mark with color:⁴⁶

⁴⁴ In this regard, Section 807.07 of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) (July 2022) provides:

If the mark includes color, the drawing must show the mark in color. ... The color claim must include the generic name of the color(s) claimed. It is usually not necessary to indicate shades of a color, but the examining attorney has the discretion to require that the applicant do so, if necessary to accurately describe the mark. The color claim may also include a reference to a commercial color identification system. The USPTO does not endorse or recommend any one commercial color identification system

TMPEP Section 1202.05(e) also provides:

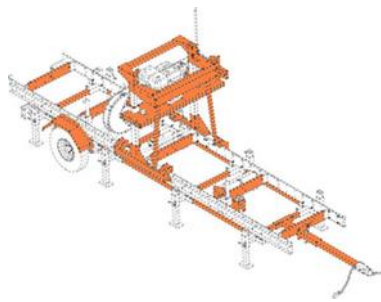
The description of the [color] mark must be clear and specific, use ordinary language, and identify the mark as consisting of the particular color as applied to the goods or services. ... If the applicant is claiming a shade of color, the shade must be described in ordinary language, for example, ‘maroon,’ ‘turquoise,’ ‘navy blue,’ ‘reddish orange.’ This is required even if the applicant also describes the color using a commercial coloring system.

⁴⁵ 52 TTABVUE 143 (Dale Affidavit ¶ 22).

⁴⁶ *Id.*, ¶ 23.



The hue of orange in the swatch appears to be slightly brighter or lighter than that shown in the registration:



Whether we compare the hue of the Respondent's swatch or that depicted in Respondent's registration, we see little difference between them and the color Petitioner applies to its portable sawmills.⁴⁷ Although the examples of Petitioner's application of color on its portable sawmills, e.g., in catalogs, photographs, the YouTube video, etc., vary somewhat in terms of shades or tints of orange, they can generally be described as a darker shade of orange than that applied by Respondent. However, they approximate each other and, indeed, when comparing the photographs from Petitioner's 1984-1985 catalog with either the hue of Respondent's swatch or in its registration, one may arguably believe they are the same. Furthermore, it has not

⁴⁷ We acknowledge that a comparison between different shades of color may be affected by the computer technology, including monitor settings.

been shown that consumers have become so educated to distinguish based on such a slight difference in hue.

When the evidence shows various shades of the same color applied to the relevant goods—even if the use is not source-identifying or by the same party—this complicates the ability for any one particular shade to acquire distinctiveness. *In re Medline Indust., Inc.*, 2020 USPQ2d 10237, *7 (TTAB 2020) (in deciding whether there is a likelihood of confusion between two different shades of green for medical gloves, Board holds that “non-trademark uses of shades of green on medical gloves tend to impair ... [a] mark’s ability to acquire distinctiveness”); *see also, Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1438 (TTAB 2007) (in determining whether an applicant’s use of the particular shade of purple on sandpaper has acquired distinctiveness, Board finds evidence of applicant’s own use of various shades of purple as unhelpful for purposes of establishing distinctiveness as to a single shade).

Moreover, as the Board further recognized in *Saint-Gobain*, when “the use of colors is common in a field, an applicant has a difficult burden in demonstrating distinctiveness of its claimed color.” *Id.* at 1441 (quoting *In re Howard S. Leight and Assoc. Inc.*, 39 USPQ2d 1058, 1060 (TTAB 1996)). Here, as discussed, Respondent admits that “color is widely used in connection with forestry products” for source-identifying purposes, but goes on to further state that “no other entity in the forestry products industry sells an orange sawmill in the U.S.”⁴⁸ We find this not to be the

⁴⁸ Response filed January 26, 2015, TSDR p. 1.

case, given the ample evidence of Petitioner's extensive prior use of the color orange on portable sawmills.

In sum, based on the record, the factor involving the length and degree of exclusivity of respondent's use of the color orange on portable sawmills does not favor a finding that Respondent's registered mark has acquired distinctiveness. To the contrary, Petitioner has demonstrated it has also used the color orange, albeit in possibly a different shade, extensively on the same type of goods and for a period of time that extends back to 1984.

**Amount of Sales and Number of Customers;
Amount and Manner of Advertising**

Respondent's sales of portable sawmills has been extensive, with over 10,000 sold by the end of 2013, worth over \$65 million.⁴⁹ During this time, Respondent spent \$8 million in advertising its goods. In some of these advertisements, including in its 2013-2020 catalogs (example shown below), Respondent has promoted the color orange in connection with its sawmills by inserting the slogan "Norwood orange equals Norwood tough!":⁵⁰

⁴⁹ 52 TTABVUE; Dale Affidavit ¶¶ 6, 8-9.

⁵⁰ 53 TTABVUE 52 (Dale Affidavit Exhib. AB).

Strongest Log Deck in its Class

The LumberPro's log deck is the strongest in its class. Ph.D.'s in materials' engineering have crunched the numbers and it's official – the Pro's log deck is stronger than the competition, and more than twice as stiff.

The Pro's wide-track log deck is built of twin, double-plated, debossed-steel almost a full quarter of an inch thick. Formed in our massive 400-ton press, the unique structural indentations boost rail strength and double the frame rigidity of your mill.

The Pro's super-strong log deck not only gives you accurate, straight lumber. It also gives you peace-of-mind ... Your mill is built to handle whatever you throw at it.

Commercial-Grade Powder-Coat

Industrial-grade powder-coating protects your investment better, and longer, than old-fashioned spray-paint, which chips, scratches and rusts out in no time.

For sure it costs a lot more to powder-coat steel. In fact, other companies choose to spray-paint their mills, to save costs and make more money.

You want a mill that's going to work hard, and look good for years to come. That's why Norwood finishes every critical component on your mill, with the very best powder-coating money can buy.

Norwood orange equals Norwood tough!

NORWOOD POWDER COAT.
RHINO-HIDE TOUGH

WORKING AS HARD AS YOU

1.800.567.0404 NorwoodSawmills.com

NORWOOD000073A | 9

[red arrow provided].

Norwood also advertised on its Facebook page its sawmills while emphasizing the color orange, including the following in November-December of 2013:⁵¹

12/16/2020 (20+) Facebook

IS IT TIME FOR SOME NORWOOD ORANGE?

NORWOOD PRODUCTS **SAWMILLS** **BAND BLADES** **SHARPENERS** **LOG SKIDDING** **LOG HANDLING**

Enter to WIN **\$500** in Norwood Sawmills Credit

Norwood Portable Sawmills
November 4, 2013

⁵¹ 52 TTABVUE 245 (Dale Affidavit Exhib. O).

In all, Respondent's sales and advertising are impressive. However, high sales and advertising figures do not always equate to a finding that mark has acquired distinctiveness. "The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case." *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010). Here, Respondent's ability to prove the putative distinctiveness of its orange color mark for portable sawmills is impaired by Petitioner's extensive use of a very similar shade of orange on the same type of goods. *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 1299, 172 USPQ 361, 363 (CCPA 1972) ("This evidence of a significant and continuous concurrent use of the term by [opposer] rebuts [applicant's] contention that it has exclusively and continuously used the mark with the result that it has become distinctive of its goods."). Respondent's sales and attempts through advertisements to get consumers to associate the color orange as a source-identifier for its sawmills needs to be counterbalanced against the presence of Petitioner. Petitioner has also long enjoyed a great deal of success in the sale of its portable sawmills and advertises these goods while also attempting to associate the color orange with its sawmills, e.g., "**Make sure it's orange.** Then you'll know you made the right decision."

No Evidence of Association of the Mark With a Particular Source By Purchasers; No Evidence of Intentional Copying or Unsolicited Media Coverage of the Product Embodying the Mark

Respondent does not point to any direct evidence showing that consumers associate the color orange with Respondent's portable sawmills. As mentioned, such a showing is "typically measured by consumer surveys." *Converse*, 128 USPQ2d at 1546. The Board also recognizes that declarations from actual purchasers attesting to their belief that a proposed mark identifies the source of the goods may also be useful and probative. *In re GJ & AM*, 2021 USPQ2d 617, at *38-39 (TTAB 2021). Here, we have no such evidence before us.

There is also a void of evidence of intentional copying by others or unsolicited media attention given to Respondent's use of orange on its portable sawmills. To the contrary, Petitioner's submission of the sawmill industry publication article stating that "[i]t's easy to spot the Wood-Mizer teams with their bright orange mills" is evidence that helps show that it is Petitioner's sawmills, not Respondent's, that are identified in the industry by the color orange.

Conclusion

The *Converse* factor involving exclusivity of use is weighed against Respondent's claim of acquired distinctiveness in view of Petitioner's long and extensive use of the color orange on portable sawmills. While Respondent has long used the color orange on its portable sawmills, with significant sales and relevant advertising, so has

Petitioner. There is insufficient evidence to weigh any of the other relevant factors in Respondent's favor for purposes of showing that acquired distinctiveness.

Based on the entirety of the record and upon weighing the relevant *Converse* factors for which we have evidence, we find Petitioner has made a prima facie showing that Respondent's registered color mark has not acquired distinctiveness under Trademark Act Section 2(f) as a source identifier for portable sawmills. Respondent has failed to rebut this showing.

Decision: The cancellation is granted on the ground that Respondent's registered mark is not inherently distinctive and has not acquired distinctiveness.⁵²

⁵² In view of our determination that the cancellation is granted on Petitioner's lack of distinctiveness claim, we do not reach Petitioner's claim that the registration was procured through fraud. *CBC Mtg. Agency v. TMRR, LLC*, 2022 USPQ2d 748, at *29 n.22 (TTAB 2022) (Because the Board resolved the cancellation proceeding on the petitioner's non-ownership claim, it need not, and did not, reach Petitioner's other claims.).