

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/641178

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Serial Number 76/641178

This letter responds to applicant's communication filed on April 9, 2007.

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the points at issue in the final action. TMEP §715.03(a). Accordingly, applicant's request for reconsideration is *denied*, and the Section 2(e)(5) functional refusal and the Sections 1, 2, and 45 non-distinctive configuration refusal are *continued*. 37 C.F.R. §2.64(b); TMEP §715.04.

**1. Refusal Under Section 2(e)(5) – Proposed Mark is Functional**

The applicant has applied to register "the three-dimensional configuration of a hand-held saw with a blade and a grip." The goods are identified as "MANUALLY OPERATED HAND-HELD SAWS FOR SAWING WOOD, PLASTIC PIPE, PLASTIC BOARD STOCK, ACRYLIC, DRYWALL, CEMENT WALLBOARD, PARTICLE BOARD, PLASTERBOARD, MELAMINE, FLAT FOAM SHEETS, WALLBOARD, ARTIFICIAL WOOD, AND COMPOSITE BOARD."

In its request for reconsideration, the applicant provided information relating to each of the four "Morton-Norwich factors":

(1) Patents

“Applicant states that the mark is not, and has not been the subject of a design or utility patent (either active or expired), or an application for a design or utility patent (either active or abandoned).” Applicant’s April 9, 2007 correspondence, p.2. “Although the existence of a utility patent could weigh against applicant in terms of showing that the configuration is de jure functional, the absence of such a patent simply has no weight in our analysis.” *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.3 (TTAB 2001).

(2) Applicant’s Advertising, Promotional and/or Explanatory Materials

As admitted by the applicant, it “does tout the utilitarian advantages of its saw blades, for example, that they cut on the pull, which allows for a thin, lightweight, and flexible blade, that the teeth are precision ground (not stamped into) the highest quality carbon spring steel, and that the teeth are electrically impulse-hardened. Similarly, the handle is designed to be comfortable, and it has a quick release design for easy blade replacement.” [emphasis in original]. Applicant’s April 9, 2007 correspondence, p.3. Where applicant’s own advertising materials extol the utilitarian aspects of its design, such materials are strong evidence that the matter sought to be registered is functional. See, e.g., *M-5 Steel Mfg., Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086 (TTAB 2001); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989).

The applicant goes on to argue “that the overall combination of features, and the particular design used to provide this functionality functions [to] indicate Applicant as the source of the goods.” The proposed mark is “the three-dimensional configuration of a hand-held saw with a blade and a grip.” The hand-held saw in question is not just any hand-held saw, it is a Japanese-style hand saw known as a Ryoba saw, which is used primarily for woodworking and carpentry. Ryoba saws contain double-edged saw blades, with one cutting edge used for ripping, and the other edge used for crosscutting. Ryoba saws cut on the push stroke rather than on the pull stroke. See the attached excerpt from <http://en.wikipedia.org/wiki/Ryoba> and the excerpt from the Takenaka Carpentry Tools Museum website at <http://www.dougukan.jp/archive/eng/dougu-e/B3e.html> attached to the October 4, 2006 final Office action. If all of the elements that make up the applicant’s saw configuration are functional, then the saw configuration *in its entirety* is functional as well.

The applicant argues that “while a saw is overall a useful article, the design of Applicant’s saw, including the shape of the blade, the shape of the handle, the manner in which the handle joins the blade, and the overall shape formed by these constituent parts, are not functional.” The functional elements of Ryoba saws have been discussed at length in the prior Office actions. Moreover, even if the applicant’s argument that its saws contain non-functional features is accurate, where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. See *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986).

(3) Alternative Designs

As for the availability of alternative hand saw designs, the evidence attached to the prior Office actions clearly shows that the applicant’s general configuration is one of a few designs available for Japanese-style Ryoba saws. The only hand saws that matter in this analysis are Ryoba hand saws. Ryoba saws by

their very nature have two cutting edges in the same *general* shape as the applicant's saw blade configuration. Further, the evidence of record shows that the overall shape of competing Ryoba saws is the same or similar as the applicant's saw configuration. As explained in the final Office action, the existence of viable alternative designs does not per se disprove functionality. The availability of alternatives does not detract from the functional character of a configuration that is the best or one of the few superior designs available. *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Moreover, "the question in each case is whether protection against imitation will hinder the competitor in competition." *In re Morton-Norwich, supra*, at 14, quoting *Truck Equipment Service Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218, 191 USPQ 79, 85 (8<sup>th</sup> Cir. 1976). The internet web site excerpts attached to the prior Office actions show that numerous Ryoba saw manufacturers other than the applicant use the same *general* shape for their Ryoba saws.

(4) Manufacturing Cost

The applicant writes that its "saws are generally more expensive to make than competitors' saws, though the expense of Applicant's saws is generally directed to the quality of Applicant's saws, rather than those factors that make up the mark covered by the instant application." Applicant's April 9, 2007 response, p. 5. An applicant's assertions that its design is more expensive or more difficult to make are insufficient to establish that the configuration is not functional. *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1821 (TTAB 1998) ("That applicant, despite the inherent advantages of a design which is simple and less expensive to manufacture than other petcocks, has, however, deliberately chosen a more complex and expensive manner in which to manufacture its product does not mean that the configuration thereof is not de jure functional."); *See In re Caterpillar Inc.*, 43 USPQ2d 1335, 1341 (TTAB 1997); *In re American National Can Co.*, 41 USPQ2d 1841, 1844-45 (TTAB 1997).

For the foregoing reasons, the Section 2(e)(5) functional refusal is CONTINUED.

**2. Refusal Under Sections 1, 2, and 45 - Non-distinctive Configuration of the Goods; Evidence Insufficient to Establish Acquired Distinctiveness**

The applicant submitted a supplemental declaration in support of its claim of acquired distinctiveness under Section 2(f). The additional evidence supplied by the applicant is insufficient to establish acquired distinctiveness.

In determining whether the proposed mark has acquired distinctiveness, the following are some of the factors that are considered: (1) length and exclusivity of use by applicant of the mark in the United States; (2) the type, expense and amount of advertising of the mark by applicant in the United States; and (3) applicant's efforts, such as unsolicited media coverage and consumer studies, in the United States to associate the mark with the source of the goods identified in the application. *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider each of these factors, and no single factor is determinative. *Id.*; see 37 C.F.R. §2.41; TMEP §1212.06 *et seq.* Further, the evidence must relate to the promotion and recognition of the specific configuration embodied in the proposed mark and not to the goods in general. *Wal-Mart*, 529 U.S. at 211, 54 USPQ2d at 1068; *See* TMEP §§1212.06 *et seq.* regarding evidence of acquired distinctiveness.

The applicant claims use of the mark for approximately nineteen years. As explained in the initial Office action, long use of the mark is one relevant factor to consider in determining whether a mark has acquired distinctiveness. *See In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984). TMEP 1212.06(a). However, when the

evidence of acquired distinctiveness is considered *in toto*, nineteen years is insufficient to establish acquired distinctiveness.

The applicant also claims "Extensive sales of products sold in association with this design in the United States, in that the number of saws sold in association with the mark from 2001 through 2006 exceeded 214,000 saws." That is approximately 42,800 saws sold per year. On its face, the foregoing sales figure does not seem to be significant, and applicant has not provided any information to the contrary. *See In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001). At best, the sales figure demonstrates the apparent popularity or commercial success of the applicant's saws, but such evidence alone does not establish that the relevant purchasers recognize the shape of the entire saw as indicating source or origin. *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *WLWC Centers, Inc. v. Winners Corporation*, 221 USPQ 701, 707 (M.D. Tenn. 1983); *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1451 (TTAB 1994).

The applicant claims "Extensive advertising of products with which the design has been used in the United States, in that total approximate advertising expenditures for Applicant's products, including the saws sold in association with the design of the instant application for the years 1996-2006 exceeded \$800,000" and "Significant trade show attendance at which products with which the design has been used have been promoted, whose trade show expenditures alone, from 1996 - 2006, exceed \$1,100,000." Large scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used. However, proof of an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars -- two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA -- found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *Mattel, Inc. v. Azrak-Hamway International, Inc.*, 724 F.2d 357, 221 USPQ 302, 305 n. 2 (2d Cir. 1983). TMEP §1212.06 (b).

The ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source. The examining attorney must examine the advertising material to determine how the term is being used, the commercial impression created by such use, and what the use would mean to purchasers. *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971) (evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH, for lectures concerning hair and skin treatment, notwithstanding ten years of use, over \$500,000 in promotion and sponsorship expenses, and the staging of over 300 shows per year). *See also In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. "There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant's highly descriptive trade name."); *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant's statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark). *Cf. In re Haggard Co.*, 217 USPQ 81, 84 (TTAB 1982) (background design of a black swatch held registrable pursuant to §2(f) for clothing where applicant had submitted, *inter alia*, evidence of "very substantial advertising and sales," the Board finding the design to be, "because of its serrated left edge, something more than a common geometric shape or design"). TMEP §1212.06(b).

In this case, the applicant's declaration contains the statement that "Representative samples of advertising materials are attached to the instant declaration." However, Exhibit C to the applicant's April 9, 2007 response consists solely of the declaration and does not contain any examples of the applicant's advertising materials. The applicant *did* submit advertising materials with its July 21, 2006 correspondence, so those materials will be examined to determine the commercial impression created by the applicant's use of the proposed mark. The advertising materials submitted with the July 21, 2006 correspondence relate to the promotion and recognition of the goods in general and not to the specific configuration embodied in the proposed mark. There is, however, the following paragraph which appears in the printout from the applicant's website at [www.sharkcorp.com](http://www.sharkcorp.com):

**Our saw product designs are unique to SHARK CORPORATION**

The unique saw design and saw blade design were originally created by SHARK Corporation and have been recognized by customers and users based on the unique designs that the saws and blades have been provided by the same source, according to SHARK Corporation's continuous sales efforts for more than ten years.

The foregoing statement is not persuasive on the issue of whether the saw configuration has acquired distinctiveness. It is awkwardly worded, and it is unclear what the statement actually means. Further, the statement is conclusory, and the applicant has provided no evidence of consumer perception of the proposed mark to support the statement.

Given the similarities of his Ryoba saws to the Ryoba saws manufactured by his competitors, the applicant's evidence *in toto* is insufficient to establish acquired distinctiveness.

For the foregoing reasons, the Sections 1, 2, and 45 non-distinctive configuration refusal is **CONTINUED**.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

/Barbara A. Gaynor/  
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## Japanese saw

From Wikipedia, the free encyclopedia  
(Redirected from Ryoba)

The **Japanese saw** or *nokogiri* (鋸) used in woodworking and Japanese carpentry differs from its North American and European counterpart since it cuts on the pull stroke as opposed to the push stroke. This allows it to have thinner blades that cut more efficiently and leave a narrower kerf. Push-saws require a thick blade to remain rigid. Otherwise, the blade would flex wildly as the craftsperson pushed on the handle, instead of cutting. A pull-saw, on the other hand, is under tension rather than compression during cutting. Therefore there is no stiffness requirement, and the blade can be much thinner.

Japanese style saws have also gained popularity outside Japan.

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## Types of Japanese hand saws

[edit]

### Dōzuki (胴付鋸)

A type of backsaw. The Japanese means "attached trunk", thus a saw with a stiffening strip attached, i.e., a backsaw.

### Ryōba (両刃)

Multi-purpose carpentry saw with two cutting edges. The Japanese means "double blade". There is a cross-cutting (*kyōko/kyō*) blade on one side and a ripping (*tatehiki*) blade on the other.

### Azobiki (鋸平起子)

A small *ryōba* saw used for cutting into the flat surface of a board rather than from the edge. The blade has a convex curve which can begin the cut anywhere on the surface.

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Two men *ryoba* can work for cutting into the last groove of a board rather than from the edge. The blade has a convex curve which can begin the cut anywhere on its convex...

- ***Mawashibiki*** (廻し引き)

A thin saw used for cutting curves, the Japanese version of a keyhole saw. The name means "turning cut".

- ***Kaebe*** (替え刃)

A saw with a disposable blade. The Japanese means "changing blade".

### Other Japanese saws

- *Oga*

A large two person saw used for ripping large boards in the days before power saws. One person stood on a raised platform, with the board below him, and the other person stood underneath him/her.

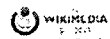
### See also

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