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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77782897

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Elesa S.p.A.

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Elesa S.p.A., has appealed the trademark examining attorney's refusal to register the applied-for mark on the grounds that it consists of a nondistinctive feature of a product design Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127 and that Applicant has failed to establish that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

FACTS

On July 16, 2009, Applicant filed an application with a drawing page featuring the photograph of a handwheel for goods identified as "machine elements, namely, handwheels" in Class 7. Applicant indicated that the mark consisted of a handwheel design and that the "metallic ring" therein was claimed as a feature of the mark.

On November 3, 2009, the examining attorney refused registration on the ground that the applied-for mark consists of a nondistinctive product design or nondistinctive feature of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); *see* TMEP §1202.02(b)(i).

On May 3, 2010, applicant responded asserting that the applied-for mark had acquired distinctiveness under Trademark Act Section 2(f) and amended the description of the applied-for mark to state that the mark “consists of a metallic ring positioned around a center portion of the handwheel.” On May 24, 2010, applicant amended the drawing to depict the applied-for mark as a gray ring in the center of the handwheel.

On July 25, 2010, the examining attorney continued refusal of the applied-for mark, finding the applicant had not provided sufficient evidence that the applied-for mark had acquired distinctiveness under Section 2(f), and required the applicant to clarify the description of the mark and the color claim.

On January 18, 2011, applicant claimed gray as a feature of the mark and amended the description of the mark to the following:

“The mark consists of a specific design feature of a handwheel, namely, a metallic ring in the color gray positioned around a center portion of the handwheel. The mark does not include the areas bounded by broken lines or the center portion of the handwheel inside of the ring, or any portion of the handwheel that is outside of the ring. The white and black portions of the

drawing are not claimed as a feature of the mark and are only included to depict positioning and placement of the mark on the goods.”

In addition, Applicant submitted additional evidence in the form of “English translations of pertinent portions” of opinions in which the Italian courts “ruled that the applied-for mark is recognized as a trademark.”

On February 17, 2011, the examining attorney issued a final refusal because the applied-for mark consists of a nondistinctive feature of a product design, and continued to find Applicant had failed to establish that the applied-for mark had acquired distinctiveness in the United States as a source indicator for the goods.

On August 17, 2011, Applicant submitted a request for reconsideration which included “six declarations from dealers averring that its handwheel design mark is recognized in this particular industry as an indicator that goods bearing this mark are those of the applicant” and “copies of pages from the applicant’s and its dealers’ 1982, 1998, and 2008 catalogs showing handwheels bearing the applied-for mark.”

This appeal follows the examining attorney’s October 13, 2011 denial of the request for reconsideration.

ARGUMENT

APPLICANT’S APPLIED-FOR MARK IS A NON-DISTINCTIVE PRODUCT DESIGN FEATURE, AND APPLICANT’S CLAIM THAT THE MARK HAS ACQUIRED DISTINCTIVENESS AS A SOURCE IDENTIFIER FOR APPLICANT’S GOODS IS INSUFFICIENT.

Registration is refused because the applied-for mark consists of a nondistinctive product design feature that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2 and 45, 15 U.S.C.

§§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); *see* TMEP §1202.02(b)(i).

In this case, the applied-for mark consists of a specific design feature of a handwheel, namely, a metallic ring in the color gray positioned around a center portion of the handwheel. As such, the applied-for mark is a feature of the product's design and may not be registered on the Principal Register with sufficient evidence of acquired distinctiveness pursuant to Trademark Act Section 2(f). Applicant does not contest that the applied-for mark is a product design feature. The sole issue on appeal is whether applicant has sufficiently proven that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f).¹

In determining whether an applied-for mark has acquired distinctiveness, the following factors are generally considered: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods, such as in unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *Id.*; *see* TMEP §§1212.06 *et seq.*

In response to a trade dress product configuration refusal, an applicant may submit evidence that the applied-for mark has acquired distinctiveness under Trademark

¹ In the February 7, 2011 final office action, as well as in the non-final office actions of November 3, 2009 and July 15, 2010, the examining attorney advised the applicant of the option to register the applied-for mark on the Supplemental Register. However, to date, applicant has not elected to pursue registration on the Supplemental Register.

Act Section 2(f) by submitting examples of advertising and promotional materials that specifically promote the applied-for mark as a trademark in the United States, dollar figures for advertising devoted to such promotion, dealer and consumer statements of recognition of the applied-for mark as a trademark, and any other evidence that establishes recognition of the matter as a mark for the goods. *See* 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.* However, the evidence must relate to the promotion and recognition of the specific configuration embodied in the applied-for mark and not to the goods in general. *See, e.g., In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2023 (TTAB 2008); *In re Edward Ski Prods. Inc.*, 49 USPQ2d 2001, 2005 (TTAB 1999); *In re Pingel Enter. Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998).

An applicant can present any competent evidence to establish that a mark has acquired distinctiveness. However, the amount and type of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985); TMEP §1212.01. In this case, because the applied-for mark is a trade dress design feature of a product, and the feature itself is a common ring shape used in a decorative manner, the applicant has a particularly high burden of establishing a prima facie case that the ring featured in the goods not only has been promoted as a source indicator for the goods, but also that the ring is recognized as a source indicator for applicant's goods.

An applicant bears a significant burden of proving acquired distinctiveness in a product design case. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d

945, 949, 122 USPQ 372, 374-75 (C.C.P.A. 1959); TMEP §1212.01. In fact, it is well established that applicants face a heavy burden in establishing distinctiveness in an application to register trade dress. *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009). As discussed below, applicant simply has not met the burden required to show that a product design has acquired distinctiveness as a source indicator.

Applicant's claim of more than five years' use is insufficient.

A mere statement of five years' use is generally not sufficient. *See, e.g., In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000). In this case, based on the common shape² and decorative nature of the applied-for product design, a claim of five years' substantially exclusive and continuous use in commerce is insufficient to establish a prima facie case of acquired distinctiveness. *See Ex parte Fox River Paper Corp.*, 99 USPQ 173 (Comm'r Pats. 1953); TMEP §1212.01.

While length of use is a relevant factor, it is certainly not necessarily conclusive or persuasive for establishing acquired distinctiveness of a product design feature. *See In re Van Valkenburgh*, 97 USPQ2d 1757, 1766 (TTAB 2011). (“[A]pplicant's 16 years of use is substantial but not necessarily conclusive or persuasive considering that its mark is a product configuration.”). *Cf. In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) (8 years use was not sufficient evidence of acquired distinctiveness for the configuration of pistol grip water nozzle for water nozzles); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use insufficient to establish

² Examples of other handwheels that feature the same overall shape and similar metallic gray color can be seen in attachments to Applicant's May 3, 2010 response.

acquired distinctiveness); *In re Ennco Display Systems Inc.*, *supra*, 56 USPQ2d at 1286 (applicant's use of the product designs ranging from seven to seventeen years is insufficient to bestow acquired distinctiveness).

Applicant's advertising materials and trade show displays are not convincing.

The mere appearance of applicant's products in advertising materials and at trade shows, absent any "look-for" advertising, does not establish that the applied-for product design feature has been specifically promoted as a source indicator for applicant's handwheels.

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. In this case, careful examination of the submitted advertising material to determine how the product design feature is being used, the commercial impression created by such use, and what the use would mean to purchasers, has revealed that applicant's promotional materials lack any "look-for" advertising and are therefore insufficient to lead to any inference that the product design feature has acquired distinctiveness. *See In re Chevron Intellectual Prop. Group LLC*, 96 USPQ2d 2026, 2031 (TTAB 2010) (finding evidence of acquired distinctiveness deficient in part because of the lack of advertisements promoting recognition of pole spanner design as a service mark); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) (finding absence of "look for" advertisements damaging to attempt to demonstrate acquired distinctiveness of proposed configuration mark); *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009) (sustaining

opposition on the ground that sound mark had not acquired distinctiveness in part because applicant failed to provide evidence corroborating that the mark was used in advertisements in such a way that it would be recognized as a source identifier for cellular telephones); *In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2023 (TTAB 2008) (affirming refusal to register product configuration for spectacles and sunglasses, as the applicant had failed to prove acquired distinctiveness chiefly because of the “absence of evidence of the advertising and/or promotion by the applicant of the earpiece design as a trademark”).

Applicant’s promotional materials fail to show that the central gray ring was specifically promoted as a source indicator for the goods. The assertion that consumers viewing these advertisements would recognize the applied-for mark a source indicator for applicant’s handwheels is tenuous at best. Likewise, the catalogs and photographs from various tradeshows are insufficient to establish that the applied-for ring design feature has acquired distinctiveness as a source indicator for applicant’s handwheels. The materials do not specifically promote the product design feature of a central gray ring as a source indicator to distinguish applicant’s handwheels from those of others. They are simply pictures of the products they were trying to sell.

Applicant’s argument that the references in its catalogs draw attention to the metallic ring at the base of the handwheel is without merit. Close examination of the instances in which this wording appears reveals that its inclusion falls short of establishing that the applied-for product design feature has been specifically promoted as a source indicator. Although the wording informs consumers that the handwheels feature a “decorative ring” that is coated electrolytically with a decorative oxide of aluminum,

they evince no clear intent whatsoever by the applicant to specifically promote the applied for gray ring as anything but “decorative,” i.e., not as a source indicator for the goods. Use of the wording “matte anodized aluminum” and “Elesa original design” would not signify to consumers that this feature is something for consumers to “look for” to distinguish applicant’s products from others.

Moreover, the catalog references fail to mention the color of the ring altogether, and they do not specifically identify the ring to be a source-indicating feature of the goods. The evidence fails to direct consumers to look for the ring as an indicator of source. Rather, the catalogs merely inform consumers that the ring portions of the goods were designed by the applicant and made out of a particular material. Accordingly, the examining attorney has found these references to be of little evidentiary weight.

Applicant’s advertising expenditures and sales figures are insufficient.

Applicant reports advertising expenditures of “approximately \$27,000” per year to promote its products. Applicant further asserts that it enjoyed sales totaling “about \$2.5 million dollars.” These figures are inapposite, however, as they do not appear to relate to the design feature in question.

Applicant’s advertising expenditures and sales figures have very limited probative value. Applicant has not provided clear evidence as to what portion of the stated expenditures relate to the applicant’s specific promotion of the particular handwheels that feature the applied-for product design feature and what portion of the sales relate to those goods. Moreover, as noted above, applicant has provided no examples of “look-for” advertising featuring the specific promotion of the product design embodied in the

applied-for mark as a source indicator for the goods. The amounts expended to promote all of its products, and the sales garnered on such products, cannot reasonably be inferred to apply to the promotion of the applied-for product design feature. While sales figures demonstrate a certain amount of general commercial success in selling applicant's products, they are not evidence that end consumers of the products recognize the gray ring portion of the applicant's handwheels as a source indicator for those goods.

Similarly, proof of an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *Mattel, Inc. v. Azrak-Hamway Int'l, Inc.*, 724 F.2d 357, 361 n.2, 221 USPQ 302, 305 n.2 (2d Cir. 1983). See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (finding 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 – insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark). In this case, the applicant's advertising expenditures fall short of establishing acquired distinctiveness of the applied-for trade dress design feature.

Even if it were assumed *arguendo* that the amounts applicant has reported spending in the advertising of its products was evidence of applicant's efforts to educate the public to associate the proposed mark with a single source, such expenditures still fall short of establishing the success of such efforts. *In re Redken Labs., Inc.*, 170 USPQ 526, 529 (TTAB 1971) (holding evidence adduced by applicant pursuant to §2(f) 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). *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (affirming refusal to register OFFICE MOVERS, INC., for moving services, 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, 1247-48 (TTAB 1983) (holding evidence 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).

The declarations submitted from dealers are of limited evidentiary value.

Applicant has submitted “six declarations from dealers averring that its handwheel design mark is recognized in this particular industry as an indicator that goods bearing this mark are those of the applicant.” However, the declarations have little evidentiary value. Moreover, as dealer statements, they certainly are not direct evidence that end consumers of the goods view the applied-for product design feature as a source indicator for the goods.

Although declarations that assert recognition of the mark as a source indicator are of some relevance in establishing acquired distinctiveness, the value of declarations depends on the statements made and the identity of declarant. *See In re Chem. Dynamics Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (finding conclusory declaration from applicant’s vice-president insufficient without the factual basis for the

declarant's belief that the design had become distinctive). Proof of distinctiveness also requires more than proof of the existence of a relatively small number of people who associate a mark with the applicant. *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."); *see also 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); *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); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032, 2035 (TTAB 1987) (finding declarations from customers which stated that designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not persuasive).

In this case, applicant's six dealer declarations hold little weight as they do not refer specifically to the product design feature at issue. Moreover, these declarations are very few in number, are nearly identical in wording, and were not executed by end consumers of the goods. In pertinent part the five of the six declarations state the following:

"I am a distributor . . . and am making this declaration in the belief that handwheels sold by Elessa under part numbers VD.FP-VDO.FP ("herein

the “Elesa handwheel mark”) has become distinctive of the goods of Elesa.”

The sixth declaration omits referring to the part numbers of the goods that are included in the other five declarations, and only refers makes the following vague reference to product feature as follows:

“I am a distributor . . . and am making this declaration in the belief that the handwheel mark at issue has become distinctive of the goods of Elesa.”

All six declarations also include the following statement:

“The Elesa handwheel mark is recognized in the trade and by purchasers of handwheels as being the trademarks of and denoting products of Elesa.”

However, it is telling that *none* of the declarations specifically refer to the product design feature at issue. None of the declarations refer to the metallic ring in the color gray positioned around a center portion of the handwheel. The declarations provide no illumination as to what aspect of the “Elesa handwheel mark” is being identified as being recognized as a source indicator for applicant’s goods. Absent any specific references to the applied-for mark at issue, namely, a metallic ring in the color gray positioned around a center portion of the handwheel, the declarations are of extremely limited probative value, as they fall far short of demonstrating that end consumers recognize the gray ring as a source indicator for the goods. Indeed, insofar as the declarations include no references to the terms “gray” or “ring” at all, they fall significantly short of even establishing that the declarants themselves recognize the gray ring in the handwheels as having acquired distinctiveness as a source indicator.

Moreover, the limited number of the declarations and the lack of any statements from end consumers of the goods weigh strongly against applicant's efforts to establish that the gray ring has established distinctiveness as a source indicator. It is perhaps notable that applicant has provided *no* direct statements from end consumers of the goods despite its claimed forty years use of the applied-for mark in United States commerce.

Applicant's submission of opinions from Italian Courts is of little evidentiary value.

Applicant's submission of Italian court opinions is inapposite. In establishing acquired distinctiveness, applicant may not rely on use other than use in commerce that may be regulated by the United States Congress. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741, 1746 (TTAB 1999); TMEP §§1010, 1212.08. Accordingly, the applicant's submitted materials from Italian courts relating to cases involving applicant's goods in Italy cannot be viewed as having relevance to the issue as to whether the product design feature at issue has acquired distinctiveness *in the United States*.

Moreover, applicant's assertion that these materials are evidence of intentional copying of its goods are of limited value, insofar as they relate to copying of goods in another country, and the record is unclear as to the exact circumstances and nature of the of the copying, i.e., whether the copying related specifically to the gray ring portion of applicant's goods. In any event, evidence of intentional copying of a product design is not probative of acquired distinctiveness. "Where the proposed mark is a product design, the copier may be attempting to exploit a desirable product feature, rather than seeking to

confuse customers as to the source of the product.” *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 (TTAB 2011).

CONCLUSION

For the reasons noted above, the evidence submitted by the applicant is insufficient to establish that the applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Applicant has failed to satisfy its heavy burden of establishing the acquired distinctiveness of a trade dress feature that embodies a common ring shape for a product that is generally ring shaped. Although applicant supplied some evidence promotion of the goods generally, and sales figures that reflect some commercial success of its products, the applicant did not provide any “look for” advertising that clearly promoted the specific product design feature at issue as a source identifier of the goods. Moreover, the few declarations applicant provided from distributors of applicant’s goods did not adequately refer to the metallic gray ring product feature for which applicant has sought to establish acquired distinctiveness. Furthermore, despite 40 years use of the applied-for mark in the United States, applicant failed to provide even one statement from an end consumer attesting to the distinctiveness of the applied-for mark at issue.

For the foregoing reasons, the refusal to register on the basis of Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051-1052, 1127, for the reason that the applied-for mark consists of a nondistinctive feature of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness, should be affirmed.

Respectfully submitted,

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