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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/005455

APPLICANT: ic! berlin brillen GmbH

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the applicant's design mark for "spectacles, sunglasses" on the grounds that the mark is a nondistinctive configuration of the goods, Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, and the applicant's evidence of acquired distinctiveness is insufficient to support the applicant's amendment seeking registration on the Principal Register under Section 2(f) of the Trademark Act, 15 U.S.C. Section 1052(f).

I. FACTS

Applicant applied for registration on the Principal Register of a product configuration comprising a design feature of the applicant's goods, namely, a three

“fingered” earpiece for sunglasses and spectacles near the hinge connecting the earpiece with the lens-enclosing portion of the frame. The three “fingers” are separated by openings that create two distinct lines. The upper line of the earpiece is straight and the bottom line is angled upward toward the portion that rests on the wearer's ears. The entire configuration resembles an asymmetrical fork. There exists a hinge at the point where the configuration joins the lens-enclosing portion of the spectacle or sunglass frame, but the hinge feature is not claimed as a part of the configuration. The broken or dotted lines show the mark’s position on the goods.

Registration was refused under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, because the mark consists of a nondistinctive product design feature of the identified goods. The applicant responded to the refusal to register by claiming pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. Section 2(f), that the mark has acquired distinctiveness. The evidence in support of the applicant’s claim of acquired distinctiveness was found insufficient, and the refusal to register was continued. This appeal follows the Examining Attorney's final refusal and denial of applicant’s request for reconsideration.

Therefore, the sole issue on appeal is whether applicant’s mark has acquired distinctiveness so as to overcome the nondistinctive product design refusal under Trademark Act Sections 1, 2 and 45.

II. ARGUMENT

THE APPLICANT'S MARK CONSISTS OF A NON-INHERENTLY DISTINCTIVE CONFIGURATION OF THE GOODS AND IS ONLY REGISTRABLE UPON A SHOWING OF ACQUIRED DISTINCTIVNESS UNDER SECTION 2(f) OF THE TRADEMARK ACT.

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S.205, 54 USPQ2d 1065 (2000), the United States Supreme Court held that while packaging may sometimes be distinctive, a configuration of a product can never be inherently distinctive; therefore, it is registrable *only* upon a showing of secondary meaning. The Court noted that product design almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design is intended not to identify source, but to make the product itself more useful or appealing. *Ibid at 1069.*

Applicant's mark is merely a product design in that it is the configuration of a design feature of sunglasses. As such, an allegation of five years' use in commerce is insufficient to show acquired distinctiveness. Therefore, the mark is only registerable on the Principal Register with a showing of acquired distinctiveness through the submission of convincing evidence to prove that in fact the purchasing public does recognize the applied-for product design feature as a trademark which identifies the source of the goods. *See In re Owens-Corning Fiberglass Corp.*, 227 USPQ 417 (Fed. Cir. 1985); *In re David Crystal, Inc.*, 132 USPQ 1 (C.C.P.A. 1961).

The burden of proving a prima facie case of acquired distinctiveness in an *ex parte* proceeding rests with applicant. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 6 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 1988), citing *Levi Strauss & Co. v. Genesco, Inc.*, 222 U.S.P.Q. 939, 942 (Fed. Cir. 1984). To establish acquired distinctiveness, applicant must show that the primary significance

of the product configurations in the minds of consumers is not the product but the producer. *In re*

Ennco Display Systems Inc., 56 USPQ2d 1279, 1283 (TTAB 2000).

The amount and character of evidence required to establish acquired distinctiveness necessarily depends on the facts of each case, and particularly on the nature of the mark sought to be registered. The applicant's burden is heavy in this case because of the inherent non-distinctive nature of the applied-for mark. *See Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S.205, 54 USPQ2d 1065 (2000); *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) ("While there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, the burden is heavier in this case because it involves product configurations.").

The applicant has submitted evidence in support of his claim of acquired distinctiveness consisting of the following:

- (1) A declaration from applicant claiming substantially exclusive and continuous use of the mark for five years.
- (2) Copies of advertisements for the goods and a statement by applicant that sales of the spectacles and sunglasses in the United States from 2001 through October 11, 2006 have been nearly 40,000 pieces. Applicant also states that from 2001 through March 2005, it spent nearly \$63,000 in U.S. marketing and advertising for the product and an additional \$115,000 in U.S. marketing and advertising for the product in 2006.
- (3) A statement by applicant that it exhibited the goods at major national trade shows attended by approximately 14,500 in New York City and 12,500 in Las Vegas in 2005 and has continued to exhibit its goods at key trade shows attended by thousands of buyers in 2006.
- (4) Declarations from ten opticians as to the recognition of the design as an indication of the source of the goods.

To determine whether the proposed mark has acquired distinctiveness, the trademark examining attorney considers the following factors: (1) how long applicant has used the mark in the United States; (2) the type 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 goods identified in the application. *See Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 173 USPQ 820 (S.D.N.Y. 1972).

In this case, applicant has used the mark in commerce for only five years in the United States. For matter that does not inherently function as a mark because of its nature (*e.g.*, nondistinctive product container shapes, overall color of a product, mere ornamentation), evidence of five years' use is *not* sufficient to show acquired distinctiveness. *See generally In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417 (Fed. Cir. 1985).

While the applicant has submitted evidence of advertising expenditures used to promote and advertise its goods, review of the sample advertising material submitted shows no promotion of the *specific configuration* of the earpiece for sunglasses and spectacles as a mark apart from the goods in general. *See In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures, notwithstanding applicant's statement that advertising of the closures involved several hundred thousand dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark.).

Applicant asserts that the absence of "look for" advertising or promotion does not mean that consumers do not recognize the design as applicant's trademark. Applicant's Brief at p. 10. However, the mere fact that applicant's advertisements include pictures of the goods does not indicate that consumers recognize one feature of the goods to be a source indicator. There is no indication that potential purchasers would view applicant's

submitted advertisements as more than pictures of the goods. *See In re Edward Ski Products Inc.* 49 USPQ2d 2001, 2005 (TTAB 1999) (“While the product design may be shown on each and every advertisement, there is no indication that potential purchasers would view this as more than a picture of the goods.”); *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811 (TTAB 1998) (consumers would not regard depiction of peacock configuration as anything more than graphic representation of the product).

Applicant states that its sales in the United States from 2001 through March 2006 have been nearly 40,000 pieces. In addition, applicant states that from 2001 through 2005, it has spent nearly \$63,000 in U.S. marketing and advertising for the product bearing the proposed trademark and an additional \$115,000 in U.S. marketing and advertising for the product bearing the trademark in 2006. This argument is unconvincing.

Applicant’s sales and advertising sums are less compelling than amounts presented in a number of other cases where acquired distinctiveness has not been found. *See Braun Inc. v. Dynamics Corp.*, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) (\$4,400,000 advertising blender trade dress insufficient to establish acquired distinctiveness); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 sales revenues and 740,000 tires sold insufficient to show acquired distinctiveness of tire tread design).

Moreover, while large-scale advertising expenditures are probative to indicate the extent to which a proposed mark has been used, an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *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).

In this case, there is no evidence that any of applicant's advertising activity had any impact on purchasers in perceiving the *specific configuration* of the earpiece for sunglasses and spectacles as a mark apart from the goods in general.

Applicant also submitted ten declarations taken from opticians who have dealt with applicant from between eighteen months to six years to demonstrate that they recognize the shape of the earpiece as a source of the goods. However, proof of distinctiveness requires more than proof of the existence of a relatively small number of persons who associate a mark with the applicant. What's more, since the declarations are only from *opticians*, the evidence is not altogether persuasive on the issue of how the average *customer* for sunglasses and spectacles perceives the specific configuration of the earpiece. *In re The Paint Products 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").

In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971). The only evidence that

the configuration of the earpiece of the sunglasses and spectacles has been recognized as a source indicator of the goods is shown in the ten declarations, none of which are from consumers, that were submitted with applicant's responses. This evidence is not enough to establish that the mark has acquired distinctiveness.

Finally, applicant argues that no other eyewear manufacturer uses this design for its product. Applicant's Brief at p. 9. This is without merit. The fact that the record contains no evidence of other users of the applicant's specific design does not overcome the applicant's burden to establish the acquired distinctiveness of that nondistinctive design. *See In re Parkway Machine Corp.* 52 USPQ2d 1628 (TTAB 1999) (particular configuration of vending machine does not become distinctive merely because no other manufacturer uses that particular configuration).

III. CONCLUSION

For the foregoing reasons, applicant's claim of acquired distinctiveness was properly denied, and the refusal to registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. Section 1051, 1052 and 1127 should be affirmed.

Respectfully submitted,

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the USPTO will no longer directly e-mail the actual Office action to the applicant. Instead, upon issuance of an Office action, the USPTO will e-mail the applicant a notice with a link/web address to access the Office action using Trademark Document Retrieval (TDR), which is located on the USPTO website at <http://portal.uspto.gov/external/portal/tow>. The Office action will not be attached to the e-mail notice. Upon receipt of the notice, the applicant can then view and print the actual Office action and any evidentiary attachments using the provided link/web address. TDR is available 24 hours a day, seven days a week, including holidays and weekends. This new process is intended to eliminate problems associated with e-mailed Office actions that contain numerous attachments.