

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: June 7, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re St. Pauly Textile, Inc.*  
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Serial No. 85769111  
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Katherine H. McGuire of Woods Oviatt Gilman LLP  
for St. Pauly Textile, Inc.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office 115,  
Daniel Brody, Managing Attorney.

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Before Kuhlke, Adlin and Goodman  
Administrative Trademark Judges.

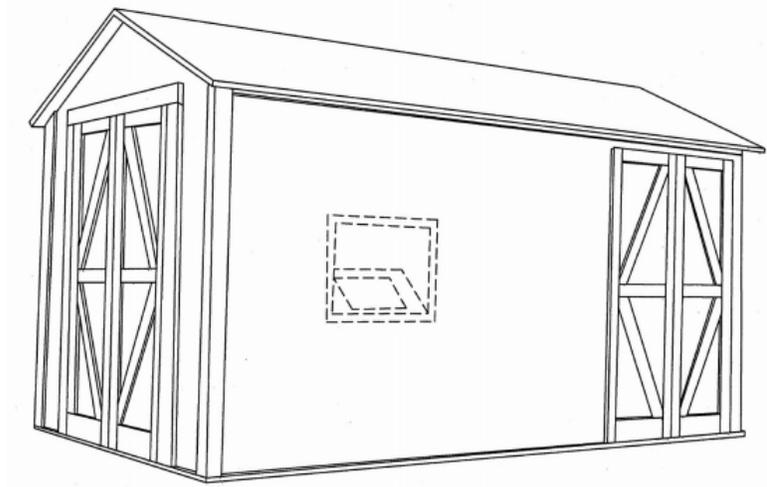
Opinion by Kuhlke, Administrative Trademark Judge:

St. Pauly Textile, Inc. (Applicant) seeks registration on the Principal Register of the trade dress shown below<sup>1</sup> for, as amended, “Recycling collection center services

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<sup>1</sup> The reproduced drawing is from the June 3, 2013 Response which was later accepted by the USPTO on June 16, 2015, but at the time of appeal a prior drawing continued to appear as the drawing on TSDR, the Trademark Status and Document Retrieval system. TSDR will be updated to reflect the correct drawing.

for collecting clothing and textile goods for redistribution to further users,” in International Class 37:<sup>2</sup>



The mark is described as follows:<sup>3</sup>

The mark consists of a three-dimensional depiction of a clothing and textile drop off station in the form of a decorative residential garden shed having a gabled roof, a first pair of double doors in a front wall, and a second pair of double doors in a side wall, wherein the first and second pair of double doors has an applied divided diamond design. The shape of the deposit opening is shown in dotted lines and does not form part of the mark.

Color is not claimed as a feature of the mark.

### **Prosecution History**

The Examining Attorney initially refused the application on the grounds that:

(1) the proposed mark (or parts thereof) is functional under Trademark Act Section

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<sup>2</sup> Application Serial No. 85769111, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on November 1, 2012, based upon Applicant’s allegation of first use and first use in commerce on November 30, 1997.

<sup>3</sup> This is the last description that was accepted by the USPTO on December 1, 2014. We consider this the operative description, but at the time of appeal a prior description continued to appear in TSDR. TSDR will be updated to reflect the current description. We refer to the mark as “Shed Trade Dress” for the remainder of the decision.

2(e)(5), 15 U.S.C. § 1052(e)(5); and (2) the proposed mark constitutes nondistinctive trade dress under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§ 1051-1053, 1127. In response, Applicant argued that its proposed mark is not functional, is inherently distinctive, and in the alternative has acquired distinctiveness. On October 4, 2013, the Examining Attorney accepted Applicant's showing of acquired distinctiveness but maintained the functionality refusal because the drawing "include[d] functional elements depicted in solid lines." Applicant responded by depicting everything except the diamond design on the doors in broken lines and amended the description of the mark to claim only the diamond design on the doors. The application was approved for publication based on acquired distinctiveness under Section 2(f). However, the allowance for publication was subsequently withdrawn and the Examining Attorney issued an Office action indicating that the evidence of acquired distinctiveness of the diamond design mark was insufficient. On October 29, 2014, Applicant amended the description and drawing again which depicts only the deposit opening in dotted lines (*i.e.*, claiming all but the deposit opening as the mark).<sup>4</sup> On December 1, 2014, the Examining Attorney accepted these amendments, withdrew the functionality refusal but maintained the refusal that the proposed mark constitutes nondistinctive trade dress and the showing of acquired distinctiveness is insufficient. In the Final Office action, the Examining Attorney accepted Applicant's June 3, 2013 drawing, and issued a final refusal

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<sup>4</sup> Applicant explains that these amendments were made after an interview with the Supervisory Examining Attorney on October 23, 2014. App. Br. 4 TTABVUE 7.

based on nondistinctiveness without a sufficient showing of acquired distinctiveness.

### **Issue on Appeal**

As noted above, the Trademark Examining Attorney has refused registration of Applicant's mark on the ground that it consists of nondistinctive trade dress under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053, 1127 and the showing of acquired distinctiveness is insufficient. Ex. Att. Br. 6 TTABVUE 3. Initially, Applicant sought registration based on acquired distinctiveness in the alternative. However, since the March 6, 2014 Response, Applicant has only argued for registration under Section 2(f) based on acquired distinctiveness, including in its Appeal Brief in which it frames the issue as "whether Appellant is entitled to register its SHED TRADE DRESS MARK based upon acquired distinctiveness for recycling collection center services for collecting clothing and textile goods for redistribution to further users." App. Br. 4 TTABVUE 8. "[W]here registration was initially sought on the basis of distinctiveness, subsequent reliance by the applicant on Section 2(f) assumes that the mark has been shown or conceded to" not be inherently distinctive. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 6 USPQ2d 1001 (Fed. Cir. 1988). *See also In re Cordua Rest. LP*, 110 USPQ2d 1227, 1233 (TTAB 2014), *aff'd*, \_\_\_ F.3d \_\_\_, \_\_\_ USPQ2d \_\_\_ (Fed. Cir. May 13, 2016). In view thereof, Applicant has conceded that its trade dress lacks inherent distinctiveness

and the only question remaining for appeal is whether it has acquired distinctiveness.<sup>5</sup>

### Acquired Distinctiveness

Acquired distinctiveness can be shown by length and exclusivity of use, extensive sales and advertising expenditures, unsolicited media coverage, consumer studies, declarations or surveys of consumers. *See In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness. *Id.* The amount and character of evidence required to establish acquired distinctiveness depends on the facts of the case and particularly on the nature of the mark sought to be registered or protected. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970); *Cordua*, 110 USPQ2d at 1233. The burden of proving a *prima facie* case of acquired distinctiveness rests with the applicant. *Yamaha v. Hoshino*, 6 USPQ2d at 1004. *See also In re Chevron Intellectual Property Group LLC*, 96 USPQ2d 2026, 2013 (TTAB 2010) (where product design sought to be registered is common, applicant has an “unusually heavy burden”) (citing *Yamaha v. Hoshino*, 6 USPQ2d at 1008).

In support of its assertion of acquired distinctiveness, Applicant initially relied solely on “substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.”<sup>6</sup> Applicant later asserted

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<sup>5</sup> The record, as discussed *infra*, also supports such a finding. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1688 (Fed. Cir. 2010).

<sup>6</sup> June 3, 2013 Response p. 1.

eighteen years of substantially exclusive and continuous use in commerce. Applicant subsequently submitted the declaration of Joseph Howlett,<sup>7</sup> who attests that Applicant was founded in 1996 and over the past 5 years (2009-2013) the number of “Shed locations has increased” from 251 sheds to 753 sheds throughout New York, Pennsylvania, Connecticut, Massachusetts and Vermont.<sup>8</sup> Mr. Howlett attests further that Applicant has collected several million pounds of clothing over the past five years, has spent more than \$250,000 on advertising since 1996 and over \$100,000 in the past five years, and Applicant and the “Shed Trade Dress Mark have received extensive coverage since [1996].”<sup>9</sup> Mr. Howlett attached excerpts from two printed publications, *Catholic Courier* and *LittleFalls Times*, describing donation campaigns and Applicant’s services.<sup>10</sup> The excerpts include the following passages:

Within the past year, both of these parishes decided to locate a St. Pauly Textile drop box on their property. ... About six years ago, however [St. Pauly] began distributing donation drop boxes to interested church and community groups. Many parishes and schools are opting to use these drop boxes – which people can access 24 hours a day ... The boxes are actually small, shed-like buildings, measuring approximately 8 by 12 feet, with a chute on the front for people to drop their bagged clothing, shoes, belts, purses, linens, blankets, and drapes into. ...

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<sup>7</sup> The declaration is not clear as to who Mr. Howlett is in relation to Applicant. *See* Decl. p. 1, August 15, 2013 Response p. 2 (“I am [sic] POSITION with St. Pauly Textile, Inc., and as such am authorized to execute this Declaration on behalf of said corporation.”). However, we accept that he is in a position with Applicant to have personal knowledge of the information to which he attests (or access to business records that demonstrate such information).

<sup>8</sup> Howlett Dec., August 15, 2013 Response p. 2.

<sup>9</sup> *Id.* at 3.

<sup>10</sup> *Id.* at 4-6.

St. Pauly Textile has more than three dozen drop boxes located in Monroe and Livingston counties and the Finger Lakes region, ... The locations of the boxes are widespread ... ;<sup>11</sup>

Since being delivered to the Manheim Town Garage late last month, the St. Pauly Textile collection shed has been met with great community response. ... St. Pauly Textile is a Rochester-based business that sets up sheds for the collection of usable clothing and distributes the donations to people that can use them, in the U.S. and in developing countries. “Looking through the window of the shed, you can see the clothing is piled right up to the top” ... St. Pauly has 412 clothing drop off sheds throughout western and central New York and has only had one organization ask to remove a shed in the 15 years they have been around.<sup>12</sup>

In addition, Applicant submitted articles from two other printed publications with the following passages:

New used-clothing donation shed comes to Salem church ... Used clothing can find a new home through Redeemer Lutheran Church’s new donation drop-off shed. St. Pauly Textile, the company that operates the shed, will distribute the donated clothes to areas in need nationally and internationally. St. Pauly’s website says organizations typically earn between \$50 and \$300 a month from the shed. Redeemer’s congregation overwhelmingly supported the new endeavor. ... The shed is the only location St. Pauly’s has in Salem, Sherer said.<sup>13</sup>

This is one shed that has generated no controversy. In fact it creates only goodwill while enabling local residents to help those in need. The shed in question is located at St. Mary-in-the-Highlands Episcopal Church in Cold Spring – a used clothing shed operated by St. Pauly

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<sup>11</sup> *Catholic Courier*, August 15, 2013 Response pp. 4-5. The article includes a picture of the interior of the shed, but not the applied-for mark.

<sup>12</sup> *LittleFalls Times*, August 15, 2013 Response at 6.

<sup>13</sup> *Statesman Journal*, June 1, 2015 Response p. 3.

Textiles Inc., a company based in Farmington, New York, near Rochester ... “I’ve been delighted with it,” the Rev. Shane Scott-Hamblen, rector at St. Mary’s, said of the shed. “It caught on much more than I would have thought. I see clothes being dropped off almost daily.”<sup>14</sup>

Applicant also points to the sign on the shed, which is not part of the applied-for mark, which includes identifying information for Applicant, St. Pauly, including Applicant’s mission statement and its web address. Finally, Applicant points to its website that “includes numerous instructions to visitors to ‘Look for the St. Pauly Shed!’” as shown below:<sup>15</sup>

The screenshot displays the website for St. Pauly. At the top, the heading "About St. Pauly" is centered. Below it, a sub-heading "Look for the St. Pauly Shed!" is followed by a paragraph stating: "St. Pauly is a Western NY based, family owned company and a member of the Better Business Bureau. Our goal is to get USEABLE clothing to people who can use it, here in the U.S. and in developing countries. We are the largest clothing collection organization in the region." Below this, there are two columns of text. The left column is titled "What to Donate:" and lists "Used Clothing, shoes, sneakers, belts, purses, linens, pillowcases, blankets, curtains, and stuffed animals." Below that is "What Not to Donate:" listing "Furniture, electronics, household items, books, toys, garbage, pillows, rags, and fabric scraps." The right column is titled "Why St. Pauly collects clothing:" and contains three numbered points: 1) According to the EPA, 85% of clothing in the U.S. is thrown away instead of donated. This means that only about 15% of clothing that could potentially be donated is collected using existing methods. 2) There is an enormous global need for used clothing. We are able to distribute clothing to people all over the world who need it, and all of the clothing that we collect is worn by someone somewhere. 3) We guarantee that the sheds remain clean and attractive. Every week we monitor and empty the sheds. Year round our service team is available to perform maintenance on the sheds. Below the "About St. Pauly" section, there is another section titled "Locations -Look for the St. Pauly Shed!". It includes a sub-heading "Look for the St. Pauly Shed!" and a paragraph: "In the 18 years that St. Pauly has existed we have developed relationships with over 1000 non-profit organizations in NY and parts of PA, CT, MA, VT, OH, RI, OR, and WA to collect clothing in a uniquely clean and community-friendly way." Below this, there is a section titled "Why non-profits choose to have a St. Pauly Shed:" with three numbered points: 1) This project is a service to communities. This builds a unique connection between community members and the organizations that host our sheds. 2) Clothing donated to our sheds is then distributed to people all over the world who need it. 3) We are able to provide anywhere from \$50 – \$300 on average per month to organizations that host our sheds. At the bottom of the screenshot, there is a paragraph: "St. Pauly has over 1,000 sheds all across NY and parts of PA, CT, MA, VT, OH, RI, OR, and WA. We collect clothing by setting up a beautifully constructed, wood frame clothing drop-off shed with a single non-profit organization in a given community."

<sup>14</sup> *Philipstown.info*, June 1, 2015 Response p. 5.

<sup>15</sup> June 1, 2015 Response pp. 6-8.

Depictions of Applicant's clothing receptacles are shown below:<sup>16</sup>



The Examining Attorney introduced the following examples of third-party clothing drop off stations which are most similar to Applicant's Shed Trade Dress:



<sup>16</sup> November 1, 2012 application (Applicant's specimen of use); and December 1, 2014 Office action p. 2 (applicant's website). The picture from the website is not the applied-for mark.

<sup>17</sup> October 4, 2013 Office action p. 10.

<sup>18</sup> June 16, 2015 Office action p. 14.

<sup>19</sup> June 16, 2015 Office action p. 23.

<sup>20</sup> June 16, 2015 Office action p. 5.



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The Examining Attorney also relies on these examples of more typical bins for collecting clothing:



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<sup>21</sup> March 6, 2013 Office action p. 26.

<sup>22</sup> October 4, 2013 Office action p. 2.

<sup>23</sup> October 4, 2013 Office action p. 6.

<sup>24</sup> October 4, 2013 Office action, p. 11.

<sup>25</sup> March 6, 2013 Office action p. 10.



With regard to the diamond door design, the record includes examples of doors with diagonal braces, which apparently provide additional strength to a door. A few examples are set forth below:



<sup>26</sup> March 6, 2013 Office action p. 21.

<sup>27</sup> March 6, 2013 Office action p. 25.

<sup>28</sup> January 5, 2014 Office action p. 2.

<sup>29</sup> January 5, 2014 Office action p. 5.

<sup>30</sup> March 29, 2014 Office action p. 3.

<sup>31</sup> March 29, 2014 Office action p. 3.

The record makes clear that the gabled roof, which appears in some of the examples above, is a basic roof design.<sup>35</sup>

Applicant argues the evidence is sufficient to establish a *prima facie* case of acquired distinctiveness. Applicant challenges the Examining Attorney's inclusion of any structure which has "a generally rectangular shape with four walls, a roof and a door opening" and argues they are irrelevant to the analysis of third-party use of similar structures.<sup>36</sup> Ex. Att. Br., 6 TTABVUE 6. Applicant narrows the category and concludes that "it appears to be the sole user of a residential garden shed for recycling collection center services for collecting clothing and textile goods for redistribution to further users." App. Br. 4 TTABVUE 12. Applicant concludes, accordingly, "a lower amount of evidence should be required to establish acquired distinctiveness in this case." App. Br. 4 TTABVUE 12.

We agree the universe of relevant types of structures is not as broad as the Examining Attorney argues; nonetheless, as shown above, the record does include numerous examples of garden shed-like buildings used for clothing donation drop

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<sup>32</sup> June 16, 2015 Office action p. 8.

<sup>33</sup> June 16, 2015 Office action p. 10

<sup>34</sup> June 16, 2015 Office action p. 11.

<sup>35</sup> Wikipedia entry for "roof," March 6, 2013 Office action p. 42.

<sup>36</sup> The Examining Attorney presented argument on the commonness of the design in relation to her argument that the Shed Trade Dress design is not inherently distinctive. As discussed above, this is no longer in issue; however, the argument is relevant to the issue of the amount and character of evidence required to establish acquired distinctiveness based on the nature of the mark sought to be registered. *Roux Laboratories, Inc. v. Clairol Inc.*, 166 USPQ at 39.

off receptacles.<sup>37</sup> Therefore, although it appears more common for a clothing donation drop off receptacle to resemble a mailbox or trash bin, it is not “unique” or “unusual” to see a garden shed-type building as a clothing drop off.<sup>38</sup> Indeed, the definition of shed, “a small building usually used for storage or shelter,”<sup>39</sup> incorporates the purpose for Applicant’s sheds in carrying out its services. In addition, the examples of third-party donation sheds correlate to examples of garden sheds in the record.<sup>40</sup> Applicant describes its mark as a “residential garden shed.”

As to the door and diamond design elements of the proposed mark, braces in general are extremely common features for doors, as they provide stability and strength, in addition to being aesthetically desirable. We observe that there are no examples of Applicant’s exact design; nevertheless, it does not stand out as

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<sup>37</sup> Applicant argues that the Examining Attorney specifically identified them for the first time in her brief. While that may be the case, these examples have been in the record since the March 6, 2013 Office actions.

<sup>38</sup> Applicant attempts to minimize the probative value of these examples by arguing that “there is no indication as to actual use of these structures, the time such structures were available to the consuming public, nor the geographical extent of use for any of these structures. App. Reply Br. 7 TTABVUE 4. What is evident from the pictures is the exposure of these structures with signs eliciting clothing donations on them to the general public. Applicant is correct that the evidence does not provide information as to the extent of use; however, the limited resources available to the USPTO to establish more detailed market information have been long recognized and taken into account in evaluating the evidence. *See In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003). *See also In re Sela Prods. LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) (evidentiary requirements in *ex parte* prosecution are not as stringent as those in *inter partes* proceedings, which generally follow the Federal Rules of Evidence).

<sup>39</sup> Cambridge Dictionaries Online ([www.dictionary-cambridge.org](http://www.dictionary-cambridge.org)). We grant the Examining Attorney’s request for judicial notice of the dictionary definition. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

<sup>40</sup> *See* March 6, 2013 Office action p. 36-38 (wikipedia excerpt on “Shed”).

particularly unusual. It is nothing more than a variation on common diagonal designs.

We find that given the nature of Applicant's proposed mark, a higher level of evidence is needed to establish *prima facie* acquired distinctiveness.

As to the length of use, it is true that evidence of substantially exclusive use for a period of five years immediately preceding filing of an application "may" be considered *prima facie* evidence of acquired distinctiveness. 15 U.S.C. § 1052(f) (emphasis supplied). However, the language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case. *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000). In this case, Applicant's eighteen years of use is insufficient, in itself, to bestow acquired distinctiveness.

The evidence regarding the expansion of Applicant's drop boxes may only demonstrate the growing popularity of its services, and while it does increase the public's exposure to the shed, it does not reveal the extent, if any, to which consumers perceive the shed as a source indicator. *Braun Inc. v. Dynamics Corp.*, 975 F.2d 815, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) ("[L]arge consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun."); *In re Bongrain Int'l (American) Corp.*, 894 F.2d 1316, 12 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin). More importantly, we cannot know which shed design is deployed. Based on the record,

Applicant has two designs, the applied-for mark with the diamond design on the doors on the front and side and the other one with an X design on the lower part of the door appearing on its website.

In addition, the amount spent on advertising for the services does not differentiate between the two shed styles, or, without more, show how the particular applied-for shed design is advertised in connection with the services to garner consumer recognition of it as a service mark. *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). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (finding evidence of sales and advertising expenditures insufficient to establish acquired distinctiveness of FISH FRY PRODUCTS where evidence involved uses of LOUISIANA FISH FRY PRODUCTS).

Applicant argues it has examples of “look for” advertising on a 2015 version of its website; however, it simply says look for the shed, it does not reference the shed design at issue or any of its specific shed design elements (i.e., “residential garden shed” with “gabled roof” and “double doors” on front and side walls with a “divided diamond design”) and could simply be perceived by consumers as “look for our

donation drop off.” *In re Teledyne Industries, Inc.*, 212 USPQ 299, 300 (TTAB 1981) (“Mere depiction of a product in advertising does not demonstrate that it is used as a mark.”) Similarly, the unsolicited media coverage simply refers to the donation drop off receptacle as what it is, a shed. There is nothing in the article to direct the reader to perceive the applied-for shed design as identifying source or as something unique. The printed publications also appear to be regional with a narrow circulation base.<sup>41</sup>

Accordingly, based upon consideration of all the evidence in the record, we find that Applicant has failed to establish that the particular Shed Trade Dress for which it seeks registration has acquired distinctiveness within the meaning of Section 2(f).

**Decision:** The refusal to register the Shed Trade Dress on the ground that it is nondistinctive trade dress and has not been shown to have acquired distinctiveness is affirmed.

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<sup>41</sup> We do not rely on the Examining Attorney’s observation that the information about the organization displayed on the shed “calls into question whether consumer recognition may be limited to the organization being identified rather than the shed configuration itself.” 6 TTABVUE 12. It could also serve to associate the services with the proposed mark. App. Br. 4 TTABVUE 17.