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Sent: 9/30/2015 5:41:33 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 86128810 - 021644.04280 - Request for Reconsideration  
Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 86128810

**MARK:**



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**APPLICANT:** Bass Pro Intellectual Property, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

021644.04280

**CORRESPONDENT E-MAIL ADDRESS:**

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 9/30/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated March 9, 2015 are maintained and continue to be final: NONDISTINCTIVE TRADE DRESS FOR SERVICES REFUSAL;

INSUFFICIENT CLAIM OF ACQUIRED DISTINCTIVENESS UNDER SECTION 2(F). *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

As indicated in the final Office action and duly acknowledged by applicant, an applicant bears the burden of proving that a mark has acquired distinctiveness. *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. An applicant can present any competent evidence to establish that a mark has acquired distinctiveness. 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 the request for reconsideration, applicant has thoughtfully described the applied-for mark as it relates to the applied-for services. That applicant's light fixtures – which are shaped like and interpreted to be light fixtures – appear in the front of the building where services are provided (where lighting fixtures are commonly located) where the consumer is able to see (which is the purpose of light fixtures) in a particular ornamental design (for ornamental purposes) does not lead to the conclusion that the particular lighting fixtures are inherently distinctive. While a mermaid light fixture may be capable of functioning as a trademark, applicant has not met its burden of proving the mark has acquired distinctiveness. The examining attorney does not have the burden of showing that the applied-for mark is not inherently distinctive. Applicant may amend the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816.

In the request for reconsideration, applicant notes that “[t]he mermaid lantern illuminates at night and it is an ornate and curious fixture that draws attention to itself.” Here, applicant acknowledges that the mark is experienced by a consumer in a functional context (as a lighting fixture to illuminate the facilities). Also, applicant, in describing the lighting fixture as “ornate,” correctly gives rise to the notion that consumers experience the mark as an ornamental feature of the services. The context in which the applied-for mark is encountered, as a lighting fixture attached to the entrance of a building, where lighting fixtures are commonly located, is not, absent compelling evidence of a directed and concerted effort by applicant to specifically connect in the minds of consumers the lighting fixture design to the

applied-for services, sufficient to show source-identifying significance. As shown in applicant's attached evidence, the lights serve a purpose: to illuminate the establishment in a visually pleasing way and light the walkway for patrons to enter the facilities.

Applicant references case law establishing that various elements of services, even elements outside of the establishment, may be protectable as trade dress due to their source identifying significance. This is well-established. In fact, the examining attorney has recommended the Supplemental Register because the mark is at least capable of indicating source. The issue here is whether the applied-for mark has acquired distinctiveness such that Section 2(f) is appropriate. Applicant has not provided evidence that consumers are *specifically directed* to the applied-for mark, only evidence that the lighting fixtures are used in connection with the applied-for services. Applicant has not provided any instances of look-for evidence, nor any evidence of any effort by the applicant to promote the applied-for mark in connection with the services. The First Circuit has stated that look-for advertising "is advertising that specifically directs a consumer's attention to a particular aspect of the product. To be probative of secondary meaning, the advertising must direct the consumer to those features claimed as trade dress." *Yankee Candle Co. v. Bridgewater Candle Co.*, 59 USPQ2d 1720, 1731 (1<sup>st</sup> Cir. 2001). "Merely 'featuring' the relevant aspect of the product in advertising is no more probative of secondary meaning than are strong sales." *Id.* In other words, even though applicant may wish or hope that consumers associate the applied-for mark with the services, that consumers simply see or experience the applied-for mark in the context of services or advertising is not by itself sufficient to show the mark has acquired distinctiveness.

It is the solely applicant's burden to show that the proposed mark has acquired distinctiveness as a source-indicator in the mind of the public. Generally, the shorter the duration of use of a mark in commerce, the greater the amount of evidence is required to show that the mark has acquired distinctiveness. As a whole, the very brief duration of use of the applicant's inherently non-distinctive mark combined with the limited probative value of the evidence submitted by the applicant is insufficient to demonstrate that the applicant has educated consumers such that the proposed mark has acquired distinctiveness as a source-indicator in the mind of the public. Simply, the applicant has not met its burden.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP

§715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

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