

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re HM Electronics, Inc.
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Serial No. 86162961
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Peter K. Hahn of Pillsbury Winthrop Shaw Pittman LLP,
for HM Electronics, Inc.

Christina Sobral, Trademark Examining Attorney, Law Office 109,
Michael Kazazian, Managing Attorney.

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Before Zervas, Ritchie and Goodman, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

HM Electronics, Inc. (“Applicant”) seeks registration on the Principal Register pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), of the proposed mark set forth below for “headsets for RF communications; communications headsets for use with communication radios, intercom systems, or other communications network transceivers” in International Class 9:¹

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¹ Application Serial No. 86162961 was filed on January 10, 2014, based upon Applicant’s claim of first use anywhere and first use in commerce since May 31, 2011.



The amended description of the proposed mark states:

The mark consists of a three-dimensional configuration of a headset. The elements of the mark are the button overlay, including the overlay shape, button openings and button opening layout, the casing shape, including the generally circular case and the curved upper part and the boom connector, including the rounded disk and cylindrical protrusion. The broken lines depicting the over-the-head band, the ear cushion, the buttons, and the boom microphone indicate placement of the mark on the goods and are not part of the mark.

The Examining Attorney issued a Final Office Action refusing registration of Applicant's mark on the grounds that:

- (i) the proposed mark includes non-distinctive elements that fails to function as a mark under Trademark Act Sections 1, 2, and 45, 15 U.S.C §§1051-1052, 1127;
- (ii) the evidence submitted is insufficient to support a Section 2(f) claim of acquired distinctiveness for the mark that includes non-distinctive elements; and

- (iii) Applicant has not submitted a drawing which claims only the distinctive and capable elements and has a corresponding mark description.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusals to register.

Failure to Function as a Mark

The Board, in *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1282-83 (TTAB 2000), explained:

In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, [529 U.S. 205, 54 USPQ2d 1065] (2000), the Supreme Court issued a recent decision on whether product designs can be inherently distinctive. ... The Supreme Court reversed the lower courts' rulings and held that "in an action for infringement of unregistered trade dress under §43(a) of the Lanham Act, a product's design is distinctive, and therefore protectable, only upon showing of secondary meaning." *Wal-Mart*, ___ U.S. at ___. In comparing product designs to color, the Court found that a "product design almost invariably serves purposes other than source identification." *Id.* As an example, the Court stated that "even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful and more appealing." *Id.* The Court reasoned that while consumers are predisposed to regard word marks or product packaging as indications of source, consumers are not predisposed to equate a product design with the source. *Id.*

Although the *Samara* case involved an unregistered product design in the context of an infringement action under Section 43(a), the Court's holding is applicable to the registration of product designs under Section 2 of the Trademark Act. In fact, the Court stated that distinctiveness is "an explicit prerequisite for registration of trade dress under §2." *Id.* citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081, 1085

(1992). There is no question, after *Samara*, that the eight product configurations involved in this case are not inherently distinctive as a matter of law, and are entitled to registration on the Principal Register only upon a showing of acquired distinctiveness under Section 2(f).

Because Applicant claims acquired distinctiveness pursuant to Section 2(f), we need only consider the question of acquired distinctiveness.

Acquired Distinctiveness

Applicant must show that the primary significance of the product configuration in the minds of consumers is not the product, but the producer. *In Re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1181 (TTAB 2014); *In Re MGA Entm't, Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007). It is applicant's burden to prove that the proposed mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”). “An applicant faces a heavy burden in establishing the distinctiveness of a product design.” *In re Van Valkenburgh*, 97 USPQ2d 1757, 1765 (TTAB 2011) (citing *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)); *In re Ennco Display Systems Inc.*, 56 USPQ2d at 1284.

In support of its claim of acquired distinctiveness, Applicant submitted three declarations of Darren Haas, Applicant's Vice President for Marketing, who states in pertinent part:

- The proposed mark has been in use on headsets for approximately 5 years.²
- Sales revenues for headsets bearing the proposed mark have totaled in excess of \$35 million; and “sales revenues are high compared to sales of other headsets by Applicant and also high compared to headsets sold by third-parties in this industry.”³
- “Based on information available to the Applicant, the headsets including the Mark are believed to be the top selling headset in the QSR industry and Applicant’s sales of headsets including the Mark are believed to be in excess of 60% of the total headsets sold in the QSR industry.”⁴
- Over the 5 year period, in excess of \$1.25 million dollars has been spent “on advertising and promoting the Mark and the associated goods”; and this amount of advertising for headsets and similar products in the QSR industry is “high.”⁵
- “The Mark was designed to be visually distinctive. In the QSR industry there are two other major competitors (3M and Panasonic) that sell headsets in competition with those sold by the Applicant. The products made by the Applicant, 3M and Panasonic are visually distinct from each other. This allows one to recognize the headset, and therefore the manufacturer, from a substantial distance. ... Headset manufacturers in the QSR industry have designed their headsets to have unique looks. This allows consumers in the QSR space to easily identify the manufacturer of each headset simply from the look of the headset itself.”⁶
- Applicant’s advertising has included the caption, “Look for the unique earpiece design,” found in print advertising,

² Haas Third Decl. at ¶ 4, Req. for Recon.

³ *Id.* at ¶ 5.

⁴ *Id.*

⁵ *Id.* at ¶ 6.

⁶ Haas Third Decl. at ¶¶ 8-10 and Exhibits A and B, Req. for Recon.

bill stuffers, electronically delivered advertising and pages from Applicant's website.⁷

Many of Applicant's advertising samples in the record depict the headpiece with the applied-for design.

In addition, Applicant submitted the declarations of (i) Keith Grubba, a store manager of a McDonald's restaurant who is involved in purchasing equipment such as the headsets at issue in this appeal; and (ii) Karen Robinson, Applicant's Senior Mechanical Engineering Manager. Mr. Grubba states in relevant part that (i) "It is my belief that the shape and look of the [Applicant's] headset has become exclusively associated with HME. When persons in the QSR industry see [Applicant's] headset, they immediately associate that headset with HME based on the shape and look of the headset";⁸ and (ii) "[t]he three major headset suppliers are [Applicant], 3M and Panasonic. Each of these manufacturers makes their headsets look visually different from headsets of other manufacturers. ... Each of these headsets are identifiable based simply on the look of the headsets."⁹ Ms. Robinson states (i) that "Each of the products made by the Applicant, 3M and Panasonic are visually distinct from each other. This allows one to recognize the headset, and therefore the manufacturer, from a substantial distance";¹⁰ and (ii) that "use of the Mark in the Quick Service

⁷ Haas Third Decl. at ¶ 19, Req. for Recon.

⁸ Grubba Decl. at ¶ 5, Sept. 30, 2014 Resp.

⁹ *Id.* at ¶ 3.

¹⁰ Robinson Decl. at ¶ 9, Sept. 30, 2014 Resp.

Restaurant industry has become exclusively associated with goods provided by Applicant.”¹¹

Upon careful consideration of the evidence and the Examining Attorney’s and Applicant’s arguments, we find that Applicant’s evidence establishes that its mark has acquired distinctiveness. Applicant has had sizable income (\$35 million) from sales of headsets incorporating its mark in five years, its revenues are high in comparison to revenues for headsets sold by third-parties, and Applicant’s sales of headsets including the mark are in excess of 60 percent of the total headsets sold in the QSR industry. Further, Applicant has had \$1.25 million in advertising and promoting the mark and associated goods, which in the QSR industry, Mr. Haas also characterizes as “high.”¹² Further, Applicant has engaged in “look for” advertising in print advertising, bill stuffers, electronically delivered advertising and pages from Applicant's website, which points consumers to the configuration of Applicant’s mark; certain advertisements state, “Look for the unique earpiece design.”¹³ “The Board explained in *In re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1187 (TTAB 2014):

In a product design application, the critical inquiry is whether the product design is being used and advertised in the marketplace in such a manner that consumers associate the product design with a particular applicant,

¹¹ Robinson Decl. at ¶ 11, Sept. 30, 2014 Resp.

¹² The Examining Attorney, in her brief, has postulated that the advertising expenditures are merely indicative of Applicant’s efforts to develop distinctiveness and not evidence that the mark has acquired distinctiveness, and that the sales figures are not probative of purchaser recognition of a configuration as an indication of source, but has not explained why. We therefore do not find her points persuasive.

¹³ Haas Decl. Exh. C., Req. for Recon.

and therefore view the product as emanating from a single source. *See Stuart Spector*, 94 USPQ2d at 1572 (“To determine whether a configuration has acquired distinctiveness, advertisements must show promotion of the configuration as a trademark.”). Sample advertisements showing “look-for” types of promotional efforts from an applicant may be particularly probative on the issue of whether a product design functions as a source identifier. “‘Look for’ advertising refers to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non source-identifying manner.” *Id.*

Despite the importance of “look for” advertising in product configuration cases, the Examining Attorney was not impressed by Applicant’s evidence. She states,

While the product design of the headsets are visible on the advertisements, these advertisements tout the small size, comfort, and sound quality of the headsets and not the particular design elements of the headsets. While, a few of applicant’s advertisements feature a line of text that indicates “look for the unique earpiece design” this line does not point to any particular element as unique The examining attorney has established that headsets generally feature a circular earpiece design making the shape common rather than unique. Additionally, the look-for evidence does not include the circular connector piece to the microphone boom. Further, the line “look for the unique earpiece design” appears at the bottom of the page in smaller font than the rest of the wording on the advertisement. Since the look-for evidence is not prominently placed it is unlikely that a consumer would see this line and view the earpiece design as an indicator of source.¹⁴

¹⁴ Examining Attorney brief at unnumbered pp. 8, 9 TTABVUE 11.

We are not troubled by the points made by the Examining Attorney; in the advertisements, the “look for” statement appears in proximity to a depiction of the “earpiece” noted in the “look for” statement and refers to the “unique earpiece design.”

Of particular significance in this case, however, is Mr. Haas’ statement that “headset manufactures in the QSR industry have designed their headsets to have unique looks,” which “allow consumers to easily identify the manufacturer of each headset simply from the look of the headset itself.”¹⁵ A similar statement was considered by the Board in *In re Black & Decker Corp.*, 81 USPQ2d 1841 (TTAB 2006). In that case, the Board found that the applicant had established acquired distinctiveness in a design of a key. The Board considered a declaration from the applicant’s marketing manager who stated, “it is an industry practice to use different and identifiable key head designs for locksets and keys”; and “other high end door lockset manufacturers use distinctly different configurations for their key heads.” The Board found this evidence significant and stated:

We note that this Board has previously considered industry practices in acknowledging that colors operate as source indicators for wire rope. *See e.g., Amsted Industries Inc. v. West Coast Rope & Rigging Inc.*, 2 USPQ2d 1755, 1757 (TTAB 1987) (“A rather unusual aspect of how color is generally applied to one or more strands of wire rope as an industry practice was the subject of considerable testimony and evidence. Even though the third-party registrations attached to applicant’s brief are not in evidence ... there is no doubt, on opposer’s record, that a number of suppliers of wire rope utilize one or more distinctively colored wire rope strands to serve as indicators of origin and have registered these indicia as trademarks”) and *Wire Rope Corporation of America, Inc. v. Secalt S.A.*, 196 USPQ 312, 315 (TTAB

¹⁵ Third Haas Decl. at ¶ 9, Req. for Recon.

1977) (“Insofar as the nature of the use of colored strands in the wire products field is concerned, it is not disputed that it is the custom, as previously indicated, for manufacturers to use different colors for application to their wire rope or cable for identification purposes and that purchasers do recognize the individual colors as source indicia”). Here, applicant has submitted photographs of ten key heads from other manufacturers of door locksets that are different from applicant’s key head design and five third-party registrations for marks consisting of key head designs for door hardware. In other words, the evidence in this case shows that it is common for manufacturers of door hardware to use key head designs as source indicators. This makes it all the more likely that consumers would perceive applicant’s applied-for mark as a trademark. *Cf. In re Upper Deck Co.*, 59 USPQ2d 1688, 1693 (TTAB 2001) (“[T]he common use of holograms for non-trademark purposes means that consumers would be less likely to perceive applicant’s use of holograms as trademarks”). The record also shows that applicant’s octagonal key head design is unlike the key head designs used by other manufacturers of door locksets.

Id. at 1844.

The declarations submitted in this application make clear that it is industry practice to include designs on headsets, and, in fact, additional manufacturer designs are in the record which differ from Applicant’s applied-for design. This evidence suggests that consumers would recognize various headsets by their designs, and that Applicant’s configuration commands sixty percent of the QSR headset market.

In view of the foregoing, we are persuaded that Applicant’s mark has acquired distinctiveness in the QSR headset market. The refusal to register on the basis that Applicant has not established that its mark has acquired distinctiveness is therefore reversed.

Drawing and Description Requirement

The Examining Attorney states in her brief:

Moreover, since applicant's product design includes nondistinctive elements incapable of acquiring distinctiveness, namely, the generally circular case that houses the buttons and rounded disk and cylindrical protrusion that connects the boom to the circular case is in the common or basic shape, such elements must be depicted in broken or dotted lines on the drawing because such elements cannot be considered part of the mark.¹⁶

However, the circular feature of the headset, shown in solid lines in the drawing, is integral to the "art deco mantle clock" design as it cooperates with the rose design of the headset. Also, the rounded disk and cylindrical protrusion connecting the boom to the circular case is not depicted in the headsets in the record. *See, e.g.:*



Thus, we are not persuaded by the Examining Attorney's evidence that the features are incapable of acquiring distinctiveness and should be displayed in dotted

¹⁶ Examining Attorney's brief at unnumbered p. 10, 9 TTABVUE 13.

lines in Applicant's drawing. The Examining Attorney's requirement for an amended drawing and for a corresponding mark description is reversed.

Decision: The refusals to register Applicant's product design mark are reversed. The application will move forward to publication in due course.