

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: December 16, 2020

Mailed: April 2, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re TBL Licensing LLC
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Serial No. 86634819
—

Sarah C. Hsia, Jason M. Sneed, and Megan E. Sneed of Sneed PLLC,
for TBL Licensing LLC.

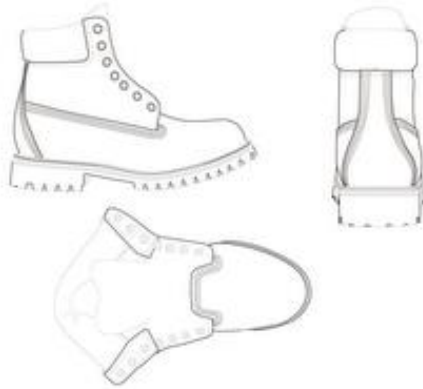
Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

—
Before Taylor, Coggins and Dunn,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

TBL Licensing LLC (“Applicant”) seeks registration on the Principal Register with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), of the asserted mark, as displayed below, for goods identified as “footwear, namely, lace-up boots” in International Class 25.¹

¹ Application Serial No. 86634819 was filed on May 19, 2015, based upon Applicant’s allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming December 1, 1988 as both the date of first use anywhere and in commerce.



The mark is described in the application as follows:

The mark consists of a three-dimensional configuration of a lace-up boot having an overall shape and silhouette as depicted in the drawings, with a visibly bulbous toe box and the following individual features: (1) the external appearance of a tube-shaped ankle collar on the outside surface of the product running from one eyelet panel to the other eyelet panel around the sides and rear of the boot and protruding over the upper side and rear panels of the boot (material on the inside of the ankle collar not being claimed); (2) outsoles having two color tones divided horizontally and extending around the circumference of the boot, and visibly showing inverted tooth shaped cuts on each side of the heel of the outsole and around the sides and front of the forward portion of the outsole; (3) an hourglass-shaped rear heel panel, defined by four vertical stitching lines from the top of the outsole to the rear collar; (4) quad-stitching forming an inverted “U” shape around the vamp line in front of the boot at the bottom of the tongue and curving around to the left and right sides and ending at the cinched portion of the hourglass stitching of the rear heel panel; and (5) eyelets shaped hexagonally on the exterior-facing outside surface. The double row stitching around the rear and side ankle collar, the single stitching around the upper two eyelets on each side, the single stitching along the upper perimeter of the shaft in front of the eyelets and the boot tongue, the appearance of the eyelets on the boot interior, the top of the ankle collar, the bottom, outer most surface of the outsole, and the uppermost surface of the outsole connecting to the boot around the perimeter, all of which are depicted in broken or dotted lines, are not being claimed as part of the mark

and serve only to show the position or placement of the mark.

Color is not claimed as a feature of the mark.

The specimen of record consists of the following photographs of Applicant's claimed mark:



Serial No. 86634819



The Examining Attorney has refused registration on the following grounds:

- (1) That Applicant's proposed mark is a product configuration comprising non-distinctive features under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051-52, 1127, for which Applicant's evidence of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f) is insufficient;
- (2) that the proposed mark comprises functional trade dress under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5); and
- (3) requirements that Applicant's drawing must be amended to depict only capable elements and the mark description must be amended to reflect that change.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. Both Applicant and the Examining Attorney filed briefs, and an oral hearing was held. As discussed below, we affirm the refusal under §§ 1, 2, and 45, and do not reach the functionality refusal under Section 2(e)(5) of the Act or the amended drawing and description requirements.

Whether Applicant's Proposed Mark is a Non-Distinctive Product Design Which Has Acquired Distinctiveness

I. Analysis of Refusal

A. Applicable Law

Applicant's mark is comprised of the three-dimensional trade dress² or product design of a lace-up boot "with a visibly bulbous toe box" and the individual features

² Applicant characterizes its asserted mark as "trade dress." However, the terms "trade dress" and "product design" have been used interchangeably for product features to which trademark rights are claimed. See *e.g.*, *Converse, Inc. v. Int'l Trade Comm'n*, 907 F.3d 1361,

noted above. A product design “is not inherently distinctive.” *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000); *see also In re OEP Enters., Inc.*, 2019 USPQ2d 309323, *16 (TTAB 2019) (quoting *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1503-04 (TTAB 2017) (“product designs can never be inherently distinctive and will always require evidence of acquired distinctiveness or secondary meaning to be registrable as marks.”) (citations and internal quotation marks omitted)). However, “a product design that provides no real utilitarian advantages to the user, but is one of many equally feasible, efficient and competitive designs, may be registrable upon a showing of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act.” *In re SnoWizard*, 129 USPQ2d at 1004 (citing *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006)).

We therefore must determine whether Applicant has made a prima facie showing that the relevant consumers perceive the design of a lace-up boot with the above-listed combined features as a trademark. Applicant bears the burden of proving that its product design has acquired distinctiveness. *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“There is no doubt that

128 USPQ2d 1538 (Fed. Cir. 2018) (a product’s design is considered distinctive, and therefore protectable as “trade dress,” only upon a showing of secondary meaning). We note further that “while ‘trade dress’ historically has been more often used to refer only to the packaging and labeling of a product, the breadth of the term has been expanded to include the shape and design of a product itself.” *In re SnoWizard, Inc.* 129 USPQ2d 1001, 1003 n.5 (TTAB 2018) (citing *Elmer v. ICC Fabricating*, 67 F.3d 1571, 36 USPQ2d 1417, 1421-22 (Fed. Cir. 1995) (trade dress refers to product packaging and the design of the product itself). We use the terms “trade dress” and “product design,” interchangeably, to refer to Applicant’s proposed mark.

Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”). That is, Applicant must show that the product design sought to be registered is perceived by relevant consumers not just as the product (or features of the product), but as identifying the producer or source of the product. *Wal-Mart*, 54 USPQ2d at 1068 (acquired distinctiveness exists “when, in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself”) (citation and internal quotation marks omitted).

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Yamaha Int’l Corp.*, 6 USPQ2d at 1008; *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381, 383 (CCPA 1960). Applicants face a heavy burden to establish distinctiveness and register trade dress. *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009); *see also Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1453, 32 USPQ2d 1724, 1742 (3d Cir. 1994) (“secondary meaning in a product configuration case will generally not be easy to establish”).

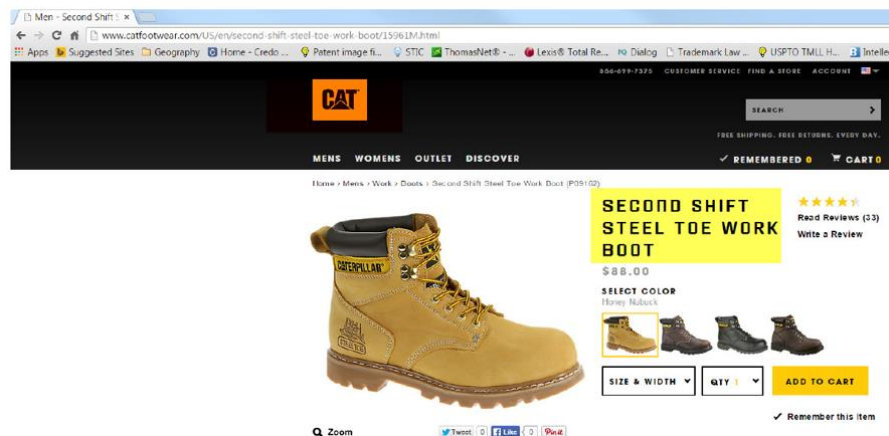
Further, in cases of trade dress or product design, the evidence provided to establish acquired distinctiveness must relate to the promotion and recognition of the specific configuration embodied in the proposed mark and not to the goods in general. *See Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.11 (1982) (“To establish secondary meaning, a manufacturer must show that, in the minds of

the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”); *see also, e.g., In re Bongrain Int’l Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (sales success may not suffice to prove that a mark has acquired distinctiveness where other marks were featured along with it or where sales growth could be attributed to the product’s popularity); *In re McIlhenny Co.*, 278 F.2d 953, 956-57, 126 USPQ 138, 140-41 (CCPA 1960) (promotion of a bottle design bearing other trademarks insufficient under § 2(f) to show that the public views the bottle design alone as a trademark). *Cf. In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (5 years use of composite mark does not speak to the issue of whether a component is viewed by itself as a mark); *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 1403, 184 USPQ 345, 348 (CCPA 1975) (advertising of a design along with word marks lacked the “nexus” that would tie together use of the design and the public’s perception of the design as an indicator of source).

B. The Examining Attorney’s Arguments and Evidence

The Examining Attorney maintains that Applicant’s proposed mark consists of a nondistinctive product design or contains nondistinctive features of a product design for which Applicant’s claim and evidence of acquired distinctiveness is insufficient. More specifically, the Examining Attorney argues that Applicant’s evidence is insufficient because “it fails to show that consumers have been conditioned to perceive the particular combinations of design features claimed here as source-indicating

trademarks.”³ With regard to Applicant’s claim of long, substantially exclusive and continuous use of its boot design, the Examining Attorney argues that during the period of claimed substantially exclusive use, there were multiple other manufacturers with similar boot designs. To support her position, the Examining Attorney made of record web pages showing third-party work-style boots from, e.g., Caterpillar, Coleman, Forever 21, Report, Shoe Republic LA, Soda Women, Nature Breeze, Rocket Dog, Skechers, Phat Farm, Dexter and Levi’s,⁴ that are similar in design to the trade dress Applicant seeks to register. More specifically, the record shows lace-up boots from multiple sources with bulbous toe boxes, ankle collars, outsoles with tooth-shaped-cuts (some with two-toned outsoles), and front-to-back vamps.⁵ A representative sample follows:

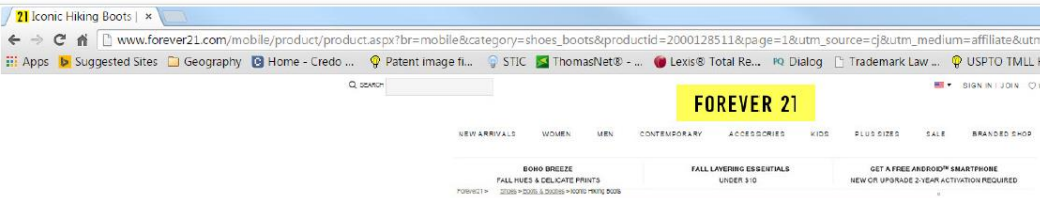
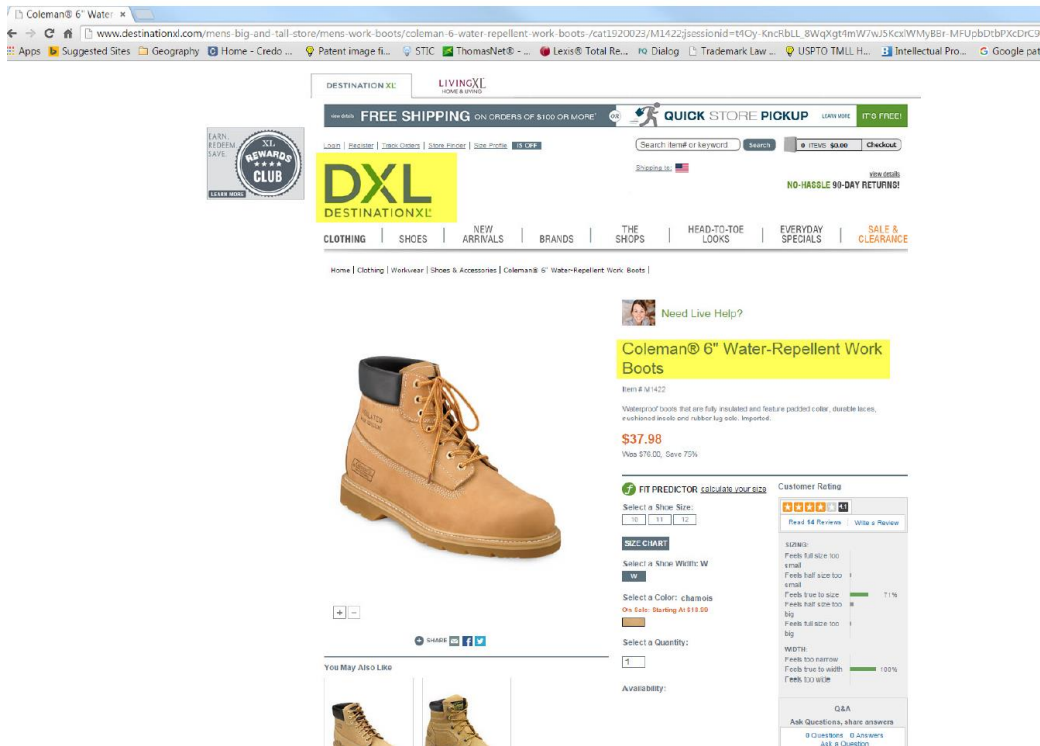


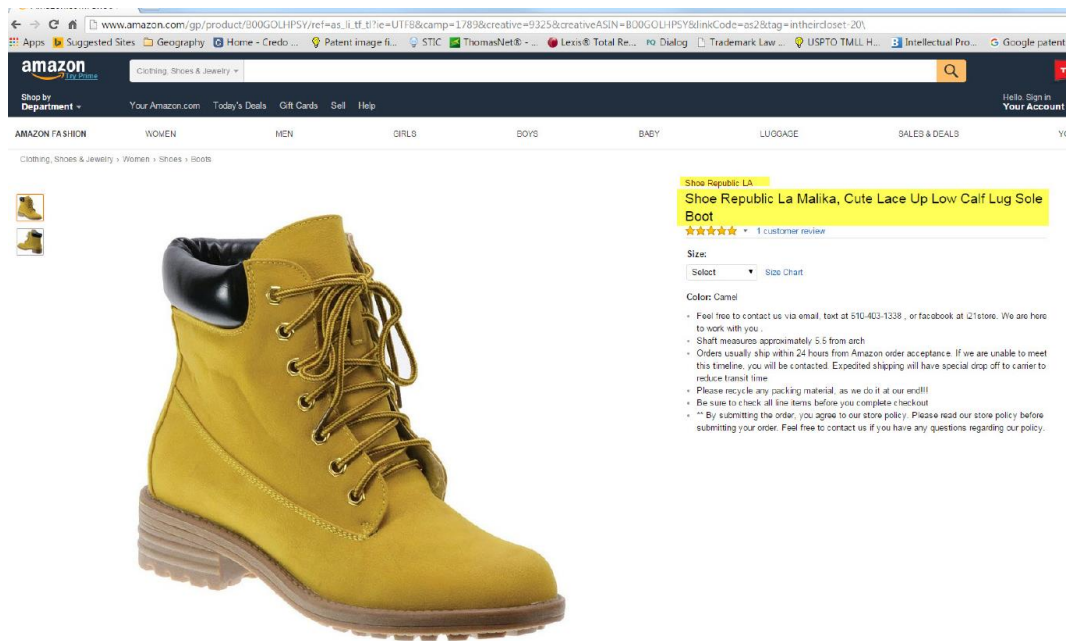
³ 18 TTABVUE 23.

⁴ October 6, 2016 Office Action; TSDR 9, 15, 22-23, 33-36, 39 and 41; *see also* May 19, 2017 Office Action; TSDR 54-55, 61-62, 72, 82, 91-92 and 136-140 and June 26, 2017 Office Action; TSDR 88, 91-92, 97, 103, 105-106, 111, 116 and 271.

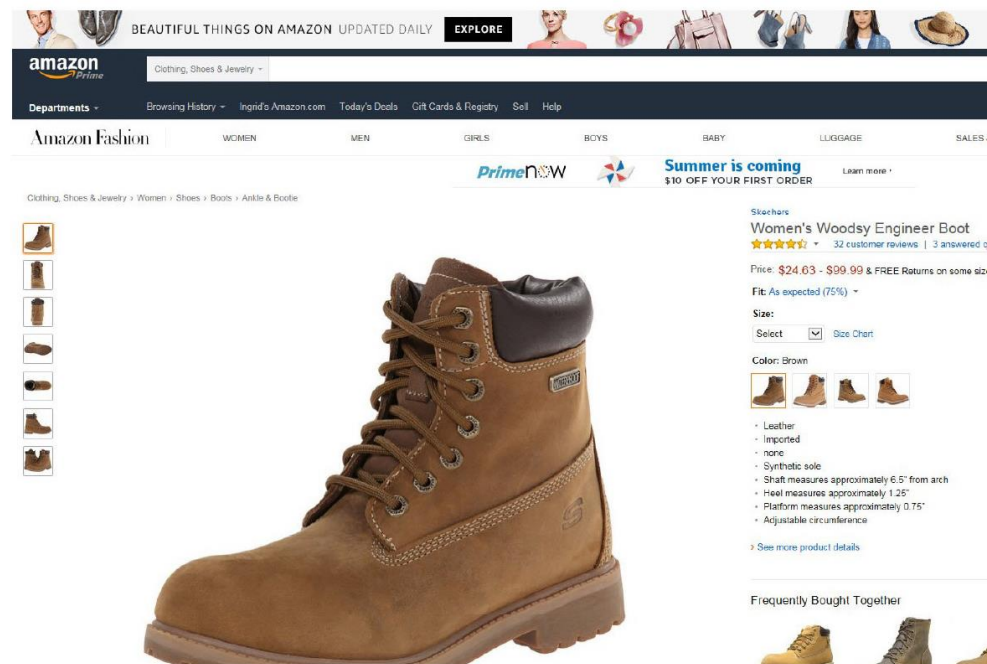
Citations to the briefs in the appeal record refer to the TTABVUE docket system. Citations to the prosecution file refer to the .pdf version of the TSDR system record. *In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238, *3 n.3 (TTAB 2021).

⁵ In most instances, the shape of the eyelets and rear heel panels are not discernable.





http://www.amazon.com/Skechers-Womens-Woodsey-Engineer-Boot/dp/B00L4SHYLK/05/19/2015.02.23.22 PM



https://www.amazon.com/Nature-Breeze-Leatherette-Padded-Collar/dp/B00NDHROVU?ie=UTF8&%2AVersion%2A=1&%2Aentrie s%2A=0 06/09/2017 09:57:17 PM


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Clothing, Shoes & Jewelry Women Shoes Boots




Nature Breeze
Nature Breeze Terrain Women Leatherette Multi Color Padded Collar Hard Toe Boot
★★★★☆ 50 customer reviews | 10 answered questions
Price: \$18.70 - \$38.95
Fit: As expected (74%)
Size: Select Size Chart
Color: Wheat

- Synthetic
- Heel measures approximately 1.25 inches"
- Synthetic
- Measurement (tested sz 6, approx.): Heel 1.25" Platform 0.5" Shaft(wheel) 6"
- Sole / Padding: Synthetic non-skid sole / cushioned foot bed with padded insole
- Closure: Lace up

Report incorrect product information.

Customers who viewed this item also bought



http://www.sears.com/phat-farm-men-s-doug-2-p-6-1-2inch/p-067VA75330812P?sid=IDx01192011x000001&qclid=CMY7j9VWV stQCFZKPswodPCUGbg&gclid=CMDiuNVWVstQCFU9CDAod2nllkQ 06/09/2017 09:58:33 PM

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Home / Shoes / Men's Shoes / Men's Boots /

Phat Farm Men's Doug 2 P 6-1/2" Wheat Boot
AAAAA 2 Reviews Description

4 Special Offers Free shipping! Orders \$49 or more see details



Key features

- Rugged wheat synthetic leather
- Comfortable padded collar
- Safe lugged rubber outsole

Color: Wheat Width: Medium Shoe Size: Select
Wheat Medium 9 9.5 10.5

C. Applicant's Arguments and Evidence

Applicant, in arguing against the refusal, maintains that “the evidence clearly demonstrates that consumers view Applicant as the source of lace-up boots bearing Applicant's Trade Dress,” and also questions the Examining Attorney's focus on the absence of “look-for” advertising. Applicant's brief pp. 20-22.⁶ Applicant supported its claim of acquired distinctiveness with the following materials:⁷

- The declarations of two of Applicant's employees, Christopher Turk, Applicant's Vice President and Secretary,⁸ and Jeff Thompson, Vice President, Global Development of Timberland, a division of VFR Outdoor, LLC, a sister company to Applicant⁹; and Todd Kirssin, the General Merchandise Manager at KTLR Inc. and Rafi Eskenazi, the head buyer for Robert Wayne Footwear, two retail footwear buyers of Applicant's lace-up boots;¹⁰ and
- Copies of unsolicited newspaper and magazine articles discussing the Timberland brand and boots, some featuring celebrities and others wearing

⁶ 16 TTABVUE 22-24.

⁷ Many of Applicant's submissions were made of record multiple times. These duplicative submissions were unnecessary and confuse the record. For clarity, in this decision we generally use the citations referenced by Applicant in its brief.

⁸ Applicant's March 30, 2016 Response, Exh. F; TSDR 71-75.

⁹ *Id.* at Exh. M; TSDR 170-174.

¹⁰ Applicant's December 21, 2017 Response, Exhs. S and T; TSDR 45-53.

Timberland boots,¹¹ blurbs and images of celebrities and others wearing Timberland boots, and advertising and promotional materials for Applicant's Timberland boots.¹²

In assessing whether Applicant has met its heavy burden of establishing acquired distinctiveness, we consider any evidence bearing on the: “(1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.” (“*Converse* factors”) *In re SnoWizard, Inc.*, 129 USPQ2d at 1005 (TTAB 2018) (quoting *Converse, Inc. v. Int’l Trade Comm’n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)). We discuss below the *Converse* factors that are relevant to this case for which we have evidence.

D. Analysis of Evidence and Arguments Relating to the Relevant *Converse* Factors

1. Association of the Trademark with a Particular Source by Actual Purchasers¹³

Direct consumer testimony can be relevant to establish acquired distinctiveness. Applicant has made of record the declarations of Todd Kirssin and Rafi Eskenazi,

¹¹ Going forward in this decision, we use the wording “Timberland boots,” alone, to also refer to Applicant’s proposed trade dress.

¹² See, e.g., Applicant’s Mar. 30, 2016 Response, Exhs. A, B, D, E, G and J2; TSDR 42-48, 51-69, 76-104 and 144, and Applicant’s Dec. 21, 2017 Response, Exhs. U and W; TSDR 54-73 and 88-94.

¹³ This factor is “typically measured by customer surveys,” *Converse*, 128 USPQ2d at 1546, although surveys are not required. Applicant did not provide a survey, but has made of record

retailers of its Timberland boots.¹⁴ Mr. Kirssin attests that “the features claimed by [Applicant] in connection with its Iconic Timberland Boot trade dress are all very distinctive features of the Iconic Timberland Boot and make the boot instantly recognizable by our customers”; and that “the shape and look of the Iconic Timberland Boot have become exclusively associated with Timberland” and that his customers “immediately associate those boots with Timberland based on the shape and look.” Kirrsin decl. ¶¶ 4 and 6.¹⁵ Mr. Eskenazi similarly attests that “the features claimed by [Applicant] in connection with its Iconic Timberland Boot trade dress are all very distinctive features of the Iconic Timberland Boot and make the boot immediately identifiable to our customers”; that “customers can recognize [the Timberland Boot] from across the store, even if it is offered in different colors than the traditional ‘wheat yellow’ color”; and that “[t]he Iconic Timberland Boot have [sic] become exclusively associated with Timberland ... based on the shape and look.” Eskenazi decl. ¶¶ 4, 8 and 10.¹⁶ Both declarations include the following images of the Timberland boot:

the declarations of two of its “dealers” and captioned images and blurbs showing that its boot trade dress is worn by “countless celebrities.”

¹⁴ In its appeal brief, Applicant refers to the boots which incorporate the product features sought to be registered in the subject application as “Timberland” boots. *See, e.g.*, 16 TTABVUE 4.

¹⁵ Applicant’s December 17, 2017 Response; TSDR 47.

¹⁶ Applicant’s December 17, 2017 Response; TSDR 53.



For multiple reasons, we find this declaration testimony has little probative value on the issue of acquired distinctiveness of the proposed mark. As noted by the Examining Attorney, the declarations reference Applicant's lace-up boot and contain the images of the boot shown above, one of which includes the embossed Timberland tree logo, matter which does not appear in the drawing of Applicant's proposed mark. Moreover, the averment that consumers recognize "the features claimed by" Applicant not only fails to indicate specific features that consumers recognize, but baselessly links consumer recognition to the legal claims in the application. While these two individual retailers may be consumers of lace-up boots, they are not the average, or end, consumer of Applicant's lace-up boot. "It is well settled that the assertions of retailers, who know full well from whom they are buying, that they themselves recognize a particular designation as a trademark, or that they believe that their customers consider it to be a mark, cannot serve to establish that members of the purchasing public, who come to the marketplace without such specialized knowledge, would in fact recognize the designation as an indication of origin." *In re Semel*, 189 USPQ 285, 288 (TTAB 1975). See also *In re Edward Ski Prods. Inc.*, 49 USPQ2d 2001 (TTAB 1999).

Applicant’s “multiple examples of unsolicited consumer association of Applicant’s Trade Dress with Applicant (some without any visible logo design)”¹⁷ are comprised of excerpts, including images, primarily from a variety of style publications or style sections of various publications (including both print and online editions), of celebrities, including Beyoncé’s daughter Blue Ivy, Jay-Z, Rihanna, Justin Bieber and Kanye West wearing Timberland boots. Many of the images include links to purchase Applicant’s boots, and all identify the boots worn by the celebrities as being Timberland boots. This evidence may demonstrate the popularity of Applicant’s lace-up boots, but it does not show that the celebrities wearing the Timberland boots associate Applicant’s claimed trade dress with the source of the boots they are wearing. Nor do these excerpts and images direct the attention of potential consumers to identify Applicant’s claimed trade dress as the source of Timberland boots.

2. Length, Degree, and Exclusivity of Use

Mr. Turk testified that Applicant’s Timberland boot commenced production in 1773 and, since that time, the boot has featured all elements in the claimed trade dress except for the two-toned outsole, which was introduced in 1988. Turk decl. ¶ 13.¹⁸ Thus Applicant has demonstrated continuous use of its applied-for product trade dress for more than thirty years. “While long use of a mark is a relevant factor

¹⁷ In making this arguments cites to the following portions of the record: Mar. 30, 2016 Response, Exh. B; TSDR 46; Exh. G; TSDR 78, 80-81, 83, 86, 89, 93-95, 97, 99, 100, 107 and Exh. J2, TSDR 144, and Applicant’s December 21, 2017 Response, Exh. U; TSDR 54-73.

¹⁸ Applicant’s March 30, 2016 Office Action, Exh. F; TSDR 73.

to consider in determining whether a mark has acquired distinctiveness, it is not necessarily conclusive or persuasive.” *Stuart Spector Designs v. Fender*, 94 USPQ2d at 1571-72 (TTAB 2009) (citing *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (internal citation omitted). On this record, although Applicant has demonstrated over 30 years continuous use of its applied-for product trade dress, the record shows Applicant’s use was not substantially exclusive given the numerous third-party uses. In coming to our finding, we recognize, as Applicant points out, that most of the third-party boots do not incorporate every feature described in Applicant’s description of goods. The overall shape and appearance of the third-party work-style boots nevertheless are quite similar to the boot trade dress Applicant seeks to register. In fact, the record shows that the overall silhouette of Applicant’s boot is quite common in the boot industry.

Furthermore, although Applicant argues that a couple of competitors have “slavishly” copied multiple elements of Applicant’s Trade Dress,” Applicant’s brief, p. 23,¹⁹ and Mr. Turk attests that imitations of the Timberland boot are not authorized, he points only to a single dispute regarding third-party use of a “too similar” boot design between Applicant and Levi Strauss & Co.²⁰ In view of what we regard as substantially similar product designs for lace-up boots, the record does not address any other efforts by Applicant to police its product design. This seeming inaction coupled with the record evidence of numerous third-party uses of very similar boot

¹⁹ 16 TTABVUE 25.

²⁰ Applicant’s March 30, 2016 Office Action, Exh. F; TSDR 74.

designs, further undercuts Applicant's assertion of substantially exclusive use. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1049 (TTAB 2013) (“[T]his [length-of-time] factor is undercut by the lack of exclusivity.”). In view thereof, Applicant fails to demonstrate the “substantially exclusive” use of the purported mark required by the statute. 15 U.S.C. § 1052(f); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 n.11 (Fed. Cir. 1985); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1434 (TTAB 2007). “When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.” *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984); *see also M-5 Steel mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1098 (“In the case before us, the record shows that there are at least three companies including opposer that produce roof vents substantially similar to applicant's vents. This alone would make it difficult for applicant to establish acquired distinctiveness.”).

Thus, the probative value of this factor is greatly diminished.

3. Amount and Manner of Advertising and
4. Amount of Sales and Number of Customers

The evidence of record demonstrates that Applicant has sold more than 15 million pairs of boots over the last 15 years, amounting to at least \$1.3 billion in revenue in the United States alone, Turk decl. ¶ 18, Thompson decl. ¶ 14,²¹ and that Applicant

²¹ *Id.* at 74 and 172.

has spent \$1.5 million on marketing and advertizing Applicant's lace-up boots bearing the applied-for trade dress from 2011-2016. Turk decl. ¶ 16.²² "However, while sales volume figures may demonstrate the growing popularity of the products, mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source." *Stuart Spector Designs v. Fender*, 94 USPQ2d at 72 (citing *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.") and *In re Bongrain* 13 USPQ2d at 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin)). Moreover, it is established that compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. *See In re Bos. Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness); *Stuart Spector Designs v. Fender*, 94 USPQ2d at 72 (substantial sales and advertising expenditures found 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).

As such, although Applicant's sales figures are impressive, the critical question is how is the proposed mark being used and ultimately perceived. That is, are

²² *Id.* at 74.

consumers exposed to Applicant's asserted product trade dress in a manner such that they can attribute an association between the proposed mark and Applicant. Here, the record shows that Applicant advertises and markets its Timberland boots through a variety of means, including, direct sales, on its website at www.timberland.com, through third-party social media outlets such as Facebook, retail stores, such as Nordstrom, Amazon.com and Footlocker, mailings and other print advertisements, and through promotions, giveaways and incentive programs. Turk decl. ¶ 17.²³ The record includes numerous examples of these advertisements, a representative sampling is shown below:



²³ *Id.* at 75.

Winter Boots — Brave Winter Storm Jonas In Style & SHOP



Fri, January 22, 2016 1:51pm EST by [Olivia Elgart](#)

...

7



Timberland Women's 6 Inch Premium Waterproof Boots

Classic Timberland® boots aren't just for the guys. Always in style, these waterproof boots are crafted for women's feet, with colorful, rugged styling that can be dressed up with tights and dresses, or brought outside with jeans and a flannel.

BUY NOW

\$160



Women's Health, November 2014



Fashion Feed

COMEBACK KICKS
Two iconic brands have successfully rebooted. (See what we did there?)

1/ Timberland
Now a bit less bulky. \$180, timberland.com

2/ Dr. Martens
Vivid laces! \$200, drmartens.com

6.7
AMOUNT, IN BILLIONS OF DOLLARS, WOMEN SPENT ON BOOTS IN THE PAST YEAR

56 WOMENSHEALTHMAG.COM / November 2014

THE BEAUTY EXPERT
allure

Internet
January 7, 2016
Impressions: 4,521,749

10 Winter Boots That Are Actually Cute

It may be unseasonably warm across the country, but trust: Snow days aren't too far behind. We culled ten pairs of cold-weather boots to help you sludge through the sleet—and look good doing it.

BY NICOLE CHAPOTEAU



Timberland leather boots,
\$160 (timberland.com).

Although we have reproduced only a few of the record examples of Applicant's advertisements, none highlight the product design features Applicant seeks to register or promote those collective features as a source indicator. Rather, the record advertisements consistently show a picture of Applicant's lace-up boots primarily with the tree logo visible and with the word mark TIMBERLAND and/or the tree logo design prominently featured and/or the "original yellow" color touted.²⁴ In essence, the advertisements generally refer to the styling of the boot, include the tree logo

²⁴ In making this finding, we acknowledge that Applicant advertises its lace-up boot in colors other than yellow. However, most of the additional colors, save black and red, are advertised as limited edition collaborations with a particular celebrity or in connection with a particular cause or event. *See e.g.*, Limited release Susan G. Komen boot in pink for breast cancer awareness, Applicant's December 21, 2017 Response at TSDR 75, St. Patrick's Day shamrock green color boot promoted by Nordstrom, *id.* at TSDR 77, Supreme and Timberland's "The Supreme Saint" in patriotic colors and motif, *id.* at TSDR 84, The Ultamiciti x Champs Sports x Timberland Collection in a variety of colors and animal image toe box, *id.* at TSDR 85 and the DJ Khaled x Timberland Secure The Bag Boot in olive green, *id.* at TSDR 86-87.

design and often tout the “original yellow” color, characteristics not claimed in Applicant’s proposed mark. “Advertising that touts a product feature for its desirable qualities and not primarily as a way to distinguish the producer’s brand is not only not evidence that the feature has acquired secondary meaning, it directly undermines such a finding.” *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662, 36 USPQ2d 1065, 1071 (7th Cir. 1995); *In re Edwards Ski Prods. Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Pingel Enter., Inc.* 46 USPQ2d 1811 (TTAB 1998). *See also First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1 USPQ2d 1779 (9th Cir. 1987) (no acquired distinctiveness found where “[i]t did not, for example, order consumers to look for the ‘familiar yellow jug’”); *Sykes Lab’y, Inc. v. Calvin*, 610 F. Supp. 849 (C.D. Cal. 1985) (cosmetic container held without acquired distinctiveness because claimant “never promoted its design separate and apart from the trademark name”).

Applicant takes issue with the Examining Attorney’s “dismiss[al]” of its acquired distinctiveness evidence because Applicant did not provide “look-for” advertising, and argues that:

So-called ‘look-for’ advertising is dated and antiquated, and Applicant does not consider it to be an effective modern model of advertising, particularly where Applicant’s distinctive trade dress has been recognized by consumers for decades ... [and] that “[t]he ultimate test in determining acquisition of distinctiveness under Section 2(f) is not Applicant’s efforts, but Applicant’s success in educating the public to associate the claimed mark with a single source. By this standard, the test is not “look for” advertising, but whether the evidence shows that consumers use the trade dress to identify the source of the goods. And the evidence most certainly does.

Applicant's reply brief, p. 9.²⁵ (Internal citations omitted).

As Applicant correctly points out, "look-for" advertising is not always necessary – "what matters is Applicant's success in obtaining the consuming public's recognition of Applicant's Trade Dress as emanating from Applicant." Applicant's brief, p. 22.²⁶ The problem with this record is that there is little evidence that the features which Applicant claims as its mark – the bulbous toe box, ankle collar, outsole shape and color, rear heel panel, vamp from back to front, and eyelets – have been advertised, or are recognized, individually or collectively as source indicators for the identified lace-up boots. Instead, the record indicates that many lace-up boots combine some or all of the claimed features in highly similar product designs. The little evidence of consumer recognition of the product design features – the retailer declarations – does not tout any of the claimed features, and refers to an image which includes another visible source indicator (i.e., the tree design element) used in the advertising encountered by customers. In these circumstances, where Applicant's advertising consistently includes the TIMBERLAND word mark and tree logo design and often touts the "original yellow" color, the absence of advertising that points out the claimed features of Applicant's product design drastically diminishes the probative value of Applicant's advertising expenditures and sales as contributing to any acquired distinctiveness of its product design.

²⁵ 19 TTABVUE 10.

²⁶ 16 TTABVUE 24.

In view of the foregoing, the Converse factors concerning Applicant's advertising practices and sales of its proposed product design mark are not particularly probative of acquired distinctiveness.

5. Intentional Copying

Applicant observes that competitors have used particular elements of its trade dress, and that others have "slavishly" copied its product design. However, "[c]opying is only evidence of secondary meaning if the [copier's] intent in copying is to confuse consumers and pass off his product as the plaintiff's." *Stuart Spector Designs v. Fender*, 94 USPQ2d at 1575 (quoting *Thomas & Betts Corp. v. Panduit Corp.*, 36 USPQ2d at 1072). Applicant did not assert, and from the record it does not appear, that the third-party uses are made for the purpose of confusing consumers or to pass off these third-party products as Applicant's. The third-party uses clearly display the manufacturer's trademark or trade name on the boots or in accompanying advertising. There is no evidence that any third-party copying of one or more elements of Applicant trade dress was intentional, or even if so, was due to an intent to confuse customers as to the source of the products. *See Thomas & Betts Corp. v. Panduit Corp., supra.*

6. Unsolicited Media Coverage of the Product Embodying the Mark

Applicant has introduced numerous examples of unsolicited media coverage, and argues that these unsolicited publications "characteriz[e] the boots bearing

Applicant's Trade Dress As 'iconic' and 'instantly recognizable.'" Applicant's brief p.

21.²⁷ These excerpts include, by way of example, the following:²⁸

- Timberland: 40 years of the yellow boot²⁹

The Timberland boot is one of fashion's most recognizable fashion classics – favoured by everyone from working men to fashion designers and pop royalty, so what's the secret to success?

...

Made up from 39 components and constructed via 80 separate factory floor steps, you'd be forgiven for thinking the subject in question is a piece of Nasa technology. This, however, is the drill dedicated to the creation of a pair of yellow, eight-hole Timberland boots.

...

Defined by this yellow boot, the brand took off in the 1990's when US hip-hop artists wore Timberlands.

²⁷ 16 TTABVUE 23. In making this claim, Applicant points to the following record evidence: Applicant's Mar. 30, 2016 Response, Exhs. A, B, D, E, and G; TSDR 42-48, 51-69 and 76-109, and Applicant's Dec. 21, 2017 Response, Exh. W; TSDR 88-94.

²⁸ The SUPERBRANDS excerpt (March 30, 2016 Response; TSDR 62-69) has little probative value because it provides "AN INSIGHT INTO BRITAIN'S STRONGEST BRANDS," and not the United States' strongest brands.

²⁹ March 30, 2016 Response; TSDR 43. <http://www.theguardian.com/fashion/2013/>. Full urls at TSDR cites.

- FALL FASHION with REFINERY29³⁰

FALL FASHION with REFINERY29

'90s-Style Timberland Boots Make a Comeback

By Joanna Douglas, Senior Fashion and Beauty Editor | Fall Fashion – Sun, Sep 15, 2013 4:44 PM EDT

Email Share 749 Tweet 92 +1 13 Pin it Print



Photos: SplashNews, Instagram/Khloe Kardashian, SplashNews

The article states: “Timberlands are one of the most recognizable shoes of all time ... Launched 40 years ago as a durable, waterproof shoe for workmen, the wheat-colored boots were repurposed in the 1990’s by members of the hip-hop community.” The article also features photos of celebrities wearing the boots, an example of which is shown above, and blurbs from celebrities and designers discussing their opinion of the boot, some referencing the yellow color. For example, Rebecca Taylor, designer, comments: “I know the guys at my gym wear them on Flatbush Avenue in Brooklyn. ... It’s the yellow with the Timberlands”

- News: Timberland Celebrates The 40th Anniversary Of Their Original Yellow Boot @Timberland³¹

³⁰ *Id.* at TSDR 46-48. <http://shine.yahoo.com/fall-fashion>.

³¹ *Id.* at TSDR 50.

- A blurb in Highsnob discussing Timberland Boot Collaborations and noting the “Original Yellow Boot”³²

HIGHSNOB

A History of Timberland 6" Boot Collaborations

By Brock Cardiner
September 19, 2013



On the heels of Timberland's collaboration with Stussy, we've taken a look back on the footwear brand's most memorable collaborations over the years. Best known for their classic "Original Yellow Boot" first introduced 40 years ago, Timberland has since gone on to become inseparable from certain global cultures like hip-hop. In the process, brands from all walks of life have teamed up with Timberland to re-imagine their iconic 6" boot. Collaborators range from mastermind JAPAN and Mark McNairy to colette and Undefeated, with everything in between. So without further ado, here are some of the brand's best collaborations. All of them and much more can be found in Timberland's brand new *ICON* coffee table book due out soon.

³² *Id.* at TSDR 52.

- 5 of Fashion's Most Iconic Pieces/Hypebeast³³



Timberland Original Yellow Boot

Though one of the youngest brands on our list, Timberland's instantly recognizable rugged yellow boots have come a long way in its 40 years, and continue to find new audiences as the brand expanded into different looks and silhouettes. But like all successful brands, Timberland draws from a rich heritage – in this case, the original boot that made it big.

The Icon

The classic wheat-colored boot features a padded leather collar, a full leather lining, and honey lug soles that are permanently bonded to the upper with the injection molding waterproof process. But what really made this boot an icon was the decision to burn its Timberland tree logo into the side of the leather upper, widely discouraged back in 1973 out of fear that damaging the leather in this way would make the boot unsellable. Instead, by the 1980s, guys in New York started wearing the boot and its popularity grew from city to city, coast to coast, creating a cultural movement from the "Al Panino" kids in Milan to the B-style movement in Japan and American hip-hop fashion, which included the yellow boot.

As discussed in Section 1 above, Applicant also made of record excerpts and images of celebrities wearing Applicant's Timberland boot, for example:³⁴

MEDIATAKEOUT.COM
The Most Visited Urban Website In The World

You Know That Rihanna Is BAD...When She Can Be COVERED IN PAINT... And Still Look Better Than 99 PERCENT OF THE CHICKS IN THE GAME!!!

February 22, 2012



³³ *Id.* at 54-55. <http://hypebeast.com/2013/10/five-iconic-pieces-of-fashion> (emphasis added).

³⁴ See footnote 14. Specific examples found at Applicant's March 30, 2016 Response; TSDR 78 and 144, respectively.

IMODELINIA

Proof that Timberland Boots are This Season's New Model Must-Haves
By Modelinia Staff
January 6, 2015

Proof that Timberland Boots are This Season's New Model Must-Haves



In inclement weather, there's nothing better than a boot that's both comfortable and stylish, and this winter, it seems the fashion and entertainment world are turning their attention to a rugged throwback.

Timberland boots— a.k.a "Timbs"—the once popular utility shoe of the '90s, are experiencing something of a renaissance this season thanks to a fresh crop of stylish cool girls who aren't afraid to put their own spin on the rugged style. Among the boot's top supporters is **Cara Delevingne** who, like **her pal Rihanna**, appears to favor the brand's signature style in black. The street style star was recently spotted rocking her go-to pair with a Burberry Brit jacket, camo-print **Hudson jeans** and her own **Cara Delevingne x Mulberry backpack**. She even kept her laces partially undone for that perfect model off-duty vibe.

Not to be outdone, **Jourdan Dunn** recently took her classic Timbs to Glasgow Airport, where she channeled a sportier look in black leather leggings and a cropped sweatshirt from Alexander Wang's best-selling **H&M collection**. Even **Suki Waterhouse**— the model known for her signature Sixties-inspired pieces and rock n' roll edge — has been seen walking the streets in the work boot, pairing the rugged style with luxe sweats and a trendy Smythe robe coat for a look that was surprisingly polished.

With arctic temperatures and heavy snowfalls plummeting the east coast this week, we couldn't think of a better time to experiment with our old Timbs. When paired with chic but casual staples like oversized coats, knit beanies, and destructed denim (as seen on the models above), these inherently rugged boots are suddenly ready to take on the elements in style!

Are you ready to break out your Timberlands again?

While the record is replete with evidence of unsolicited media coverage of Applicant's Timberland boot, such coverage is insufficient to establish acquired distinctiveness, because there is simply no evidence that the media coverage and celebrity usage have focused on the product trade dress Applicant seeks to register.

See Stuart Spector Designs v, Fender, 94 USPQ2d at 1575 (finding that examples of exposure of guitar bodies through third parties' permitted or licensed use in various media, including television, live performances, movies, charitable events, and merchandising, did not direct potential consumers to identify the guitar bodies as an indication of commercial source, and were not probative of acquired distinctiveness). Instead, much of the record media coverage highlights the classic "wheat" or "yellow" colored boot, and the presence of the Timberland tree logo burned into the side of the leather upper of Applicant's boots, of which the Hypebeast article opines "made the boot an icon."

E. Conclusion

In conclusion, and considering all of the evidence relevant to the six *Converse* factors in determining whether Applicant's proposed mark has acquired distinctiveness, we find, for the reasons discussed above, that Applicant has not established that its proposed product design has acquired distinctiveness as a source identifier in connection with its lace-up boots. In view of our ruling on the issue of acquired distinctiveness, we do not reach the functionality refusal under Section 2(e)(5) of the Act or the requirements for an amended drawing and corresponding description to reflect only assertedly capable features. *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) ("Having found that Applicant's mark is merely descriptive of a feature or characteristic of the goods, we need not reach the alternative ground for refusal that Applicant's mark is deceptively misdescriptive.").

Decision: The refusal to register Applicant's mark under Trademark Act Sections 1, 2, and 45 on the ground that Applicant's proposed mark is a non-distinctive product design that has not acquired distinctiveness under Section 2(f) of the Act is affirmed.