

This Opinion is not a
Precedent of the TTAB

Mailed: June 22, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Lululemon Athletica Canada Inc.
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Serial No. 86718537
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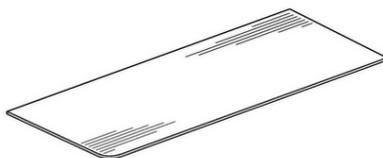
David M. Kramer of DLA Piper LLP (US),
for Lululemon Athletica Canada Inc.

Samantha Sherman, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Quinn, Kuhlke and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Lululemon Athletica Canada Inc. (“Applicant”) seeks registration on the Principal Register of the design shown below for “yoga mats,” in Class 28.¹



¹ Application Serial No. 86718537 was filed on August 7, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as February 1, 2010.

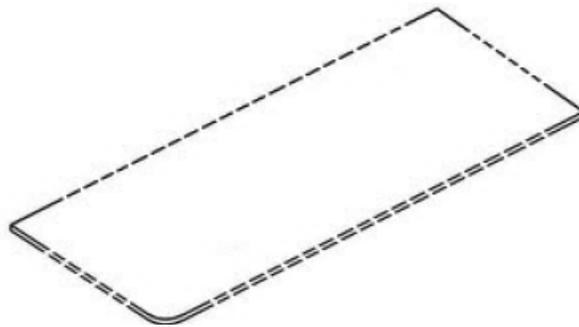
The description of the mark in the application reads as follows:

The mark consists of a rectangular yoga mat product configuration comprising three corners forming right angles and the fourth being curved.

Color is not claimed as a feature of the mark.

The Trademark Examining Attorney refused registration of Applicant's mark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that Applicant's mark is a non-distinctive product design and that Applicant has not provided sufficient proof of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

In addition, the Trademark Examining Attorney issued a final requirement that Applicant provide an acceptable drawing and description of the mark. Trademark Rule 2.52(b)(2), 37 C.F.R. § 2.52(b)(2). However, during the prosecution of the appeal, Applicant agreed to amend the drawing of its mark and the description of the mark, thus, resolving the refusal based on those requirements.² The amended drawing is displayed below:



The amended description of the mark reads as follows:

² Applicant's Reply Brief (7 TTABVUE).

The mark consists of a three-dimensional configuration of a rectangular-shaped yoga mat having one corner being curved and the remaining three corners being right angles. The straight sides of the yoga mat and the other parts shown in the broken lines serve to show positioning of the mark and form no part of the mark.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

Configurations of products, such as we have at issue in this appeal, are not inherently distinctive and may only be registered as marks upon a showing of acquired distinctiveness. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 US 205, 54 USPQ2d 1065 (2000). The applicant bears the burden of proving acquired distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); *In re Fantasia Dist., Inc.*, 120 USPQ2d 1137, 1143 (TTAB 2016).

“Distinctiveness is acquired by ‘substantially exclusive and continuous use’ of the mark in commerce.” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 n. 11 (Fed. Cir. 1985) (citing *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 UPQ 939, 942 (Fed. Cir. 1984)). An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness. *See In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000).

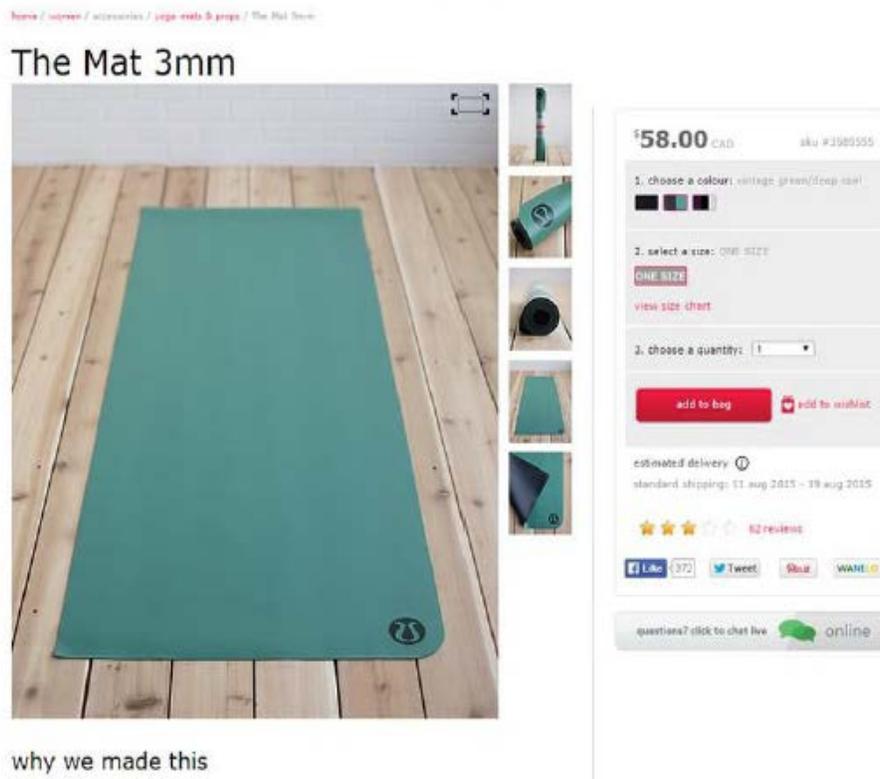
Acquired distinctiveness may be shown by direct or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer

association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, however, the burden is heavier for product configurations. *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009); *In re Ennco*, 56 USPQ2d at 1283 (product configurations face a heavy burden to establish secondary meaning); *see also Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue). Thus, even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness especially where the subject matter sought to be registered is a product design.

In its application, Applicant declared that its “mark has become distinctive of the goods/services through the applicants [sic] substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.” Applicant included a photograph of the yoga mat and a screen shot of its website. The photograph of the yoga mat is displayed below:



The screen shot of Applicant's website is displayed below:



In its April 29, 2016 Response to an Office Action, Applicant submitted the Declaration of Kieran P. Moore, Applicant's in-house Intellectual Property Counsel,

to support Applicant's claim that the configuration of the yoga mat acquired distinctiveness.³ Mr. Moore attested to the following facts:

- Applicant has used the yoga mat design in interstate commerce for over five years;⁴

- Applicant has promoted its yoga mat through its Internet website (lululemon.com) and "other Internet platforms and social media web sites";⁵

- A video embedded in Applicant's website promoting the yoga mat has been viewed over 14,000 times since January 2013;⁶

- Applicant's yoga mat has received "widespread media attention," including coverage in *Shape* and *Jezebel* magazine websites;⁷

- "Applicant has expended significant resources in connection with promoting the Yoga Mat Design Mark";⁸ and

- Applicant has sold over 1.34 million units bearing the Yoga Mat Design Mark".⁹

Applicant included excerpts from its website and from other websites reviewing yoga mats as exhibits to the Moore declaration. Applicant's yoga mat is very highly rated. The Internet excerpts and reviews include photographs of Applicant's yoga mat. Other than the photographs of Applicant's yoga mat, there is no reference to the

³ TSDR p. 15. References to TSDR pages are citations to the .pdf format.

⁴ Moore Decl. ¶4 (TSDR p. 16).

⁵ Moore Decl. ¶5 (TSDR p. 16).

⁶ Moore Decl. ¶5 (TSDR p. 16).

⁷ Moore Decl. ¶6 (TSDR p. 16).

⁸ Moore Decl. ¶7 (TSDR p. 16).

⁹ Moore Decl. ¶8 (TSDR p. 16).

design of the yoga mat in the record. Applicant did not include any “look for” advertising directing consumers to the shape of its yoga mat.¹⁰ None of Applicant’s customers or potential customers refer to the shape of the yoga mat in the comments included in Applicant’s website.¹¹ None of the authors reviewing yoga mats refer to the shape of Applicant’s yoga mat.

Below are representative photographs of Applicant’s yoga mat and representative photographs of third-party yoga mats.

- Applicant’s yoga mats¹²



¹⁰ “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. *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d at 1572.

¹¹ See also the excerpts from Applicant’s website attached to the October 29, 2015 Office Action (TSDR pp. 7-13).

¹² The photographs were extracted from exhibits to the Moore declaration.



• Third-party yoga mats

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¹³ HemingWeigh (October 29, 2015 Office Action, TSDR p. 14).

¹⁴ Sivan Health and Fitness (October 29, 2015 Office Action, TSDR p. 21).

¹⁵ Athletic Intuition (October 29, 2015 Office Action, TSDR p. 42).

¹⁶ Manduka (Moore Decl., Annex 2, April 29, 2016 Response, TSDR p. 50).



After reviewing the record, we find that the design of Applicant's yoga mat has not acquired distinctiveness. Applicant claims that its mark is a yoga mat with three right angle corners and one curved corner. One curved corner is not a distinguishable feature of the yoga mat. *See* the photographs of the yoga mats. Without any advertising directing consumers that Applicant's yoga mat has one curved corner, consumers are unlikely to notice that feature of Applicant's yoga mat, let alone perceive it as being exclusively associated with a single source. Although Applicant features photographs of the curved corner of its yoga mat on its website, none of the reviewers and none of Applicant's customers or potential customers refer to the curved corner when writing about Applicant's yoga mat. Neither Applicant's advertising, nor third-party media coverage, refer to the design of Applicant's yoga mat featuring three right angles and one curved corner and, thus, do not demonstrate that the design has acquired distinctiveness.

With respect to Applicant's advertising, Applicant did not submit any evidence regarding advertising expenditures. Applicant's reference to the extent of its advertising was vague ("Applicant has expended significant resources in connection with promoting the Yoga Mat Design Mark."). While Applicant's witness stated that the video embedded in its website had been viewed over 14,000 times since January

2013, Applicant did not indicate how many individuals viewed the video, let alone how many individuals accessed Applicant's website.

While Applicant's sale of over 1.34 million yoga mats is impressive, commercial success is not necessarily probative of purchaser recognition of the product design as an indication of source. *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d at 1572; *see also 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 fact, the record indicates that Applicant's sales are a result of its being a highly-rated product. *See In re Bongrain Int'l (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1368 (TTAB 2013) (applicant's sales success attributable to applicant offering a quality product at a competitive price); *In re Ennco*, 56 USPQ2d at 1285 (applicant's sales, while impressive, may only demonstrate the growing popularity of the product, not consumer recognition of the trademark).

This record does not support a finding that consumers perceive the design of Applicant's yoga mat as an indicator of source. There is simply nothing in the record that promotes the design of Applicant's yoga mat in a way that would imbue it with source-identifying significance. For example, Applicant's website and the product

reviews show the product like any other advertising or photographs for purposes of product comparison.

Based on a consideration of the all the evidence in the record, we find that Applicant failed to establish that the configuration of its yoga mat featuring three right angle corners and one curved corner has acquired distinctiveness within the meaning of Section 2(f) of the Trademark Act.

Decision: The refusal to register Applicant's mark is affirmed.