

This Opinion is Not a
Precedent of the TTAB

Mailed: February 27, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Diesel Power Gear, LLC

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Serial No. 87261073

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Joseph Shapiro of Strong & Hanni,
for Diesel Power Gear, LLC.

Lourdes Ayala, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Bergsman, Lynch and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Diesel Power Gear, LLC (“Applicant”) seeks registration on the Principal Register
of the bearded skull design, shown below, for the goods listed below:

Vehicle accessories, namely, fitted seat covers, bumpers,
steering wheel covers, auto aftermarket accessories,
namely, vehicle grilles, in International Class 12;

Clothing and apparel, namely, shirts, pants, shorts,
jackets, hoodies, and hats, in International Class 25; and

Floor mats for vehicles, in International Class 27.¹



Applicant describes the mark as follows:

The mark consists of skull with geometric facial features including eyes, polygonal eyes, arrow nose, and track mouth/jaw, as well as a long beard.

Color is not claimed as a feature of the mark.

The Examining Attorney refused to register Applicant's applied-for mark solely as to the goods identified in International Class 25 under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the bearded skull design fails to function as a trademark because it is merely a decorative feature of Applicant's clothing.

Applicant filed screenshots of t-shirts displaying the bearded skull design as its specimen of use. The excerpts from screenshots showing the mark on t-shirts are reproduced below:

¹ Application Serial No. 87261073 was filed on December 7, 2016. The filing basis for the goods in International Class 25 is Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as June 1, 2015.

The filing basis for the goods in International Classes 12 and 27 is Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's claim of a bona fide intent to use the mark in commerce.



The Examining Attorney contends that the bearded skull design as used by Applicant is an ornamental feature of Applicant's clothing "because the proposed mark is prominently displayed on the front or as a part of a design across the front of t-shirts" and, therefore, it "is not likely to be perceived as a source indicator by consumers."²

Applicant contends that the bearded skull design functions as a trademark because it is "distinctive and unique, and is not a well-known design" and "because consumers are familiar with the practices of the trade, in which a large version of a mark is frequently placed on a t-shirt as a source identifier."³

The critical question in determining whether the bearded skull design functions as a trademark is the commercial impression it makes on the relevant public, *i.e.*, whether the term sought to be registered would be perceived as a mark identifying the source of the goods. *See In re Keep a Breast. Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017); *In re Hulting*, 107 USPQ2d 1175, 1177-79 (TTAB 2013); *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d 1684, 1686 (TTAB 2013) ("In considering whether matter is ornamental ... relevant considerations include the commercial impression made by the design."); *see also In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) ("[T]he manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered

² Examining Attorney's Brief (6 TTABVUE 7).

³ Applicant's Brief, p. 2 (4 TTTABVUE 4).

in determining whether the asserted mark has been used as a trademark with respect to the goods named in the application.”).

Examining Attorneys consider the following factors in analyzing whether ornamental features function as a trademark:

1. The commercial impression of the proposed mark;
2. The relevant practices of the trade;
3. Secondary source, if applicable; and
4. Evidence of distinctiveness.

TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1202.03 (October 2018).

With respect to the commercial impression engendered by the subject matter sought to be registered, “[w]hen evaluating a mark that appears to be ornamental, rather than functioning as an indicator of source, ‘the size, location, dominance and significance of the alleged mark as applied to the goods’ are all relevant factors in determining whether it is inherently distinctive.” *Hulting*, 107 USPQ2d at 1178 (quoting *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993)); see also *In re Dimitri’s Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1998); *In re Astro-Gods Inc.*, 223 USPQ 621, 623 (TTAB 1984). In this application, the mark appears on the specimens as part of the decoration covering most of the front of the t-shirts. In one display, the bearded skull design is part of a modified American flag design taking the place of the stars. In the other display, the bearded skull design is surrounded by the words “AMERICAN PROUD” and “Diesel Power.” Nothing about the bearded skull design stands out from the other wording and elements on the specimens so as to be viewed

as a source-identifier. Based on these specimens of use, the commercial impression engendered by the bearded skull design is not likely to be perceived as anything other than part of thematic whole of the ornamentation on Applicant's t-shirts. There is no probative evidence of record that purchasers perceive the bearded skull design as a trademark.

Without any supporting evidence, Applicant contends that it "is well known, companies frequently place large versions of their mark on the front of a t-shirt, either as the only mark, or as a predominating feature in conjunction with other design features."⁴ The Examining Attorney agrees asserting that "where consumers have been conditioned to recognize trademarks in a certain location, as on the breast area of a shirt, ornamental matter placed in a different location is less likely to be perceived as an indicator of source" (citing TMEP §§ 1202.03 (a) and (b)).⁵

There is no per se rule regarding the registrability based on the size or location of a mark on clothing. Rather, the determination of whether the subject sought to be registered is merely ornamentation or serves a trademark function is based on the commercial impression engendered by the mark taking into consideration the size, location, dominance and significance of the alleged mark as applied to the goods. *In re Lululemon Athletica Canada Inc.*, 105 USPQ2d 1684, 1689 (TTAB 2013). As noted above, since the bearded skull design is emblazoned across the center of the t-shirt

⁴ Applicant's Brief, p. 4 (4 TTABVUE 4). Applicant's Exhibit A attached to its appeal brief was not timely filed and, therefore, will be given no consideration. Trademark Rule 2.142(d) ("The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.")

⁵ Examining Attorney's Brief (6 TTABVUE 7).

as an integral part a larger design that will be perceived as part of the thematic whole of the ornamentation on Applicant's t-shirts, it is not displayed in the manner in which consumers have been conditioned to recognize trademarks.

Thus, we turn to whether the bearded skull design serves as a secondary source trademark. To prove that a design has a secondary source function, Applicant must submit evidence that the design is recognized as a mark through its use with other goods or services. *See In re Paramount Pictures Corp.*, 213 USPQ 1111, 1112 (TTAB 1982) (MORK & MINDY was registrable for decals because the applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services); *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized "O" design registrable for T-shirts, where applicant had previously registered the "O" design for skis); *see also In re Watkins Glen Int'l, Inc.*, 227 USPQ 727, 729 (TTAB 1985) (reversing the refusal and finding stylized checkered flag design registrable for patches and clothing items, where applicant had previously registered WATKINS GLEN and checkered flag design (with "WATKINS GLEN" disclaimed) for services); *In re Expo '74*, 189 USPQ 48, 50 (TTAB 1975) (reversing the refusal and holding EXPO '74 registrable for handkerchiefs and T-shirts, since applicant, organizer of the 1974 World's Fair, had previously registered EXPO '74 for other goods and services). There is no evidence that the bearded skull design has been used or registered in connection with other goods or services. Accordingly, the bearded skull design does not serve as a secondary source. *See In re The Original Red Plate Co.*, 223 USPQ 836,

839 (TTAB 1984) (affirming ornamental refusal where the applicant did not meet its evidentiary burden to show secondary source).

Finally, while the bearded skull design is inherently distinctive, because the commercial impression engendered by the bearded skull design is not likely to be perceived as anything other than part of thematic whole of the ornamentation on Applicant's t-shirts, Applicant has failed to make trademark use of the design.

Decision: The refusal to register Applicant's bearded skull design designation used in connection with the identified International Class 25 goods is affirmed. The application will nonetheless proceed to issuance of a notice of allowance solely with regard to the goods identified in International Classes 12 and 27.