

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: January 10, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re IGT*  
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Serial Nos. 87448071, 87448088, 87448100, 87448105, 87448113, 87448123,  
87448129, 87448137, 87448145  
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Michael G. Kelber, Adam H. Masia, and Andrea S. Fuelleman of Neal, Gerber & Eisenberg, LLP, for IGT.

Frank Lattuca, Trademark Examining Attorney, Law Office 109,  
Michael Kazazian, Managing Attorney.

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Before Thurmon, Deputy Chief Administrative Trademark Judge, Greenbaum and Goodman, Administrative Trademark Judges.

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

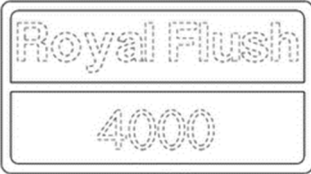
These appeals involve designs that are basic geometric shapes used by Applicant on the displays of video poker gaming machines. The Examining Attorney refused registration, finding the shapes fail to function as trademarks and that Applicant failed to prove the shapes have acquired distinctiveness. We consolidate these appeals<sup>1</sup> and affirm.

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<sup>1</sup> We consolidate the appeals and decide them in a single opinion because they involve common issues of law and fact with similar records. *See In re Anderson*, 101 USPQ2d 1912,

## I. The “Marks” and the Prosecution History

These appeals involve certain geometric shapes that appear on the displays of certain video poker machines sold by Applicant. There are nine applications covered by this consolidated decision, and all involve the same goods, namely, “Gaming machines, namely, devices which accept a wager,” in International Class 28. There are, in reality, four alleged marks at issue in these appeals, but three of the four are presented in a black and white version and a color version. One of the alleged marks is presented in black and white, in color, and in black and white with shading to indicate contrasting colors. All of the applications were filed on May 12, 2017 based on use in commerce.<sup>2</sup> The alleged marks and their corresponding descriptions follow.



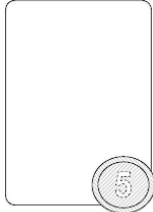
Serial No.	Drawing of the mark	Description of the mark
87448071		The mark consists of a stylized rectangle with a horizontal line through the middle, forming two, thinner inner rectangles stacked vertically. The dotted outline of the Royal Flush and 4000 text inside the inner rectangles is not claimed as a feature of the mark.

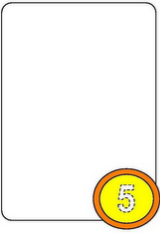


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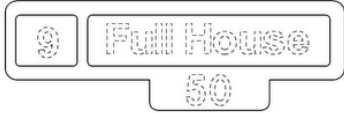

1915 (TTAB 2012) (Board sua sponte consolidated two appeals). All record references are to Serial No. 87448071, unless otherwise noted.

<sup>2</sup> The following applications claimed first use in commerce at least as early May 22, 1999: 87448071, 87448088, 87448100, 87448105, 87448113, 87448123 and 87448129. The following applications claimed first use in commerce at least as early May 17, 2001: 87448137 and 87448145.

Citations to the prosecution record identify the record and date, and where appropriate, specific pages within the record. These records may be found in the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system.

Serial No.	Drawing of the mark	Description of the mark
87448088		<p>The mark consists of a stylized rectangle with a horizontal line through the middle, forming two, thinner inner rectangles. The outer rectangle outline and horizontal line is red, the upper inner rectangle is blue, and the lower inner rectangle is yellow. The dotted outline of the Royal Flush text and the 4000 text inside the inner rectangles is not claimed as a feature of the mark. The color white appearing in the mark is background only, and not claimed as a feature of the mark. The color(s) yellow, orange, and blue is/are claimed as a feature of the mark.</p>
87448100		<p>The mark consists of an outline of a playing card with two concentric circles located on the lower right hand corner of the playing card. The dotted outline of the number 5 inside the circle is not claimed as a feature of the mark. The color white appearing in the mark is background only, and is not claimed as a feature of the mark.</p>
87448105		<p>The mark consists of an outline of a playing card with two concentric circles with two contrasting colors located on the lower right hand corner of the playing card. The contrasting shading in the inner circle and the outer circle represent contrasting colors. The dotted outline of the number 5 inside the circle is not claimed as a feature of the mark. The color white appearing in the mark is background only, and is not claimed as a feature of the mark.</p>

Serial No.	Drawing of the mark	Description of the mark
87448113		<p>The mark consists of an outline of a playing card with two concentric circles located on the lower right hand corner of the playing card. The inner circle is yellow and the outer circle is orange. The dotted outline of the number “5” inside the circle is not claimed as a feature of the mark. The color white appearing in the mark is background only, and is not claimed as a feature of the mark. The color(s) yellow and orange is/are claimed as a feature of the mark.</p>
87448123		<p>The mark consists of a wide stylized rectangle with a vertical line, forming two inner rectangles placed side by side, horizontally. The inner rectangle on the right side contains an inner rim. The dotted outline of the Full House and 50 text inside the inner rectangles is not claimed as a feature of the mark.</p>
87448129		<p>The mark consists of a wide stylized rectangle with a vertical line through the middle, forming two inner rectangles placed side by side, horizontally. The outer rectangle outline and vertical line is blue, the left inner rectangle is red, the right inner rectangle is yellow and the rim in the right inner rectangle is orange. The dotted outline of the Full House text and the 50 text inside the inner rectangles is not claimed as a feature of the mark. The color white appearing in the mark is background only, and not claimed as a feature of the mark. The color(s) blue, red, yellow, and orange is/are claimed as a feature of the mark.</p>

Serial No.	Drawing of the mark	Description of the mark
87448137		<p>The mark consists of an irregular octagon design with two inner geometric shapes, namely a square and a rectangle, placed side by side, horizontally. The dotted outline of the 9 and Full House and 50 text inside the shapes is not claimed as a feature of the mark.</p>
87448145		<p>The mark consists of an irregular octagon design with two inner geometric shapes, namely a square and a rectangle, placed side by side, horizontally. The interior square and a rectangle are both black and outlined in white, and the background of the octagon is blue. The dotted outline of the 9 text, the Full House text and the 50 text inside the inner two geometric shapes is not claimed as a feature of the mark. The color white appearing in the 9 text, the Full House text and the 50 text is background only, and not claimed as a feature of the mark. The color(s) blue, black and white is/are claimed as a feature of the mark.</p>

For ease of reference, in the remainder of this decision we will refer to the four different shapes at issue here in the following manner:

- the first two marks shown above will be identified as the “stacked rectangle” marks;<sup>3</sup>

<sup>3</sup> Application Serial Nos. 87448071 and 87448088.

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- the third, fourth and fifth marks shown above will be identified as the “card shape” marks;<sup>4</sup>
- the sixth and seventh marks shown above will be identified as the “side-by-side rectangle” marks;<sup>5</sup> and,
- the eighth and ninth marks shown above will be identified as the “eight-sided shape” marks.<sup>6</sup>

The following specimen was submitted for seven of the applications (i.e., all but the eight-sided mark),<sup>7</sup> and shows the general display upon which each of those seven alleged marks appear.



We refer to this as the “Frenzy Poker” machine in the remainder of this decision.

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<sup>4</sup> Application Serial Nos. 87448100, 87448105 and 87448113.

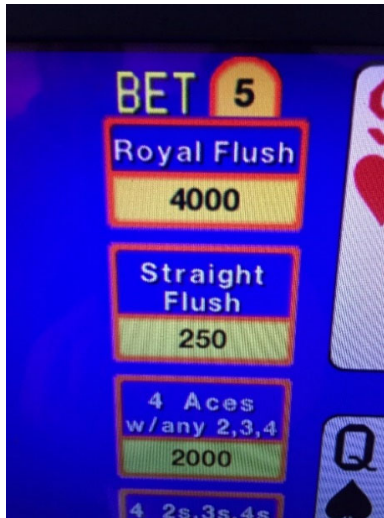
<sup>5</sup> Application Serial Nos. 87448123 and 87448129.

<sup>6</sup> Application Serial Nos. 87448137 and 87448145.

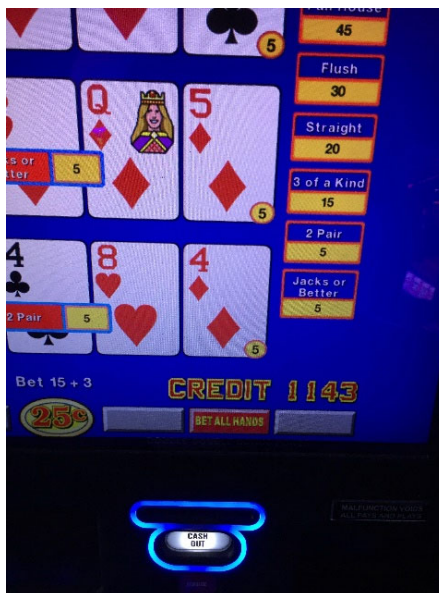
<sup>7</sup> The following applications included this specimen: 87448071, 87448088, 87448100, 87448105, 87448113, 87448123 and 87448129.

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The stacked rectangle marks were also supported by the following specimen, which is a close-up of a portion of the display screen of the Frenzy Poker machine.

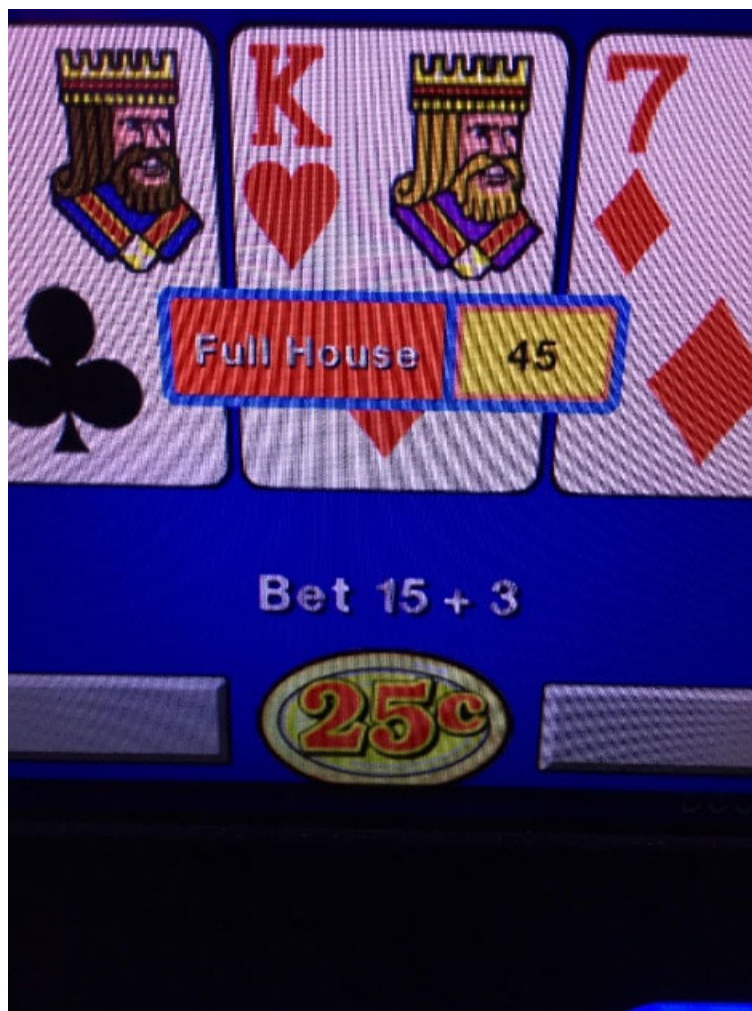


The card shape applications were supported by the following additional specimen, which is also a close-up of a portion of the display for the Frenzy Poker machine. The stacked rectangle marks are also visible on this specimen, though on the other side of the display.



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The side-by-side rectangles applications were supported by the following additional specimen, which is another close-up of a portion of the display for the Frenzy Poker machine.





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The eight-sided shape applications are based on a different video poker machine, one that apparently allows users to play up to fifty hands of poker at once. The two following specimens were submitted in support of those two applications.





The Examining Attorney found these shapes, in black and white and color form, failed to function as marks.<sup>8</sup> Each application involved “a common background shape,” the Examining Attorney asserted. “There is nothing to suggest a consumer would view it as identifying a brand.” Applicant responded by arguing that “[c]ommon geometric shapes are classified as inherently distinctive, and thus do not require

<sup>8</sup> Office Action dated August 15, 2017 (“Registration is refused because the applied-for mark, as used on the specimen of record, does not function as a trademark to indicate the source of applicant’s goods and to identify and distinguish them from others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127 ...”).

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secondary meaning, when they are sufficiently stylized or designed in some way, as is the case here.”<sup>9</sup> Applicant identified numerous registrations of marks that include shapes.<sup>10</sup>

The Examining Attorney issued a final refusal to register based on the finding that these shapes failed to function as marks,<sup>11</sup> and Applicant responded by presenting a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.<sup>12</sup> The Examining Attorney maintained the final refusal, but reconsidered the applications based on the claim of acquired distinctiveness, a claim he found was not supported by the evidence Applicant submitted.<sup>13</sup> Applicant responded, again arguing that the shapes had acquired distinctiveness.<sup>14</sup> The Examining Attorney continued the final failure to function refusal, and found Applicant’s Section 2(f) evidence

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<sup>9</sup> Response to Office Action dated January 26, 2018 (Serial Nos. 87448071 and 87448088). The same Response to Office Action, except for references to different marks/shapes, was submitted on January 29, 2017 for the other seven applications.

<sup>10</sup> *Id.*

<sup>11</sup> Office Action dated February 12, 2018 (Serial Nos. 87448071, 87448088, 87448100, 87448105 and 87448113). Essentially the same Office Action was mailed on February 14, 2017 (Serial Nos. 87448123 and 87448129) and February 16, 2017 (Serial Nos. 87448137 and 87448145).

<sup>12</sup> Request for Reconsideration dated August 10, 2018. Applicant also file Notices of Appeal on the same date in all applications. The Board remanded, 2 TTABVue, and the Examining Attorney considered Applicant’s claim of acquired distinctiveness as noted above.

<sup>13</sup> Office Action dated September 14, 2018.

<sup>14</sup> Response to Office Action dated March 14, 2018.

insufficient to overcome the refusal.<sup>15</sup> These appeals then resumed<sup>16</sup> and all nine appeals have been fully briefed.

## **II. Evidentiary Issue**

Applicant filed essentially identical Appeal Briefs and Reply Briefs in support of each appeal, with only the discussion of the specific shapes at issue differing in the briefs. The Examining Attorney did the same. We note that the Examining Attorney objected to evidence submitted for the first time with Applicant's brief. We sustain the objection, and have not considered this evidence. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (record should be complete prior to appeal).<sup>17</sup>

## **III. Analysis**

### **A. The Shapes Are Not Inherently Distinctive**

Applicant argues that each alleged mark "is a fanciful, highly distinctive and unique combination of shapes, and the positioning, organization and layout of those shapes."<sup>18</sup> Applicant refers to a number of registered marks that consist of or include shapes.<sup>19</sup> Some registrations cited by Applicant include relatively common shapes.<sup>20</sup>

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<sup>15</sup> Office Action dated April 7, 2019.

<sup>16</sup> 4 TTABVUE.

<sup>17</sup> Consideration of this evidence would not have changed the outcome of this appeal because the evidence is cumulative and no more probative than other evidence of record.

<sup>18</sup> 6 TTABVUE at 9-11.

<sup>19</sup> *Id.* at 12-17.

<sup>20</sup> Registration No. 4138256 for the following mark is an example of a somewhat common or basic shape the Office found inherently distinctive.



The validity of those registrations is not at issue here, and the USPTO is required to evaluate Applicant's current "trademark applications for compliance with each and every eligibility requirement ... " *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016). The shapes Applicant seeks to register here are more common and are used in a less distinctive manner than any of the registered marks Applicant identifies. The third-party registrations relied upon by Applicant, to the extent relevant at all, provide no support for Applicant's argument that its shapes and colors are inherently distinctive.

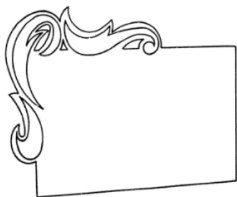
We begin our evaluation of these shapes by noting what they are not. These shapes are not part of or background to distinctive composite trademarks. The shapes, with or without the color claims, serve as frames for information relevant to the video poker game being played. The game information presented within the shapes is not distinctive. No other allegedly distinctive elements are joined with the shapes. Either the shapes standing alone (again, with or without the color claims) are inherently distinctive or they are not. *Cf. In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988) (discussing the inherent distinctiveness of a portion of a background design being registered separately from the other elements of the mark, and noting: "it all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in an of itself.") (citation omitted).

The Board and our reviewing court have evaluated other designs consisting of common shapes to determine whether the designs were inherently distinctive. In *In re Serial Podcast, LLC*, 126 USPQ2d 1061 (TTAB 2018), the Board noted, “Most common geometric shapes, such as circles, squares, triangles, ovals, and rectangles, when used as backgrounds for the display of word marks, are not considered inherently distinctive, and have difficulty acquiring distinctiveness.” *Id.* at 1073 (citing *In re Benetton Grp. S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998)). The



following mark was at issue in the *Serial Podcast* case: The

Board found the generally rectangular tiles surrounding the letters were common and thus not inherently distinctive. And in *In re E. J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308 (CCPA 1958), the following design, a “decorative panel which forms the setting or serves as the background for applicant’s registered mark ‘Brach’s” (*id.* at 309), was found to lack distinctiveness.



At bottom, “the focus of the inquiry is whether or not the [alleged mark] is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive.” *Tone Brothers Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994),

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citing *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 27 USPQ2d 1189, 1192-93 (2d Cir. 1993).

We take guidance from the cases cited above and find the shapes at issue here, in both black and white and color forms, are not inherently distinctive. This finding is based on a careful evaluation of the shapes as they are used on the specimens of record. See *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) (“The issue of inherent distinctiveness is a factual determination made by the board.”). We now provide more explanation of our evaluation of the various shapes presented in these appeals.

The stacked rectangle marks are simply two rectangles stacked with rounded outer corners. Alternatively, these marks can be described as a single rectangle with curved outer corners and a horizontal line dividing the rectangle into halves. The card shape marks are simply the shape of a playing card with a circle superimposed on the lower right corner. These alleged marks are used on video poker machines that present images of playing cards, making the shape of a card perhaps the most basic shape possible for such goods. Superimposing a circle over a corner of the playing card merely adds one exceedingly common shape to another. Zero plus zero is still zero.

The side-by-side rectangle marks are just that, two rectangles side-by-side, with curved outer edges. Alternatively, these marks can be described as a single rectangle with curved outer edges and a vertical line dividing the shape into two unequal sections. The eight-sided marks are perhaps the least common, but these are merely two rectangles with curved outer edges stacked one above the other, where the lower

rectangle is smaller than the upper one. This configuration results in eight sides, but does not make the shape unusual or unique. None of these shapes are inherently distinctive. They are all common, simple shapes.

The *Brach & Sons* and *Serial Podcast* cases are instructive here. The *Brach & Sons* design was much more stylized than the shapes at issue in these appeals, but was found not inherently distinctive. The rectangular tiles in the *Serial Podcast* case are similar to some of the shapes at issue here, and those tiles also were found not inherently distinctive. The only stylized aspect we see in Applicant's shapes are the rounded corners, which the Board noted was a common practice in *Serial Podcast*, 126 USPQ2d at 1074 ("the slight rounding or beveling of the rectangles' corners is a mere refinement that is commonplace in geometric designs").

The Examining Attorney provides samples of other video gaming displays that use similar common geometric shapes as borders for information.<sup>21</sup> None of the shapes in evidence, whether used with third-party products (i.e., the evidence submitted by the Examining Attorney) or on Applicant's products, are presented as trademarks. In every instance, the shapes are merely borders for some other informational content, like a player's score or bet. This evidence is similar to that presented in *Benetton*. There, the green rectangular background design sought to be registered, without wording or any distinctive matter, was found not to be inherently distinctive in part

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<sup>21</sup> Office Action dated August 15, 2017 at 6 (showing stacked rectangles, side-by-side rectangles and circles on a video gaming machine), 8-9 (same), 11-13 (card shapes, rectangles and circles).



because “as shown by the evidence submitted by the Examining Attorney, applicant is not alone in using a green rectangle background design. Others in the clothing industry (such as J, CREW) use green rectangles as background designs for their word and/or design marks.” 48 USPQ2d at 1217.

The specimens show the shapes Applicant seeks to register are used as borders for information relevant to the video poker game. This content appears to relate to some aspect of the game, such as a player score, an amount wagered, or information about the poker hand shown. What that content is does not matter here. But the fact that these shapes serve as borders makes it even less likely that consumers will “immediately rely on” these shapes as marks. *Tone Brothers*, 31 USPQ2d at 1331.

The color versions of these shapes are not inherently distinctive either. The specimens show that Applicant’s video poker machines are awash in bright colors, and the colors used with these shapes do not stand out. In fact, the colors used with these shapes are used for a variety of features on the displays.

The shapes Applicant seeks to register are used numerous times on the video poker machine displays. The Frenzy Poker display, for example, was submitted as a specimen for all but the eight-sided marks, and shows the following.

- The stacked rectangle marks are shown 13 times on the display and nothing draws particular attention to any one of these shapes, to the colors used with these shapes, or to the collective presentation of all 13 shapes.
- The card shaped marks appear three times and once with each hand of poker shown on the display. Nothing draws particular attention to these shapes or colors, except to the extent they relay information presumably relevant to the game.

- The side-by-side rectangle marks appear twice and seem to convey information about particular hands. For example, in the first appearance of the side-by-side rectangle mark, it states “Jacks or Better” and the numeral “5.” The hand shown has two queens, so the mark appears to be telling the player that this hand is better than a pair of jacks. The second appearance of this shape states “2 Pair” and also shows the numeral “5.” This information is superimposed on a hand that contain a pair of fours and a pair of eights. Again, the shape is a border for information apparently relevant to the poker hand being played.

The manner in which these shapes and colors are used is an additional reason that these designs are not inherently distinctive marks. These designs are borders for information about the game being played. They appear numerous times on a single screen and are not presented as distinctive marks. The upper part of the Frenzy Poker specimen, on the other hand, prominently presents a number of elements that might be inherently distinctive. The presentation of other branding on the display reduces still further the likelihood that consumers will immediately recognize as distinctive trademarks the shapes and colors at issue here. *In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017). *See also Benetton*, 48 USPQ2d at 1217 (“It is not unreasonable to assume, therefore, that the individuals’ association of the green rectangle background design with applicant was predicated upon the impression conveyed by the BENETTON marks appearing thereon rather than by any distinctive characteristic of the green rectangle per se.”).

The same analysis applies to the eight-sided marks and the specimens submitted with those applications. These shapes are used with fifty-hand video poker machines and appear to indicate the score for certain hands that appear in the 50 poker hands shown on the display. For example, the second specimen shows three poker hands

highlighted and each hand includes three numeral “8” cards. The first of the eight-sided marks contains the words “3 of a kind,” an apparent reference to the highlighted hands. Three versions of the “eight-sided marks” are shown on this display, and as with the uses of the other shapes discussed above, nothing draws attention to these eight-sided shapes as distinctive marks.

For all these reasons, we find Applicant’s alleged marks are not inherently distinctive. We, therefore, affirm the Examining Attorney’s refusal to register these shapes for failing to function as marks.

### **B. Applicant Failed To Prove Acquired Distinctiveness**

When the initial refusal to register was made final, Applicant elected to submit evidence of acquired distinctiveness. Applicant bears the burden of proof on this issue. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1331, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015). Applicant submitted evidence showing that relevant consumers have been exposed to these shapes on the displays of its video poker machines for about 20 years. The following extract from Applicant’s response to the first Office Action<sup>22</sup> illustrates its position on this issue:

Applicant’s mark is continuously displayed on Applicant’s gaming machines throughout the play cycle and in between players. More specifically, Applicant’s mark is first seen when a potential player passes by or walks up to one of Applicant’s gaming machines while the gaming machine is not being played. The player will continue to see Applicant’s mark prominently on the gaming machine when the player deposits money or a ticket into the gaming

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<sup>22</sup> Though this response was submitted before Applicant explicitly made its claim of acquired distinctiveness, it reflects the position taken by Applicant concerning the consumer impact of the displays on its video poker machines.

machine to initiate a gaming session. Once a player initiates a gaming session, it will continue to see Applicant's mark throughout the gaming session. A player will also see Applicant's mark when the player cashes out, at which point the gaming machine goes back into idle mode between players, which also prominently displays Applicant's mark.<sup>23</sup>

When Applicant elected to expressly claim these shapes have acquired distinctiveness, it claimed a long period (about 20 years) of continuous and substantially exclusive use.<sup>24</sup> Applicant submitted evidence of its sales volume to show that it is a leading manufacturer of video poker machines.<sup>25</sup> Advertising was submitted showing the promotion of Applicant's video poker machines within the gaming industry.<sup>26</sup> Applicant also claimed the shapes at issue here have received unsolicited media attention.<sup>27</sup> Applicant also argued that these shapes should be registered because the Office has registered other marks that include shapes.<sup>28</sup>

We find the shapes at issue here have not acquired distinctiveness. Applicant's arguments are not persuasive and its evidence is insufficient. In the following sections, we explain why the different arguments advanced by Applicant fall short.

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<sup>23</sup> Response to Office Action dated January 26, 2018 (for '071 and '088 applications). The same argument was presented in support of all other applications in a Response to Office Action dated January 29, 2018.

<sup>24</sup> 6 TTABVUE 19-20.

<sup>25</sup> *Id.* at 20-21 and evidence cited therein.

<sup>26</sup> *Id.*

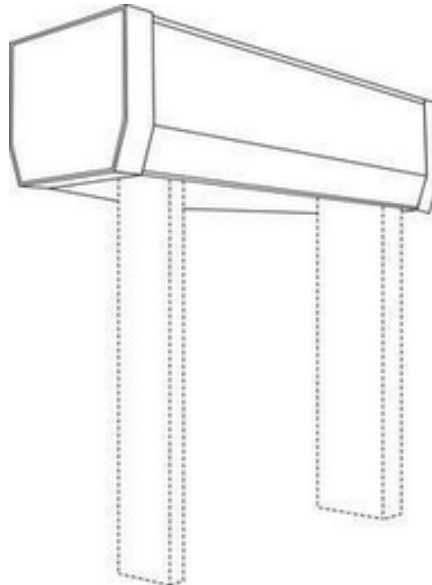
<sup>27</sup> *Id.* at 22.

<sup>28</sup> *Id.* at 12-18.

**1. The Repeated Presentation of Applicant’s Shapes Did Not Result in Acquired Distinctiveness**

Repeated exposure to a symbol or feature that is not inherently distinctive—for example, a descriptive word, a color, or a common geometric shape—may lead to acquired distinctiveness if the symbol or feature is presented to consumers as a trademark. There must be something about the exposure that leads relevant consumers to view the symbol as a trademark. Applicant’s arguments fail because it ignores this critical requirement. Decisions of this Board and our primary reviewing court provide insights into this requirement.

The following pole spanner design used with gasoline pumps at Chevron stations was found nondistinctive in *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026 (TTAB 2010):



This geometric shape is far more complex than any of the shapes Applicant claims as marks in these appeals. And in use, this design featured well-known branding, as shown below:



In an effort to show that the pole spanner design had acquired distinctiveness, Chevron established “the following facts:

1. Applicant has used its pole spanner design since at least as early as 1988;
2. Applicant’s pole spanner design is used in approximately 8,000 service stations throughout the country; and
3. Consumers visited applicant’s service stations approximately 467 to 667 million times in 2007-2008.”

*Id.* at 2030. In the present appeals, Applicant claims about 20 years of exposure to the alleged marks and repeated exposures to many consumers. The arguments Applicant makes are effectively identical to those made by Chevron, though Chevron’s evidence showed far more extensive consumer exposure to its pole spanner design.

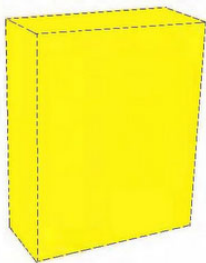
The Board found this evidence insufficient for two reasons. First, the Board noted that for common shapes and designs, very strong evidence of acquired distinctiveness

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is needed. *Id.* (“Because the subject matter sought to be registered is a mere refinement of the commonly used pole spanner design in the automobile service station industry, applicant has a relatively heavy burden for establishing acquired distinctiveness.”) (citing *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985); *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89, 91 (CCPA 1980)).

The Board next found that even 20 years of use and hundreds of millions of exposures to the design were not sufficient to prove acquired distinctiveness. *Chevron*, 96 USPQ2d at 2030-31. “Even assuming that applicant’s service station services are highly successful, such success does not, in and of itself, demonstrate recognition by the purchasing public of applicant’s pole spanner design as a service mark,” the Board explained. *Id.* at 2031 (citing *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000)).

The Board reached a similar conclusion in *In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017), which involved the mark shown below (the yellow box used with regular CHEERIOS cereal).



General Mills submitted evidence to support its claim that the yellow color had acquired distinctiveness, including the fact that this color has been used on Cheerios cereal boxes for over 70 years. *General Mills*, 124 USPQ2d at 1018-19. That evidence also included unsolicited media references to the yellow color as “distinctive,” “instantly recognizable,” and “iconic.” *Id.* at 1019. Survey evidence was submitted showing over 50% of those sampled associated the yellow color with the CHEERIOS product. *Id.* at 1020-21, 1026-27.

After considering all the evidence, the Board found General Mills had failed to prove the yellow color had acquired distinctiveness. *Id.* at 1027. This conclusion was based in part on the fact that while boxes of regular CHEERIOS were yellow, the boxes also featured the CHEERIOS trademark. *Id.* at 1025 (all exposures to General Mills’ yellow trade dress “include repeated, prominent displays of the front of Applicant’s box, with the mark CHEERIOS in bold, black letters in sharp contrast to the yellow background, as well as an audio track on which the term CHEERIOS is repeatedly sung or spoken”). Because the CHEERIOS trademark was prominent on the boxes, there was little reason for consumers to rely on the yellow color of the box as a source identifier.

The same logic was applicable to the Chevron case described above and to the present appeals. Applicant’s video poker machines are branded products, making these appeals analogous, in this sense, to both the *General Mills* and *Chevron* decisions. Consumers seeing the common geometric shapes that Applicant now



claims as trademarks are unlikely to view such features as brands when other prominent branding is present on the machines.

We find that the mere exposure to the shapes at issue in these appeals did not convert these common features into distinctive brands, particularly given use of similar shapes by third parties.<sup>29</sup> See *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (“the burden [of proving acquired distinctiveness] is particularly heavy when that use has not been exclusive”); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use not sufficient to prove acquired distinctiveness given similarity of configuration to other guitars).

## **2. Applicant Did Not Promote the Shapes as Marks in its Advertising**

The lack of “look for” advertising was an important factor in the *Chevron* case noted above. The Board explained,

the absence of advertisements and promotions featuring or promoting recognition of the pole spanner design as a service mark. While the pole spanner design is a feature of applicant’s gasoline pump configuration in 8,000 service stations seen by over 500 million people in a two-year period, there is nothing to indicate that applicant’s customers view the pole spanner design as anything other than a feature of the gasoline pump, or that applicant has done anything to foster the impression that the pole spanner design is an indication of source.

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<sup>29</sup> As mentioned above, the Examining Attorney made of record samples of other video gaming displays that use similar common geometric shapes as borders for information. See n.22, supra. This evidence refutes Applicant’s claim that its use of these shapes has been “substantially exclusive,” which is hardly surprising considering how common these shapes are.

*Chevron*, 96 USPQ2d at 2030.

Common shapes used as borders like those at issue in these appeals are not likely to become distinctive without advertising drawing consumer attention to the shapes as source identifiers. None of Applicant's advertising does this. Rather, the advertising evidence simply shows Applicant's video poker products and touts the features of those products.<sup>30</sup> The only branding promoted in Applicant's advertising is its IGT mark and the specific product marks for the different machines.<sup>31</sup> None of the advertising of record draws any attention to the geometric shapes Applicant now claims are trademarks.<sup>32</sup>

This Board and the courts have repeatedly emphasized the importance of such evidence in similar contexts. *See, e.g., Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723-24 (TTAB 2010) (perhaps most damaging to showing of acquired distinctiveness is lack of any "look for" advertising); *Duraco Prods. Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 32 USPQ2d 1724, 1741 (3d Cir. 1994) (advertising

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<sup>30</sup> Request for Reconsideration dated August 10, 2018 at 29-30, 36-38, 39-42, 62-63.

<sup>31</sup> The Frenzy Poker machine specimen shown above is an example of the machine branding shown in some of the advertising submitted by Applicant. There is, however, only one presentation of this brand in the advertising materials and it shows the branding alone rather than on a video poker machine. *Id.* at 40.

<sup>32</sup> A good example of this point can be seen at *id.* at 56, which appears to be the second page of a two-page advertising document. In the upper screen image shown on this page, some of the alleged marks are displayed. But in this image, these "marks" are presented multiple times with no differentiation from the information they convey. There is absolutely nothing in this screen image to suggest that these shapes are trademarks. Nor is there any suggestion or claim in the text of the advertising document to that effect. The geometric shapes are merely part of the display. All of the advertising evidence of record that shows the geometric shapes at issue here are exactly like this example in this important respect.

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expenditures “measured primarily with regard to those advertisements which highlight the supposedly distinctive, identifying feature” of the product configuration); *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 USPQ2d 1065, 1071-72 (7th Cir. 1995) (“look for” advertising encourages consumers to connect the claimed trade dress with the particular producer); *First Brands Corp. v. Fred Meyer Inc.*, 809 F.2d 1378, 1 USPQ2d 1779, 1782 (9th Cir. 1987) (“advertising campaign has not stressed the color and shape of the antifreeze jug so as to support an inference of secondary meaning”).

Applicant’s advertising evidence, therefore, is not probative because it does nothing to promote the geometric shapes as trademarks. The advertising is directed at gaming industry insiders rather than the consumers who play the games. Applicant’s acquired distinctiveness arguments focus on consumers, which is appropriate because the applications do not include any trade channel limitations. But the advertising evidence does not reach those consumers, and for that additional reason, does nothing to build distinctiveness of these shapes with consumers. *See, e.g., In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ2d 373, 376 (CCPA 1959) (an applicant must “submit proof that its mark is distinctive, not only to ‘experts’ in the field, but to the purchasing public”); *In re UDOR U.S.A., Inc.*, 89 USPQ2d 1978, 1987 (TTAB 2009); *In re Edward Ski Prods., Inc.*, 49 USPQ2d 2001, 2005 (TTAB 1999).

### 3. Media Coverage Does Not Show Acquired Distinctiveness

Applicant argues the following two excerpts from articles about video poker show the shapes have acquired distinctiveness:

Those hard-core video poker enthusiasts know what their games look like. They are the same video poker variations—from Jacks or Better to Bonus Poker to Double Double Bonus to Deuces Wild—that first appeared in the original Fortune 1 Players Edge video poker machines that put IGT on the map. These days, they are generally found in the multi-game Game King machines, but the games are the same. They even look the same, with the same color scheme, card faces and sounds.” Solving Video Poker: How video poker king IGT manages to bring new players to the old game. <https://www.cdccgamingreports.com/solving-video-poker/>

The familiar computer interface and the company’s eventual partnership with Ernie Moody, who invented multi-hand play, combine to make IGT video poker the games of choice for the vast majority of people who play...[IGT’s games] are staples in casinos across the country.” CASINO SCENE: IGT rules supreme over video poker empire. [https://www.nwitimes.com/entertainment/columnists/john-brokopp/casino-scene-igt-rules-supreme-over-video-pokerepire/article\\_c7b8444d-eb21-529d-b3f7-59ee48201d90.html](https://www.nwitimes.com/entertainment/columnists/john-brokopp/casino-scene-igt-rules-supreme-over-video-pokerepire/article_c7b8444d-eb21-529d-b3f7-59ee48201d90.html).<sup>33</sup>

Applicant grossly overstates the import of these excerpts.

Neither of these excerpts makes any mention of the specific shapes and colors Applicant claims as marks in these appeals. There is no mention of the stacked rectangle mark, the card-shaped mark, the side-by-side rectangle mark, or the eight-sided mark. None. The first excerpt does mention that some video poker players

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<sup>33</sup> 7 TTABVUE 22.

“know what their games look like.” The piece goes on to mention that several of IGT’s (i.e., Applicant here) games “look the same, with the same color scheme, card faces and sounds.” The second excerpt says nothing about the appearance of the displays, but does note that IGT’s machines are popular.

This evidence falls far short of proving acquired distinctiveness. At most, it suggests that some consumer may recognize an IGT video poker machine from its overall look and sounds. That is a far cry from showing that a specific feature on the display is a distinctive trademark. The specimens of record clearly show prominent branding on these machines. It is hardly surprising that someone familiar with these machines can easily spot them on a casino floor.

To prove acquired distinctiveness, Applicant must present evidence supporting the inference that relevant consumers view the specific designs as source-identifying marks. Applicant claims that video poker players recognize its machines and therefore almost every visible feature of the machines is a distinctive trademark. This argument defies logic and the record. This argument would be equivalent to Volkswagen claiming that because consumers recognize the shape of its Beetle car, every visible feature of the car, from its wheels to windshield wipers are somehow distinctive marks. In fact, the opposite is more likely true. That is, because consumers can recognize Applicant’s video poker machines, they are probably less likely to look for additional, secondary branding on those machines. Whether this premise is ultimately correct does not matter here, because the evidence does not come close to proving these shapes have become distinctive trademarks.

The *General Mills* decision noted the following evidence of unsolicited media mentions of the yellow box.

- The iconic cereal known by its distinctive yellow box, is 70 years old this year and still a force on the breakfast cereal market. (USA Today, Applicant’s response of May 18, 2016 at 200.)
- Basically, Trix didn’t have the cover of the overall Cheerios brand, which has long marketed itself as “made with 100% whole grain.” Its yellow box is instantly recognizable (and even nostalgic for some). (Stealing Share, *Id.* at 265.)
- The yellow Cheerios box has been an iconic item in American households. People can easily recognize this bright yellow box and its simplicity in the crowded cereal shelves. (Loyola Digital Advertising, *Id.* at 274.)
- That’s an alarming increase when compared to the single gram that sits in each serving of the original Cheerios that come in that iconic yellow box. (*Id.* at 206.)
- The De Blasios welcomed the comparison; a post on Bill’s campaign website entitled “Cheerios” features the family posed around the cereal’s signature yellow box. (*Id.* at 210.)
- Let’s say you like Cheerios. Sure, you’ve internalized a positive emotional association with the yellow box and the logo, but your loyalty is ultimately based on how much you like the cereal. (*Id.* at 212.)
- Cheerios are easy to find on store shelves: Just look for the big yellow box. (*Id.* at 216.)
- There are now 13 types of Cheerios on grocery store shelves, which some fans of the original in the iconic yellow box think are 12 too many. (*Id.* at 226.)

*In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1019-20 (TTAB 2017).

The Board found this evidence relevant, but insufficient, to prove acquired distinctiveness. The media evidence Applicant relies upon proves nothing about the specific shapes at issue in these appeals, and is **much** less compelling than the evidence the Board found insufficient in the *General Mills* case.

#### **4. There Is No Direct Evidence of Acquired Distinctiveness**

At times, Applicant seems to argue that there is direct evidence of acquired distinctiveness. For example, Applicant asserts that the evidence “establishes that relevant consumers do, in fact, associate Applicant’s Mark as a brand identifier for Applicant and its goods.”<sup>34</sup> Direct evidence of acquired distinctiveness includes survey evidence, evidence of actual confusion, or evidence of copying that shows the copied mark is distinctive. *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1506 (TTAB 2017). There is no such evidence in the record.

Applicant’s confusion on this point appears to arise from misplaced reliance on cases finding that two marks used together can each be distinctive. This is a common scenario. Indeed, the Chevron and General Mills situations discussed above are good examples. The color version of the Chevron display shows the CHEVRON word mark and the chevron-shaped design mark. These are distinct marks that are often used together. Boxes of Cheerios cereal feature both the CHEERIOS mark and the GENERAL MILLS mark, which are also distinct trademarks because each creates a separate commercial impression.

This issue does not arise here because there is no evidence the common shapes and colors at issue in these appeals create any distinctive commercial impression. There is nothing to separate, because there is nothing distinctive about these shapes. Applicant is correct that marks used together can, and often do, create separate

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<sup>34</sup> 7 TTABVUE 23.

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commercial impressions. What Applicant misses is that every mark must be distinctive, and the basic, common shapes and colors at issue here are not.

### **C. Conclusion**

As noted at the start of our analysis, these appeals all present the same question: whether each shape, with or without color, is distinctive. Having considered all of the evidence, we find that the shapes, with or without color, are not inherently distinctive and have not acquired distinctiveness. For that reason, the proposed marks fail to function as trademarks for Applicant's goods.

**Decision:** The refusal to register under Sections 1, 2 and 45 of the Trademark Act on the ground that Applicant's proposed marks fail to function as marks and that Applicant has not established acquired distinctiveness under Section 2(f) of the Trademark Act is affirmed in each application.