

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re JBL International, Inc.*

—  
Serial No. 88941388

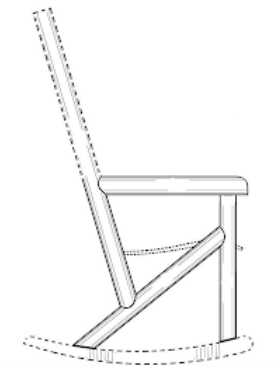
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John S. Egbert, Kevin S. Wilson, and Michael F. Schwartz of Egbert, McDaniel &  
Swartz, PLLC,  
for JBL International, Inc.

Marco Wright, Trademark Examining Attorney, Law Office 120,  
David Miller, Managing Attorney.

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

Opinion by Wellington, Administrative Trademark Judge:

JBL International, Inc. (“Applicant”) seeks registration on the Principal Register  
of the following product design configuration:



claiming that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(f), for “furniture, namely, rocking chairs” in International Class 20.<sup>1</sup>

The mark is described in the application as follows:

The mark consists of a three-dimensional configuration of the side of a rocking chair. Specifically, the mark consists of a three-dimensional configuration of the chair arm, the front leg, the bottom portion of the chair back, and a beam that supports the chair back by attaching to the upper portion of the front leg and the back portion of the curved base of the chair. The broken lines depicting the top portion of the chair back, the seat, and the curved base of the chair are for illustrative purposes only and not claimed as a part of the mark. The lining shown on the drawing is for shading purposes only and does not indicate color.

The Trademark Examining Attorney refused registration on two bases: (1) under Section 2(e)(5) of the Act, 15 U.S.C. § 1052(e)(5), on the ground that Applicant’s mark, which consists of a three-dimensional configuration of the goods, is a functional design for such goods, and, alternatively, (2) under Sections 1, 2, and 45 of the Act, 15 U.S.C. §§ 1051-1052, 1127, on the ground that Applicant’s mark consists of a non-distinctive product design or a non-distinctive feature of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness under Trademark Act Section 2(f).

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<sup>1</sup> Application Serial No. 88941388, filed on May 31, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use of the mark anywhere and in commerce in “2010,” which the Office construes as December 31, 2010. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §903.05 (July 2022) (providing that, for purposes of dates of first use in commerce, “[w]hen only a year is given, the date presumed for purposes of examination is the last day of the year.”).

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. The appeal has been fully briefed.

## **I. The Record**

During the prosecution of the application, Applicant submitted the following materials:

- Copies of seven design patents it owns for chairs or an armrest;<sup>2</sup>
- Advertisements for and photographs of Applicant's goods;<sup>3</sup>
- Printouts from third-party retail websites Walmart and Home Depot;<sup>4</sup>
- Photographs of Applicant's goods in Home Depot, Walmart, and HEB Grocery Stores;<sup>5</sup>
- A declaration, signed under oath, by Applicant's Vice President, Justin Lee, with attachments, including photographs of Applicant's goods and a copy of Applicant's Reg. No. 6141460 for a mark described as an "abstract drawing of a rocking chair," for metal and wood furniture.<sup>6</sup>

The Examining Attorney submitted Internet printouts from third-party retail websites showing various styles of rocking chairs.<sup>7</sup>

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<sup>2</sup> Attached to Applicant's response filed March 8, 2021.

<sup>3</sup> Attached to Applicant's response filed March 8, 2021.

<sup>4</sup> Attached to Applicant's response filed December 15, 2021.

<sup>5</sup> Attached to Applicant's response filed December 15, 2021.

<sup>6</sup> Attached to Applicant's Request for Reconsideration, filed July 18, 2022.

<sup>7</sup> Attached to Office Actions issued on September 8, 2020, March 30, 2021, and January 18, 2022.

## II. Functionality

### A. Applicable Law

Section 2(e)(5) of the Trademark Act prohibits registration of “a mark which . . . comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). “A product design or a product feature is considered functional in a utilitarian sense if: (1) it is ‘essential to the use or purpose of the article,’ or (2) it ‘affects the cost or quality of the article.’” *In re MK Diamond Prods.*, 2020 USPQ2d 10882, at \*5 (TTAB 2020) (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982))).

Our determination of functionality is generally guided by the analysis first applied in *In re Morton-Norwich*, 213 USPQ 9, 15-16 (CCPA 1982). *See, e.g., Valu Eng’g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1489 (TTAB 2017); *Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1513 (TTAB 2017); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017). *Morton-Norwich* identifies the following inquiries or categories of evidence as helpful in determining whether a particular design is functional:

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design’s utilitarian advantages;
- (3) the availability to competitors of functionally equivalent designs; and

- (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

*Morton-Norwich*, 213 USPQ at 15-16.

The *Morton-Norwich* functionality considerations “are not exclusive, however, for functionality ‘depends upon the totality of the evidence.’” *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (quoting *Valu Eng’g*, 61 USPQ2d at 1424). Indeed, in any given case, some of the considerations may not be necessarily relevant to a finding of functionality, nor will they have to weigh in favor of functionality to support a finding of functionality. *Change Wind*, 123 USPQ2d at 1456; *Heatcon*, 116 USPQ2d at 1370. *Cf. Poly-America*, 124 USPQ2d at 1519 (“Petitioner need not present evidence fitting within all four categories in *Morton-Norwich*.”). Ultimately, the determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *See, e.g., Valu Eng’g, Inc.*, 61 USPQ2d 1424; *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009).

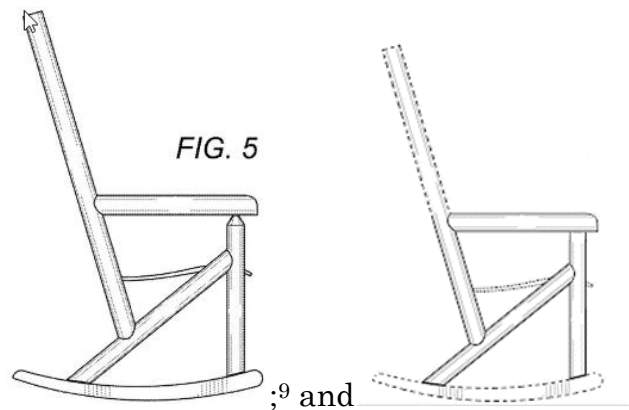
## **B. Analysis of Arguments and Evidence**

In reviewing the arguments and evaluating the evidence in conjunction with the *Morton-Norwich* functionality considerations, we note at the outset that there are no utility patents of record. In addition, although Applicant provided some advertisements for its products, the Examining Attorney does not point to any in which Applicant highlights or ‘touts’ a utilitarian advantage of its product design.

The record is also devoid of any evidence that Applicant’s product design helps minimize the cost or simplify the manufacture of its rocking chairs. To the contrary, Applicant’s Vice President, Justin Lee, affirmatively avers under oath that its

product design is “neither more cost effective to produce nor easier to assemble than other rocking chair/chair designs.”<sup>8</sup>

Applicant also argues that its product design mark is not functional based on its ownership of seven design patents for rocking chairs, each having nearly the same or very similar product configuration. For example, U.S. D830,075S contains a claim for an “ornamental design for a chair, as shown and described,” and, as demonstrated below, the patent drawing (left) is nearly identical to Applicant’s product design (right):



“Our law recognizes that the existence of a design patent for the very design for which trademark protection is sought ‘presumptively . . . indicates that the design is not *de jure* functional.’” *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, at 1377 (Fed. Cir. 2012) (quoting *Morton-Norwich*, 213 USPQ at 17 n.3); see also *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, \*6 (TTAB 2019) (quoting the same language and finding a design patent for an umbrella “covers the applied for mark”

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<sup>8</sup> Applicant’s Request for Reconsideration, filed July 18, 2022, at TSDR p. 8 (Lee Dec. ¶ 4).

<sup>9</sup> Patent issued on October 9, 2018; a copy is attached to Applicant’s March 8, 2021 response, at TSDR pp. 24-27.

and thus “is evidence of non-functionality”). *Cf. Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1206 n.25 (TTAB 2018); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1432-33 (TTAB 2016).

As explained in TMEP Section 1202.02(a)(v)(A):

Design patents cover the invention of a new, original, and ornamental design for an article of manufacture. ... A design patent is a factor that weighs against a finding of functionality, because design patents by definition protect only ornamental and nonfunctional features. However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination.

[Citations omitted].

Accordingly, Applicant’s design patents constitute evidence weighing against a finding of functionality. We hasten to add that the existence of these design patents is not dispositive of the issue of whether Applicant’s product design is functional, but is one factor in our analysis.

The Examining Attorney’s rationale for holding Applicant’s product configuration mark functional is based exclusively on evidence that, he contends, “shows that it is one of a few superior designs available.”<sup>10</sup> He elaborates:<sup>11</sup>

Specifically, the evidence consisting of third-party entities providing goods similar to the application shows rocking chairs featuring a similar design to the applied-for mark in that these rocking chairs have an arm-rest connected to the chair’s back and front legs with an angled rear leg, or they have an armrest and front leg that meet at an approximate 90-degree angle similar to the applied-for mark in this case.

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<sup>10</sup> 8 TTABVUE 6.

<sup>11</sup> 8 TTABVUE 5.

The following are some excerpted examples of the evidence that the Examining Attorney specifically references in his brief:

Search **POTTERY BARN**

DESIGN SERVICES THE FALL LOOKBOOK INSPIRATION BESTSELLERS SHOP ROOMS SUSTAINABILITY

FURNITURE OUTDOOR BEDDING BATH RUGS WINDOWS LIGHTING PILLOWS & DECOR MIRRORS & ART KITCHEN & DINING ORGANIZATION GIFTS HALLOWEEN

**FREE SHIPPING ON ORDERS OVER \$79**  
USE CODE: SAVEMORE EXCLUSIONS APPLY

**ENDS TOMORROW - UP TO 25% OFF YOUR ORDER**  
USE CODE: SAVEMORE EXCLUSIONS APPLY

**UP TO 40% OFF**  
FURNITURE, DECOR & MORE

Home > Furniture > Accent Chairs > **Raylan Leather Rocking Chair**

### Raylan Leather Rocking Chair

QUESTION + ANSWER: See 1 Answer ▾  
Up to 25% Off with Code SAVEMORE

[Clear Selection](#)

— SELECT FABRIC AND COLOR

FILTER BY COLOR ▾

10+ Weeks (Made-to-Order)

Leather, Nubuck Loden Green	Leather, Vegan Java	Leather, Churchfield Chocolate	Leather, Churchfield Camel

12

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<sup>12</sup> September 8, 2020 Office Action, at TSDR p. 3.



### Backyard Creations® Gray Adirondack Rocking Patio Chair

Model Number: RWS6298 | Menards® SKU: 2735113



Compare  Add to Lists

13



14

Roll over image to zoom in



Brand: Casart

### Casart Log Rocking Chair Wood Porch Rocker Lounge Patio Deck Balcony Furniture Rustic Single Rocker Natural

★★★★☆ 6 ratings

\$169<sup>99</sup>

Get \$50 off instantly: Pay \$119.99 upon approval for the Amazon Rewards Visa Card.

Assembly options: **Get expert assembly** Details

Without expert assembly

Expert assembly  
+\$94.00 per unit

▼ What's included

<b>Furniture base movement</b>	Rock
<b>Room Type</b>	Patio Garden
<b>Material</b>	Wood, Cedar
<b>Furniture Finish</b>	Wood
<b>Maximum</b>	250 Pounds

14

<sup>13</sup> September 8, 2020 Office Action, at TSDR p. 11.

<sup>14</sup> January 18, 2022 Office Action, at TSDR pp. 5.



## HIGH BACK LOG ROCKING CHAIR

\$227.99

The carefully crafted curved rocking foot ensures a smooth ride while the traditionally styled high-back vertical slats provide complete support. Both you and baby will be lulled by the smooth motion of this elegant rocker. It is lightweight so you can take it with you as follow the sun. Solid cedar construction ensures years of carefree use. Cedar is also naturally resistant to decay, insect, and weather damage and, when left untreated, the creamy natural color weathers gracefully to a silvery grey.

*Cushions Sold Separately.*

**Handcrafted in the USA**

39" h x 25" w x 36" d

SKU: 010005A

15

Although many of the rocking chairs shown in the third-party retail websites have some of the design traits similar to those found in Applicant's product design, many do not. Furthermore, other than having some similar design traits in common, the Examining Attorney does not articulate how they make Applicant's product design "one of a few superior designs available." That is, while the Examining Attorney points out that some of the third-party rocking chairs have "an arm-rest connected to the chair's back and front legs with an angled rear leg" or "an armrest and front leg that meet at an approximate 90-degree angle," there is no explanation how these design traits are 'superior' or how they are utilitarian because they are 'essential to the use or purpose' of the rocking chairs. *MK Diamond Prods.*, 2020 USPQ2d 10882, at \*5.

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<sup>15</sup> January 18, 2022 Office Action, at TSDR pp. 10.

The third-party evidence tends to show that there are several alternative functionally equivalent designs available to Applicant's competitors. Indeed, some of the third-parties' rocking chairs bear little resemblance in product design to Applicant's, to wit:



Roll over image to zoom in

### POLYWOOD R100MA Presidential Outdoor Rocking Chair, Mahogany

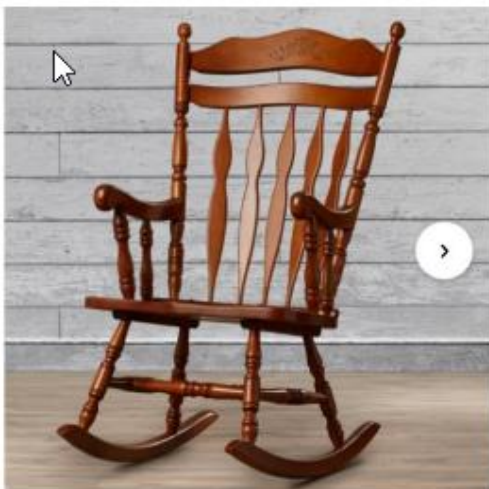
Visit the POLYWOOD Store  
★★★★★ 120 ratings

Was: ~~\$219.00~~ Details  
With Deal: **\$206.98 & FREE Returns**  
You Save: **\$12.02 (5%)**

Get \$50 off instantly: Pay \$156.98 upon approval for the Amazon Rewards Visa Card.

Color	Mahogany
Material	Plastic
Item Dimensions LxWxH	33.75 x 26.25 x 42.5 inches
Furniture Finish	Mahogany
Item Weight	37 Pounds

16



### Medium Oak Greenwood Rocking Chair

See More from [Loon Peak®](#)  
★★★★★ 4.7 | [319 Reviews](#)

**\$189.99** ~~€217.50~~ 13% Off

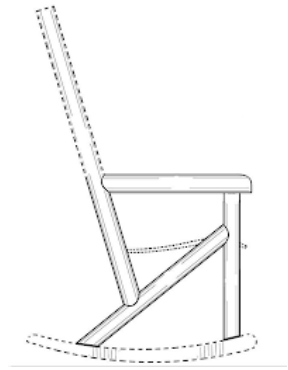
Pay as low as \$13 per month. [Buy with Wayfair Financing](#)

FREE Shipping  
Get it by Mon, Sep 14  
Ship To: [67346 - Grenola](#)

1

<sup>16</sup> March 30, 2021 Office Action, at TSDR pp. 3.

For the sake of clarity, we acknowledge that all of the third-party rocking chairs have a higher chair back, a seat, and a curved base of the chair (to allow for rocking back and forth). Although these features are depicted in Applicant product design, Applicant specifically disclaims those sections of the rocking chairs as features of its proposed design mark by outlining them in dotted lines:



### **C. Conclusion - Functionality**

Upon review of the entire record before us, we conclude that a prima facie showing that Applicant's mark is functional has not been made. *See Becton, Dickinson*, 102 USPQ2d 1376. Accordingly, we reverse the Examining Attorney's refusal to register Applicant's product design under Section 2(e)(5) of the Act.

### **III. Distinctiveness of Applicant's Product Design**

We turn now to the Examining Attorney's alternative refusal based on Applicant's product design mark being nondistinctive and Applicant's proof of acquired distinctiveness being insufficient.

#### **A. Applicable Law**

Pursuant to Sections 1, 2, and 45 of the Act, a mark may be only registered on the Principal Register for goods if it is distinctive and distinguishes an applicant's goods

from those of others by indicating the source of the goods.<sup>17</sup> *See In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached.”)

Product configuration design marks, such as the one Applicant seeks to register, are never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068-69 (2000) (“In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist.”). *See also, e.g., OEP Enters.*, 2019 USPQ2d 309323, at \*16 (“[P]roduct designs can never be inherently distinctive and will always require evidence of acquired distinctiveness or secondary meaning to be registrable as marks.”) (quoting *Kohler v. Honda*, 125 USPQ2d at 1503-04). Accordingly, we must determine whether Applicant’s evidence in support of its acquired distinctiveness claim under Section 2(f) of the Act is sufficient to show that “consumers perceive the design of Applicant’s [goods] as an indicator of source.” *Larian*, 2022 USPQ2d 290, at \*51 (TTAB 2022).

Applicant bears the burden of proving, at least, a prima facie case of acquired distinctiveness in an ex parte proceeding. *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, \*8 (TTAB 2021). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1335, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)). In making such a showing, Applicant must demonstrate

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<sup>17</sup> Section 1 of the Act concerns the requirements for filing a trademark application; Section 2 lists grounds on which the USPTO may refuse registration; and Section 45 provides the definition of a “trademark,” requiring it “identify and distinguish [an applicant’s] goods ... from those manufactured or sold by others and to indicate the source of the goods ....” 15 U.S.C. §§ 1051-1052, 1127.

that consumers perceive the primary significance of its product configuration as not the product, itself, but the source of that product. *Larian*, 2022 USPQ2d 290, \*37 (citing *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009)).

Our ultimate Section 2(f) analysis and determination in this case is based on weighing all of the evidence considered as a whole, under the following six factors:

- (1) association of the [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.

*In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1105 (TTAB 2018) (quoting *Converse, Inc. v. Int’l Trade Comm’n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)). These are known as the “*Converse* factors.”

Finally, “[i]t is axiomatic that ‘the lesser the degree of inherent distinctiveness, the heavier the burden to prove that [a mark] has acquired distinctiveness.’” *Larian*, 2022 USPQ2d 290, at \*38 (quoting *Udor*, 89 USPQ2d at 1986). “While there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, the burden is heavier in this case because it involves product configuration[.]” *Id.* (quoting *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283-84 (TTAB 2000)); *see also* *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir.

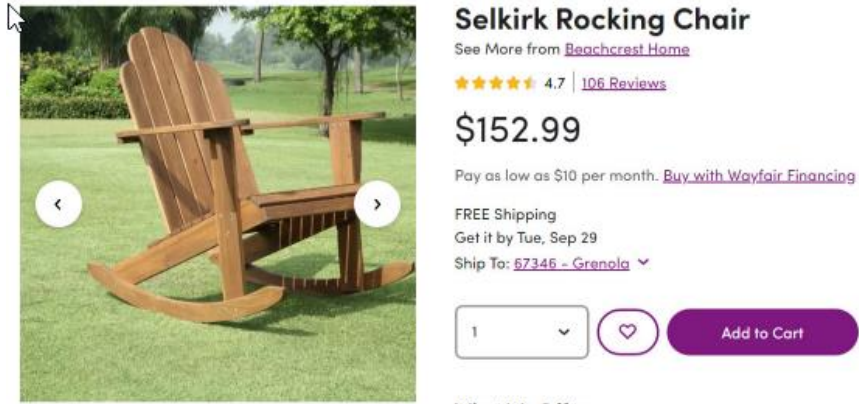
1988) (evidence required to show acquired distinctiveness is directly proportional to the degree of nondistinctiveness of the mark at issue).

### **B. Analysis of Arguments and Evidence**

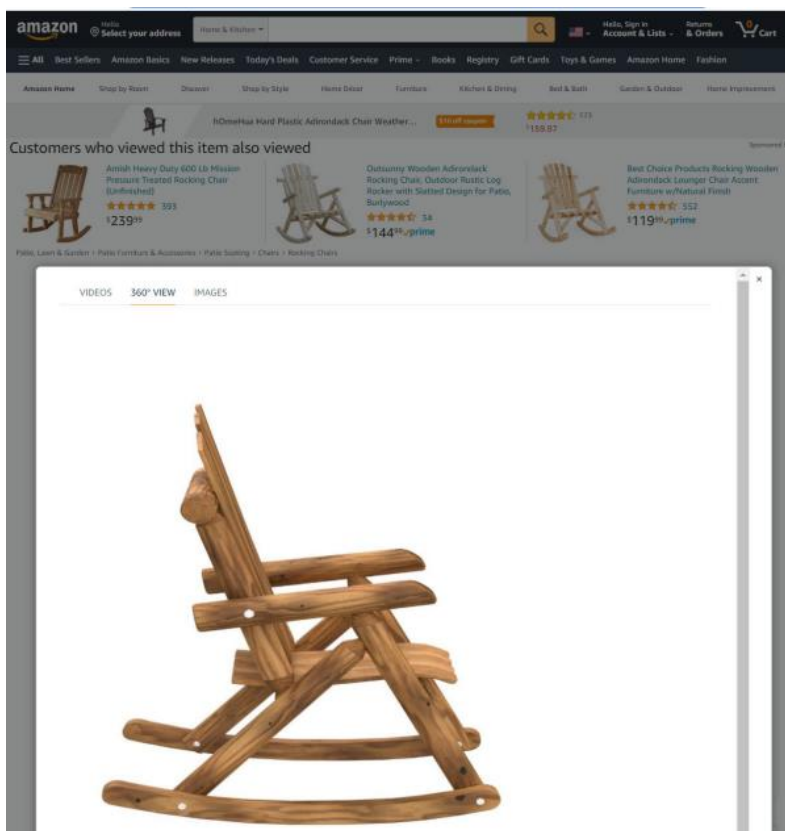
Following up on the last-mentioned axiom, *supra*, we find that Applicant has a very high burden for proving acquired distinctiveness, not only because the mark is a product configuration design, but also because the evidence adduced by the Examining Attorney shows that many of the same features that Applicant claims have become distinctive in its mark are also found in rocking chairs manufactured by others. Indeed, as the Examining Attorney illustrates, albeit in the context of arguing that Applicant's mark is functional, several third parties offer rocking chairs with an "armrest and front legs [that] meet approximately at a 90-degree angle" and/or the "rear leg is attached to the seat back and connects diagonally from the rocker to the front leg."<sup>18</sup> Along with the examples already reproduced above, such as the "High Back Log Rocking Chair," we highlight the following additional record examples:

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<sup>18</sup> 8 TTABVUE 5-6 (Examining Attorney's description of twelve third-party rocking chairs depicted in Internet third-party evidence).



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Despite this third-party evidence of very similar rocking chairs, Applicant claims that its proposed mark “has become distinctive of the goods [ ] through the applicant’s substantially exclusive and continuous use of the mark in commerce that the U.S.

<sup>19</sup> September 8, 2020 Office Action, at TSDR p. 6.

<sup>20</sup> January 18, 2022 Office Action, at TSDR p. 6.



Congress may lawfully regulate for at least the five years immediately before the date of this statement.”<sup>21</sup> In its brief, Applicant relies on the following factors that it believes help show its product configuration mark has acquired distinctiveness: length of use, sales figures, and advertising and promotion.

As to length of use, Applicant’s Vice President, Justin Lee, has averred that “[s]ince at least as early as 2010, [Applicant] and related company United General Supply Co., Inc., designed its rocking chairs and chairs to have a unique design.”<sup>22</sup>

In terms of sales figures, advertising and promotion, there is very little meaningful evidence. In its brief, Applicant makes several statements regarding specific figures regarding units sold, estimates of sales in dollar amounts, and type or extent of promotional activity since 2010. However, the statements are not supported with evidence. In particular, Mr. Lee did not provide any of this information in his sworn declaration. Thus, Applicant’s assertions in its brief “are unsupported by sworn statements or other evidence, and ‘attorney argument is no substitute for evidence.’” *OEP*, 2019 USPQ2d 309323, \*14 (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (internal quotation omitted)).

Moreover, although Applicant submitted printouts or copies of photographs showing its goods in a retail setting, there is no additional evidence to provide context, e.g., how many goods were actually sold, the time in which they were available for

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<sup>21</sup> Applicant’s response filed March 8, 2021, at TSDR p. 1.

<sup>22</sup> Applicant’s Request for Reconsideration, filed July 18, 2022, at TSDR p. 7 (Lee Dec. ¶ 2). The averment of “2010” matches the claimed date of first use in commerce in the application.

sale, customer feedback, etc. For example, a few photographs appear to show Applicant's furniture at a trade show or expo; however, the photographs do not show Applicant's rocking chairs having the product configuration design prominently displayed.<sup>23</sup> Again, we have no additional evidence showing the number of attendees for any expo or trade show.

Applicant's evidence does show that its rocking chairs have been sold at some large retailers, including Home Depot and Walmart.<sup>24</sup> While we may conjecture this reflects some significant consumer exposure and possibly significant sales volume, there is also one major shortcoming in Applicant's evidence. That is, in all of Applicant's evidence, there is no "look for" type of promotion.<sup>25</sup> In other words, we cannot conclude that Applicant has tried to direct consumer attention to any of the features that it believes are unique to Applicant's chairs. This type of promotional effort, while not necessary for purposes of proving acquired distinctiveness, often is probative to sway a fact finder in determining whether certain features have become distinctive in the minds of consumers over time and consumers may identify the source product by those features. *See In re Becton, Dickinson*, 102 USPQ2d 1376; *Kohler v. Honda*, 125 USPQ2d 1517.

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<sup>23</sup> Applicant's response filed March 8, 2021, at TSDR p. 48-53.

<sup>24</sup> Applicant's response filed December 15, 2021, at TSDR p. 11-19.

<sup>25</sup> "Look for" evidence can be described as:

... refer[ing] to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non source-identifying manner.

*Stuart Spector v. Fender*, 94 USPQ2d 1572.

Applicant also relies on “evidence showing that the product packaging used by Applicant highlights the profile of the chair applied for in this application.”<sup>26</sup> Specifically, Applicant points to a logo it uses on its product packaging materials as well as on tags/plates placed on the back of its chairs:



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<sup>26</sup> 9 TTABVUE 5.

<sup>27</sup> Applicant's Request for Reconsideration, filed July 18, 2022, at TSDR p. 10.

<sup>28</sup> Applicant's Request for Reconsideration, filed July 18, 2022, at TSDR p. 16.

Applicant is the owner of U.S Reg. No. 6141460 for the mark:



for “furniture; furniture, namely, metal furniture, wood furniture” in Class 20.<sup>29</sup>

To the extent that Applicant’s use of its logo mark may direct a consumer’s attention to the overall design of Applicant’s rocking chairs, consumers encountering such use are not prompted to focus on any particular features of Applicant’s mark. Rather, consumers may perceive this mark as generally suggestive of Applicant’s rocking chairs, without offering any special attention to the combination of features that Applicant claims has become distinctive as a source-identifier. As the Examining Attorney correctly describes the registered mark, it is “a two-dimensional drawing of the side-view of a rocking chair ... [and] is not the applied-for configuration mark in this case.”<sup>30</sup> Furthermore, and perhaps more importantly, there is no evidence for us to gauge the number of consumers who have encountered such product packaging with the logo mark or how many of these chairs have the logo tag on the back.

Finally, in addition to some of the evidentiary shortcomings already mentioned, we point out that the record is devoid of other types of evidence that can be probative under the *Converse* factors. Specifically, Applicant did not submit any customer surveys, though not required, or declarations showing that actual purchasers

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<sup>29</sup> U.S. Reg. No. 61414601 issued on September 1, 2020. Applicant submitted a copy of the registration with its Request for Reconsideration, filed July 18, 2022, at TSDR pp. 18-19.

<sup>30</sup> 8 TTABVue 10.

associate Applicant's proposed mark with Applicant as the source of its rocking chairs. There is also no evidence showing intentional copying of Applicant's product design or unsolicited attention given to Applicant's rocking chairs based on the product design embodying the mark.

### **C. Conclusion – Distinctiveness**

Based on the entirety of the record and upon weighing the *Converse* factors, we find Applicant falls short of carrying the high burden of showing that its product configuration mark has acquired distinctiveness pursuant to Trademark Act Section 2(f) for rocking chairs.

## **IV. Applicant's Amendment to Seek Registration on the Supplemental Register**

During the prosecution of its application, Applicant "request[ed] that it [be] allowed to amend to the Supplemental Register only in the alternative and only after an appeal of the [Examining Attorney's] decision on the issue of acquired distinctiveness to the Trademark Trial and Appeal Board."<sup>31</sup> In denying Applicant's request for reconsideration, the Examining Attorney agreed that, given those conditions, "Applicant may amend the application to the Supplemental Register."<sup>32</sup> Both Applicant and the Examining Attorney re-affirmed these positions in their appeal briefs.<sup>33</sup>

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<sup>31</sup> Applicant's Request for Reconsideration, filed July 18, 2022, at TSDR p. 5.

<sup>32</sup> August 16, 2022 Office Action, at TSDR p. 1.

<sup>33</sup> See, e.g., 6 TTABVUE 12 (Applicant's brief) and 8 TTABVUE 3 (Examining Attorney, in referring to the August 16, 2022 Office Action, states that "the Examining Attorney advised the Applicant that if an appellate tribunal ultimately determines that the applied-for mark

Accordingly, the aforementioned conditions having been met in this decision, the application is hereby amended to seek registration of the mark on the Supplemental Register.

**Decision:** We reverse the refusal to register Applicant's proposed mark under Trademark Act Section 2(e)(5), on the ground that it is functional. However, we affirm the alternative refusal to register the proposed mark on the Principal Register under Trademark Act Sections 1, 2 and 45, on the ground that it is not inherently distinctive and has not acquired distinctiveness under Trademark Act Section 2(f).

Applicant's alternatively proposed amendment to seek registration on the Supplemental Register, accepted by the Examining Attorney, is entered and the application will be forwarded for registration on the Supplemental Register.

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is a nonfunctional design and also determines that the Applicant has not established acquired distinctiveness, Applicant may amend the application to the Supplemental Register.”)