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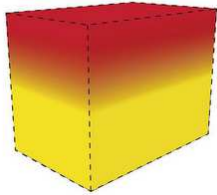
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221004
Party	Defendant Tom Miles
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition Proceeding 91221004

In the matter of the Counterclaim against RN 4677405 in IC 5



For the mark: (yellow-to-red color-fade product packaging)

Registration Date: Jan. 27, 2015

Tom Miles ('Miles'), Counterclaimant

v.

International IP Holdings LLC ('IIPH'), Respondent

MILES TRIAL BRIEF

Tom Miles, hereby files this brief in support of its counterclaim to cancel IIPH color scheme product packaging.

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Table of Contents

I. ISSUES FOR REVIEW 4

II. INTRODUCTION 4

 A. Tom Miles 4

 B. International IP Holdings, LLC 4

 C. Procedural Information 5

III. DESCRIPTION OF THE RECORD 6

IV. STATEMENT OF FACTS 7

V. ARGUMENT 9

 A. Standing 9

 B. Does the Record Support Acquired Distinctiveness 9

 1. NO EVIDENCE TO SUPPORT ACQUIRED DISTINCTIVENESS

 2. NO EVIDENCE TO SUPPORT USE ON TWO ADJACENT SIDES WITH A RED TOP

 C. Does the Matter in the Drawing Act as a Source Identifier..... 11

VI. CONCLUSION 13

Table of Authorities

<i>Bausch & Lomb Inc. v. Leupold & Stevens Inc.</i> , 6 USPQ2d 1475 (TTAB 1988)	12
<i>Boyds Collection Ltd. v. Herrington & Co.</i> , 65 USPQ2d 2017, 2020 n.8 (TTAB 2008)	10
<i>Cold War Museum Inc. v. Cold War Air Museum Inc.</i> , 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).....	9
<i>Exxon Corp.v. Fill-R-Up Systems, Inc.</i> , 182 USPQ 443, 445 (TTAB 1974)	10
<i>Fujifilm Sonosite, Inc. v. Sonoscape Co., Ltd.</i> , 111 U.S.P.Q.2d 1234 (TTAB 2014).....	9
<i>In re Boston Beer Co., L.P.</i> , 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999)	8, 10
<i>In re Busch Entm't Corp.</i> , 60 USPQ2d 1130, 1134 (TTAB 2000)	10
<i>In re Chemical Dynamics Inc.</i> , 939 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988)	11
<i>In re Dakin's Miniatures, Inc.</i> , 59 USPQ2d 1593, 1596 (TTAB 1999)	11
<i>In re David Crystal, Inc.</i> , 296 F.2d 771, 132 USPQ 1 (CCPA 1961)	12
<i>In re Reed Elsevier Properties Inc.</i> , 482 F.3d 1376, 1380, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007)	12
<i>Institut National des Appellations D'Origine v. Vintners International Co. Inc.</i> , 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992)	11
<i>Saab-Scania Aktiebolag v. Sparkomatic Corp.</i> , 26 USPQ2d 1709 (TTAB 1993)	10

Statutes and other references

37 CFR § 2.122(b)(2)	10
Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 81 Fed. Reg. 69950, 69952 (October 7, 2016)	4, 10
TBMP §704.03 (Jan. 2017)	10

I. PRELIMINARY STATEMENT/ISSUES FOR REVIEW

The major issues for review are:

- A. Does Miles have standing to bring this proceeding;
- B. In light of the fact that IIPH registered RN 4677405 with a 2(f) acquired distinctiveness claim, an admission that the mark is not inherently distinctive, does Miles prove, by a preponderance of the evidence and with argument, that the mark (a color scheme) has not acquired distinctiveness;
- C. Does the matter in the drawing act as a source identifier.

II. INTRODUCTION

A. TOM MILES

There is no evidence in the record regarding the business of the counterclaimant. No testimony was taken, no declarations nor affidavits filed. The application that was originally the subject of the opposition was abandoned by Miles during the proceeding and the opposition sustained.

B. IIPH LLC

There is no evidence in the record regarding the business of the respondent with regards to the matter shown in the drawing or the matter as described in the description.


The statements made in the declaration of Scott Henderson in the file of the application/registration are not testimony. See 37 CFR § 2.122(b)(2). Miscellaneous Changes to

Trademark Trial and Appeal Board Rules, 81 Fed. Reg. 69950, 69952 (October 7, 2016). TBMP §704.03 (Jan. 2017). There were no self-authenticating exhibits attached to the declaration in the application file to have evidentiary value for what they show on their face.

No testimony was taken and no declarations or affidavits were filed during the proceeding.

C. PROCEDURAL INFORMATION

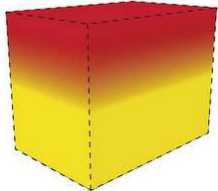
IIPH filed the subject application on **November 12, 2013** under Section 1(a) with a claimed first use date of September 2004. The mark description was “The mark consists of a transitioning

color scheme from red to orange to yellow.” The original drawing was a rectangle:  .

The initial application was refused for being non-distinctive under Trademark Act sections 1, 2 and 45.

Respondent filed a response to the refusal which contained a Declaration of Scott Henderson but contained no self-authenticating evidence.

The description was changed to “The mark consists of THE COLORS RED, ORANGE AND YELLOW IN A TRANSITIONING SCHEME FROM RED TO ORANGE TO YELLOW AS APPLIED TO PRODUCT PACKAGING. THE DOTTED LINES ARE TO SHOW PLACEMENT OF THE MARK ONLY.”

The drawing of record was amended from  to  .

Note that the drawing is now a prism and shows the 3-color scheme on at least two adjacent sides and that the prism has a red top.

The subject application was approved for publication, published for opposition and registered on January 27, 2015.

This proceeding was filed on March 11, 2015 as an opposition to Miles' SN 86138010. This counterclaim against the subject registration was filed on April 13, 2015 with the answer.

The Miles' application subject to the opposition was abandoned and the opposition was sustained. Trial dates were reset for the counterclaim.

No testimony was taken by either party. Miles filed a Notice of Reliance in two parts at 15 & 16 TTABVUE. The parties suspended briefly for settlement discussions but did not come to an agreement. IIPH filed a Notice of Reliance at 19 TTABVUE.

III. DESCRIPTION OF THE RECORD

The evidence of record consists of:

- (1) The pleadings and the file history of the subject registration;
- (2) IIPH's response to office action submitted in Miles Notice of Reliance at 15 TTABVUE;
- (3) USPTO registrations and corresponding internet materials of third party registrations submitted in Miles Notice of Reliance at 16 TTABVUE;
- (4) Internet materials, Twitter files and the status copy of RN 4315511 submitted by IIPH in its Notice of Reliance at 17 TTABVUE.

IV. STATEMENT OF FACTS

1. The only date that IIPH can rely on is the filing date of the application, November 12, 2013. There is no evidence in the record regarding any other date.
2. The subject registration has an acquired distinctiveness claim in whole.
3. There was no testimony taken by IIPH during this proceeding to support acquired distinctiveness at the time of the application or at the present. No self-authenticating evidence regarding the acquired distinctiveness of this registration was submitted during the trial period.
4. There were no pleaded defenses or affirmative defenses by IIPH regarding distinctiveness or regarding a transfer of distinctiveness from use in another form from the IIPH bottle trade dress registration to the present color scheme. A bottle shape and a prism shape are not so close that use of the former would be considered probative evidence the latter was also distinctive.
5. If the carefully selected Twitters submitted in IIPH's Notice of Reliance were considered for the truth of the matter asserted, consumers only remember the bottles. (See: "red and yellow bottle" at 19 TTABVUE 10, "red mini-bottles" at 19 TTABVUE 14, "little red and yellow bottles" at 19 TTABVUE 21, "Cadillac-red bottle" at 19 TTABVUE 21, "little red/yellow bottle" at 19 TTABVUE 66, "red an yellow bottle" at 19 TTABVUE 68, "red and yellow bottle" at 19 TTABVUE 73, "bottle is a rainbow, no its not, its orange, red and black" at 19 TTABVUE 75, "small red/orange bottle" at 19 TTABVUE 77, "LIL RED N YELLOW BOTTLE" at 19 TTABVUE 79, "ubiquitous red bottle" at 19 TTABVUE 81.) The Twitters are not evidence of acquired distinctiveness for the subject registration, a prism with at least two adjacent sides containing the 3-color scheme and a red top.

6. Nothing in the record for IIPH is self-authenticating except the status copy of a registration for the color scheme for the IIPH bottle. There are no pleaded claims or defenses regarding this registration nor any testimony to otherwise show its relevance.

7. There is no evidence about how many of the subject prisms were sold either before the subject application was filed or since.

8. There is no evidence in the record there are any sales of any product or packaging using the prism color scheme presently. Even if there were, it is well settled that even compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. See *In re Boston Beer Co., L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness).

9. The pictures of the boxes in the application file (which are not self-authenticating) do not, on their face, illustrate use of the mark in the drawing. The picture at 15 TTABVUE 90 only has one side with the 3-color scheme. The picture at 15 TTABVUE 37 doesn't have a solid red top. The picture of a box submitted as a specimen only shows one side, not two as in the drawing. The one side shown in the specimen has a red, orange, yellow and blue bottle with a two-tone blue scenery; an orange color; and wording all over a background. This scenery of blue colors along with a bottle obscure the background. The blue scenery scheme could just as easily be as much a part of the background as the registered yellow-orange-red color scheme. Visually, the words 5 Hour Energy and bottle are the dominant parts of the one box side shown.

10. There is scant evidence available for either party. However, the bulk of the record is all about bottles, not prisms. There is no supplied evidence that IIPH had promoted and achieved customer

recognition of a yellow-orange-red color scheme on two adjacent sides of a prism, nor with a red colored box top at the time of the application or since.

11. The registration that IIPH brought into the record, a copy of its bottle color scheme registration (registered April 09, 2013, two years before the subject application) at 19 TTABVUE 59-64, is not available for unpleaded defenses by IIPH. However, this registration is available, for the sake of argument, as an admission against interest that the bottle color scheme is now presumptively distinctive and was distinctive before IIPH filed the subject application. As such, the bottle will be noticed by consumers at the expense of the less used non-distinctive components like the prism color box scheme. *Fujifilm Sonosite, Inc. v. Sonoscape Co., Ltd.*, 111 U.S.P.Q.2d 1234 (TTAB 2014)(unpleaded registrations available for whatever probative value that they have like third party registrations).

V. ARGUMENT

A. STANDING

Miles, now counterclaimant, automatically has standing as the applicant in the original opposition in this proceeding.

B. DOES THE RECORD SUPPORT ACQUIRED DISTINCTIVENESS

1. NO EVIDENCE TO SUPPORT ACQUIRED DISTINCTIVENESS

The subject registration has an acquired distinctiveness claim in whole. The prism and its color scheme's **non-distinctiveness** is a nonissue, a fact. The matter shown in the drawing is not distinctive. *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

The statements made in the declaration of Scott Henderson in the file of the application/registration are not testimony. There were no self-authenticating exhibits attached to the declaration in the application file to have evidentiary value for what they show on their face. See 37 CFR § 2.122(b)(2). Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 81 Fed. Reg. 69950, 69952 (October 7, 2016). TBMP §704.03 (Jan. 2017).

The declaration by Scott Henderson, for the sake of argument, at 15 TTABVUE 25, 26 doesn't even mention any specific facts regarding packaging outside of bottles. The words "applied-for-mark" are used frequently like a fill-in-the-blank phantom declaration so the declaration can be used over and over for various purposes and does not appear to be valid for this use since no specifics regarding the actual characteristics of this packaging are contemplated. The attached pictures show there is not a consistent use of this color scheme.

Even if there were sales information for this particular packaging, such sales information may demonstrate only the commercial success of IIPH's business and its underlying goods, but not that relevant consumers view the matter as a mark for such goods. *In re Boston Beer Co.*, 53 USPQ2d at 1058; *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

The sales attributed to the box coloring scheme are not delineated and can be assumed to be but nothing more than a tiny fraction of overall sales. *Saab-Scania Aktiebolag v. Sparkomatic Corp.*, 26 USPQ2d 1709 (TTAB 1993). Several different boxes with different color schemes are included in the non-self-authenticating documents submitted with the declaration.

The evidence in the record, including the Twitters and other materials downloaded from the internet submitted by IIPH at 17 TTABVUE, are not available for the truth of the matter asserted. See *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2008); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974). If they were available, they

neither support a claim that this color scheme packaging is distinctive, used with any frequency or consistency, nor support the argument consumers notice anything about the box coloring schemes when they are used.

Likewise the pictures (which are not self-authenticated) in 15 TTABVUE in support of the declaration, indicate only the bottles are the primary packaging.

There is no probative evidence in the record to support acquired distinctiveness.

2. NO EVIDENCE TO SUPPORT USE ON TWO ADJACENT BOXSIDES WITH A RED COLORED TOP

Note, the matter in the amended drawing is in the shape of a prism and the color scheme must appear on two adjacent sides. Trademark Rule 2.51(a)(2) provides, in part, the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods. Use only on one side when two sides are in the drawing would not be a substantially complete representation.

Use where the two sides are heavily obscured with other matter leaves in doubt whether the background is a substantially exact representation.

There is no probative evidence, in the record, to support a prism with at least two adjacent sides containing the color scheme has ever been used in the marketplace.

C. DOES THE MATTER IN THE DRAWING ACT AS A SOURCE IDENTIFIER

The actual words on the box, especially “5 Hour Energy is this case, is more likely to be impressed upon a consumer’s memory than the background color scheme. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999).

The removal of the subject color scheme would not alter the commercial impression of the rest of the box as shown in the specimen, because it is merely a background. It is well established an element of a composite is registerable only if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of goods and also distinguishes the goods from those of others. *Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); and *In re Chemical Dynamics Inc.*, 939 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988).

There is no consumer evidence included in the record.

Nowhere in un-authenticated IIPH's advertisements does IIPH even mention, let alone emphasize, the packaging color scheme in such a way that would cause buyers to look for the registered color configuration as a source indicator. This configuration is neither promoted as a trademark nor demonstratively perceived as one by purchasers. *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (CCPA 1961); and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475 (TTAB 1988).

If the pictures in the record were a representative example and also were admissible evidence, this color scheme on prisms has seen no more than occasional use by IIPH. 15 TTABVUE 88 shows at least four different color schemes on boxes.

Third-party registrations and uses of similar color schemes on packaging are found at 16 TTABVUE 2-41. These websites are selling competitive products and are evidence of public awareness of red and orange and yellow color schemes originating with parties other than IIPH. They are probative of the lack of acquired distinctiveness in IIPH's matter. See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 1380, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007) (third-party websites are competent sources to show likely perception of website content).

On their face, these third party websites show advertising and packaging that uses red, yellow and orange color schemes. These sources are competent to show that it is likely that consumers see many packaging schemes that use the same colors as IIPH and that the scheme is not seen as being a source unique to IIPH.

There is no evidence in the record that the color scheme would be perceived as a trademark. Without exception, the prism packaging shown in the un-authenticated pictures in the record show a picture of the bottle as a dominant feature on the prism packaging. For the sake of argument, it is a safe assumption that people recognize a picture of the 5 Hour Energy bottle contained on the packaging and realize that the packaging contains bottles. The presence of the identifying shape of the bottle is an overriding distinctive recognition by the buying public of the packaging's contents rather than the background color scheme. There is no supporting evidence that a consumer would buy a prism packaging that only contained the color scheme omitting the words and pictures of the bottles. The color scheme on the prism packaging does not stand on its own as a distinctive element indicating source.

VI. CONCLUSION

There is no probative evidence that the prism color scheme has acquired distinctiveness. There is also evidence that third parties use very similar color schemes on very similar products.

For the sake of argument, there is evidence in the record that the IIPH bottle is distinctive (it is a registered trademark). The color scheme background is an unnecessary and unsubstantiated element for consumer recognition. There is no proof that the color scheme of the prism shaped packaging has acquired distinctiveness and source recognition.

The registration should be revoked.

Submitted By: /Wendy Peterson/
Date: February 6, 2017
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CERTIFICATE OF SERVICE

I hereby certify that on February 6, 2017, the foregoing was served on IIPH's correspondent of record by email to:

cschneider@oaklandlawgroup.com

/Wendy Peterson/