

This Opinion is Not a  
Precedent of the TTAB

Mailed: June 29, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*JVMAX, Inc.*  
*v.*  
*ESR Performance Corp.*  
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Cancellation No. 92063873  
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William R. Brees and Brittany J. Maxey-Fisher of Maxey Law Offices, PLLC,  
for JVMAX, Inc.

David F. Tamaroff of Lipscomb & Partners, PLLC,  
for ESR Performance Corp.

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Before Bergsman, Hightower and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

ESR Performance Corp. (“Respondent”) has registered on the Principal Register under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), the mark comprising the design of a bullet cartridge, shown below, for “automobile antennas,” in Class 9.<sup>1</sup>

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<sup>1</sup> Registration No. 4954143, registered May 10, 2016, based on an application filed April 23, 2015. Registrant claimed first use of its mark anywhere and first use in commerce as of November 3, 2010.



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

The mark consists of a three-dimensional configuration of an automobile antenna that is shaped like a bullet cartridge. The dotted lines are not part of the mark and serve only to show the position or placement of the mark on the antenna base.

JVMAX, Inc. (“Petitioner”) petitioned to cancel the registration of Respondent’s mark on the grounds that Respondent’s configuration has not acquired distinctiveness, that Respondent’s mark is aesthetically functional, and that Respondent committed fraud when it prosecuted its application for registration.

Respondent, in its Answer, denied the salient allegations in the Petition for Cancellation.

#### I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Respondent’s registration file. The parties stipulated that the

discovery deposition of Enrique Baiz, Respondent's President, may be admitted as a testimony deposition.<sup>2</sup> Petitioner submitted the testimony and evidence listed below:

1. Notice of reliance on Internet documents;<sup>3</sup>
2. Testimony deposition of Tristan Morse, an unidentified individual associated with DLT, LLC, dba CravenSpeed, a third party distributor of automobile antennas;<sup>4</sup>
3. Testimony deposition on written questions of William E. Lauer, an unidentified individual associated with Metra Electronics Corp., a company that sells automobile antennas;<sup>5</sup>
4. Testimony deposition of John Volchko, Petitioner's owner and officer;<sup>6</sup>
5. The discovery deposition of John Volchko;<sup>7</sup> and

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<sup>2</sup> 10 TTABVUE.

<sup>3</sup> 11-13 TTABVUE. 12 TTABVUE 320-369 and 13 TTABVUE appear to be Internet documents advertising the sale of various bullet-shaped products. 11 TTABVUE through 12 TTABVUE 319 are Instagram photographs of people, guns, and ammunition that have no apparent relevance to the issues in this proceeding.

<sup>4</sup> 18 TTABVUE. The portion of the Morse deposition designated as confidential is posted at 19 TTABVUE. Petitioner identifies Mr. Morse as the corporate representative of DLT, LLC. Petitioner's Brief, p. 1 (39 TTABVUE 2).

<sup>5</sup> 20 TTABVUE. The portion of the Lauer deposition designated as confidential is posted at 21 TTABVUE.

<sup>6</sup> 23 TTABVUE. The portion of the Volchko deposition designated as confidential is posted at 24 TTABVUE.

<sup>7</sup> 25 TTABVUE. The portion of the Volchko discovery deposition designated as confidential is posted at 26 TTABVUE.

Although Trademark Rule 2.120(k)(1), 37 C.F.R. § 2.120(k)(1), provides that a discovery deposition of an officer, director or managing agent of a party may be offered into evidence by an adverse party, Petitioner introduced the discovery deposition of its principal. Because Respondent did not object to Petitioner's introduction of the discovery deposition of Petitioner's principal and, in fact, acknowledged it in its recounting of the record, mistakenly stated that it was stipulated into the record, and cited to it in its brief (37 TTABVUE 4, 5 n.3,

6. Discovery deposition of Enrique Baiz, Respondent's President.<sup>8</sup>

## II. Evidentiary Issue

Respondent objects to and moves to strike portions of the Tristan Morse testimony deposition.<sup>9</sup> Mr. Morse testified regarding third party DLT, LLC's sales of and advertising expenditures for bullet shaped antennas but does not corroborate his testimony with documentary evidence.<sup>10</sup> Specifically, Respondent refers us to the following testimony:

Q. What was the first date on which DLT, LLC, sold an automobile antenna bearing the product design of bullet shape?

A. Based on our sales records we sold a bullet shaped antenna called the Super Stubby Antenna beginning May 14<sup>th</sup> of 2007. [...]

Q. What was the first date on which DLT, LLC, sold an automobile antenna bearing the product design of a .50 caliber bullet shape?

A. October 15, 2013, on sales order 12429584.<sup>11</sup>

Respondent's counsel attended the deposition via telephone<sup>12</sup> but did not cross-examine Mr. Morse. Respondent's counsel concedes that "there is no evidence that

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9, and 11), we deem that the discovery deposition of Petitioner's principal has been stipulated into the record.

<sup>8</sup> 27-29 TTABVUE. The portions of the Baiz deposition designated as confidential are posted at 30 TTABVUE.

<sup>9</sup> 35 TTABVUE.

<sup>10</sup> 35 TTABVUE 1-4.

<sup>11</sup> 18 TTABVUE 7-8.

<sup>12</sup> 18 TTABVUE 3.

Mr. Morse was reading directly from these sales records”<sup>13</sup> and that “it does not appear that Mr. Morse was reading from the sales records.”<sup>14</sup> Respondent argues that Mr. Morse’s testimony violates the “best evidence rule” (Fed. R. Evid. 1002) because Mr. Morse testified about the contents of his company’s sales records without introducing those records into evidence and that the testimony about the sales records is hearsay.<sup>15</sup>

The “best evidence rule” is a common law proposition that has been codified in Rule 1002 of the Federal Rules of Evidence, which states the following:

To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided in these rules or by Act of Congress.

The “best evidence rule” requires the production of the original document when the contents of that document are at issue. Fed. R. Evid. 1004 excuses this requirement where it can be shown that the original has been lost or destroyed, as long as unavailability is not the result of the proponent’s bad faith, the original is not obtainable, or the document is not closely related to a controlling issue.

Respondent’s motion is not well taken. It is reasonable for a witness to review business records before testifying. Mr. Morse testified about his company’s sales of bullet shaped antenna based on his review of his company’s business records. He was

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<sup>13</sup> 35 TTABVUE 3.

<sup>14</sup> 35 TTABVUE 7.

<sup>15</sup> 35 TTABVUE 5-6.

not testifying about the contents of his company's business records; the business records formed the foundation for his testimony.<sup>16</sup>

Respondent's objection is overruled and motion to strike accordingly denied.

### III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). John Volchko, Petitioner's owner and its officer, testified that Petitioner is in the business of "selling after-market car antennas to the public,"<sup>17</sup> including bullet-shaped antenna.<sup>18</sup> Because Petitioner is a competitor of Respondent, it presumptively has an interest in the outcome of these proceedings beyond that of the general public. *See Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1201 (TTAB 2018); *Poly-America, L.P. v. Illinois Tool Works Inc.*,

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<sup>16</sup> As noted above, Respondent does not contend that Mr. Volchko was reading from his company's sales records. Therefore, we do not overrule the objection on the ground that it is a procedural objection that could have been cured if raised during the deposition. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 707.03(a) (June 2017); *cf. Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070-71 (TTAB 2011) (objection concerning authentication made in brief but not in testimonial deposition procedural in nature and not timely raised); *Ross v. Analytical Tech. Inc.*, 51 USPQ2d 1269, 1271 n.4 (TTAB 1999) (objection raised for the first time in brief to manner in which testimonial depositions were filed waived since purported defect could have been cured if promptly raised).

<sup>17</sup> Volchko Testimony Dep., p. 7 (23 TTABVUE 8).

<sup>18</sup> Volchko Testimony Dep., p. 15 (23 TTABVUE 16).

124 USPQ2d 1508, 1512 (TTAB 2017). Respondent, in its brief, does not challenge Petitioner's standing.

Petitioner has established its standing to bring the petition for cancellation.

#### IV. Aesthetic Functionality

Petitioner alleges that “[c]onsumers purchase bullet shaped antennas based on the ornamental appearance of those antennas” and, therefore, the bullet shaped antenna is functional and unregistrable pursuant to Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5).<sup>19</sup> In its brief, Petitioner argues that “[b]ecause consumers purchase automobile antennas based on the way they look, the look of the automobile antenna is a competitive feature not related to the source of the goods” and, thus, the bullet-shaped design “is essential to the purpose of the product which is purchase[d] in large part for the way it looks.”<sup>20</sup>

A mark is aesthetically functional and, therefore, prohibited from registration by Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), if there is a “competitive need” for the feature. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994) (the color black for boat engines is functional because it has color compatibility with a wide variety of boat colors and it makes the engines appear smaller); *Grote Indus.*, 126 USPQ2d at 1209 (holding that that the design of the product configuration did not serve an aesthetic purpose independent of any source-identifying function); *In re Florists' Transworld Delivery Inc.*, 106

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<sup>19</sup> Petition for Cancellation ¶¶35-36 (1 TTABVUE 8).

<sup>20</sup> Petitioner's Brief, pp. 39-40 (32 TTABVUE 40-41).

USPQ2d 1784, 1787 (TTAB 2013) (a feature is prohibited from registration “if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage”).

Mr. Volchko, Petitioner’s principal, testified that consumers purchase after-market antenna because “[t]hey want something that looks cool on their vehicle.”<sup>21</sup> Likewise, during the prosecution of its application, Respondent’s principal, Enrique Baiz, testified that “all the customers seemed to indicate that they purchased the product [3 inch antenna] because of its distinctive appearance.”<sup>22</sup> Accordingly, Petitioner concludes that the design of the bullet shaped antenna “is essential to the purpose of the product.”<sup>23</sup>

However, Petitioner has not established a competitive need for use of the bullet-shaped antenna. The record shows that the parties and others offer equivalent antenna with many diverse designs. Petitioner sells “20 to 30 different types” of antenna.<sup>24</sup> Metra Electronics Corporation “has sold at least ... 50 different shapes of automobile antennas between August 1<sup>st</sup>, 2010 and [July 19, 2017].”<sup>25</sup> DLT, LLC, dba CravenSpeed, has sold “12 different shapes of automobile antenna” “since August 1, 2010.”<sup>26</sup> Petitioner has not proven that the bullet-shaped antenna design serves an

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<sup>21</sup> Volchko Testimony Dep., p. 16 (23 TTABVUE 17).

<sup>22</sup> Baiz Decl. ¶22 attached to the December 30, 2015 Response to Office Action in Respondent’s application prosecution history. (TSDR 17); *see also* Baiz Discovery Dep. Exhibit 18 (28 TTABVUE 226).

<sup>23</sup> Petitioner’s Brief, p. 40 (32 TTABVUE 41).

<sup>24</sup> Volchko Discovery Dep., p. 7 (25 TTABVUE 8).

<sup>25</sup> Lauer Testimony Dep., p. 5 (20 TTABVUE 6).

<sup>26</sup> Morse Testimony Dep., p. 4 (18 TTABVUE 5).

aesthetic purpose independent of any source-identifying function. Because a product design is aesthetically pleasing and commercially successful does not mean that it is aesthetically functional. *See Florists' Transworld Delivery Inc.*, 106 USPQ2d at 1789. “[F]unctionality hinges on whether registration of a particular feature hinders competition and not on whether the feature contributes to the product’s commercial success.” *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001).

This examination of competitive need “should not discourage firms from creating [a]esthetically pleasing mark designs, for it is open to their competitors to do the same.” [*Qualitex*], 514 U.S. 159, 115 S.Ct. 1300 [34 USPQ2d 1161]; *see also Brunswick*, 35 F.3d at 1533, 32 USPQ2d at 1124 (“[A]esthetic ingredients to commercial success are not necessarily de jure functional. ... Color compatibility and ability to decrease apparent motor size are not in this case mere aesthetic features. Rather these non-trademark functions supply a competitive advantage.”). Mere taste or preference cannot render a color — unless it is “the best, or at least one, of a few superior designs” — de jure functional.

*L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349.52 USPQ2d 1307, 1310 (Fed. Cir. 1999).

This case thus is distinguishable from *Brunswick* and *Florists' Transworld Delivery*. In *Brunswick*, 32 USPQ2d at 1124, our primary reviewing court found that the color black served the nontrademark purpose of reducing the apparent size of outboard boat engines. In *Florists' Transworld Delivery*, 106 USPQ2d at 1791, the Board found that competitors need to use black packaging to convey an appropriate message or sentiment and that the exclusive appropriation of the color black to single entity would severely limit the availability of appropriate color choices. In the case before us, there is no evidence that there is a competitive need for a bullet cartridge-shaped antenna.

Accordingly, the bullet cartridge-shaped antenna design is not aesthetically functional.

#### V. Acquired Distinctiveness

Having found that Respondent's configuration is not aesthetically functional, we must determine whether the bullet cartridge shaped antenna has acquired distinctiveness for automobile antennas and, therefore, is protectable as a mark under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

Because the subject matter sought to be registered is a product design, it is not inherently distinctive, and can be registered as a mark only on a showing of acquired distinctiveness. *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000) ("Consumers are aware of the reality that, almost invariably, even the most unusual of product designs — such as a cocktail shaker shaped like a penguin — is intended not to identify the source, but to render the product itself more useful or more appealing."); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1837 (TTAB 2013). A mark has acquired distinctiveness "if it has developed secondary meaning, which occurs when, 'in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.'" *Wal-Mart*, 54 USPQ2d at 1068 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.11 (1982)); see also *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) ("An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to

establish acquired distinctiveness.”). There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, but the burden is heavier for product configurations than for word marks. *Stuart Spector Designs*, 94 USPQ2d at 1554; *see also EFS Mktg. Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 37 USPQ2d 1646, 1649 (2d Cir. 1996) (“[C]onsumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or a product-packaging trade dress.”).

Our primary reviewing court has instructed as follows for petitions to cancel on the ground that a mark is not inherently distinctive and has not acquired distinctiveness:

In a Section 2(f) case, the party seeking cancellation bears the initial burden to “establish a prima facie case of no acquired distinctiveness.” [*Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988)]. To satisfy this initial burden, the party seeking cancellation must “present sufficient evidence or argument on which the board could reasonably conclude” that the party has overcome the record evidence of acquired distinctiveness — which includes everything submitted by the applicant during prosecution. *Id.* at 1576-77. The burden of producing additional evidence or argument in defense of registration only shifts to the registrant if and when the party seeking cancellation establishes a prima facie showing of invalidity. The Board must then decide whether the party seeking cancellation has satisfied its ultimate burden of persuasion, based on all the evidence made of record during prosecution and any additional evidence introduced in the cancellation proceeding.

*Cold War Air Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1630 (Fed. Cir. 2009); *see also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1764 (TTAB 2013), *aff’d per curiam*, 565 F. App’x 900 (Fed.

Cir. 2014). Applying these standards, we must determine whether Petitioner has established a *prima facie* case of no acquired distinctiveness and, if so, whether Respondent has introduced additional testimony and evidence in defense of its registration establishing acquired distinctiveness.

A. Whether Petitioner Has Established a *Prima Facie* Case of No Acquired Distinctiveness?

We turn first to the evidence of acquired distinctiveness in Respondent's application for registration. Enrique Baiz, Respondent's President, submitted two declarations to support acquired distinctiveness.<sup>27</sup> The evidence is summarized below:

- "Based on information and belief," Respondent was the first company "to adopt" the bullet cartridge shape for automobile antenna;<sup>28</sup>
- Since November 3, 2010, Respondent has sold over 44,780 bullet cartridge shaped automobile antennas;<sup>29</sup>
- Since November 3, 2010, Respondent has generated over \$508,900 in revenues through retail and wholesale sales of the bullet cartridge shaped automobile antennas;<sup>30</sup>

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<sup>27</sup> The statements made in declarations filed in an application to support the registration of the mark sought to be registered are not testimony on behalf of the applicant or registrant and, therefore, are hearsay. *See* Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2).

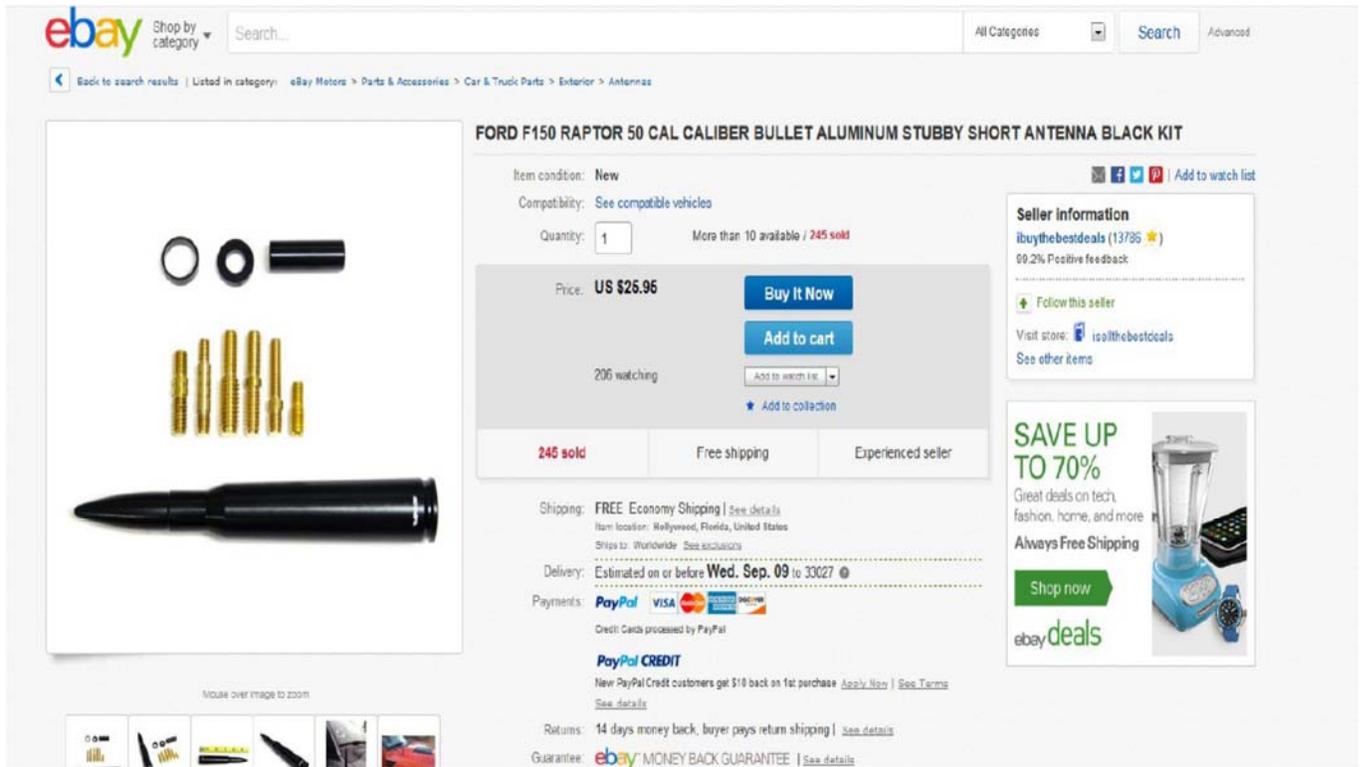
<sup>28</sup> Baiz Decl. ¶5, November 11, 2015 Response to Office Action (TSDR 11) and Baiz Decl. ¶8, December 30, 2015 Response to Office Action (TSDR 15).

Citations to the TSDR database are to the downloadable .pdf format.

<sup>29</sup> Baiz Decl. ¶¶10 and 11, December 30, 2015 Response to Office Action (TSDR 10).

<sup>30</sup> Baiz Decl. ¶¶12 and 13, December 30, 2015 Response to Office Action (TSDR 10); *see also* Respondent's response to Petitioner's Interrogatory No. 9, Baiz Discovery Dep., Exhibit 43 (29 TTABVue 283).

- Since November 30, 2010, Respondent has spent over \$203,000 marketing the bullet cartridge shape antenna;<sup>31</sup>
- Respondent sells the bullet cartridge shape antenna “mostly thru ebay.”<sup>32</sup> Respondent submitted representative eBay listings of the bullet cartridge shape antenna.<sup>33</sup> One of the listings is reproduced below:<sup>34</sup>



The writing on the base of the cartridge as shown in the above-noted eBay posting is illegible. However, the product advertised in an Amazon.com posting displays the

<sup>31</sup> Baiz Decl. ¶14, December 30, 2015 Response to Office Action (TSDR 11).

<sup>32</sup> Baiz Decl. ¶9, November 11, 2015 Response to Office Action (TSDR 11) and Baiz Decl. ¶23, December 30, 2015 Response to Office Action (TSDR 12).

<sup>33</sup> Baiz Decl. Exhibits B, C and D, November 11, 2015 Response to Office Action (TSDR 62-64) and Baize Decl. Exhibits S and T, December 30, 2015 Response to Office Action (TSDR 91-92).

<sup>34</sup> Baiz Decl. Exhibit D, November 11, 2015 Response to Office Action (TSDR 64) and Baiz Decl. Exhibit T, December 30, 2015 Response to Office Action (TSDR 92).

letters “VMS,”<sup>35</sup> Respondent’s product mark,<sup>36</sup> as do the photographs of the bullet cartridge shaped antenna advertised in Respondent’s product flier distributed at the SEMA Show<sup>37</sup> and the photographs posted on Facebook and Instagram.<sup>38</sup> The photograph reproduced below illustrates Respondent’s use of the VMS mark on the bullet cartridge shaped automobile antenna:<sup>39</sup>



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<sup>35</sup> Baiz Decl. Exhibit A, December 30, 2015 Response to Office Action (TSDR 19).

<sup>36</sup> Baiz Discovery Dep., p. 53 (27 TTABVUE 54) (“VMS Racing, it’s a brand that we sell products under” and “Q. Does [Respondent] sell any antennas that are not VMS Racing brand? A. No.”).

<sup>37</sup> Baiz Decl. ¶18 and Exhibit K, December 30, 2015 Response to Office Action (TSDR 16 and 83). The SEMA Show “consists of over 6500 companies all over the world. It is considered the biggest automotive aftermarket show in the world. The Show attracts over 125,000 visitors related to the automotive industry each year.” Baiz Decl. ¶15, December 30, 2015 Response to Office Action (TSDR 16).

<sup>38</sup> Baiz Discovery Dep., pp. 154, 159 and Exhibits 14 and 15 (27 TTABVUE 166 and 171 and 28 TTABVUE 158-221).

<sup>39</sup> 28 TTABVUE 193.

- Respondent has attended the SEMA Show since 2010 where it distributes thousands of catalogs and promotional material containing advertisements for the bullet cartridge shaped antennas;<sup>40</sup>
- Respondent has distributed tens of thousands for product catalogs and mailers containing advertisements for the bullet cartridge shaped antennas;<sup>41</sup>
- Respondent attached 104 declarations from customers purportedly attesting to their recognition that the bullet cartridge shape antennas come from one source.<sup>42</sup> The declarations are identical and read as follows:
  1. I, the undersigned, declare that I am a regular purchaser of automotive parts and that I live in \_\_\_\_\_ . (City/State).
  2. I am familiar with the automotive parts offered by [Respondent] and/or offered by others and have purchased automotive parts for \_\_\_ years.
  3. I recognize the Bullet Cartridge-Shaped Automobile Antenna Design shown above as coming from one source because this shape for automobile antenna is unique and distinctive and readily recognizable and distinguished from other automobile antennas.<sup>43</sup>

Petitioner introduced the testimony deposition of Tristan Morse, an unidentified person associated with DLT, LLC, dba CravenSpeed, a third party that has sold automobile antennas since 2006.<sup>44</sup> Mr. Morse testified that DLT, LLC “sold a bullet

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<sup>40</sup> Baiz Decl. ¶¶15-18 and Exhibits D-K, December 30, 2015 Response to Office Action (TSDR 16-17 and 75-83).

<sup>41</sup> Baiz Decl. 19-20 and Exhibits M-O, December 30, 2015 Response to Office Action (TSDR 17 and 84-87); *see also* Respondent’s response to Petitioner’s Interrogatory No. 10, Baiz Discovery Dep. Exhibit 43 (29 TTABVUE 284) (Respondent advertises its products by distributing printed catalogs and brochures, attending the SEMA Show, and postings on Instagram and Facebook).

<sup>42</sup> Baiz Decl. Exhibit A, November 15, 2015 Response to Office Action (TSDR 12-61) and Baiz Decl. Exhibit C, December 30, 2015 Response to Office Action (TSDR 21-74).

<sup>43</sup> A drawing of the bullet cartridge shape antenna is displayed at the top of the declaration.

<sup>44</sup> Morse Dep., p. 3 (18 TTABVUE 4).

shaped antenna called the Super Stubby Antenna beginning May 14<sup>th</sup> of 2007.”<sup>45</sup> Also, James Lauer testified that Metra Electronics Corporation first sold a bullet cartridge shaped automobile antenna on June 29, 2015.<sup>46</sup>

After reviewing this evidence, we find that Petitioner has established a *prima facie* case that the bullet cartridge shaped design has not acquired distinctiveness for the reasons discussed below. First, in his declarations, Mr. Baiz stated that “based on information and belief,” Respondent was the first to “adopt” the bullet cartridge shaped automobile design. Although Mr. Baiz did not provide any background to explain the basis for his information and belief, he later testified that he searched the Yahoo!, Google, and Bing search engines for bullet cartridge shaped automobile antennas and, presumably, he did not find any other companies selling bullet cartridge shaped automobile antenna.<sup>47</sup> Mr. Baiz’s statement was contradicted by

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<sup>45</sup> Morse Dep., p. 6 (18 TTABVUE 7). Petitioner introduced an excerpt from the RaptorFormZ.com website, an Internet forum, with a January 23, 2010 posting date, discussing the “CravenSpeed Stubby and Bullet Antennas.” Baiz Discovery Dep., pp. 228-29 and Exhibit 40 (27 TTABVUE and 29 TTABVUE 238-68).

Petitioner introduced an excerpt from the TitanTalk.com website, an Internet forum, with a November 8, 2013 posting date, where a user posted a photograph of his “.50 Cal Stubby Antenna.” Mr. Baiz did not recall that his company ever using “.50 Cal” in connection with its bullet cartridge shaped automobile antenna. Baiz Discovery Dep., pp. 215-16 and Exhibit 39 (27 TTABVUE 227-28 and 29 TTABVUE 219-37). At 29 TTABVUE 223 of Baiz Discovery Dep. Exhibit 39, the photograph of the bullet cartridge bullet shaped antenna displays the trade name “Craven Speed.”

Mr. Baiz testified that he purchased a bullet cartridge shaped automobile antenna from DLT, LLC in December 2013. Baiz Discovery Dep., pp. 213-15 and Exhibit 38 (27 TTABVUE 225-27 and 29 TTABVUE 218); Respondent’s response to Petitioner’s Interrogatory No. 11, Baiz Discovery Dep. Exhibit 43 (29 TTABVUE 284).

<sup>46</sup> Lauer Testimony Dep., p. 6 (20 TTABVUE 7). Mr. Baiz testified that he learned that Metra Electronics was selling a bullet cartridge shaped automobile antenna at the 2015 SEMA Show. Baiz Discovery Dep., p. 209 (27 TTABVUE 221).

<sup>47</sup> Baiz Discovery Dep., pp. 104-05 (27 TTABVUE 105-06).

Mr. Morse who testified that DLT, LLC sold a bullet shaped antenna in May 2007. While the foundation for Mr. Morse's testimony was not fully developed, his testimony was clear and specific. *Cf. Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965) ("Oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding."). Moreover, Respondent did not take the opportunity to cross examine Mr. Morse and challenge his testimony. Accordingly, at the time Respondent filed its application to register its product design as a trademark, its use was not substantially exclusive. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 941 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.").

Even if Respondent were the first and only user of a bullet cartridge shape antenna, such use would not automatically represent that consumers recognize the shape as a trademark or that it has acquired distinctiveness. *See J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 126 USPQ 362, 364 (CCPA 1960); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1854 (TTAB 2017); *In re Mortg. Bankers Ass'n of Am.*, 226 USPQ 954, 956 (TTAB 1985); *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); *In re Meier's Wine Cellars, Inc.*, 150 USPQ 475, 475 (TTAB 1966); *In re G. D. Searle & Co.*, 143 USPQ 220, 223 (TTAB 1964), *aff'd*, 360 F.2d 650, 149 USPQ 619 (CCPA 1966).

Second, from November 3, 2010 through December 22, 2015 (the date the second Baiz declaration was signed), Respondent purportedly sold “over 44,780” bullet cartridge shaped antennas or approximately 8,950 a year generating revenues of \$508,900. Respondent did not provide any testimony or evidence to put this figure into context vis-à-vis the automotive antenna after-market to explain the significance of this figure. Because Petitioner and Respondent are spending time, effort and money litigating this cancellation proceeding, we assume that the bullet cartridge shape antenna is a commercially successful product and, therefore, that is what the sales figures represent. However, sales success is not necessarily indicative of acquired distinctiveness, but may be attributed to other factors, including the popularity of the design or Respondent offering a quality product at a competitive price. See *Cicena, Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401, 1406 (Fed. Cir. 1990); see also *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark); *Grote Indus.*, 126 USPQ2d at 1212; *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1285 (TTAB 2000) (applicant’s sales, while impressive, may only demonstrate the growing popularity of the product, not consumer recognition of the trademark).

Third, we are skeptical of the \$203,000 figure Respondent spent advertising and promoting its bullet cartridge shaped antennas<sup>48</sup> (or approximately \$40,600 per year). If Respondent has generated \$508,900 in revenues from the sales of those products (or approximately \$101,800 per year), then Respondent has spent 39.9% of the revenues on advertising. Moreover, the accuracy of advertising expenditures is undermined by Mr. Baiz's testimony that Respondent does not keep track of the advertising expenditures per product.

A. We don't have a particular method of tracking any advertising expenses. The only way we know is by the amount of money we paid either in different fees for either Facebook feeds or catalogue fees, brochure fees, employee commissions.

Q. When you look at those different fees that you just mentioned, how do you divide up those fees for the 4,000 products that you have at [Respondent]?

A. We don't divide them. We just advertise all over, across; the product, that is.<sup>49</sup>

\* \* \*

Q. So what method was used to calculate the advertising and promoting expenses on the corrected number?

A. On the corrected number, we basically used the cost of the catalogues printed, brochures printed, trade shows, employee commissions that are paid for products sold. And that's pretty much it.

Q. And it was proportioned for different products or was it the amount for all those things that you stated that was included in the declaration?

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<sup>48</sup> Baiz Decl. ¶14, December 30, 2015 Response to Office Action (TSDR 16).

<sup>49</sup> Baiz Discovery Dep., p. 97 (27 TTABVUE 98).

A. So it's across the line.<sup>50</sup>

Other gaps and inconsistencies in Respondent's trial evidence and prosecution of the application for the bullet cartridge shaped automobile antenna call the reliability of the advertising figure into question. For example,

- Enrique Baiz, Respondent's President, was unable to estimate gross profits from the sale of bullet cartridge shaped automobile antennas;<sup>51</sup>
- Mr. Baiz was unable to explain why Respondent originally listed February 13, 2015 as Respondent's first use dates other than it was a mistake;<sup>52</sup>
- Mr. Baiz was unable to explain why Respondent attested to \$36,000 in retail and wholesale sales of bullet cartridge shaped automobile antennas in his November 10, 2015 declaration attached to the November 15, 2015 Response to an Office Action other than it was a mistake;<sup>53</sup>
- Mr. Baiz was unable to explain why Respondent attested to \$3,000 in advertising and promotional expenses for the bullet cartridge shaped automobile antennas in his November 10, 2015 declaration attached to the November 15, 2015 Response to an Office Action other than it was a mistake.<sup>54</sup>

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<sup>50</sup> Baiz Discovery Dep., pp. 98-99 (27 TTABVUE 98-100).

<sup>51</sup> Baiz Discovery Dep., p. 60 (27 TTABVUE 61). Mr. Baiz also testified that Respondent does not have any "record of performance of different products ... to make business decisions." Baiz Discovery Dep., pp. 136-37 (27 TTABVUE 148-49).

<sup>52</sup> Baiz Discovery Dep., p. 92 (27 TTABVUE 93). Subsequently, Mr. Baiz explained that February 13, 2015 was the date that Respondent started selling 5½ inch bullet cartridge shaped automobile antenna. Baiz Discovery Dep., p. 129 (27 TTABVUE 141).

<sup>53</sup> Baiz Discovery Dep., pp. 94-97 (27 TTABVUE 95-98).

<sup>54</sup> Baiz Discovery Dep., p. 97 (27 TTABVUE 98).

Fourth, generalized advertising figures, as we have in this case, are usually insufficient proof of acquired distinctiveness where the promotional material does not use the design alone but instead with other marks (*e.g.*, VMS).<sup>55</sup> See *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 3 USPQ2d 1727, 1729 (Fed. Cir. 1990) (sales and advertising figures alone may not suffice where other marks were featured with the mark at issue or the growth could be attributed to the product's popularity); *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (advertising displaying the design at issue along with word marks lacked the "nexus" that would tie together use of the design and the public's perception of the design as an indicator of source); *In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967) (where a container design appeared with a word mark, any alleged association of the design with the company "was predicated upon the impression imparted by the [word] mark ... rather than by any distinctive characteristic of the container per se"); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1245 (TTAB 2015) ("It is well-settled that, where, as here, a party's advertising and sales data is based on materials and packaging in which the mark at issue is almost always displayed with another mark, such data does not prove that the mark at issue possesses the requisite degree of consumer recognition.").

Fifth, the exhibits from the SEMA Show and Respondent's catalogs and fliers display Respondent's bullet cartridge shaped antenna as just one of many products

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<sup>55</sup> At the SEMA Show where Respondent advertises its products, VMS is the most prominent mark. Baiz Decl. ¶¶15-18 and Exhibits D-K, December 30, 2015 Response to Office Action (TSDR 16-17 and 75-83); Baiz Discovery Dep., Exhibit 8 (27 TTABVUE 400-23).

sold under the VMS Racing trademark. The excerpt from a product flier reproduced below is representative of Respondent's catalogs and fliers. Respondent's bullet cartridge shaped antenna is displayed in the lower right-hand quadrant of the photograph.<sup>56</sup>



<sup>56</sup> Baiz Decl., December 30, 2015 Response to Office Action (TSDR 86).

There is nothing that highlights or emphasizes the bullet cartridge shaped antenna as anything other than a product shape. Respondent's catalogs, fliers, and eBay and Amazon postings do not create an association between the bullet cartridge shaped automobile antenna and Respondent as the source of the antenna. "When advertisements are submitted as evidence of acquired distinctiveness, they must demonstrate the promotion and recognition of the specific configuration embodied in the applied-for mark and not of the goods in general." *AS Holdings*, 107 USPQ2d at 1838; *see also In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2013 (TTAB 2008) (advertising failed to show that design feature was anything other than a component of the product); *In re Edward Ski Prods. Inc.*, 49 USPQ2d 2001, 2005 (TTAB 1999) ("While the product design may be shown on each and every advertisement, there is no indication that potential purchasers would view this as more than a picture of the goods."); *In re Pingel Enter. Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998) (advertisements show the product configuration is used solely as an illustration of applicant's product). For example, there is no "look for advertising" that directly calls attention to the product configuration in question and associates it with Respondent. "The Board and other courts have long taken notice of the importance of such advertisements in regard to configuration or product design marks." *Grote Indus.*, 126 USPQ2d at 1213 (quoting *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010), *aff'd mem.*, 2011 WL 5400095 (Fed. Cir. Nov. 9, 2011)); *see also In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 423-24 (Fed. Cir. 1985) (describing effective "look for" advertising); *In re Data Packaging Corp.*,

453 F.2d 1300, 172 USPQ 396, 398-99 (CCPA 1972) (example of effective “look for” advertising); *but cf. In re Burgess Battery Co.*, 112 F.2d 820, 46 USPQ 39, 40 (CCPA 1940) (despite some evidence that applicant used “look for” advertising, the consuming public will likely view repeating black-and-white stripes on batteries to be ornamentation and not an indicator of source). Consumers are more likely to associate VMS Racing than the product configuration as a trademark.

Finally, we do not find the customer declarations persuasive because they suffer from multiple deficiencies that vitiate their probative value on the issue of acquired distinctiveness.<sup>57</sup> We are troubled by the lack of information about the people who signed the forms and what they knew about aftermarket automobile antennas. For example,

- The statement that the declarants are familiar with parts offered by Respondent and others presumes, without expressly stating, that the declarants are familiar with aftermarket automobile antennas;

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<sup>57</sup> Form statements may be used to show acquired distinctiveness. *Florists’ Transworld Delivery Inc.*, 106 USPQ2d at 1794 n.9; *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1319 (TTAB 2011) (acknowledging that form statements may be used to show acquired distinctiveness and that they do not have to include a declaration as provided in Trademark Rule 2.20). However, the fact that they are form statements, weighed together with the other shortcomings identified below, does lessen the probative value of the statements. *See, e.g., In re Pacer Tech.*, 338 F.3d 1348, 67 USPQ2d 1629, 1633 (Fed. Cir. 2003) (Where multiple affidavits are “nearly identical,” “conclusorily worded,” “fail to explain what it is about Pacer’s adhesive container cap that is unique or unusual, or distinctive,” and “represent the views of a small segment of the relevant market,” “they are not the kind of ‘competent evidence’ that could carry Pacer’s burden of rebutting the PTO’s prima facie case.”) (citation and internal quotation marks omitted).

- The statements do not describe the conditions under which the statements were presented to the declarants or their understanding as to what they were signing;<sup>58</sup>
- The statements do not indicate whether the declarants have ever purchased an aftermarket automobile antenna or whether the declarants intend to purchase an aftermarket automobile antenna;
- The statements do not indicate whether the declarants have ever purchased a bullet cartridge shaped automobile antenna;
- The statements do not indicate that the declarants have an understanding as to whether there is a standard shape for aftermarket antenna so that a bullet cartridge shaped antenna may be perceived as unique and distinctive; and
- The statements do not indicate that the declarants perceive any automobile antenna whose shape is unique, distinctive, and readily recognizable as emanating from one source.

Respondent's universe of declarants familiar with automotive parts sold by Respondent and others is too broad. Someone who has never purchased an aftermarket automobile antenna or does not intend to purchase one in the future is not a relevant consumer. *See Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d

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<sup>58</sup> Mr. Baiz testified that some of the declarants were friends, some were customers, some were walk-in customers, and some were given the statements at car shows and meets; they were all people who had a relationship with Respondent. Baiz Discovery Dep., pp. 124-26 (27 TTABVUE 136-38). Also, Respondent sent messages through eBay to individuals who purchased products, not necessarily automobile antennas, and asked them to sign the declarations. Baiz Discovery Dep., pp. 140-41 (27 TTABVUE 152-53).

1468, 1508 (TTAB 2017) (declarations found unpersuasive where the declarants were not representative of the product purchasers); *Luzco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1493-94 (TTAB 2017) (where the goods at issue are Tequila, a survey universe comprising purchasers of hard liquor rather than purchasers of Tequila is too broad). Thus, the statements themselves lead us to question whether the statements accurately reflect the declarants' personal recollection and experience or whether they were merely signing what was put before them.

B. Whether Respondent Has Established Acquired Distinctiveness?

Because Petitioner has established a *prima facie* case that the bullet cartridge shaped design has not acquired distinctiveness, we now proceed to review the rest of the record pertaining to acquired distinctiveness, not discussed above, to determine whether, on the entire record, Respondent has established the requisite acquired distinctiveness to support registration of the bullet cartridge shape automobile antenna. *Yamaha*, 6 USPQ2d at 1004, 1010; *Grote Indus.*, 126 USPQ2d at 1211.

An excerpt from Baiz Discovery Dep. Exhibit 1, one of Respondent's catalogs (year unknown) is reproduced below.<sup>59</sup> This catalog presents the first version of the bullet cartridge shaped antenna.<sup>60</sup> The bullet cartridge shaped antenna is one of 4,000 products that Respondent sells.<sup>61</sup> The display of the bullet cartridge shape automobile

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<sup>59</sup> Baiz Discovery Dep., p. 18 and Exhibit 1 (27 TTABVUE 19 and 258-76).

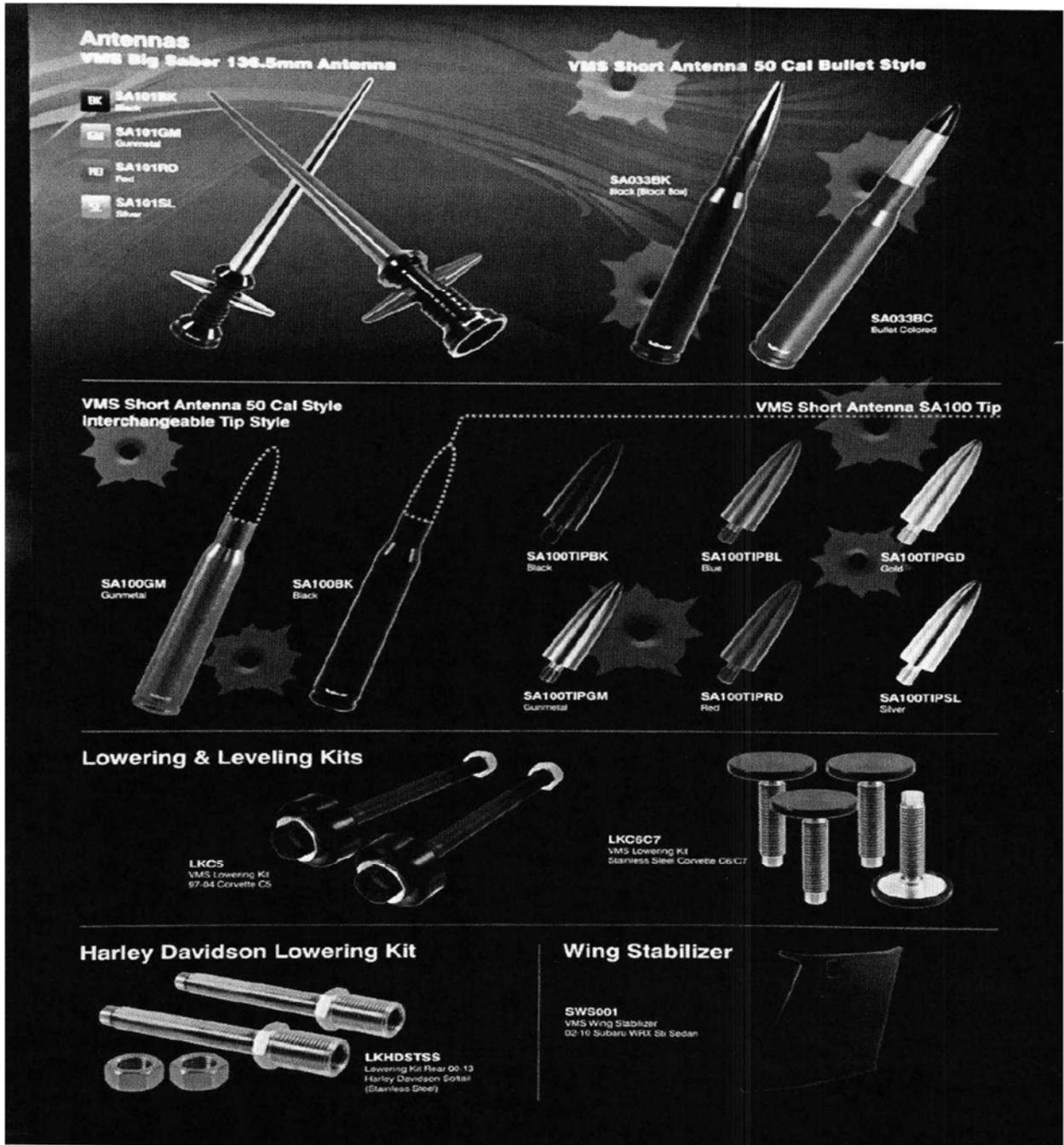
<sup>60</sup> Baiz Discovery Dep., p. 19 and Exhibit 1 (27 TTABVUE 20 and 262).

<sup>61</sup> Baiz Discovery Dep., p. 36 (27 TTABVUE 37).

design catalog entry is representative of the way Respondent has promoted its product in its catalogs and brochures.

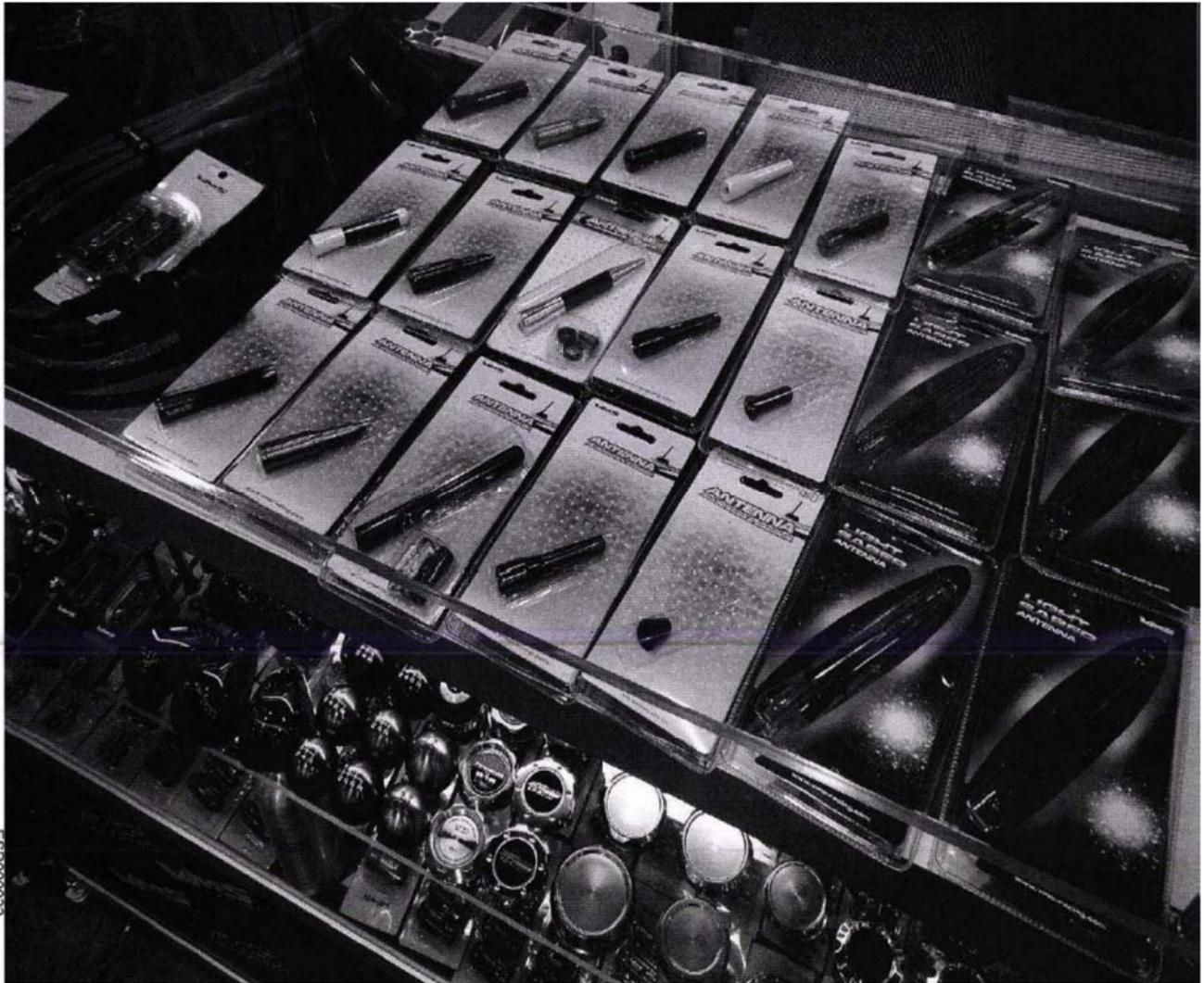


An excerpt from Baiz Discovery Deposition Exhibit 3, a catalog supplement prepared for the 2015 SEMA Show, is reproduced below.<sup>62</sup>



<sup>62</sup> Baiz Discovery Dep., pp. 31-32 and Exhibit 3 (27 TTABVUE 32-33 and 304).

Respondent's packaging for its antennas, including the bullet cartridge shaped antenna is reproduced below.<sup>63</sup> This photograph was taken at the SEMA Show. This is the typical packaging that Respondent uses.<sup>64</sup> The bullet cartridge shaped automobile antennas at issue are displayed in the second column from the left side.



<sup>63</sup> Baiz Discovery Dep. p. 74 and Exhibit 8 (27 TTABVUE 75 and 401).

<sup>64</sup> Baiz Discovery Dep., p. 75 (27 TTABVUE 76).

Respondent has never used the “tm” symbol or federal registration symbol ® in connection with the bullet cartridge shaped automobile antenna,<sup>65</sup> nor has Respondent taken any action to notify competitors that it considers the bullet cartridge shaped automobile antenna to be a trademark prior to the filing of its application.<sup>66</sup> After the registration issued, the only action Respondent has taken to notify competitors that it considers the bullet shaped automobile antenna to be a trademark is to send cease and desist letters.<sup>67</sup>

The record, viewed in its entirety, is insufficient to prove that the primary significance of the bullet cartridge shaped automobile antenna identifies the source of the automobile antenna. Respondent’s nine years of use is significant but not necessarily conclusive or persuasive considering that its mark is a product configuration. *See In re R.M. Smith, Inc.*, 734 F.2d 1482,222 USPQ 1, 3 (Fed. Cir. 1984) (eight years use was not sufficient evidence of acquired distinctiveness for the configuration of pistol grip water nozzle for water nozzles); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1766 (TTAB 2011) (16 years use not sufficient to prove acquired distinctiveness); *ic! berlin brillen*, 85 USPQ2d at 2023-24 (five years of use is not sufficient to establish acquired distinctiveness for a configuration of an earpiece for frames for sunglasses and spectacles); *Ennco Display Sys.*, 56 USPQ2d at 1286

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<sup>65</sup> Baiz Discovery Dep., pp. 85-86 (27 TTABVUE 86-87).

<sup>66</sup> Baiz Discovery Dep., p. 86 (27 TTABVUE 87).

<sup>67</sup> Baiz Discovery Dep., pp. 86-87 (27 TTABVUE 87-88).

(applicant's use of product designs ranging from seven to 17 years is insufficient to bestow acquired distinctiveness).

Respondent's sales and advertising of the product has been modest. Any sales success that Respondent has achieved is not necessarily indicative of acquired distinctiveness and may be attributed to the aesthetically pleasing product design. *See In re Bongrain Int'l (Am.) Corp.*, 13 USPQ2d at 1729 (growth in sales may be indicative of the popularity of the product itself rather than recognition of a term or design as denoting origin); *Goodyear Tire and Rubber Co. v. Interco Tire Corp. (US Pats)*, 49 USPQ2d 1705, 1720 (TTAB 1998). Moreover, because there is nothing in the way Respondent advertises or packages its product that distinguishes it from any one of the other 4,000 aftermarket automobile parts that Respondent sells, there is nothing in Respondent's advertising or packaging that would signal to consumers or competitors that the bullet cartridge shape automobile antenna is anything other than a product shape.

There is no evidence of unsolicited media coverage identifying the bullet cartridge shaped automobile antenna uniquely and exclusively with Respondent. *Van Valkenburgh*, 97 USPQ2d at 1767 ("Such publicity would have been probative that readers, authors, and others in the motorsports field identified the design of the motorcycle stand as a trademark.").

As to intentional copying as evidence of acquired distinctiveness, Respondent argues that "competitors have relentlessly tried to copy [Respondent's] Registered

Design.”<sup>68</sup> However, the record shows that consumers find the bullet cartridge shaped automobile antenna “looks cool on their vehicle” and, therefore, competitors have adopted to capture the intrinsic desirability of the design. *See Cicena, Ltd. v. Columbia Telecomms. Grp.*, 14 USPQ2d at 1406 (“Attempting to capitalize on a market demand for a type of product does not always indicate secondary meaning,” especially where the product has some “intrinsic consumer-desirability.”); *Van Valkenburgh*, 97 USPQ2d at 1768 (“Where the proposed mark is a product design, the copier may be attempting to exploit a desirable product feature, rather than seeking to confuse customers as to the source of the product.”). There is no evidence that Petitioner, or other competitors, copied Respondent’s product design to trade on Respondent’s goodwill.

In sum, Respondent has failed to meet its burden of showing that the bullet cartridge shaped automobile antenna has acquired distinctiveness.

## VI. Fraud

Because we found that Respondent has not established that its product design has acquired distinctiveness, we need not address Petitioner’s fraud claim. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

**Decision:** The petition for cancellation is granted on the ground that the purported mark has not acquired distinctiveness and the registration will be cancelled in due course.

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<sup>68</sup> Respondent’s Brief, p. 7 (37 TTABVUE 8).