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ESTTA Tracking number: **ESTTA1162618**

Filing date: **09/28/2021**

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

Petition for Cancellation

Notice is hereby given that the following parties has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Zoetop Business Co., Limited		
Entity	Corporation	Citizenship	Hong Kong
Address	19/F TAIKOO SHING, 14 TAIKOO WAN RD. RM. 112 QUARRY BAY, 0 HONG KONG		

Name	Roadget Business Pte. Ltd.		
Entity	Corporation	Citizenship	Singapore
Address	7 TEMASEK BOULEVARD #12 07 SUNTEC TOWER ONE SUNTEC, 038987 SINGAPORE		

Attorney information	CANDICE E. KIM GREENBERG TRAURIG, LLP 1840 CENTURY PARK EAST 1900 LOS ANGELES, CA 90067 UNITED STATES Primary Email: gtipmail@gtlaw.com Secondary Email(s): candice.kim@gtlaw.com, kimce@gtlaw.com 3105863867
Docket Number	178669014200

Registration Subject to Cancellation

Registration No.	5067692	Registration date	10/25/2016
Registrant	Airwair International Ltd. COBB'S LANE, WOLLASTON NORTHAMPTONSHIRE, NN297SW UNITED KINGDOM		

Goods/Services Subject to Cancellation

Class 025. First Use: 1960/00/00 First Use In Commerce: 1984/00/00 All goods and services in the class are subject to cancellation, namely: Footwear

Grounds for Cancellation

The mark is or has become generic	Trademark Act Section 14(3), or Section 23 if on Supplemental Register

The mark comprises matter that, as a whole, is functional	Trademark Act Sections 14(1) and 2(e)(5), or Section 23 if on Supplemental Register
Failure to function as a mark	Trademark Act Sections 14(1) and 1,2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 14(1) and 1,2 and 45; and Section 2(f)

Related Proceedings	Case. No. 3:20-cv-07696-SI in the United States District Court, Northern District of California

Attachments	60290899_5.pdf(207257 bytes)

Signature	/cek/
Name	Candice E. Kim
Date	09/28/2021

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

In the Matter of Registration No. 5,067,692

For the mark:
Registered: October 25, 2016

ZOETOP BUSINESS CO., LIMITED and ROADGET BUSINESSS PTE. LTD.,	)	
Petitioners,	)	Cancellation No.:
v.	)	
AIRWAIR INTERNATIONAL LTD.,	)	
Respondent.	)	

PETITION FOR CANCELLATION

Petitioners ZOETOP BUSINESS CO., LIMITED, a Hong Kong corporation, having a principal place of business of Rm. 112 19/F Taikoo Shing, 14 Taikoo Wan. Rd., Quarry Bay, Hong Kong, and ROADGET BUSINESS PTE. LTD., a Singapore company, having a principal place of business of 7 Temasek Boulevard, #12 07 Suntec Tower One, Singapore 038987 (collectively, "Co-Petitioners") believe that they have been and will continue to be damaged by the continued registration of the product design that is the subject of Registration No. 5,067,692 and hereby petition for cancellation of the same.

The grounds for cancellation are as follows:

1. Co-Petitioners operate or previously operated an e-commerce business that markets, distributes, and sells clothing and footwear products in the United States and throughout the world.

2. Upon information and belief, Respondent AIRWAIR INTERNATIONAL LTD. is a United Kingdom corporation with an address of Cobb's Lane, Wollaston, Northamptonshire, United Kingdom, NN29 7SW (the "Respondent").

3. Upon information and belief, Respondent designs, manufactures, markets, and sells footwear.

4. Upon information and belief, on or about March 14, 2016, Respondent filed a federal trademark application to register a product design consisting of "longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching, and a tab located at the top back heel of footwear" (the "Sole and Tab Design") in Class 25 for footwear. The application's drawing is shown below:

The application included a Section 2(f) claim of acquired distinctiveness based on five or more years of use. This application was assigned Ser. No. 86/939,740.

5. On October 25, 2016, with no further requirement of proof of acquired distinctiveness under Section 2(f), including proof that Respondent's alleged use had been substantially exclusive, Ser. No. 86/939,740 matured into Registration No. 5,067,692 (the "692 Registration").

6. Many years before the 692 Registration issued, on February 25, 1994, Respondent's predecessor-in-interest filed a federal trademark application to register an identical product design that "consist[ed] of longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching, and a tab located at the top back heel of footwear," *i.e.*, the same product design as the 692 Registration. This application was assigned Ser. No. 74/494,465.

7. Registration of Ser. No. 74/494,465 was refused for numerous reasons, including that the applied-for product configuration did not function as a trademark and the features of the applied-for product configuration were ornamental, functional, and not inherently distinctive. In support of said refusals, Examiners relied on, among other things, evidence of other shoes available in the market reflecting the same product design features as the applied-for product design, and there was evidence of the existence of textbooks describing similar product design features that pre-dated Respondent's predecessor-in-interest's purported first uses of the applied-for product design.

8. Ultimately, Respondent's predecessor-in-interest conceded that its applied-for product design was only entitled to registration on the Supplemental Register. Accordingly, on April 11, 2000, Ser. No. 74/494,465 matured into Supplemental Registration No. 2,341,976. On information and belief, Supplemental Registration No. 2,341,976 was assigned to Respondent between 2005 and 2008.

9. On March 27, 2007, Respondent made another attempt to register its product design on the Principal Register. Respondent filed Ser. No. 77/141,333 for a product design "consist[ing] of longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching, and a tab located at the top back heel of footwear," again, the same product design as the 692 Registration. And again, the product design was refused because the mark "consists of a nondistinctive configuration of the goods that does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source." The Examiner further concluded that the Section 2(f) claim was insufficient and requested multiple disclaimers, including disclaimer of the tab at the back of the heel and the welt stitching because these features are functional and therefore incapable of functioning as a trademark. Respondent did not file a response to this refusal, and on January 7, 2008, Ser. No. 77/141,333 was abandoned.

10. The Trademark Trial and Appeal Board should cancel the Registration for the Sole and Tab Design because i) the Sole and Tab Design is a product configuration comprising non-distinctive features under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, for which Respondent's claim of acquired distinctiveness under Section 2(f), 15 U.S.C. §1052(f), based on five years of use is insufficient because, *inter alia*, such use has never been substantially exclusive; ii) the Sole and Tab Design comprises functional trade dress under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); and iii) the Sole and Tab Design is or has become generic under Trademark Act Section 14(3), 15 U.S.C. §1064(3).

11. Registration for the Sole and Tab Design should be cancelled because it consists of a nondistinctive product design or nondistinctive product design features that are not

registrable on the Principal Register without sufficient proof of acquired distinctiveness, including, but not limited to, substantial exclusivity. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); *see* TMEP §1202.02(b)(i).

12. Respondent bears the burden of proving that its product design has acquired distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). Based on the prosecution history for the 692 Registration, Respondent claimed acquired distinctiveness under Section 2(f) based on five years' use in commerce and based on prior registrations. However, this evidence is insufficient to show acquired distinctiveness for nondistinctive product design marks such as the Sole and Tab Design. First, evidence of five years' use considered alone is generally not sufficient to show acquired distinctiveness for nondistinctive product design marks. *See*, *e.g.*, *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1467 (TTAB 2017); *see also In re Ennco Display Systems Inc.*, 56 USPQ2d at 1286 (applicant's use of the product designs ranging from seven to seventeen years is insufficient to bestow acquired distinctiveness). Second, the claimed prior registrations were either for different product design features or were never granted registration on the Principal Register, and neither they nor the 692 Registration show acquired distinctiveness because the elements of the Sole and Tab Design are highly nondistinctive.

13. Ribbing on the side of the sole edge running in the direction of heel to toe is not new or creative; it appears on numerous boots and footwear products that are currently on the

market, has appeared on boots that pre-date the first use in commerce claimed by Respondent, appears as a result of brushing off excess material resulting from the heat sealing process, and was the subject of patents and textbooks pre-dating Respondent's alleged first-use-in-commerce date for the Sole and Tab Design. Further, "dark" over "light" color bands on the sole of a shoe incorporates an infinite number of possibilities over which Respondent should not have exclusivity. It is and has always been a common design choice to use two colors on a sole, and there are only two ways to organize any such two colors – dark over light or light over dark. Indeed, even in previous iterations of its and its predecessor-in-interest's attempts to register this product design and ones similar to it, more limited rights were sought, with a claim made as to the color black with respect to what is now more broadly described as a "dark color band" in the 692 Registration. Similarly, the tab is commonly used on footwear to allow a user to pull footwear onto one's foot, and the welt stitching is commonly used to highlight the point at which the upper meets the sole and to provide increased wear or durability of the seam to which welt stitching is applied. In short, none of these features are particularly unique or distinctive in footwear design.

14. Accordingly, registration for the Sole and Tab Design should be cancelled because it is a product configuration comprising non-distinctive features under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, for which Respondent's evidence of acquired distinctiveness under Section 2(f), 15 U.S.C. §1052(f) is insufficient.

15. The Sole and Tab Design comprises functional trade dress under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).

16. The Sole and Tab is comprised of utilitarian elements common to many footwear products that are extensively manufactured, marketed, and sold in the United States and do not create a unique product design distinguishable from other footwear. Ribbing is utilitarian in that it is typically used on footwear to impart a light appearance to a thick or heavy sole and to eliminate and/or reduce the appearance of imperfections on the sole edge, both when new and as the footwear experiences wear and tear.

17. The tab is functional in that it serves a utilitarian purpose, namely, to provide a means for a user to pull the footwear onto one's foot.

18. The welt stitching is common in the industry and serves the utilitarian function of providing increased wear or durability of the seam to which welt stitching is applied.

19. Accordingly, registration for the Sole and Tab Design should be cancelled because it comprises functional trade dress under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).

20. The Sole and Tab Design is generic or has become generic under Trademark Act Section 14(3), 15 U.S.C. §1064(3). Even assuming Respondent could ever have owned any rights in the Sole and Tab Design through acquired distinctiveness, which it cannot, in view of extensive third party use of substantially similar or identical designs to the Sole and Tab Design for many years, the Sole and Tab Design has been abandoned due to the elements of the product design becoming generic. As noted above in Paragraph 13, the ribbing, two-color soles, tab, and welt stitching are common design features that have appeared on footwear products since well before Respondent's claimed first use in commerce, and that persist in the footwear market today. Indeed, it is not surprising that ribbing is a common feature, given that it is a result of the

brushing away of excess material created during the heat sealing process, or that tabs are often used on the back of all kinds of footwear for ease of pulling onto one's foot.

21. Respondent made three attempts to register the Sole and Tab Design on the Principal Register in a span of more than twenty years. During that period and for many years prior and after, countless third parties have used substantially similar or identical product design elements on footwear. Upon information and belief these third parties manufacture, market, and sell footwear that incorporate subsantially similar or identical product design elements.

22. Consumers do not view the Sole and Tab Design as an indicator of source. Rather, for designs that incorporate an identical or substantially similar Sole and Tab Design, consumers look to logos, word marks, or other distinctive trade dress design to determine the source of the goods.

23. Accordingly, the Sole and Tab Design is generic or has become generic under Trademark Act Section 14(3), 15 U.S.C. §1064(3), and should be cancelled.

24. By virtue of the foregoing, Registration No. 5,067,692 for the Sole and Tab Design should be cancelled by the Trademark Trial and Appeal Board.

25. If the 692 Registration is permitted to remain, Co-Petitioners are damaged and will continue to be damaged because the continued existence of such improper 692 Registration stands as a bar to Co-Petitioners' ability to manufacture, market, and sell products containing design features that are universal in footwear. Additionally, Respondent's 692 Registration gives Respondent an unfair competitive advantage because it grants Respondent an exclusive right to a product configuration that is nondistinctive, functional, and/or generic, and has been used on countless footwear designs across the United States for decades.

WHEREFORE, Co-Petitioners respectfully request that this Petition be granted and Registration No. 5,067,692 be cancelled on the grounds set forth above.

Date: September 28, 2021

Respectfully submitted,

By: 

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CERTIFICATE OF ELECTRONIC TRANSMISSION

The undersigned hereby certifies that a true copy of the foregoing PETITION FOR CANCELLATION is being filed electronically with the United States Patent and Trademark Office Trademark Trial and Appeal Board on September 28, 2021, through the ESTTA electronic filing system at the website http://estta.uspto.gov/.

By: