

9/23/02

This Opinion is Not
Citable as Precedent
of the TTAB

Hearing:
July 16, 2002

Paper No. 18
GFR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thomas P. Muchisky

Serial No. 75/576,465

Lionel L. Lucchesi of Polster, Lieder, Woodruff & Lucchesi,
L.C. for Thomas P. Muchisky.

Jennifer Stiver Chicoski, Trademark Examining Attorney, Law
Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Hanak, Quinn and Rogers, Administrative Trademark
Judges.

Opinion by Rogers, Administrative Trademark Judge:

By application serial no. 75/576,465, applicant seeks
registration of the design depicted below:



Ser No. 75/576,465

Applicant claims to have used the design since 1967 for goods identified as "head and cable assembly for use in conjunction with professional use massage machines." The description in the application reads: "The mark consists of the configuration of a head and cable assembly used in conjunction with professional massage machines. The head assembly consists of a circular, cup-shaped attachment on the end of a cable. The cable terminates in a reinforced plug end that connects to professional massage machines." Registration is sought under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f).

Originally, applicant identified the goods as "professional use massage machines," and the description of the design read, "the mark consists of a three-dimensional appearance of a massage assembly." The specimens of use show massage machines that include a head and cable assembly.

In her initial Office action, the examining attorney refused registration of applicant's design on the theory that applicant was seeking registration of the functional configuration of the head and cable assembly that is a part of applicant's various massage machines. However, she also acknowledged that certain functional product designs may be registered as marks if shown to have acquired

distinctiveness and, therefore, the examining attorney required the applicant to submit evidence of acquired distinctiveness. She also required an amended description of the design and, depending upon the exact nature of the portion of its goods that applicant sought to register as a mark, suggested that amendment of the drawing might be in order. Finally, she noted that the identification of goods appeared too broad because she concluded from her comparison of the drawing and specimens that applicant was seeking to register the configuration of only a portion of applicant's goods. The examining attorney therefore suggested amendment of the identification to list only that portion of the massage machines, i.e., the head and cable assembly, depicted in the drawing. The suggestion was for applicant to adopt the proposed amended identification "if accurate."¹

In the response to the Office action, applicant adopted the suggested description of the mark and the suggested identification of goods, which are those that we recited earlier in this decision. Applicant also argued against the functionality refusal and argued that his head

¹ We note that the Office action closed with the following: "If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney." The examining attorney's phone number followed her signature.

and cable assembly is an inherently distinctive design. In the alternative, applicant argued that the configuration has acquired distinctiveness; and applicant included a declaration attesting to substantially exclusive and continuous use of his mark in commerce for "more than 30 years" preceding the filing date of the application.

The examining attorney continued her refusal to register the configuration as not inherently distinctive and found the declaration of applicant to be insufficient evidence of acquired distinctiveness. Applicant submitted additional evidence of acquired distinctiveness, which the examining attorney found unpersuasive. The refusal to register the configuration, because of its asserted non-distinctiveness and lack of acquired distinctiveness, was made final. Applicant appealed. Applicant and the examining attorney have filed briefs and oral argument was held.

We must first clarify the issue on appeal, as there has been some confusion on the point. Applicant, in his responses to the examining attorney's first two Office actions (i.e., the two "non-final" Office actions) argued in the alternative that the configuration is inherently distinctive or has acquired distinctiveness. Further, in his reply brief on appeal, applicant appears to maintain

the alternative positions. However, during prosecution of the application, the United States Supreme Court issued its decision in Wal-Mart Stores Inc. v. Samara Brothers Inc., 529 U.S. 205, 54 USPQ2d 1065 (2000). That decision held that trade dress in the nature of a product design cannot be inherently distinctive and is protectible only on a showing of acquired distinctiveness. *Id.* Thus, the question whether applicant's product design is, as applicant initially argued, inherently distinctive, is not before us.

In his initial brief, applicant presented the issues on appeal as whether his configuration is "de jure functional" and [assuming it is not] whether there is sufficient evidence of acquired distinctiveness. The examining attorney, in her brief, clarified that she had not issued a de jure functionality refusal and focused her arguments solely on the evidence of acquired distinctiveness. Applicant, in his reply brief, noted a footnote in the examining attorney's brief that referred to certain elements of the head and cable configuration as de jure functional, and applicant objected to the reference. It is clear from a reading of the footnote, however, that the examining attorney did not refer to the entire configuration as de jure functional and used the footnote

for the sole purpose of explaining why she had not made final an earlier requirement that applicant submit an amended drawing showing de jure functional elements of the overall configuration in dotted or broken lining. See Trademark Rule 2.52(a)(2)(ii), formerly 2.51(d), 37 C.F.R. § 2.52(a)(2)(ii); see also, TMEP Section 807.03(a). Thus, whether the configuration of applicant's product is de jure functional is not a question before us.

The sole question on appeal is whether there is sufficient evidence of acquired distinctiveness to support registration of "the configuration of a head and cable assembly used in conjunction with professional massage machines" for goods identified as "head and cable assembly for use in conjunction with professional use massage machines." During oral argument, applicant's counsel argued, for the first time during the prosecution of the application, that the proposed mark consists not just of the head and cable assembly, but the head and cable assembly coiled or looped in the specific manner shown in the drawing. [See the reproduction at the outset of this decision.] Counsel acknowledged that the assembly does not remain in this position when used in conjunction with applicant's professional massage machines, but argued that it is always stored and displayed in this manner. The

examining attorney countered that she had not previously considered the looping or coiling of the assembly to be an aspect of the mark and noted that it is not mentioned in the mark description, which highlights the head assembly and plug end: "The mark consists of the configuration of a head and cable assembly used in conjunction with professional massage machines. The head assembly consists of a circular, cup-shaped attachment on the end of a cable. The cable terminates in a reinforced plug end that connects to professional massage machines."

Counsel for applicant suggested that he had been misled into agreeing with the mark description and identification of goods suggested by the examining attorney in the initial Office action, thereby implying that, had he not been misled, counsel would have made reference to the coiled or looped display of the product in his description of the mark. We see no merit in counsel's argument or suggestion that the description of the mark might have been stated differently had he not been misled by the examining attorney.

The description proffered by the examining attorney was prefaced by the statement that a "clear and concise description of the mark should also be included" in an application seeking registration of a product configuration

and by a statement that any such description "may be in the following form." Finally, as noted infra, applicant was invited to telephone the examining attorney with questions or if he otherwise needed assistance in responding to the Office action. We therefore consider the question of the registrability of applicant's product configuration shown in the drawing vis a vis the description of record. Thus, the particular loop or coil aspect shown in the drawing is not considered an element of the design, as it is not referenced in the description.²

Turning to the identification of goods and applicant's counsel's claim that he was misled into adopting the suggestion of the examining attorney, we also see no merit in this contention. As we have already noted, applicant was invited to consider adopting the identification suggested by the examining attorney, if the identification was accurate. Accordingly, the question we must resolve is whether applicant has demonstrated that his cable and head

² At the oral hearing, the examining attorney noted that the particular loop or coil shown in the drawing is not, in any event, shown in the specimens. In the drawing, the plug end of the assembly is perpendicular to the head end and is pointing at the head end. In the depictions in the specimens, the plug end is turned 90 degrees and is inserted into a massage machine, so it does not point toward the head; or the plug plugs into a massage machine and ends up parallel to the head end, not perpendicular to it.

assembly has acquired distinctiveness as a mark for such assemblies, not for entire professional massage machines.

The Supreme Court has explained that "consumer predisposition to equate [product design] with the source" of the product "does not exist," and that "even the most unusual of product designs" is intended to render the product more appealing, not to identify source. *Wal-Mart*, supra, 54 USPQ2d at 1069. It is against this backdrop that we must consider applicant's evidence of acquired distinctiveness. Moreover, it is applicant's burden to prove acquired distinctiveness. Yamaha International Corporation v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); In re Meyer & Wenthe, Inc., 267 F.2d 945, 122 USPQ 372 (CCPA 1959). As this Board has noted, the burden of showing acquired distinctiveness in a product configuration is significant. See In re Gibson Guitar Corp., 61 USPQ2d 1948, 1951 (TTAB 2001); and In re Ennco Display Systems Inc., 56 USPQ2d 1279, 1283-84 (TTAB 2000).

The evidence of acquired distinctiveness includes the declaration of applicant, in which applicant attests to more than 30 years of substantially exclusive and continuous use in commerce prior to the application filing date and contends that the head and cable assembly "is

recognized in the trade and by consumers of the goods sold by companies owned by Applicant, i.e., eccentric-head, cable-driven massage machines, as being the trademark of GPI and PGF (including acquisitions thereof) and denoting goods of GPI and PGF (including acquisitions thereof)." In addition, when responding to an Office action, counsel reported that applicant's "predecessor in interest used the same mark for at least an additional ten (10) years."³

Counsel also has asserted that applicant had more than \$2 million in annual U.S. sales for each of the four years from 1995 through 1998 and more than \$3 million in sales in 1999; and that applicant spent an average of \$129,000 per year on print and convention advertising in the U.S. for each of the years from 1995 through 1999, ranging from a low of \$107,000 in 1997 to a high of \$159,000 in 1999.⁴

³ GPI and PGF are acronyms for companies for which applicant states he is CEO and majority shareholder. The examining attorney has not questioned applicant's reference to the head and cable assembly as "the trademark of GPI and PGF" and as denoting the goods of those companies, rather than as the trademark of applicant. In addition, there is nothing in applicant's declaration or anywhere else in the record that reveals the existence of a predecessor to applicant; and counsel does not, in his brief, make further mention of a period of 10 years use by a predecessor. Thus, we have discounted this reference.

⁴ Counsel's report of these figures does not specifically state that the advertising expenditures were in the U.S., but the figures follow the report of U.S. sales and precede the report of worldwide sales. Also, in applicant's brief, the sum of a second set of advertising figures is referenced as the total for worldwide advertising. Thus, the first set of advertising

Finally, applicant relies on exhibits he submitted, specifically copies of brochures or advertisements for applicant's massage machines, and on reprints of pages from the World Wide Web that the examining attorney made of record.⁵ Applicant contends that these "clearly demonstrate that persons in the trade promote their devices by depicting the goods." Also, applicant contends that much of his advertising and that of his distributors is "'image advertising' that features Applicant's mark" and, therefore, discriminating, professional purchasers would undoubtedly recognize applicant's head and cable assembly as an indication of source.

The examining attorney, in contrast, notes that none of applicant's advertising promotes the look of the head and cable assembly of applicant's professional massage machines as a mark for the head and cable assemblies or, for that matter, the machines themselves. It is the examining attorney's contention that the photographs of applicant's goods will be viewed by consumers as nothing more than that and "[do] not aid potential purchasers in

figures has been considered as the set of U.S. figures and the second set of advertising figures as the worldwide figures.

⁵ The World Wide Web pages include reprints of advertisements for, or descriptions of, various types of cables, and various types of massage units, most apparently for personal use, but some apparently considered "professional" models.

understanding the significance of the head and cable assembly design as a trademark." We agree. See, in this regard, *Gibson Guitar*, supra, 61 USPQ2d at 1952 (Board was not persuaded that consumers would understand from photographs that the guitar configuration was meant to be a source-identifier); see also, In re Edward Ski Products Inc., 49 USPQ2d 2001, 2005 (TTAB 1998).⁶

We also agree with the examining attorney that the absence of any affidavits or declarations from distributors, purchasers or users of applicant's goods undermines applicant's contention that the head and cable assembly has become recognized as a mark indicating applicant as the source of head and cable assemblies for professional massage machines. It is not sufficient that applicant intend that consumers identify the product configuration with applicant; it is the actual recognition

⁶ We also note, in regard to the photographs of applicant's products, that the head and cable assemblies shown do not match the precise contours of the assembly shown in the drawing, insofar as the drawing shows a cable of uniform diameter between the head and plug ends, while the photographs show cables with varying diameters, specifically, cables with thicker sections near the head and plug ends. The examining attorney did not raise any question about whether the drawing is a substantially exact representation of the design shown in the specimen photographs and nor do we. However, the difference suggests that applicant may vary the type of cable he uses in manufacturing his product. Varying the contours of the product would, we believe, tend to make it less likely that consumers of applicant's product have come to recognize a particular design of the assembly as a mark.

by consumers that is significant. Cf. *Edward Ski Products*, supra, 49 USPQ2d at 2005, where declarations from distributors who would be expected to know source of products bought for resale were discounted as evidence of acquired distinctiveness and there were no declarations from ultimate purchasers.

Turning to the sales and advertising figures, the record provides no context in which to assess this evidence. We have no indication of the size of the market for professional massage machine head and cable assemblies. Moreover, we have no information about the nature or frequency of the conventions that applicant attends and no information about the reach of applicant's advertising. Thus, the weight to be accorded applicant's sales and advertising figures is limited. See *Gibson Guitar*, supra, 61 USPQ2d at 1952 (no information provided to assess applicant's relative position in the marketplace).

In his brief, counsel asserts that applicant's declaration of more than 30 years of substantially exclusive and continuous use of the head and cable assembly "is sufficient to support registrability." We disagree. The mere fact that a product has been on the market for a long period of time may be solely attributable to the value of the product and does not, per se, indicate any

Ser No. 75/576,465

recognition of the design of the product as indicating the producer rather than the product. See Braun Inc. v. Dynamics Corp., 975 F.2d 815, 827, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) (“[L]arge consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun.”); see also, *Ennco*, supra, 56 USPQ2d at 1283 (TTAB 2000) (burden on applicant attempting to show acquired distinctiveness is to show that primary significance of design has become identification of the producer).

Decision: The refusal of registration of applicant's product design as a functional configuration devoid of acquired distinctiveness is affirmed.