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April 14, 2005
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pacific Market, Inc.

Serial No. 75445415

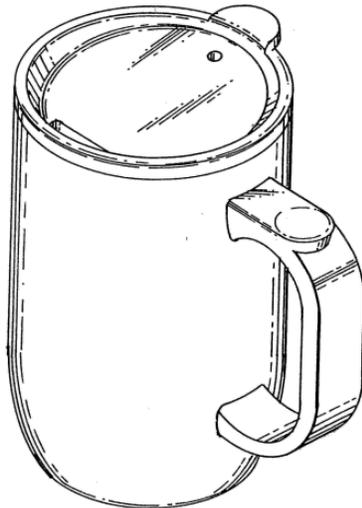
Michael J. Folise of Seed Intellectual Property Law Group
PLLC for Pacific Market, Inc.

Shari L. Sheffield, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Pacific Market, Inc., seeks registration on the
Principal Register of the product design shown below:



for goods identified in the application, as amended, as "drinkware, namely, thermal insulated beverage containers," in International Class 21.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this product design based upon the ground that applicant has failed to demonstrate that this matter has acquired distinctiveness as a source indicator.²

¹ Application Serial No. 75445415 was filed by Pacific Market, Inc. on February 28, 1998 based upon applicant's allegation of first use in commerce at least as early as April 15, 1996. The application states that the lining shown in the image is merely to indicate shading. Applicant has also amended the application to include a claim of acquired distinctiveness for this product design.

² During much of the prosecution of this application (e.g., Office actions dating from November 1998 through April 2003), the Trademark Examining Attorney took the position that this matter is barred from registration inasmuch as it is a *de jure* functional configuration under Sections 1, 2 and 45. However, in the final refusal, she explicitly withdrew *de jure* "functionality" as a continuing basis for refusal (Office action of September 2003).

At one point in the prosecution, she also took the position that this design is absolutely barred from registration under Sec. 2(e)(5) of the Lanham Act as amended (Office action of May 2003). However, as noted by applicant (response of June 2003), Lanham Act Section 2(e)(5) applies only to applications filed after October 30, 1998. Technical corrections to Trademark Act of 1946 (TCTA), Pub. L. No. 105-330, Section 201(b), 112 Stat. 3064 (1998). Given the filing date of this application (February 28, 1998), the Trademark Examining Attorney then dropped that statutory ground, reverting again to the refusal of this design as being a non-distinctive configuration under Sections 1, 2 and 45 of the Lanham Act (Office action of September 2003).

Applicant and the Trademark Examining Attorney submitted briefs. Applicant did not request an oral hearing.

We affirm the refusal to register.

Applicant argues that the evidence of record is sufficient, according to a preponderance of the evidence, to sustain applicant's claim of acquired distinctiveness. In re Motorola Inc., 3 USPQ2d 1142 (TTAB 1986). By contrast, the Trademark Examining Attorney argues that applicant's evidence of acquired distinctiveness is insufficient to make a *prima facie* showing that the relevant consumers understand this design to be a source identifier.

The Supreme Court has recently stated 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 Stores, Inc. v. Samara Brothers, Inc., 120 S.Ct. 1339, 146 L.Ed.2d 182, 54 USPQ2d 1065, 1069 (2000). It is against this backdrop that we must consider applicant's claim 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 the Board has noted, the burden of showing acquired distinctiveness in a product configuration is significant. See In re Gibson Guitar Corp., 61 USPT2d 1948, 1951 (TTAB 2001); and In re Ennco Display Systems, Inc., 56 USPQ2d 1279, 1283-84 (TTAB 2000).

The evidence of acquired distinctiveness rests largely on the declarations of two of applicant's employees.³

First, applicant's product manager of drinkware, Tami Fujii, states that "[o]ur customers for this product includes Starbucks Coffee Company," and that an attached sampling of "catalog pages from competitive companies selling competitive products" demonstrates that "a wide

³ Although the record contains a declaration prepared by applicant's counsel on March 24, 1999, evidently intended to be executed by Ken Mooney, product manager for Starbucks Coffee Company (applicant's largest single distributor of this product), a signed copy of this declaration was never made a part of the record, and so we have not considered the contents of this document. We should hasten to add that even if we had treated this declaration as having been properly executed, it would add nothing of significance to the record beyond that of the Fujii and Styles declarations, *infra*, and hence, would not change the result herein.

variety of product shapes and configurations are available for insulated drinkware," and that "[a]ll of the products are substantially similar in terms of manufacturing cost and thermal efficiency." Ms. Fujii's declaration goes on to state, as follows:

6. Pacific Market, Inc. is in the business of providing its customers with unique, identifiable products. The product configuration, which is the subject of the above trademark application, was specifically designed with the concept of providing our customer with a product identity based on the external appearance of the product configuration. That is, the product was specifically designed with the intention that it be a distinctive design in the market place. As is apparent from a comparison of the designs shown in Group Exhibit A and the subject product design, the subject design is unique and readily identifiable due to its distinctive appearance.

Second, applicant's director of project/product management, Rowena Styles, states as follows:

3. The design for which the Applicant has applied for registration consists of the external appearance of a beverage container having a substantially cylindrical smooth sided main body and reduced diameter tapering foot portion.
4. Our customers for this product have included Starbucks, Target Stores, Seattle's Best Coffee, and six others.
5. Exhibit A attached hereto consists of a page from the Target 1999 holiday

catalog (page 85 thereof) in which the product is shown advertised therein. This catalog has nationwide distribution.

6. The product, which is the subject of this product configuration trademark registration application, has an unusual shape and is not similar to any of the other shapes for insulated drinkware that I am aware of.
7. The Applicant, Pacific Market, Inc., has sold over 153,222 products shown in the drawings for this trademark application since at least as early as April 15, 1996, more than five years prior to the date of this declaration.

Although applicant's employees, in their declarations, conclude that this mug is "unique," "unusual" and "distinctive," we clearly do not find this configuration to be inherently distinctive. In fact, the involved beverage container appears to have a fairly traditional shape. The individual features mentioned by applicant as comprising the overall design (e.g., the smooth, cylindrical body having a reduced diameter tapering foot portion) are functional and fairly unremarkable.

Moreover, the record includes no evidence that this shape is recognized in the trade and by the ultimate consumers of the goods sold by applicant as being the trademark of Pacific Market, Inc. We agree with the

Trademark Examining Attorney that the absence of any affidavits or declarations from the purchasers or ultimate users of applicant's goods undermines applicant's contention that the configuration of this beverage container is recognized as a source indicator for this line of drinkware.

Turning to the duration and volume of applicant's use of this product configuration, it is clear that applicant had been marketing this insulated travel mug for less than two years at the time it applied for the instant registration. In the five-year period prior to Ms. Styles' declaration of July 2001, applicant had sold more than 150 thousand of these beverage containers to customers through distributors such as Target Stores, Starbucks Coffee, Seattle's Best Coffee, and others. However, in providing a raw figure delineating the asserted volume of sales, applicant fails to provide any context in which to assess this number. For example, if we were to permit ourselves to conjecture about the size of the market in the United States for insulated travel mugs, marketing 150 thousand insulated travel mugs over a period of five years does not seem that significant. Thus, the weight to be accorded applicant's sales figures

is most limited. See Gibson Guitar, *supra*, 61 USPQ2d at 1952 (no information provided to assess applicant's relative position in the marketplace).

However, even if we should be willing to find this volume of sales as representing a significant volume, the mere fact that a product has been on the market for five years and applicant can attest to the sale of tens-of-thousands of mugs during each of these years, this success may be solely attributable to the value of the product and does not, *per se*, indicate any 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).

As to applicant's alleged promotion of this product design, the Trademark Examining argues that applicant has failed to submit copies of any advertisement placed by

applicant specifically promoting the overall look, the shape or the styling of applicant's beverage container as a mark for its drinkware. It is the contention of the Trademark Examining Attorney that the photographs of applicant's beverage containers will be viewed by consumers as nothing more than that. We agree. See 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); and In re Edward Ski Products Inc., 49 USQP2d 2001, 2005 (TTAB 1998).

It is not sufficient that applicant intends that consumers identify the product configuration with applicant; it is the actual recognition 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.

There is absolutely no information in this record about the amount of money that applicant has expended on the promotion of this design - if indeed, there has been any such advertising.

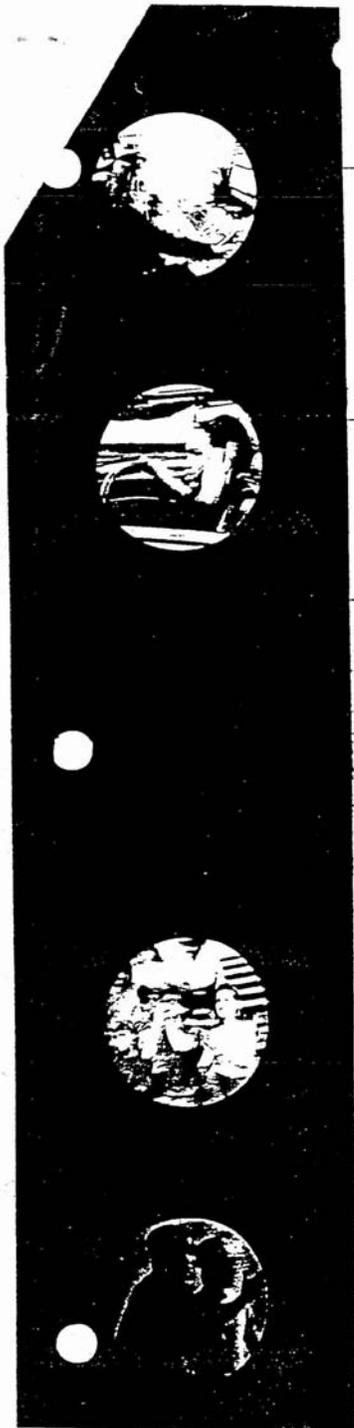
In the face of the Trademark Examining Attorney's criticisms that there is no evidence of any "look-for" advertisements, applicant argues in its brief that some tribunals "have found that trade dress can be recognizable even when the advertising does not specifically tell a consumer to look for it." Applicant's brief, p. 7. Furthermore, applicant argues that "applicant's advertisement of its Cafe Desktop beverage container as having a unique and distinctive shape in comparison with other beverage containers is more than adequate to meet the threshold of 'look for' advertising required by the courts." *Id.* at 8. We disagree. Rather, we find it most damaging to applicant's position herein that there is nothing in the record promoting the look, shape or styling of this product design.

For example, the point of sale display attached to the Styles declaration shows the outline configuration of a variety of different stainless steel beverage containers (e.g., Bodum® coffee presses, carafes and pots on the left two-thirds of the page and applicant's MiGo® coffee cups and mugs on the right third of the page). Although it is most difficult to read all the text on the photocopy of this graphic display, as far as we can discern, in

describing applicant's MiGo® cups and mugs, the text merely mentions the drink capacity of the containers, the double wall insulation and the spill-resistant lids. Styles declaration, Exhibit A, comprising a copy of page 85 of a Target stores holiday catalogue of 1999. In fact, the text and the images of this advertisement are fairly consistent with those shown in the print advertisements of applicant's competitors.⁴ Fujii declaration, Exhibit 2.

Another exhibit in the record is a product brochure card entitled "PMI Stainless Drinkware" (unverified, but attached to applicant's response of July 7, 2000). This brochure pictures in relief seventeen different cups, mugs, tumblers, bottles and carafes apparently produced by applicant. The involved container (which we have circled, *supra*) comprises one small image of an undistinguished mug, labeled "Cafe Mug 12 oz.":

⁴ Competing mugs appear to be made of combinations of stainless steel (with or without rubber grips), often with rubber bases or "footpads," or made of glass, molded thermoplastic, stoneware, and/or porcelain, being either vacuum or non-vacuum in design, having soft lids that press into place or screw-on metal lids, some having a handle and others without. They appear to be formed in a variety of different shapes and sizes.



PMI STAINLES[®] DRINKWARE

- Unique seals on both press-on and screw-on lids provide a leak-proof fit
- Durable, corrosion-resistant 18.8 gauge stainless steel
- Precision welded and burnished rim for a quality finish that's obvious at a glance
- Recessed non-skid footpads
- Lifetime warranty

DOUBLE WALL CONSTRUCTION

- PMI's double-wall, non-vacuum products reflect the same advanced design, superior workmanship and meticulous attention to detail.



Camp Cup
12oz.



Camp Cup
16oz.



Cafe Mug
12oz.



Cafe Mug (Rubber Bottom)
12oz.



Chubby
12oz.



Square Traveler
14oz.



Bell Traveler
12oz.



Ethel Traveler
16oz.



Teardrop Traveler
16oz.

DOUBLE WALL VACUUM CONSTRUCTION

- Precision vacuum chamber - from top to bottom - maximizes the insulation capability and eliminates hot spots.
- Our low heat vacuuming process creates an extraordinary durable stainless product.
- Inside liner is copper-coated - greatly enhancing temperature retention. Hot drinks stay hotter; cold drinks stay colder.
- A unique tablet absorbs excess gasses, creating a much better vacuum with higher thermal qualities.
- Precision metal threads - formed into the body - create a superior leak-proof seal between lid and cup.



Rocket Tumbler
16oz.



Tapered Tumbler
12oz.



Ethel Tumbler
16oz.



Teardrop Tumbler
16oz.

BOTTLES



1 Liter



Carafe

By way of contrast with the "Cafe mug," we note that several other styles of beverage containers on this page

actually have names that do call slight attention to their styling or shape (e.g., Chubby, Teardrop Traveler, Tapered Tumbler, etc.). However, even that small claim of distinction is absent from the "Cafe Mug."

Although the small print right above this row of cups and mugs contains puffery about applicant's "advanced design," this is a general statement applied to all of its beverage containers. As far as we can see, the unique shape alleged by applicant throughout the prosecution of this application is nowhere mentioned in this brochure.

In support of registrability herein, applicant has pointed repeatedly to the case of In re Motorola Inc., supra.



However, we find that the instant case is easily distinguished factually from the Motorola case:

- In Motorola, the Board found that there appeared to be a wealth of existing microphone designs, and that Motorola had demonstrated convincingly with its submission of photographs that its hand-held microphones were substantially different in size, shape and contour from the competing products on the market. As noted

above, we find that applicant herein has provided examples of several mugs marketed by applicant's competitors having a similar look, shape or style.

- Motorola had a detailed word description of how its microphone was unique - how it differed from those of competitors.⁵ Apart from a generalized and rather vague description of a smooth, cylindrical body having a reduced diameter, tapering foot portion (characteristic of a number of competing travel mugs), it is not clear what combination of unique features applicant is really claiming as its protectable design.⁶

⁵ "... an essentially oviolate, or egg-like, overall configuration, devoid of any substantial straight lines, flattened somewhat on the top side, and which further includes a contrasting grille structure in the form of differing truncated arcuate members, a portion of which protrudes outwardly and downwardly petal-like from the front side thereof." *Id.* at 1143,

⁶ In addition to those individual features named by applicant in its responses and brief submitted during the prosecution of this application, the drawing shows prominently the lid and handle. As noted earlier, however, the unremarkable nature of the overall shape of this product creates a most challenging burden on applicant to demonstrate acquired distinctiveness.

Furthermore, should applicant be issued a registration for the involved product design, the failure of applicant to enumerate specifically the exact combination of features that it claims comprise its mark could itself hinder competition given the uncertainty competitors may face in designing a non-

- In spite of the fact that a hand-held microphone retails for much more than a travel mug, affidavits in the Motorola case attested to sales of three million units over a period of almost twenty-five years. Applicant has alleged sales of 150 thousand travel mugs over a period of five-year.
- Motorola submitted declarations of individuals involved in the repair, installation, and servicing of two-way radio equipment, individuals involved in the offering of mobile telephone services, as well as the declarations of users of applicant's radio equipment. All of these declarations demonstrated that Motorola's configuration had become distinctive of its radio apparatus. Here, we have the declarations of two of applicant's employees - both immersed in managing this particular product. The record is devoid of any affidavits or declarations from

infringing product. Cf. In re R.M. Smith, Inc., 734 F.2d 1482, 1484, 222 USPQ 1 (Fed. Cir. 1984).

Certainly, if applicant should ultimately prevail herein, it is recommended that it amend this application to set forth clearly and in detail what it is applicant is claiming as its mark. See In re Sandberg & Sikorski Diamond Corp., 42 USPQ2d 1544, 1545 n. 1 (TTAB 1996).

distributors, purchasers or the ultimate users of applicant's goods.

- Twenty-five years of Motorola's promotional materials prominently featured applicant's microphone configuration. Here, we find no prominent usage of the claimed configuration in a way that would predispose potential consumers to associate the shape of the mug with a single source of the goods.

Decision: The refusal to register applicant's design as a product configuration devoid of acquired distinctiveness is hereby affirmed.