

CITABLE AS PRECEDENT

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Benetton Group S.p.A.

Serial No. 74/325,713

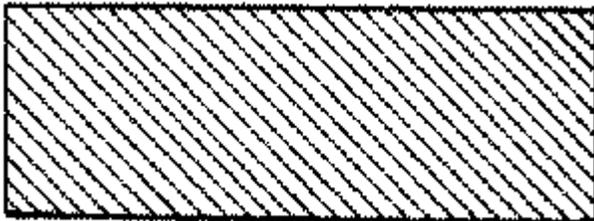
Herbert Dubno of Karl F. Ross P.C. for applicant.

Teresa Rupp, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Benetton Group S.p.A.
to register the mark shown below



for "clothing articles and footwear, namely, shirts,
blouses, sweaters, cardigans, pullovers, sweatshirts,
undershirts, lingerie, dresses, suits, skirts, pants,

shorts, trousers, culottes, pantsuits, hats, scarves, afghans, stockings, socks, slippers, sandals, shoes, boots, kerchiefs, coats, jackets, and gloves.”¹ Applicant claims that the mark has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act. The application includes the following statements: “The drawing is lined for the color green. The mark consists of a horizontal green rectangle used as a background for a variety of words and designs.”

The Trademark Examining Attorney has refused registration pursuant to Sections 1, 2 and 45 of the Act on the ground that the matter sought to be registered does not function as a trademark to distinguish applicant’s goods from the goods of others.²

¹ Application Serial No. 74/325,713, filed October 26, 1992, based on the filing of an application to register the mark in Italy. The foreign application matured into Italian Registration No. 652,897 on June 7, 1995.

² The bulk of the briefs addresses the issue on appeal. However, the Examining Attorney’s final refusal and appeal brief include remarks directed to the alleged de jure functionality of the mark sought to be registered. That is to say, the Examining Attorney essentially posits that the green rectangle design is functional because there is a competitive need to use the same design, which, according to the Examining Attorney, is borne out by the evidence showing that others in the clothing industry use a green rectangle as background for their word and/or design marks. To the extent that the Examining Attorney’s refusal encompasses a functionality refusal, the refusal is not well taken. Suffice it to say that the evidence of record bearing on the utility of green rectangle backgrounds does not persuade us in the least that the applied-for mark is de jure functional. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994), cert. denied 115 S.Ct. 1426 (1995).

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs, and applicant's counsel and the Examining Attorney appeared at an oral hearing before the Board.

Applicant contends, in urging that the refusal be reversed, that its green rectangle design has become distinctive, indicating to an ultimate purchaser that goods bearing the design originate with applicant. Applicant asserts that there is nothing functional about its design, and that while it is not alone in the clothing industry in using a green rectangle as a background for a word or design, applicant is the only one whose background has acquired distinctiveness as a source identifier. Applicant acknowledges that "[it] has not submitted any evidence that it uses, promotes or advertises its green rectangle without one of the BENETTON marks thereon." (brief, p. 11) Applicant goes on to claim, however, that "over the many years of selling BENETTON clothing with green rectangular tags bearing the name BENETTON and/or a BENETTON logo that customers have now recognized the green rectangle per se as indicative of BENETTON." (brief, p. 11)

In support of its position, applicant submitted two declarations (one with related exhibits) of its president, Gilberto Benetton. Applicant also submitted twenty-seven

form statements from individuals attesting to the distinctiveness of the matter sought to be registered.³

The Examining Attorney maintains that the matter sought to be registered does not function as a trademark and, thus, is not registrable, citing Sections 1, 2 and 45 of the Trademark Act. The Examining Attorney also maintains that if the involved matter is found to be capable of functioning as a trademark, then the evidence of acquired distinctiveness is insufficient for purposes of registration. In support of this position, the Examining Attorney points to the evidence which she submitted showing that others in the clothing trade use green rectangles as backgrounds for their word and/or design marks. In this connection, the Examining Attorney made of record actual labels, photographs of labels and labels on clothing items as shown in catalogs. The labels are, for the most part, rectangular in shape and green in color.

Although applicant has characterized this appeal as "a case of first impression" (brief, p. 12), we view this case as similar to prior cases involving the registrability of a background design as a separate mark. See: 1 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §§7:26-7:29 (4th ed. 1997).

³ It is noted that one individual signed three statements, and that two other individuals signed two statements each. Thus, the

Where, as here, an applicant seeks to register a background design that is used in connection with a word and/or design mark, that background design may be registered as a trademark only if it creates a commercial impression separate and apart from the word and/or design mark in conjunction with which it is used. In re Anton/Bauer Inc., 7 USPQ2d 1380 (TTAB 1988). If the background design is inherently distinctive, it may be registered without evidence that it is recognized as a trademark; if it is not inherently distinctive, then proof of acquired distinctiveness as provided under Section 2(f) is required. In re E.J. Brach & Sons, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958). In particular, common geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as backgrounds for the display of word marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the background design alone. In re Anton/Bauer Inc., supra at 1381. In this connection, Professor McCarthy has observed the following:

Most common geometric shapes are regarded as not being inherently distinctive, in view of the common use of such shapes in all areas of advertising. Thus, such ordinary shapes as circles, ovals, squares, etc., either when used alone or as a background for a

number of individuals signing the twenty-seven statements is twenty-three.

word mark, cannot function as a separate mark unless (1)the shape is likely to create a commercial impression on the buyer separate from the word mark or any other indicia and (2)the shape is proven to have secondary meaning--that is, consumer recognition and association between the shape alone and the seller. The policy behind this rule seems clear: no one seller should be allowed to appropriate such commonplace shapes as circles, squares, and ovals and claim only he can use such a shape as a background for his word mark. The rationale is that such designs have been so widely and commonly used as mere decorative graphic elements that the origin-indicating ability of such designs has been diminished.

McCarthy on Trademarks and Unfair Competition, supra at §7:29.

The fact that applicant's rectangle is green does not change the standard by which these types of marks are judged. We find that applicant's green rectangle falls into the category of a background design requiring proof of acquired distinctiveness for purposes of registration.

In the present application, applicant has claimed that the background design it seeks to register has become distinctive through use in commerce and has made a claim to that effect under Section 2(f). As noted above, applicant submitted the declarations, along with related exhibits, of Gilberto Benetton, and the form statements of twenty-three individuals.

Mr. Benetton declares that the mark sought to be registered has become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce for the five years prior both to the filing of the application and to the filing of the claim of distinctiveness. More specifically, Mr. Benetton asserts that the mark sought to be registered has been used in commerce with the United States on clothing since 1980. Mr. Benetton further states that "he is not aware of any use of the green rectangle by others as a trademark for goods in international class 25 and does not believe that any other legal entity has the right to claim trademark use of the green rectangle of the same or a similar color as a trademark." One of the two declarations is accompanied by advertising materials (numbering about twelve, two of which are for cosmetics) showing use of the green rectangle as a background for BENETTON, the BENETTON logo and UNITED COLORS OF BENETTON in connection with clothing.⁴

Applicant's form statements of twenty-three individuals are identical and read as follows:

The undersigned, under the penalties of perjury, DECLARES: that he/she is a customer of a Benetton retail

⁴ We note that some of the advertisements show the green rectangle background with rounded corners. Others show the green rectangle with rounded corners and a white border. These uses are to be contrasted with the specific mark sought to be registered showing a rectangle with straight corners and no border.

establishment and is familiar with Benetton trademarks including the name Benetton, the Benetton logo and the United Colors of Benetton, all on green rectangles;

That he/she recognizes the green rectangle as representing Benetton and has come to associate the green rectangle as indicative of Benetton as a source of products bearing marks containing the green rectangle; and

That he or she recognizes that the green rectangle without words or symbols indicates Benetton Group S.p.A. as the source of goods associated with that green rectangle in promotional literature or as labeling on goods.

The evidence of distinctiveness offered by applicant is insufficient to persuade us that the green rectangle design, used solely as a background for applicant's word and/or design marks, has become recognized as a trademark for the clothing items to which the green rectangle design is applied. In the present case, although applicant's use in the United States of the green rectangle dates back to 1980, no sales or advertising figures have been provided. Further, applicant itself concedes that the record is devoid of any evidence of applicant's use, promotion or advertisement of the green rectangle without one of the BENETTON marks thereon. Moreover, there is nothing in the record to show that applicant has called attention to its green rectangle per se or otherwise has promoted this background design in a way that would set the design apart

from the word and/or design mark for which it serves as a background.

The form statements of twenty-three individuals, although entitled to probative weight, do not carry the day for applicant. Generally speaking, the Board has no problem with form statements. In re Petersen Manufacturing Co., 229 USPQ 466 (TTAB 1986). See also: In re Data Packaging Corp., 453 F.2d 1300, 172 USPQ 396 (CCPA 1972); and In re Schenectady Varnish Co., 280 F.2d 169, 126 USPQ 395 (CCPA 1960). However, in the present case, in the absence of some basic background information about the individuals and their experience with applicant, it is difficult to gauge the probative value of the statements. The statements would have been more helpful in this particular case if they had included facts such as the length of time that the individuals were customers of applicant, or the frequency of the individuals' purchases from applicant, or the individuals' degree of familiarity with applicant or with the clothing industry and practices of other manufacturers of clothing. See, e.g.: In re Schenectady Varnish Co., supra ["We have been customers...for twenty years...."]. Also, given the nature of applicant's services, the statements of twenty three individuals do not establish an association of the green rectangle design with a single source by other than an extremely small number of the

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purchasing public. See: In re Soccer Sport Supply Co., 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975).

Further, applicant, by its own admission, does not use the green rectangle per se, and, as far as the record shows, the individuals never saw the green rectangle without one of applicant's marks appearing thereon, or had called to their attention the green rectangle background design. It is not unreasonable to assume, therefore, that the individuals' association of the green rectangle background design with applicant was predicated upon the impression conveyed by the BENETTON marks appearing thereon rather than by any distinctive characteristic of the green rectangle per se. In re Mogen David Wine Corporation, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967). In point of fact, as shown by the evidence submitted by the Examining Attorney, applicant is not alone in using a green rectangle background design. Others in the clothing industry (such as J. CREW) use green rectangles as background designs for their word and/or design marks. See: Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939, 941-42 (Fed. Cir. 1984), aff'g 219 USPQ 1205 (TTAB 1983). Simply put, the statements are outweighed by the other evidence of record.

In sum, applicant's use of the green rectangle solely as a background design, and the statements from an extremely small number of the purchasing public are simply

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insufficient facts for us to conclude that applicant's background design has come to be recognized as a trademark for clothing. Distinctiveness means that the primary significance of the green rectangle design for clothing is as a designation of source rather than as a mere background to the presentation of applicant's BENETTON marks. *Roselux Chemical Co. et al. V. Parsons Ammonia Co., Inc.*, 229 F.2d 855, 132 USPQ 627 (CCPA 1962). Applicant has failed to show that its green rectangle background design functions primarily as an indicator of source.

Decision: The refusal to register is affirmed.

R. F. Cissel

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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