

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      MAY 3, 1999

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Michael Khadivar

---

Serial No. 74/551,771

---

Robert S. Beiser of Michael, Best & Friedrich, LLP for  
Michael Khadivar

Kathleen M. Vanston, Trademark Examining Attorney, Law  
Office 103 (Michael Szoke, Managing Attorney)

---

Before Seeherman, Chapman and Bucher, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Michael Khadivar has appealed from the final refusal  
of the Trademark Examining Attorney to register the  
asserted mark shown below:

Ser. No. 74/551771

for an "AM/FM audio cassette player."<sup>1</sup> The application includes the following description of the mark: "The mark consists of a three-dimensional configuration of an AM/FM cassette player." The application was originally based on a bona fide intention to use the mark in commerce. The asserted mark was published for opposition on August 22, 1995. A notice of allowance issued on March 12, 1996, and applicant filed a statement of use with claimed dates of first use and first use in commerce of July 1995.<sup>2</sup>

The Examining Attorney finally refused registration on the basis that the applied-for mark is de jure functional, and that it is not inherently distinctive under Sections 1, 2, and 45 of the Trademark Act, 15 USC §§1051, 1052 and 1127. In her brief on appeal, however, the Examining Attorney withdrew the refusal to register based on de jure functionality.

Briefs have been filed, but an oral hearing was not requested by applicant.

---

<sup>1</sup> Application Serial No. 74/551,771, filed July 21, 1994.

<sup>2</sup> The Board notes that there are some differences between the applied-for mark and the configuration as shown in the specimens of record. Inasmuch as the Examining Attorney accepted applicant's statement of use, we presume that the Examining Attorney believes the drawing is a "substantially exact representation of the mark" as actually used as evidenced by the specimens in accordance with Trademark Rule 2.51(a)(2).

The only issue before the Board is whether the applied-for mark is inherently distinctive; that is, does it function as a trademark.<sup>3</sup>

The Examining Attorney describes the applied-for mark as follows:

The applicant seeks registration for a three-dimensional configuration of an AM/FM cassette player. Applicant is not claiming the position of the buttons and knobs on the player. Applicant is claiming the vertical configuration of the player, the placement of the doors and panels and the shallow housing. (brief, p. 2)

The Examining Attorney's position is essentially that the asserted mark for an AM/FM audio cassette player is not unique and has nothing distinctive about it; that all such products have windows, display panels, doors and buttons located in various places on the players; and that purchasers will not perceive the configuration as a trademark or source indicator.

The Examining Attorney has made of record photocopies of several advertisements showing various AM/FM audio cassette players. While none shows exactly the same

---

<sup>3</sup> We note that both applicant and the Examining Attorney in their arguments made statements which essentially relate to the question of acquired distinctiveness. Those arguments would apply only to a claim of distinctiveness under Section 2(f) of the Trademark Act. Here applicant is only claiming the applied-for mark is inherently distinctive.

configuration as applicant's applied-for mark, they nonetheless show designs all of which include buttons, knobs, doors and panels; further, a few of the designs show a more vertical than horizontal configuration.

Applicant, on the other hand, argues that it is the first and only entity in the industry offering this particular design; that the vertical orientation of the design which makes it suitable for wall mounting is arbitrary, as are its "unusual dimensions, orientation and the configuration of its controls" (brief, p. 10); and that it is a nonfunctional shape which distinguishes applicant's product from those of other manufacturers.<sup>4</sup>

This Board previously had occasion to consider the question of inherent distinctiveness in relationship to a configuration in the case of *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992), involving the configuration of a floor mat for "plastic mats for use under chairs." The applicant argued that its applied-for mark was "unique" because there was no evidence that others used the identical design configuration for chair mats. However, there was evidence showing uses of fairly similar chair

---

<sup>4</sup> Applicant submitted a photocopy of his application for a design patent; however, although applicant stated that he received said design patent, a copy of the patent as issued was never submitted.

mats. As stated by the Board in Robbins, supra, at 1542-1543:

Thus, while applicant's applied for design may be unique in the sense that it is a "one and only," the record demonstrates that said design is not unique in the sense it has an "original, distinctive, and peculiar appearance." *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960) quoting with approval from *Ex Parte Haig & Haig, Ltd.*, 118 USPQ 229, 230 (Asst. Comm. 1958). In other words, the record demonstrates that applicant's applied for design is not inherently distinctive or unique in the sense that the term "distinct" is defined as "clearly perceived or marked off" or "unmistakable," or in the sense that the term "unique" is defined as "highly unusual, extraordinary." *Webster's New World Dictionary of the American Language* (2d ed. 1970).

If the concept of inherent distinctiveness was defined as meaning simply "one and only," then one could obtain a registration for a design which, while "unique" in this sense, differed only slightly from the designs of other competing products and /or containers. There would be no need that the applied for design have an "original, distinctive and peculiar appearance" as required by the *Haig & Haig* ("Pinch bottle") and *McIlhenny* ("Tabasco bottle") cases.

Thus, the essential criterion of an inherently distinctive mark is that it is immediately recognizable by consumers as a source indicator.

In the present case, although applicant may be the only party in his industry offering this particular configuration, the design is not unique or unusual in the sense described in the Robbins case. Instead, the configuration applied for by applicant consists of very ordinary components that go into any AM/FM audio cassette player from any manufacturer. How these components are arranged by applicant remains ordinary, and is not unusual. Applicant's design is nothing more than an arrangement of all the components involved in an AM/FM audio cassette player put together in a manner which makes sense for the involved product, e.g., the buttons which control the cassette player are located directly below the window in which the cassette is inserted. The record before us does not demonstrate that applicant's applied-for mark is inherently distinctive.<sup>5</sup>

---

<sup>5</sup> We point out that in cases involving the issue of inherent distinctiveness of trade dress, background designs, and color, the Board and many courts have utilized the test set forth in the case of Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). See also, Tone Brothers Inc. v. Sysco Corp., 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); In re Sunburst, Inc., \_\_\_ USPQ2d \_\_\_, Serial No. 74/300843, (TTAB March 31, 1999); In re File, 48 USPQ2d 1363 (TTAB 1998); In re J. Kinderman & Sons Inc., 46 USPQ2d 1253 (TTAB 1998); and In re Hudson News, 39 USPQ2d 1915 (TTAB 1996), aff'd in decision without published opinion, 1997 U.S. App. LEXIS 15556 (Fed. Cir. June 12, 1997).

Applicant's claim that the narrow depth of the housing is an unusual and discernible design feature is not persuasive. As applicant himself has pointed out, and as is shown and described in applicant's specimens of record, the purpose of the narrow depth of the unit vis-a-vis the length is so that the unit can be mounted on a wall, rather than free-standing.<sup>6</sup> The purchasing public would readily perceive this configuration as making the product suitable for wall mounting.<sup>7</sup>

Accordingly, we find that applicant's configuration is not immediately recognizable as a distinctive way of identifying the source of applicant's goods. Rather, purchasers will look upon applicant's design as the configuration of applicant's product, and not as an indicator of the source of the goods.

---

<sup>6</sup> We note that applicant stated in his reply brief (p. 3) that "Specifically, the Applicant's design is intended to be mounted flush with the user's wall in order to minimize any aesthetic disruption. The distinctive appearance of the Applicant's design is best appreciated when the design is viewed after installation. The Applicant's design will be viewed primarily in this manner."

<sup>7</sup> Obviously, applicant cannot argue that the depth/length ratio of the configuration is superior for wall mounting the AM/FM audio cassette player since that would be an admission that that portion of the claimed configuration was de jure functional.

**Ser. No.** 74/551771

Decision: The refusal to register is affirmed.

E. J. Seeherman

B. A. Chapman

D. E. Bucher  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board