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THE TTAB

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Build-A-Bear Workshop, Inc.

Serial No. 76351071

Sherry Gunn Hanlon of Blackwell Sanders Peper Martin for
Build-A-Bear Workshop.

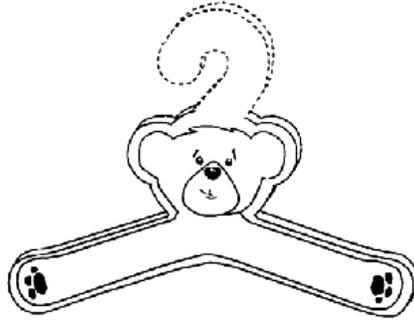
Teresa Rupp, Trademark Senior Examining Attorney, Law
Office 106 (Mary I. Sparrow, Managing Attorney)

Before Seeherman, Hairston, and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Build-A-Bear
Workshop, Inc. to register the mark shown below on the
Principal Register for "toy accessories, namely, toy
clothing."¹

¹ Application Serial No. 76351071, filed December 20, 2001,
alleging a date of first use anywhere and a date of first use in
commerce of October 26, 1997.



The application includes the following description: "The mark consists of the configuration of the packaging for toy clothing. The dotted line is not claimed as part of the mark but is merely to show the mark's position on the packaging."

The trademark examining attorney has refused registration of applicant's mark on the ground that it fails to function as a mark under the provisions of Sections 1, 2, and 45 of the Trademark Act. When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney argues that applicant's mark, which consists of a teddy bear design on a hanger for toy clothing, is a "hybrid packaging/product design" which requires a showing of secondary meaning. (Brief, p. 2). The examining attorney notes that applicant's toy clothing is sold on the hanger which a purchaser may keep and use to

hang the toy clothing. In view thereof, the examining attorney argues that the mark clearly is a hybrid of a product design and a packaging design. Relying on *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), the examining attorney argues that where, as here, it is difficult to determine whether the issue is one of the design of the goods or the packaging, a showing of secondary meaning should be required.

Alternatively, the examining attorney argues that, assuming applicant's mark is merely product packaging, the mark is not inherently distinctive. The examining attorney argues that applicant's mark is not unique and unusual since applicant's goods are toy clothing, including clothing for teddy bears. According to the examining attorney, "[b]ecause the applicant sells toy clothing for teddy bears, the hanger for the clothing that has a teddy bear motif would not be viewed as inherently a trademark for the goods. Rather, the teddy bear hanger would be viewed as part of the overall theme for these goods and would be viewed as one means of telling the consumer that the clothing hanging on these hangers is specifically designed for teddy bears." (11/10/04 Office Action, p. 2). In support of her position that the mark is not inherently distinctive, the examining attorney submitted printouts

from three web sites which she maintains show that it is not unusual for clothes hangers to have a whimsical or decorative feature. At two of the web sites, children's clothes hangers featuring animal designs are offered for sale. At the third web site, doll clothes hangers featuring a heart design are offered for sale.

Applicant, in urging reversal of the refusal to register, takes issue with the examining attorney's characterization of its mark as a hybrid packaging/product design. Applicant contends that its mark is "trade dress consisting of point of sale display and packaging display." (Brief, p. 6). According to applicant, the examining attorney's contention that its mark is in any way a product design is unsupportable because applicant is seeking to register its mark for toy clothing, not hangers for toy clothing. Since its mark is not a product design, applicant maintains that it is not required to show secondary meaning.

Further, applicant argues that its mark is inherently distinctive in that it is unique and highly visible to purchasers and potential purchasers of its toy clothing. Applicant argues that the examining attorney has produced no evidence which shows that the mark is not inherently distinctive. With respect to the printouts submitted by

the examining attorney, applicant argues that if it were seeking to register its mark for hangers for toy clothing, this evidence might be relevant, but the evidence is not relevant here because applicant is seeking to register its mark for toy clothing. Finally, applicant argues that the examining attorney's position is contrary to the PTO's decisions in connection with applicant's other two marks (shown below) which were found to be inherently distinctive.



Registration No. 2,344,661 issued April 25, 2000, for newsletters and brochures on the subject of stuffed animals and related items; retail store services and retail store services via a global computer network featuring toy animals and plush toy animals and related items.



Registration No. 2,990,861 issued September 6, 2005, for toy footwear.

Under Wal-Mart, a product design or configuration cannot be inherently distinctive. Also, the Court in Wal-Mart indicated that in cases where it is difficult to distinguish between product design and product packaging, "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." 54 USPQ2d 1069. In this case, however, we are not persuaded that the design applicant seeks to register is ambiguous trade dress or a hybrid packaging/product design, as the examining attorney argues. Applicant's goods are toy clothing and the design applicant seeks to register consists of a teddy bear design on hangers for toy clothing. The design cannot be considered the configuration of toy clothing; it is quite clearly only packaging for the goods. Thus, the examining attorney's reliance on Wal-Mart is misplaced and applicant is entitled to seek registration of its design on the basis that it is inherently distinctive.

We turn then to the question of whether the design is inherently distinctive. Among the factors our primary reviewing court has looked to in determining whether a design is inherently distinctive are: whether the design is a common basic shape or design; whether it is unique or unusual in a particular field; or whether it is a mere

refinement of a commonly-adopted and well-known form or ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods. See *in re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003) and *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). Further, in determining whether a design is inherently distinctive, we look to the specimens of use and any other material submitted by applicant during the prosecution of the application. In *re The Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986).

Applicant argues that its design is unique in the field and thus inherently distinctive. While the design applicant seeks to register may be unique in the sense that we have no evidence that anyone else is using a design which is identical to it, it is nonetheless not inherently distinctive. Although the design is a noticeable element of the packaging, it is likely to be regarded as mere ornamentation rather than as a trademark for the goods. As evidenced by the specimens of use, applicant's goods are teddy bear clothing; therefore, consumers are likely to view the teddy bear hanger design used in connection with such goods as simply indicating that the toy clothing is designed for teddy bears. Moreover, the use of designs on

hangers is not unusual. The evidence submitted by the examining attorney shows that at least two companies market children's clothes hangers with animal designs.

Applicant also points out that the Supreme Court, in Wal-Mart, noted that symbols such as packaging "almost automatically tell a consumer that they refer to a brand" and "immediately signal a brand or a product source." 54 USPQ2d at 1068 (emphasis in original). However, the Court also observed that there will clearly be cases "where it is not reasonable to assume consumer predisposition to take ... packaging as an indication of source." 54 USPQ2d 1068. This is especially true where, as in this case, applicant's design is highly suggestive of the product. Applicant's teddy bear hanger design will be perceived as connoting that the toy clothing is for teddy bears. Purchasers and prospective purchasers of applicant's goods are unlikely to regard applicant's teddy bear hanger design as identifying the source of toy clothing.

With respect to applicant's contention that the examining attorney's position in this case is inconsistent with that taken in two prior cases, it is well settled that each case must be decided on its own merits, and the Board is not bound by prior actions of the Office. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566

(Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]. In this regard, we also note that the two prior registrations cover goods that are different from those involved herein.

Finally, applicant, in its appeal brief, requests that if the Board were to determine that its mark cannot be registered on the Principal Register because it is inherently distinctive, applicant be permitted to submit a claim of acquired distinctiveness. The examining attorney, in her brief, has objected to applicant's request as untimely.

Trademark Rule 2.142(g) provides, in relevant part, that an application which is decided on appeal, as we do here, will not be reopened except for entry of a disclaimer or upon order of the Commissioner. Accordingly, the Board has no power to reopen examination of the application for consideration of a Section 2(f) claim, and applicant's request is therefore denied. The proper procedure would have been for applicant to submit a claim of acquired distinctiveness as an alternative claim during the prosecution of the application.

Ser No. 76351071

In sum, we find that the design applicant seeks to register fails to function as a mark for toy clothing.

Decision: The refusal to register is affirmed.