

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alexander Manufacturing Company

Serial No. 75/449,466

Lionel L. Lucchesi of Polster, Lieder, Woodruff & Lucchesi,
L.C. for Alexander Manufacturing Company.

Catherine Pace Cain, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Alexander Manufacturing Company (applicant), a
Missouri corporation, has appealed from the final refusal
of the Trademark Examining Attorney to register the mark
shown below:

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for hand tools, namely, screwdrivers.¹ Applicant has amended the description of its mark to the following: "The mark consists of the configuration of a screwdriver comprising a round barrel and a separate blade with reversible tip inserted into one end of the barrel. The thick lines are a feature of the mark, and the other lining is for shading purposes only and is not intended to indicate color." The Examining Attorney has refused registration on the basis that applicant's asserted mark has not been shown to have acquired distinctiveness.² Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

The specimens of record consist of a photograph of applicant's pocket screwdrivers (reproduced below).

¹Application Serial No. 75/449,466, filed March 12, 1998, based upon applicant's allegations of use of the mark since 1989.

²An earlier refusal that applicant's mark was *de jure* functional has been withdrawn.

Examining Attorney's Arguments

Arguing that the ultimate burden of persuasion is on applicant to prove acquired distinctiveness under Section 2(f) of the Act, 15 USC §1052(f), it is the Examining Attorney's position that the evidence submitted by applicant to demonstrate acquired distinctiveness is insufficient. Applicant's evidence consists of advertising expenses covering all of applicant's screwdrivers (not just the screwdriver which is the subject of this application),³ pages from applicant's catalogs displaying some of applicant's screwdrivers, and a declaration of applicant's president attesting to the substantially exclusive and continuous use of applicant's asserted mark for at least five years. This declaration also states that applicant's mark is recognized in the trade and by consumers.⁴

³ Applicant's counsel indicates that applicant's advertising expenditures for specific hand tools are considered confidential (appeal brief, 7). For the year 1999, applicant spent a total of \$154,000 advertising and promoting all of its screwdrivers, including screwdrivers with different shapes.

⁴ In addition to the foregoing evidence, applicant's counsel points to copies of four of applicant's existing registrations which it submitted for the first time with its appeal brief. The Examining Attorney has objected to this evidence under Trademark Rule 2.142(d), arguing that this evidence is untimely. We agree. Evidence submitted for the first time with an appeal brief is untimely. *In re JT Tobacconists*, 59 USPQ2d 1080, 1084 n.2 (TTAB 2001). In any event, those registrations are for different marks. Two of those registrations are for triangular-shaped barrels, one is for a ten-sided barrel and the remaining registration is for the configuration of a button inserted into one end of a round screwdriver barrel. We note that in the latter registration, the configuration of the round barrel with square-cut ends is shown in dotted lines, indicating that no claim is being made to that matter.

The Examining Attorney contends that, because applicant's advertising expenses relate to all of applicant's screwdrivers, it is not possible to determine the specific advertising figures for applicant's subject mark. In any event, the Examining Attorney argues that there is no frame of reference placing applicant's total expenditures in context with respect to the expenditures of other screwdriver manufacturers. The Examining Attorney maintains that there is no evidence of record of the impact of applicant's efforts on the purchasing public; that is, there is no evidence with respect to the perception of, or recognition by, purchasers of applicant's configuration as a trademark. Finally, in further support of her position that applicant has not demonstrated that its screwdriver configuration functions as a mark, the Examining Attorney points to promotional literature, submitted by applicant, of other manufacturers' pocket screwdrivers, which the Examining Attorney contends are similar to applicant's screwdrivers.

Applicant's Arguments

Applicant, on the other hand, contends that the combination of a cylindrical barrel with square-cut ends and a reversible blade (regular and Phillip's head) is a distinctive mark. Applicant argues that the catalog

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photographs of its pocket screwdrivers, which it refers to as "image advertising," promote its goods as a trademark. With respect to the examples of competitive products, applicant argues that they display screwdrivers which are not the same as, or similar to, applicant's.

Opinion and Decision

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000), the Supreme Court stated that if trade dress falls within the category of product design, which is the type of mark applicant here seeks to register, the trade dress can never be inherently distinctive. *Id.* 54 USPQ2d at 1068 ("It seems to us that design, like color, is not inherently distinctive..."). Accordingly, a product design or product configuration is registrable (or protectable) only upon a showing of acquired distinctiveness. *Id.* 54 USPQ2d at 1068, 1069. In this connection, the Supreme Court noted that product design almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design (such as a cocktail shaker shaped like a penguin) is intended not to identify the source, but to render the product itself more useful or appealing.

First, we note that applicant's description of its mark in the application mentions only the round barrel and the reversible blade inserted into one end of the barrel. It is clear from applicant's appeal brief, 3 (as well as arguments made at the oral hearing), however, that applicant is claiming more than what is revealed in that description. Specifically, applicant's counsel indicates that the elements of applicant's mark include a round or cylindrical barrel *with square-cut ends* as well as a reversible blade. Further, at the oral hearing applicant's attorney also indicated that the fluted aspect of the metal screwdriver blade was another element of its mark. However, this aspect of applicant's asserted mark was not mentioned in applicant's brief or in other papers filed in connection with this application. Moreover, this feature of the screwdriver blade is not clearly shown in the specimens of record.⁵

Applicant has admitted, appeal brief, 4, that the reversible blade is not new. "In fact, a visit to any hardware store will reveal the existence of alternative reversible blade screwdrivers...". It appears, therefore,

⁵ Should applicant prevail in any appeal, the description of its mark should be clarified to include reference to square-cut ends as well as other elements which applicant claims function as its mark. See TMEP §§1202.02(d).

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that this aspect of applicant's configuration should have been shown in dotted lines and not claimed as a feature of its mark. That is, if a mark comprises the design of only a portion of a product, broken lines should be used in the drawing to indicate that portion of the product that is not claimed as part of the mark. See Trademark Rule 2.52(a)(2)(ii); *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980); and *In re Famous Foods, Inc.*, 217 USPQ 177 (TTAB 1983).

With respect to other elements of applicant's pocket screwdrivers, a review of the competitive products reveals screwdrivers of very similar appearances. See, for example, the pocket screwdrivers of Enduro and HPC Promotions (shown below).

These competitive screwdrivers have round barrels and, in the case of the HPC product, have at least one square-cut end (as opposed to two in applicant's configuration). The fact that applicant's screwdrivers may differ from those of another manufacturer in this minor detail would not seem to be the kind of difference in design likely to be recognized by the average purchaser of such goods as an indication of origin. Furthermore, applicant has acknowledged that it does not tout the design elements of its screwdrivers. Appeal brief, 6; and Response filed June 1, 1999, 2. Applicant states that its advertising merely refers to the fact that applicant's screwdrivers accommodate reversible

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blades. Nor does applicant promote the round handle with square-cut ends in combination with the reversible blade as a trademark in any material made of record. That is to say, there is no record of any "look for" advertising which would draw potential purchasers' attention to those features of applicant's screwdrivers which applicant claims function as its mark. Indeed, we have held that advertising that touts a product feature for its desirable qualities and not primarily as a way to distinguish the goods is not only not evidence of acquired distinctiveness but in fact undermines such a finding. *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279 (TTAB 2000).

In sum, while applicant displays its goods in its catalogs (and now on the Internet), there is simply no evidence that applicant has tried to associate either the round handle or the square-cut ends (or any other feature of its goods) as an indication of origin. In any event, applicant's screwdriver configuration consisting of a round barrel with square-cut ends is not significantly different from the product design of competitors. Nor is there any evidence that consumers or potential purchasers associate any claimed features exclusively with applicant. Accordingly, we agree with the Examining Attorney that

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applicant has failed to carry its burden of demonstrating that the subject mark has acquired distinctiveness.

Decision: The refusal of registration is affirmed.