

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral hearing:
June 20, 2006

Mailed:
February 21, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elevator Safety Company

Serial No. 76507676¹

James J. Merek of Merek, Blackmon & Voorhees, LLC for
Elevator Safety Company.

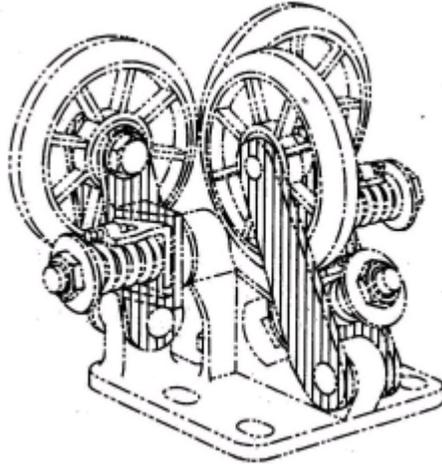
Linda A. Powell, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Rogers, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

The Elevator Safety Company has filed an application
to register as a trademark on the Principal Register the
following:

¹ Applicant has also appealed refusals issued in eight related
and consolidated cases. While the Board heard oral argument on
those appeals as well as this appeal at the same oral hearing,
the issues in the consolidated cases are different and a decision
in those cases is being issued under a separate opinion.



for "elevator roller guides" in International Class 7, describing the mark as follows "The mark is comprised of the colors red and black as used on an elevator roller guide. The drawing is lined for the color red. The base, excluding the wheels, nuts, bolts, pins, springs, and washers, is in the color black. The configuration of the roller guide is shown in dotted lines in the drawings for the purpose of indicating placement of the colors, and does not form any part of the mark in this application";²

The examining attorney refused registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127, on the ground that applicant's alleged mark is ornamental and not inherently distinctive and, thus, fails to function as a trademark.³ In maintaining the refusal under Sections 1, 2 and 45, the examining attorney also found that applicant did not make a sufficient

² Application Serial No. 76507676, filed April 18, 2003, alleging 1961 as the date of first use and first use in commerce.

³ The examining attorney initially also refused registration under Section 2(e)(5), 15 U.S.C. §1052(e)(5), on the ground that the mark is functional; however, this refusal was subsequently withdrawn.

evidentiary showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). The examining attorney offered applicant the option of seeking registration on the Supplemental Register, but applicant maintained its position that the mark is registrable on the Principal Register.

When the refusal was made final, applicant appealed. Briefs have been filed and an oral hearing was held upon applicant's request. We affirm the refusal to register.

In response to the refusal based on lack of inherent distinctiveness applicant argues that its mark has acquired distinctiveness. In support of its assertion of acquired distinctiveness, applicant relies on: (1) the declaration of Douglas W. Hamilton, III, applicant's vice president; (2) the declarations of Gordon Ferguson, General Manager of Eltec Systems, LLC and Wayne Chiang, Senior Buyer of ThyssenKrupp Elevator, customers of applicant; (3) an agreement entered into with Bral Corporation, a supplier of applicant; (4) a third-party's response to a cease and desist letter; and (5) samples of applicant's advertising. In addition, applicant submitted product literature from third parties discussing their elevator roller guides.

Color marks, as a matter of law, are not inherently distinctive and can only be registered upon a showing of

acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1162-1163 (1995). See also *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). Refusals based on failure to function may be overcome by a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. The burden of proving a prima facie case of acquired distinctiveness in an ex parte proceeding rests with applicant. See *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. See *In re Ennco*, 56 USPQ2d 1279, 1283 TTAB (2000). See also 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. 2005).

There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness; however,

the burden of proving that a color mark has acquired distinctiveness is substantial. In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). See also Yamaha, supra, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue).

After careful review of the evidence of record, we agree with the examining attorney that applicant's evidence of acquired distinctiveness is insufficient to permit registration of the claimed colors under Section 2(f).⁴

Applicant states:

[It has] consistently and repeatedly promoted the red and black color combination as a source indicator for a prolonged period. For over forty (40) years, [applicant] has sold its roller guides with the red and black color combination. Since at least 1992, [applicant] has widely distributed its product catalog unquestionably promoting the red and black color combination as

⁴ Applicant's objection to the examining attorney's arguments in her brief regarding the use of the color red by third-parties, as shown in the evidence submitted by applicant, and her analysis of the cease and desist letter and the Bral agreement, also submitted by applicant, is not well taken. The examining attorney did not submit new evidence, refer to extrinsic evidence or raise a new refusal; she simply elaborated on evidence already in the record and discussed by applicant. We add, however, that the examples of third-party use of the color red on wheels and guide shoes is not particularly probative here where applicant seeks a particular color combination on the pivot arm and base of an elevator roller guide. With regard to the examining attorney's characterization of applicant's industry as "very large," we agree that there is no evidence of record upon which we may determine the size of the elevator guide industry.

a source indicator. On the inside cover of [applicant's] product catalog, two business cards are displayed with the red and black color combination. The binder of the product catalog was deliberately chosen to be black. The dividers were intentionally made red. The individual brochures in the product catalog have a black border with the name ELSCO in red. The Company letterhead also promotes the red and black color combination as that of [applicant]. The company envelopes further promoted the red and black color combination as that of [applicant]. A brochure distributed separately from the product catalog promotes the red and black color combination as a source indicator.

Br. pp. 5-6.

The examining attorney notes:

Though the brochure is provided in the colors red, black, gray and white, none of the photographs of the actual elevator roller guides is in color. The Trademark Examining Attorney finds no evidence that the color of the elevator roller guides is promoted in the applicant's brochure. As no mention is made of color and no color photograph is provided in the applicant's advertising, it is hard to construe that the applicant has promoted the colors red and black in a manner in which consumers would reasonably make the leap to recognize the colors on the goods as identifying the source of those goods.

Br. p. 7.

Although applicant may have sold its goods with the black and white color combination for over forty years, in this case, given the nature of the proposed mark, a color combination on an industrial product, applicant's length of use is insufficient, in itself, to bestow acquired distinctiveness. Rather, further evidence is required to

show the method of using the mark and the effectiveness of such use "to cause the purchasing public to identify the mark with the source of the product." Owens-Corning, supra, 227 USPQ at 422. Cf. TMEP §1212.05(a) ("For matter that does not inherently function as a mark because of its nature (e.g., ...overall color of a product, mere ornamentation), evidence of five years' use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness.")

In addition, mere figures of product sales and advertising, standing alone, are not sufficiently probative of purchaser recognition of a color combination as an indication of source.⁵ Cf. 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."); In re Bongrain Int'l (American) Corp., 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729

⁵ We further note that it is not clear from Mr. Hamilton's declaration how much of the sales and advertising figures presented pertain to the mark sought in this application. However, even given the most liberal interpretation, these figures are not particularly extraordinary, e.g., \$100,000 in advertising expenditures.

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(Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin). It is well established that compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 sales revenues and 740,000 tires sold insufficient to show acquired distinctiveness of tire tread design).

As noted above, the more important question is how is the alleged mark being used, i.e., in what manner have consumers been exposed to the alleged mark so that we can impute consumer association between the claimed color combination and the product producer. To determine whether the color combination has acquired distinctiveness, advertisements must show promotion of that color combination as they appear on those goods as a trademark.

As noted by the examining attorney, there is nothing of record that shows that the alleged mark is being promoted as a source indicator. The examples in the record show a picture of the product in black and

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white. Applicant's elevator guides are never depicted in color, nor is there any mention or description of the product's color in any of the advertising, let alone any promotional effort that focuses upon the trademark significance of the color combination as applied to the product. Applicant's use of the colors red and black as background and decorative colors in its brochures, catalogs, envelopes and business cards, is not sufficient to support a showing of acquired distinctiveness of the color combination as used on applicant's goods.

The record presented here is substantially different from the record in Owens-Corning where the evidence included advertising expenditures of \$42,421,000 in television, radio, newspapers and consumer magazines that featured the Pink Panther and included the advertising slogan "[a]dd another layer of pink." In addition, a further \$11,400,000 was expended on "brochures, displays and other promotional items that highlighted the 'pink' color *as applied to applicant's insulation.*" Owens-Corning, *supra*, 227 USPQ2d at 423 (emphasis added).

Applicant also submitted an agreement between it and one of its suppliers that includes the following statements:

4. Bral hereby expressly acknowledges that Hamilton⁶ and/or a related company is the owner of certain trademarks including but not limited to the marks consisting of (1) the red and black colors for roller guides and roller guide parts; and, (2) the product configurations for ELSCO's roller guides including but not limited to the product configurations of Model A, Model B, Model C and Model D roller guides.

5. Bral further agrees not to infringe upon any of Hamilton's or any related company's trademarks including but not limited to those identified in paragraph 4.

6. Bral hereby agrees not to contest the validity of Hamilton's or any related company's trademarks including but not limited to those identified in paragraph 4 in any proceeding including but not limited to any proceeding brought by Hamilton or any related company for enforcement of its trademarks.

Bral Agreement.

The statements in this agreement do not show consumer perception; rather, they only show that the Bral Corporation acknowledges applicant's ownership of certain trademarks and agrees not to contest such ownership in furtherance of the agreement.

In addition, applicant submitted two consumer declarations which include the following statements:

⁶ Hamilton is apparently applicant's parent company.

The red and black color combination appearing on each of the Models A,B,C, and D⁷ signifies to me that ELSCO is the manufacturer of that roller guide. In other words, the red and black color combination identifies ELSCO as the source of origin of the roller guide. The red and black color combination does not serve any purpose other than to identify ELSCO as the source of origin. Further, the red and black color combination is not a natural by-product of the manufacturing process. Rather, it is my understanding that this color combination is painted on the components of the roller guide.

Chiang and Ferguson Decls.

We do not find these two identical declarations to be particularly persuasive. This conclusory statement is made without particularity as to how consumers are exposed to the alleged mark. Also, the record does not reveal the size of the relevant consumer base and whether these two declarations are sufficiently representative of the potential purchasers.

Finally, applicant also submitted a response by a third-party to a cease and desist letter from applicant, noting that this competitor agreed to switch from a red and black color combination to a blue and black color combination. While this letter may provide plausible support for applicant's assertion that it considers the

⁷ Applicant has various elevator roller guide models. The shape of the roller guide depicted in the drawing for this application is for Model B.

color combination on its elevator guide to have source-identifying significance and a competitor did not want to engage in litigation over this assertion, this is not evidence of customer perception of applicant's proposed color mark. Further, a party's willingness to enter into a settlement agreement may result from economic or business considerations and may have little to do with the party's view of the merits of its adversary's claim.

Accordingly, based upon consideration of all the evidence in the record, we find that applicant has failed to establish that the claimed color combination has acquired distinctiveness within the meaning of Section 2(f).

Decision: The refusal to register the color combination claimed as a mark on the grounds that the mark is not inherently distinctive and has not been shown to have acquired distinctiveness is affirmed.