

Hearing:
April 21, 1998

Paper No. 2
RLS/hlj

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PRECEDENT OF THE TTAB

MARCH 31, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sunburst Products, Inc.

Serial No. 74/300,843

Anthony G. Vella of Sheldon & Mak, Inc. for Sunburst
Products, Inc.

Caryn L. Hines, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney)

Before Simms, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Sunburst Products, Inc. (applicant), a California
corporation doing business as Free Style USA, has appealed
from the final refusal of the Trademark Examining Attorney
to register the asserted mark shown below:

for wrist watches.¹

The Examining Attorney has refused registration because applicant's asserted mark is mere ornamentation which is not inherently distinctive, and because applicant has not demonstrated to the satisfaction of the Examining Attorney that its asserted mark has acquired distinctiveness.

Background

This application has a long and convoluted history. In order to more fully understand the subject matter presented for registration and the arguments for and against registration, a brief discussion of the history of this application is believed to be in order.

When this application was filed, applicant claimed that the following six elements comprised its mark:

- (a) A watch case and bezel of different contrasting colors, with the color of the watch strap matching the color of the bezel;
- (b) A multi-colored band consisting of at least two colors;
- (c) Flexible, woven webbing having the appearance of nylon material as the watch strap with the strap attached to the watch case by threading the strap through string

¹ Application Serial No. 74/300,843, filed August 3, 1992, with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 USC §1052(f), based upon an allegation of substantially exclusive and continuous use of the asserted mark for at least five years. In the application, applicant claims use of the asserted mark since at least as early as March 1986.

- bars and along the back of the watch;
- (d) A rectangular outline on the watch face;
 - (e) A unique, plastic buckle and clasp design for opening and closing the strap; and
 - (f) Scalloped indentations on each side of the rectangular watch case, each scallop being between a pair of function buttons, with the watch case having a rectangular bezel with slightly rounded edges.

With the original application, applicant submitted a declaration of its president explaining that in October 1989, applicant obtained a preliminary injunction from the United States District Court for the Central District of California based upon its configuration mark. On pages two and three of that order, apparently prepared by applicant as plaintiff in that litigation, the same six elements listed above are recited² and the court stated, in this preliminary injunction order, that applicant's trade dress was non-functional, "a unique, distinctive and arbitrary combination of elements ... itself unique and distinctive," and, in addition, that applicant's trade dress had acquired a secondary meaning.³ This court order itself notes that

² However, in the court order, the fourth element is indicated to be "A blue, rectangular outline of the watch face."

³ Of course, if a mark is inherently distinctive, that is, the public immediately recognizes it as an indication of origin by its very nature, then no evidence of secondary meaning or

applicant as plaintiff had been involved in other cases which had determined, by preliminary injunction or temporary restraining order, that applicant's trade dress was protectable because it was "non-functional and inherently distinctive, and has achieved secondary meaning." In an appeal from one of the cases brought by applicant, the Ninth Circuit Court of Appeals (Appeal No. 89-56025) stated, according to applicant, that applicant's trade dress was non-functional, and indicated that applicant's trade dress had acquired secondary meaning. According to applicant, that case was later settled and a consented permanent injunction was later issued against the Advance Watch Company, Ltd.

Applicant subsequently amended both the drawing of its mark and the description of its mark, pursuant to Examiner's Amendment. See Examiner's Amendment, issued March 1, 1996. The mark has been amended to that shown at the beginning of this opinion and the description is set forth below:

The claimed trademark is the matching color of the watch bezel and the watch band, as indicated by the stippling on the drawing, as well as the contrasting colors of the watch case and the watch bezel, as indicated by the lack of any

acquired distinctiveness is necessary for protection or registration.

stippling on the drawing. The contrasting colors are different from the color of the bezel and the watch band. The mark is the foregoing combination of elements in a sports watch having the shape shown. The physical configuration of the watch and the watch band are not claimed per se.

In addition, at the same time, applicant made the following disclaimers:

No claim is made to the exclusive right to use the configuration of the watch by itself nor the three-dimensional shape or the two-dimensional watch face as shown in the drawing nor to the watch band by itself nor to any particular color by itself, apart from the mark as claimed and shown in the drawing.

No claim is made to the exclusive right to use a colored watch bezel per se, nor to a colored watch band per se, nor to contrasting colors on a watch per se, apart from the mark as claimed and shown.

Further, on December 9, 1996, applicant entered the following additional statement:

The subject matter shown in broken lines in the drawing is not part of the mark, but represents the configuration of the goods on which the mark appears. However, the mark is claimed only in relation to a type of sports watch of the shape shown.

As can be seen, essentially only the first of the six elements originally claimed in applicant's application is now being claimed as applicant's mark. That is to say,

applicant's asserted mark is now only the watch bezel and watch strap in matching colors and the contrasting color of the watch case.

Examining Attorney's Arguments

Although the Examining Attorney at one time refused registration because the asserted mark was considered de jure functional, that refusal was withdrawn. As indicated above, the Examining Attorney has now refused registration because she considers the asserted mark to be mere ornamentation which is not inherently distinctive⁴ and which applicant has not shown has acquired distinctiveness. Essentially, it is the Examining Attorney's position that applicant's asserted mark consists of minor variations of common designs of sports watches without any origin-indicating significance. The Examining Attorney argues that the variation in appearance of applicant's watches is not normally seen as a trademark.

The proposed mark is merely ornamental because the use of multicolored and/or interchangeable bezels on a watch is a mere aesthetic variation on a common watch theme. The record reflects that this type of ornamentation in the field of watches is widely used. Colors on sports watches are fairly common, especially on the watch face and the

⁴ As noted, in the original application applicant asserted that its mark had acquired distinctiveness. We consider this to be an admission that its mark is not inherently distinctive. In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1444 (TTAB 1994).

strap. This is shown by the record and is common knowledge. The applicant's watch is a variation on a general pattern. However, thlis [sic] variation is not so radical in relation to the pre-existing trade practice that consumrs [sic] would immediately see this as an indication of origin in a trademark sense. Therefore, this type of ornamentation should be available to any company in the watch industry without restriction.

Examining Attorney's appeal brief, 5-6. The Examining Attorney has made of record photocopies (in black and white) of certain pages from a Best showroom catalog which the Examining Attorney states show various multi-colored watches and watch bands or straps. In another exhibit, this one submitted by applicant (on May 17, 1993), the Examining Attorney notes that competitors offer sports watches with "interchangeable bands and bezels" in a variety of colors.

With respect to applicant's claim of acquired distinctiveness, it is the Examining Attorney's position that there is no evidence of the promotion as a trademark of the specific features of applicant's watches, and that there is no evidence of public recognition of these features as a mark.

In the present case, if one looks only at applicant's advertisements and promotional evidence, the nature of the claimed mark as an exclusive indication

of origin would not be apparent. The potential purchaser would simply see a line of very colorful sports watches. In the context of the actual marketplace where colorful watches are commonplace, including the use of colored bezels (both permanent and interchangeable), colored watch bands and all the other separate features of applicant's watch, the trademark potential of the particular features applicant is claiming would be obfuscated by the bewildering array of very similar goods. Whatever distinctiveness exists in applicant's claimed mark would be muted by its place among very similar competing goods. To bring out this distinctive potential, it is necessary to advertise and promote the goods in such as [sic] way that the purchaser's attention is somehow drawn to the particular feature claimed as a mark. This may be an explicit "look for" approach, but it may be somewhat more subtle or indirect. But there must be something that will draw the purchaser's attention to the claimed mark. The trademark nature of applicant's claimed mark would not become self-evident based simply on repetitive exposure, which sometimes is sufficient with ordinary nondistinctive matter. Additional evidence and/or a more "focused" type of evidence is necessary where a high degree of nondistinctiveness inheres in a mark such that purchasers seeing the subject matter in question would be less apt to discern a source-indicating significance from its use by any one party.

Examining Attorney's action, June 5, 1996. And in the Examining Attorney's brief, 7, the Examining Attorney argues:

The applicant has not presented any evidence showing promotion of the claimed mark as an origin indicating device. All of applicant's advertisements simply present the watches as a line of very colorful sports watches. The applicant uses only vague references to the claimed "contrasting color" mark such as "hot fashion look," "high fashion," and "power fashion." Additionally, many of the advertisements make no mention of the appearance of the goods. The sponsorship advertisements from the response received May 17, 1993 merely show athletes modeling the applicant's watches. The sponsorship advertisements do not show anything about the appearance of the product that is source indicating. The consumer correspondence states how well the applicant's Shark⁵ watches are liked but does not relate that the claimed mark is a source identifier. In fact none of the consumer correspondence even mentions the features the applicant is claiming as its trademark...

The Examining Attorney also notes, in an Office Action issued June 5, 1996, that not all of applicant's SHARK watches conform to the description of the mark in this application. ("This too obfuscates and mutes whatever distinctive potential the claimed mark has.") In this regard, we observe that most, but not all, of applicant's

SHARK watches show the watch band or strap to be in the same color as the watch bezel. Some do not.

Applicant's Arguments

Applicant, on the other hand, argues that a mark may be inherently distinctive if it is not "generic" or "descriptive," but rather is suggestive, arbitrary or fanciful.⁶ Here, applicant argues that there is no evidence that the asserted mark is generic or descriptive. Also, according to applicant, no competitor uses matching colors on the bezel and watch strap, with a watch case of contrasting color.

With respect to acquired distinctiveness, applicant points to more than seven years use of the asserted mark, sales of over \$3.4 million per year⁷ and advertising expenditures of over \$100,000 per year from 1987 to the present. Applicant also points to attempts by third parties to copy its trade dress and to the outcomes of those lawsuits, discussed earlier. Applicant concedes that its watches are primarily advertised and promoted though

⁵ This is the word mark which applicant uses on these watches.

⁶ See *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S.Ct. 1300, 34 USPQ2d 1161 (1995). See also *In re Hudson News Co.*, 39 USPQ2d 1915, 1921-22 (TTAB 1996), *aff'd. unpublished*, 1997 U.S. App. LEXIS 15556 (Fed. Cir. June 12, 1997)(blue trade dress motif for newsstand services not inherently distinctive but "simply a mere refinement of a basic blue interior decorating scheme").

⁷ These figures include sales of the SHARK and the SHARK JR. watches.

action photographs of athletes wearing applicant's watches and endorsements of professional athletes.

Applicant has also relied upon certain materials from its litigation against the Advance Watch Company. Among other things, applicant has submitted a 1989 declaration of the president of a marketing research firm involved in that litigation. That declaration describes a pilot study called "Watch Study, Likelihood of Confusion." In that pilot study respondents were shown either the SHARK or ADVANCE watch and asked what company put out that watch and their reasons for so stating. The respondents were then shown the other watch and the same questions were asked. If there was no response to the initial question, the respondents were asked if they thought these products were put out by the same company or by different companies. Of the 54 interviews conducted, the declarant indicates that, in his opinion, 63% of those interviewed thought these watches were put out by the same company.

Discussion and Opinion

There is no question that color may be the subject of a trademark. *Qualitex Co., supra*. Trade dress, including color, is registrable if it is not de jure functional and if it is distinctive, either inherently so or by virtue of acquired distinctiveness. See *Two Pesos, Inc. v. Taco*

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Cabana, Inc., 505 U.S. 763, 769, 112 S.Ct. 2753, 23 USPQ2d 1081 (1992) and Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 115 S.Ct. 1426 (1995).

As to the question of inherent distinctiveness, as noted above, we believe that this issue is not properly before us because this application was initially filed with a claim of acquired distinctiveness under Section 2(f). Nevertheless, we offer the following observations on this issue.

First, while it may be true that applicant's particular color scheme may be argued to be "unique" or novel to the extent that no other company uses this precise design, the fact that applicant's design may be said to be the one and only of its kind does not necessarily mean that it is inherently distinctive. See *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542-3 (TTAB 1992). The leading case by our primary reviewing court in this area is *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977). There, the court looked to whether the trade dress:

was a "common" basic shape or design, whether it was unique or unusual in a particular field, [or] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation

for a particular class of goods viewed
by the public as a dress or
ornamentation for the goods[.]

Applying this framework to the case at hand, applicant's design mark is nothing more than a mere refinement of a common or basic color scheme for sports watches and therefore would not immediately be recognized or perceived as a source indicator. That is to say, we believe that applicant's design would be viewed by prospective purchasers as just a slightly different ornamentation. The matching bezel and watch strap color and contrasting bezel and watch case color are essentially minor variations of a common way of adorning sports watches (contrasting colors of bezel and strap). The evidence of record, applicant's disclaimer in this case (indicating that no claim is made to the exclusive right to use colored watch bezels and straps, nor to contrasting colors per se), as well as counsel's admission at the oral hearing demonstrate that contrasting bezel and watch strap colors are in the public domain. In other words, if a competitor is free to use, say, a bezel in the color red and a watch strap in the color blue, applicant's red bezel and matching red watch band are unlikely to be considered sufficiently distinctive in and of themselves to signify origin. Rather, we believe that purchasers will merely look upon

these matching colors (and contrasting watch color) as a different form of ornamentation.

We turn then to the only real issue before us--- acquired distinctiveness. With respect to applicant's evidence of acquired distinctiveness, much of this evidence, including declarations and the preliminary injunction orders and consent decrees, involves applicant's claim to a different "mark" (that is, the six elements originally claimed in this application). Accordingly, and aside from the fact that those orders were not final adjudications entitled to preclusive effect, we believe that much of applicant's evidence has little bearing upon applicant's claim of trademark rights to the matching and contrasting colors in this application.

For a variety of reasons, we have given little weight to applicant's ten-year old pilot study. Among other things, the respondents in that study were shown applicant's watch which contained allegedly origin-indicating matter other than the asserted mark herein sought to be registered. This reason alone is sufficient to give little weight to the study. For example, some of the respondents thought that the watches came from the same source on the basis of features (such as the square shape of the watch case or the placement of other features such

as buttons) which are not part of the mark now sought to be registered. It is also clear that some of the respondents thought that both of the watches were made by the "Quartz" Company (apparently used on the face of the watches).

Also, the respondents were apparently shown watches from applicant and the Advance Watch Company which were the same color (apparently either orange and/or blue). Suffice it to say that we have largely discounted this pilot study in the analysis of this case.

We agree with the Examining Attorney that, although applicant has displayed its goods in its catalogs and, to some extent, in advertisements and promotions (magazine covers), there is no evidence showing that purchasers or potential purchasers of applicant's watches recognize the specifically claimed features in this application as an indication of origin. That is to say, although applicant may want purchasers and potential purchasers to view the matching and contrasting colors as applicant's trademark, there is simply no evidence of the effectiveness of applicant's efforts in this regard to promote recognition as a trademark of this specific aspect of the watches' appearance. Applicant has not shown that it has promoted its color scheme as a trademark in its catalogs (some parts of which do not even clearly show that the strap is the

same color as the bezel), and there is no indication that potential purchasers would view this as more than a picture of the goods. See *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811 (TTAB 1998). The color scheme has simply not been advanced as a means of recognizing applicant as the source of its watches (unlike the mark SHARK shown thereon).

Furthermore, the claimed popularity of applicant's watches⁸ may well result from other features of its products which are deemed superior by the purchasing public. Moreover, applicant's sales and advertising figures are not determinative of the success of applicant's attempts to develop distinctiveness of its asserted color scheme. In *re Pingel, supra* (sales growth over time does not suffice to establish that purchasing public has come to view petcock configuration as a trademark for motorcycle fuel valves) and *In re Semel*, 189 USPQ 285 (TTAB 1975). Nor does the fact that competitors may have sold "look-alikes" that may resemble applicant's watches in some respects indicate their desires to copy the particular aspect of applicant's watch which applicant now claims to be its mark in this application.

⁸ We have nothing which indicates the relative size of applicant's sales to those of competitors. See *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1452, 1457 (TTAB 1998) and *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1227 (TTAB 1992).

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In summary, applicant has not met its burden of establishing a prima facie case of acquired distinctiveness.

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DECISION: The refusal of registration is affirmed.

R. L. Simms

E. J. Seeherman

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