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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Gibson Guitar Corp.**

Serial No. 75/513,342

Lucian Wayne Beavers and Martha B. Allard of Wadley & Patterson for Gibson Guitar Corp.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney)

Before Seeherman, Wendel and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Gibson Guitar Corp. has appealed from the final refusal of the Trademark Examining Attorney to register the design of a guitar body, shown below, for "stringed musical instruments, namely guitars."¹ Applicant has described the mark as comprising "a fanciful design of the body of a

¹ Application Serial No. 75/513,342, filed July 6, 1998, and asserting first use and first use in commerce on December 31, 1934.

guitar" and has stated that "the matter shown by the dotted lines is not a part of the mark and serves only to show the position of the mark on the goods."

Registration has been refused pursuant to Section 2(e)(5) of the Trademark Act, 15 U.S.C. 1052(e)(5), on the ground that the applied-for mark is de jure functional, and pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052 and 1127, on the ground that, if the product design is not de jure functional, it does not function as a mark, but is merely a configuration which has not acquired distinctiveness.²

² Initially applicant claimed that the configuration was inherently distinctive; however, during the prosecution of this application the Supreme Court held that a product configuration could not be inherently distinctive. **Wal-Mart Stores, Inc. v. Samara Brothers, Inc.**, 529 U.S. 205, 54 USPQ2d 1065 (2000). Applicant has not pursued this argument in the appeal and, accordingly, the question of inherent distinctiveness is not before us in this appeal.

Applicant and the Examining Attorney have filed appeal briefs, but applicant did not file a reply brief, and did not request an oral hearing.

We turn first to the issue of whether the guitar configuration is de jure functional. A product feature is functional and cannot serve as a trademark if it is essential to the use or purpose of the article or it affects the cost or quality of the article. A functional feature is one the exclusive use of which would put competitors at a significant non-reputation-related disadvantage. **Qualitex Co. v. Jacobson Products Co.**, 514 U.S. 159, 34 USPQ2d 1161 (1995), quoted in **TraFFix Devices Inc. v. Marketing Displays Inc.**, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

In **In re Morton-Norwich Products, Inc.**, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), the Court set forth four factors to be considered in determining whether a product design is de jure functional: (1) the existence of a utility patent that discloses the utilitarian advantages of the design; 2) advertising materials in which the originator of the design touts the design's utilitarian advantages; 3) the availability to competitors of alternative designs; and 4) facts indicating that the design results from a

comparatively simple or cheap method of manufacturing the product.

In this case, applicant has stated that there is no utility patent, nor is there any evidence that its guitar configuration results from a simpler or cheaper method of manufacture. Accordingly, these factors do not weigh in our decision.³

With respect to the second factor, applicant's advertising materials tout the functional advantages of its guitar shape. Specifically, the advertisement for applicant's Epiphone guitar, submitted as Exhibits B and E to applicant's response filed on September 27, 1999, includes the following copy:

The new Epiphone Advanced Jumbo™ (AJ) acoustics are different from any other ordinary dreadnought guitar. Our AJ body shape not only looks more like a bell, but also rings like a bell. The more rounded upper bout produces sweeter highs while the broader waist and wider lower bout creates more powerful lows. Combined with a solid Sitka spruce top, mahogany back and sides, reverse-belly™ rosewood bridge and AJ scalloped top bracing, this unique body shape creates a sound which is much more balanced and less "muddy"

³ The Examining Attorney characterizes the absence of a utility patent as a factor which weighs in applicant's favor. We disagree. Although the existence of a utility patent could weigh against applicant in terms of showing that the configuration is de jure functional, the absence of such a patent simply has no weight in our analysis.

than other ordinary dreadnought
acoustics.

This copy clearly indicates that the particular features of the applicant's configuration—the rounded upper bout, the broader waist, and the wider lower bout, provide certain acoustical advantages in terms of the sounds the guitar makes. "This unique body shape creates a sound which is much more balanced and less 'muddy' than other ordinary dreadnought acoustics."

We are not persuaded by applicant's argument that this advertisement does not tout the functional features of the guitar shape, but is merely puffery. Even if one cannot ascertain with specificity the sound of "sweeter highs", "more powerful lows", and a balanced and less muddy sound, the clear import of the advertisement is that the shape of the guitar is what produces a better musical sound.

With respect to the third factor, the availability of alternative designs, it is not clear, after **TraFFix Devices Inc. v. Marketing Displays Inc.**, supra, whether the availability of alternatives weighs as a factor in applicant's favor. In TraFFix the Court said that there is no need to engage in speculation about other design possibilities because the functionality of, in that case, the spring design,

"means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.
58 USPQ2d at 1007

Even assuming the availability of alternative designs remains a factor in determining whether a configuration is de jure functional, applicant has not shown that there are alternative guitar shapes which can produce the same sound as applicant's configuration. On the contrary, the evidence indicates that the specific shape of applicant's guitar is necessary for such sound. In particular, the literature for the Santa Cruz Guitar Company's "Vintage Jumbo Model," which appears identical in shape to the configuration sought to be registered, states that:

"Round shouldered dreadnoughts have a unique sound," enthused Santa Cruz president Richard Hoover. "Their deep, rich, bass and sweet, strong treble really shine in chord-oriented styles like country, folk and blues."
www.santacruzguitar.com

In view of the foregoing, we find that applicant's configuration is de jure functional.

Although this finding means that applicant's configuration is prohibited from registration by Section 2(e)(5) of the Act, in the interest of rendering a complete

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opinion we now turn to the question of whether, assuming arguendo the configuration is not functional, it has acquired distinctiveness as a trademark.

It is applicant's burden to prove acquired distinctiveness. **Yamaha International Corporation v. Hoshino Gakki Co., Ltd.**, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); **In re Meyer & Wenthe, Inc.**, 267 F.2d 945, 122 USPQ 372 (CCPA 1959). In general, the more descriptive the term, the greater the evidence necessary to demonstrate acquired distinctiveness. See **Yamaha International Corporation v. Hoshino Gakki Co., Ltd.**, supra. The same is true when the proposed mark is a configuration. Id.

In this case, applicant's evidentiary burden is high. The record shows that applicant's guitar configuration is extremely similar to those used by other guitar manufacturers. In fact, in the first Office action the Examining Attorney considered the configuration to be the same as the dreadnought shape; the differences which applicant pointed out in its response to that action are relatively minor, having to do with a slightly rounder shoulder, broader waist and wider lower bout. See Exhibit C to the September 27, 1999 response.⁴ Although guitar

⁴ Applicant also claims that the neck of the guitar intersects the applied-for shape at a different angle from the dreadnought,

collectors and aficionados may well be aware of these differences, the determination of acquired distinctiveness must be made on the basis of casual guitar purchasers as well. Applicant's identification of goods is for guitars per se. These would include inexpensive guitars which might be purchased by people who wish to learn guitar as a hobby, or by parents for their young children. Such casual purchasers are not likely to note the differences between applicant's guitar configuration and those of others, let alone recognize the overall configuration as a trademark without significant education on the part of applicant.

We turn then to an examination of the evidence of acquired distinctiveness provided by applicant.

Applicant has been using the configuration sought to be registered since 1934, a period of 66 years. Although this is a long period of time, the number of guitars sold during this period is relatively small. For the first time in its brief, applicant states that "over 100,000 guitars embodying the shape have been sold in the United States..."

Brief, p. 7.⁵ Based on this figure, an average of only 1600

but this is not apparent from the drawing, and in any event the neck is not claimed as a feature of the mark.

⁵ Although this "evidence" was not timely submitted prior to the filing of the notice of appeal, see Trademark Rule 2.142(d), in her brief the Examining Attorney has treated this information as though it were of record, and we will therefore do the same.

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guitars were sold each year during that period. On its face, this does not seem to be a significant number of guitars sold each year, and applicant has given us no information which would indicate the contrary, e.g., the relative position between applicant's sales of this configuration and sales of other configurations. Moreover, of this 100,000 figure, approximately 10,000 of the guitars were sold since 1999 through applicant's Epiphone division. Thus, in the 64 years between 1934 and 1998, the average number of this shaped guitar sold each year was even less than 1600. As for the sales of 10,000 in a two-year period, again there is no evidence to show whether this is a large number of sales of guitars vis-à-vis the sales of other companies.

With respect to applicant's advertising, the material made of record by applicant is an advertisement for the Epiphone Advanced Jumbo guitars (Exhibit B); and a 1999 Epiphone catalog which, as applicant indicates, shows guitars with the applied-for configuration at pages 23-25. Page 23 is the same advertisement as Exhibit B, while similar language to that quoted supra is repeated on page 24. Although the copy does point out that the "body shape not only looks more like a bell, but also rings like a bell," because the copy goes on to point out the advantages

of this shape in creating better tones, consumers are not likely to regard this language as indicating that the shape is a source-indicator, but as a functional feature.

Applicant has also submitted, as Exhibit F, a calendar in which, for the month of October, a guitar with the configuration at issue is pictured next to a nude woman, who is shown from the rear. Applicant asserts that this photograph "emphasizes the round curvaceous shape of the guitar..." Response filed September 27, 1999. However, we are not persuaded that consumers would understand from this picture that the guitar configuration is meant to be a source-identifier. There is no language accompanying the picture to this effect, and this photograph appears in a calendar featuring nude or scantily-dressed women with guitars. The photographs are more likely to be seen as using the women's bodies to draw attention to the guitars, rather than to the particular guitar configuration. For example, the December photograph is taken from above, thereby distorting the picture of the woman to emphasize her breasts. We do not think that consumers are likely to see that the pictured guitar has a breast shape. Even in the October photograph of the configuration at issue, one would not be aware of the specific features which applicant claims are unique to this guitar, such as the round

shoulder, from the picture of the woman, whose hair covers much of her back, such that one couldn't clearly say whether her shoulders are more like the rounded shoulders of applicant's configuration, or the flat shoulder design of the dreadnought guitar.

Moreover, even if the advertising materials could be said to indicate to the public the particular shape of applicant's guitar configuration, applicant has provided no evidence of the amount or distribution of such materials. Thus, we cannot determine what kind of exposure, and hence impact, these materials have had.

Finally, applicant points to Chapter 3, called "The Round-Shoulder Jumbos," in a book entitled Gibson's Fabulous Flat-Top Guitars, An Illustrated History & Guide.⁶ Exhibit A. From our reading of this chapter, this book appears to be a history of the Gibson Guitar Company, and the various guitars which it introduced. Applicant asserts that the fame of the guitar, the fact that it is "so unique and well known," is shown by its being the subject of an entire chapter. Applicant states that the guitar configuration sought to be registered is commonly referred

⁶ By Eldon Whitford, David Vinopal, & Dan Erlewine. Applicant's submission does not indicate the copyright date.

to as the Gibson "Round Shoulder Jumbo" or "Advanced Jumbo."

There is no evidence as to what exposure this book has had to the consuming public. Certainly the information reflected in the chapter which is of record, providing minute details as to the measurements, bridges, necks, braces, etc. of each guitar model which Gibson introduced, including several paragraphs written about a guitar of which only three were made, indicates that this book was not written for the casual purchaser, but for collectors and those with a deep interest in the history of guitars and the Gibson Guitar Company. As such, we cannot conclude that purchasers in general would recognize the configuration as a trademark because of this book.

Moreover, although the chapter is entitled "The Round-Shoulder Jumbos, throughout the chapter the guitars are not referred to by this term, but as "Jumbos," "Advanced Jumbos" or "AJs." Indeed, there are very few references in the chapter even to the fact that the guitars have rounded shoulders. The first reference we note is on page 48, although the chapter begins on page 18. The references to round shoulders in the chapter are minimal, and are buried in the rest of the text. In fact, references to the colors of the woods and the changes to the shape of the necks are

given far greater prominence. As a result, readers of the chapter are unlikely to regard the round-shouldered shape as unique, or to consider the round shoulders to be a source-identifying feature. We would also point out that the configuration sought to be registered is for the overall shape of the body, not just for the rounded shoulders.

As noted previously, given the similarity of applicant's configuration to that of other guitars, applicant has a heavy burden to demonstrate acquired distinctiveness. We find that applicant has failed to meet this burden, and that the evidence submitted by applicant is insufficient to demonstrate that the configuration has acquired distinctiveness, such that consumers would regard it to be a trademark. Thus, even if the configuration were not functional, applicant would not be entitled to registration.

Decision: The refusal to register is affirmed on the ground that the configuration is de jure functional and, even if it were not functional, it does not function as a trademark.