

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gates (U.K.) Limited

Serial No. 74/560,560

C. H. Castleman, Jr. for Gates (U.K.) Limited.

Karyn K. Ryan, Trademark Examining Attorney, Law Office 109
(Ronald Sussman, Managing Attorney).

Before Seeherman, Quinn and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Gates (U.K.) Limited has filed an application to
register the combination of color and design elements
depicted below as a mark for "waterproof footwear."¹

¹ Serial No. 74/560,560, filed August 12, 1994, claiming dates of
first use of November 28, 1983.

The following description of the mark has been made of record:

The mark consists of a red rectangular border within which black colored indicia are displayed against a white background, the specific indicia forming no part of the mark.

A claim of acquired distinctiveness under Section 2(f) has been made as an alternative basis for registration.

Registration has been finally refused on the ground that the proposed mark fails to function as a trademark under Sections 1, 2, and 45 of the Trademark Act. The requirement that applicant delete the term "INDICIA" and the surrounding dotted rectangle has also been made final.

Applicant and the Examining Attorney have filed briefs but no oral hearing was requested.

We first consider the requirement that the term "INDICIA" and surrounding dotted rectangle be deleted from the drawing of the mark. The Examining Attorney² maintains that this element of the drawing is overly encompassing and fails to provide notice of the scope of the applied-for mark. Because the specimens of record show various forms of wording and design matter, the Examining Attorney argues

² We note that a total of three Examining Attorneys have taken part in the examination of this application.

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that the term "INDICIA" covers each and every one of these forms and, as a result, covers multiple marks. The black coloring per se is said to be inseparable from the lettering or design features encompassed by the "INDICIA." Thus, the "INDICIA" term is considered to be a "phantom" element being used to seek to register more than one mark in a single application, as is prohibited under *In re International Flavors & Fragrances Inc.*, 47 USPQ2d 1314 (TTAB 1998), aff'd, ___ F.3d ___, 51 USPQ2d 1513 (Fed. Cir. 1999). In addition it is argued that there is insufficient depiction of the spatial relationship or proportions of the "INDICIA" to give a complete representation of the mark as required under TMEP §807.

Applicant describes its proposed mark as a design mark consisting of a combination of three different colors oriented in a specific spatial relationship with respect to one another combined with a particular geometric design, with some indicia being present. In particular, the mark is defined as a label design consisting of a red rectangular border of significant width, a white background within the border, and indicia of black color imprinted thereon. Applicant argues that it is not attempting to cover multiple marks, inasmuch as the "INDICIA" portion of its mark is being relied upon only for its color and not

its content.³ Applicant insists there is nothing "phantom" about the color black and that the mark creates a single impression, regardless of the particular matter imprinted in this color on the white background contained within the rectangle defined by the red border. Applicant argues that its mark does not differ substantially from the background polka dot label design involved in *In re Swift & Co.*, 223 F.2d 950, 106 USPQ 286 (CCPA 1955), except that applicant has included in its drawing not only the background geometry and coloring but also the particular color of the matter imprinted on this background.

We agree with applicant that there is no "phantom" element involved here. Applicant has made it clear in its description of the mark that the particular "indicia" imprinted on the white background is not part of the mark sought to be registered. While the specimens of record may show different wordings used on the background, such as "Hunter" or "Gardener," these wordings are not part of the

³ Applicant further argues that the question of the registrability of phantom marks has not been fully settled, citing numerous marks on the register and attempting to introduce evidence to this effect. We have given no consideration to this argument, or evidence, in view of the affirmance by our principal reviewing court of our decision in *In re International Flavors & Fragrances Inc.*, *supra*. We consider future Office policy as to the non-registrability of phantom marks to have been fully determined by the explicit holding of the court that an applicant may only seek to register a single mark in a single application and that phantom marks violate this registration requirement.

mark being claimed, only the coloring thereof. This is not a situation similar to that in the *International Flavors* case, wherein the "xxxx" designation in the mark sought to be registered covered a multitude of different words. Here the "INDICIA" element is being used to indicate the specific black coloring of whatever words or design appear within the white background. This is an unchanging element of the mark sought to be registered.

In the *International Flavors* case the Board discussed the registrability of color marks and the Office's requirement that the drawings for such marks show how the color is being, or will be, used in connection with the goods or services, so as to put others on notice of the precise manner of use of the color. Applicant has simply complied with this requirement by including the "INDICIA" element in the drawing to put others on notice of the manner in which the color black is being used in its mark. Furthermore, contrary to the position taken by the Examining Attorney, we see no reason why this particular coloring cannot be claimed separately from the wording of the "indicia." Nor do we find it necessary for applicant to specifically indicate the proportions or spatial relationship of the "indicia" being imprinted on the

background, since the "indicia" is not a part of the mark being claimed.

Accordingly, the requirement that the term "INDICIA" and the surrounding dotted rectangle be deleted from the drawing is reversed. In light of the accompanying description of the mark, the drawing is acceptable.⁴

Thus, we turn to the refusal to register on the ground that the proposed mark as set forth in the original drawing fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act, in that it neither identifies nor distinguishes applicant's goods from those of others nor indicates their source. In making our analysis, we must consider whether the proposed mark is inherently distinctive, and if not, whether the showing submitted by applicant is sufficient to establish acquired distinctiveness as provided for under Section 2(f).

The Examining Attorney maintains that the proposed mark is a non-distinctive geometric background design, even

⁴ In the event that applicant otherwise prevails on appeal, the application should be remanded to the Examining Attorney for consideration of whether an amended drawing should be required which more concisely depicts the potential proportions of the matter imprinted on the white background and which would not use the term "indicia," so as to avoid the misfiling by the Office of the drawing under the word "indicia." A more appropriate means of depicting the mark would appear to be to enlarge the dotted rectangle to cover nearly all of the area within the white background and to refer to "all matter within the dotted rectangle" in the description of the mark.

with the additional color features. The copies of third-party registrations and applications made of record by the Examining Attorney showing the use by others of red rectangular borders or red geometric carriers as components of marks for clothing items are noted.

Applicant asserts that its mark is not a common geometric background design or a mere color mark, but instead a unique combination of both color and geometry, which conveys to purchasers a unique impression indicating a single source of the goods. Applicant argues that its mark is distinguishable from that involved in *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988), applicant's mark consisting of much more than the simple parallelogram background design sought to be registered in the *Anton/Bauer* case. Applicant argues that the level of distinctiveness of its mark, with its combination of geometric and color components, is on a par with the polka dot label design which was found to be inherently distinctive in *In re Swift & Co.*, *supra*.

A background design used in connection with a word and/or design mark may be registered as a trademark only if it creates a commercial impression separate and apart from the word and/or design mark with which it is being used.

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In re Benetton Group S.p.A., 48 USPQ2d 1214 (TTAB 1998); In re Anton/Bauer, *supra*. If the background design is inherently distinctive, it may be registered without evidence that it is recognized as a trademark; if it is not inherently distinctive, proof of acquired distinctiveness under Section 2(f) is essential. In re E.J. Brach & Sons, 256 F.2d 325, 118 USPQ 308 (CCPA 1958). Most common geometric shapes, when used as the background display for a word mark, are not regarded as being inherently distinctive, but rather require evidence of acquired distinctiveness, and the fact that the background may be a particular color does not change this standard. In re Benetton Group S.p.A., *supra*.

In *Anton/Bauer*, the background design sought to be registered was a simple uncolored parallelogram design. In the *Benetton Group* case the design sought to be registered consisted of a horizontal green rectangle used as the background for words and/or designs. Here the proposed mark consists not only of a white rectangular background with a red border, but also the particular coloring of the words and/or designs used thereon. Both the degree of geometric design and the number of colors involved are greater than in the prior cases. Nonetheless, we do not find this combination of geometric shapes and the colors

red, white and black sufficiently distinctive to conclude that the background would create a commercial impression separate and apart from the words and/or designs used in conjunction therewith. The evidence of record shows the prior use by others in the clothing field of marks having a rectangular background shape with a red border. It goes without saying that the use of the color black in the imprinting of words on a label or packaging is commonplace. Thus, there is no reason to believe that purchasers would be likely to attribute such design and/or color features to a single source. Applicant's background design clearly does not reach the level of distinctiveness of the polka dot label design involved in the *Swift & Co.* case. Accordingly, we find that applicant's combination of geometric background design and colors is not inherently distinctive and may be registered only upon proof of acquired distinctiveness.

Applicant argues that, if its proposed mark is not found to be inherently distinctive, it has submitted evidence which establishes a strong prima facie case of acquired distinctiveness under Section 2(f). Applicant relies upon the declarations submitted by its Assistant Secretary, Curtis H. Castleman, Jr., to the effect that the proposed design mark has been used exclusively and

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continuously since 1983 (the final declaration having been made in 1998) and that the retail sales figures of its waterproof footwear in the United States for the period from 1983 until April 1998 totalled approximately \$10 million. Although applicant has provided no advertising figures, representative promotional literature in the form of a catalog, a magazine advertisement, a brochure distributed in the United States, and a reproduction of the mark as used on packaging for the footwear have been made of record. Applicant maintains that inasmuch as applicant's combination of geometric shape and color is much more distinctive than the simple geometric shape involved in *Anton/Bauer*, its burden of proof to establish acquired distinctiveness should be lower and that applicant has in fact met this burden.

The Examining Attorney, on the other hand, contends that applicant has failed to meet its burden of proving that its proposed mark is perceived by the public as a trademark. The Examining Attorney points out that there is no evidence of consumer recognition of the geometric design and color combination as a source indicator, apart from the wording thereon, or that it creates a separate commercial impression.

Distinctiveness means that the primary significance of applicant's color and design combination must be as a designation of source, rather than as mere background for the presentation of applicant's various word marks. See *Roselux Chemical Co., v. Parsons Ammonia Co., Inc.*, 229 F.2d 855, 132 USPQ 627 (CCPA 1962); *In re Benetton Group S.p.A.*, *supra*. While applicant has submitted evidence of an extended period of use of its proposed mark in connection with its waterproof footwear and of significant sales of its footwear in the United States, applicant has failed to submit any evidence whatsoever of promotion of, or consumer recognition of, the background design and color combination used by applicant as a mark in itself.

Nowhere in the promotional material which has been made of record do we see anything which would cause purchasers to view the white rectangular background with a red border and the black coloring of the words and/or design imprinted thereon as a separate indicator of source. Whether the background design is used as part of a label placed directly on the footwear or as part of the total designation found elsewhere in applicant's advertising or packaging, there is nothing which would specifically draw purchasers' attention to this background/color combination as a means of recognizing applicant as the source of the

goods. There is no promotion of the background/color combination in a way that would set this background design apart from the word such as "Hunter" or "Gardener" imprinted thereon. Cf. *In re Haggard Co.*, 217 USPQ 81 (TTAB 1981)[Black Swatch design, rather than words imprinted thereon, most readily discernible from a distance by purchasers and, in point-of sale display, Black Swatch design seen from one side without any words].

Accordingly, we find the evidence submitted by applicant insufficient to establish that the combination of geometric shape and colors which applicant uses as a vehicle for the words imprinted thereon, has acquired distinctiveness as a mark in itself. Applicant has failed to prove that this background design and color combination functions primarily as an indication of source. Thus, applicant's proposed mark is not registrable, either on the basis of inherent distinctiveness or acquired distinctiveness.

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Decision: The refusal to register on the ground that applicant's design/color combination fails to function as a mark under Sections 1, 2 and 45 is affirmed. The requirement that the "INDICIA" element be deleted from the drawing is reversed.

E. J. Seeherman

T. J. Quinn

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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