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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Burco, Inc.

Serial Nos. 78140350; 78140360; and 78140376

Mary C. Bonnema of McGarry Bair for applicant.

David Taylor, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Seeherman, Quinn and Drost, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications were filed by Burco, Inc. to register the designations 2216, 2252 and 3217 for "replacement glass for outside rear-view mirrors."[1] Applicant has claimed acquired distinctiveness pursuant to Section 2(f) of the Trademark Act.

In each application, the trademark examining attorney refused registration under Sections 1, 2 and 45 of the

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[1] Application Serial Nos. 78140350, filed July 1, 2002, alleging dates of first use of May 1981; 78140360, filed July 1, 2002, alleging dates of first use of March 1989; and 78140376, filed July 1, 2002, alleging dates of first use of February 1993.

Trademark Act on the ground that applicant's numerical designations serve merely as model numbers or part numbers that are neither inherently distinctive nor have acquired distinctiveness.

When the respective refusals were made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

In view of the common questions of law and fact that are involved in these three applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

In support of registration, applicant argues that just because a proposed mark is a numerical designation does not automatically mean that the designation does not function as a trademark. Applicant contends, in pointing to the evidence it has submitted, that its numerical designations are used and perceived as trademarks for its goods sold thereunder. More specifically, applicant points to its years of use of the designations, sales of products under the designations, and advertising expenditures relating to promotion of its numerical designations. Applicant also relies on its specimens, which are packages for the goods, asserting that the designations are prominently displayed

thereon. In sum, applicant states that its respective numerical designations serve "as *both* a model number *and* as a source indicator for Applicant's goods." (Request for Reconsideration, filed October 24, 2003, in S.N. 78140350) (emphasis in original).[2]

The examining attorney maintains that the proposed marks, as used on the specimens, merely identify model, style or grade designations, and would not be perceived as trademarks for applicant's goods. The examining attorney, relying on evidence obtained from applicant's web site on the Internet, asserts that applicant merely utilizes various four-digit numbers as part numbers that customers may use for ordering the appropriate part. With respect to the claim of acquired distinctiveness, the examining

[2] In its appeal briefs, applicant references eight third-party registrations of numerical trademarks, contending that applicant's involved designations "should be registered for all of the same reasons that those numerical trademarks were registered." The examining attorney's brief is silent on this point. Notwithstanding this silence, this evidence was never properly made of record in a timely fashion. Accordingly, the third-party registration evidence is not of record and has not been considered in reaching our decision. In any event, such evidence, even if of record, is of no moment. The issue in this consolidated appeal is not whether numbers can be registered; clearly, in appropriate circumstances, numbers are registrable as trademarks. Rather, the issue herein is whether applicant's part numbers have acquired distinctiveness. These third-party registrations provide no apparent support for applicant's position that it has demonstrated that its numerical designations have acquired distinctiveness. Further, as is often stated, each case must be decided on its own merits. In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001).

attorney contends that the evidence in support thereof is insufficient, finding that the length of use of the proposed marks, the advertising figures and the enforcement actions undertaken by applicant against alleged infringers fall short in establishing acquired distinctiveness.

It is settled that numbers used only to indicate model, style or grade are not registrable as trademarks because they do not serve to identify and distinguish an entity's goods from similar goods manufactured and sold by others. Such numbers, however, can serve, in appropriate circumstances, the dual purpose of a model or grade designation and a trademark indicating origin of the goods. That is to say, if it is shown that the numeric designation has attained recognition by the public as a source identifier in addition to any other function it may perform, then it may be registrable as a trademark. In re Dana Corp., 12 USPQ2d 1748 (TTAB 1989); and In re Peterson Manufacturing Co., Inc., 229 USPQ 466 (TTAB 1986).

The specimens of record show the respective numerical designations appearing on labels affixed to packaging for the goods. One of applicant's specimens, which is also representative of how applicant's other two marks are actually used, is reproduced below.

Applicant claims, as noted above, that its numerical designations function both as model numbers and as source indicators. In connection with the latter function, applicant has claimed that its numerical designations have acquired distinctiveness as provided under Section 2(f).

Applicant has submitted four declarations. The first declaration is from Michael Mervenne, applicant's vice president. Mr. Mervenne states that applicant's numerical trademarks 2216, 2252 and 3217 have been used in commerce since at least as early as 1981, 1989 and 1993, respectively. Mr. Mervenne further asserts that the marks "identify [applicant] as the well-known source of quality automotive replacement mirror parts" and that the marks

"identify specific types of automotive replacement mirror parts, in addition to serving the source-indicating function." According to Mr. Mervenne, applicant and its parts have "achieved significant commercial success." In this connection, Mr. Mervenne states that during the period 1999-2002, applicant sold $422,331 of its glass with the part no. 2216; $320,101 of its glass with the part no. 2252; and $387,176 of its glass with the part no. 3217. It is also claimed that competitors have attempted to "copy, misappropriate and trade off of" applicant's marks, and that applicant has acted promptly to stop these third-party uses. Exhibits relative to these actions accompany the declaration. Applicant's success in stopping others from using its numerical marks is, according to Mr. Mervenne, "convincing evidence that these competitors have either expressly or impliedly acknowledged the distinctiveness and trademark significance of these marks."

Two other declarations, both identically worded, are from a purchasing agent employed by Mygrant Glass Co., Michael Hayward, and from a vice president of Old Dominion Glass, Inc., Donald Rommell. Both individuals state that they are responsible for ordering and stocking automotive replacement mirror parts and that they are familiar with applicant's goods. Further, Messrs. Hayward and Rommell

state that they have for the last five years purchased replacement mirror parts from applicant. They also state, in pertinent part, the following:

> The trademarks 2216, 2252, and 3217 clearly and unequivocally designate to me automotive replacement mirror parts that are made by [applicant], and not by any other entity. With confidence, I can order [applicant's] products by these number trademarks and know that the products I receive will be genuine [applicant] products.
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> Our customers, which include auto retailers, routinely ask for 2216, 2252, 3217 brand replacement mirrors by those numbers alone because they know that the numbers designate and identify [applicant's] products.

The fourth declaration is from Elisabeth Mervenne, vice president of marketing for applicant. Of the four, this last declaration is the one most recently prepared. Ms. Mervenne reiterates, word for word, several of the same statements made by Mr. Mervenne in his earlier-submitted declaration. Ms. Mervenne further claims that she is intimately familiar with applicant's competitors and the automotive industry and that no other entity uses "these numeric trademarks." In this connection, Ms. Mervenne points to the declarations of Messrs. Hayward and Rommell in stating that applicant's numerical designations are perceived in the industry as trademarks. Ms. Mervenne goes

on to make the following assertions relative to applicant's promotional efforts:

> In addition to their long standing use and commercial success, [applicant's] advertising of such numeric trademarks provides further evidence that [applicant] uses the numerals as actual trademarks. First, as evidenced by the specimens in this case, the numeric trademark is prominently displayed on the relevant product packaging. Second, when [applicant] receives orders for the products associated with the numeric marks, the actual numeric mark is used, as is evidenced by the prior filed Declarations of Donald Rommell and Michael Hayward. Third, [applicant] widely advertises the numeric marks to distributors across the nation. Fourth, [applicant] spends over $150,000 per year in promoting its numeric trademarks through its catalog, which includes printing costs, research and development, production (layout, design and formatting), and labor.
>
> [Applicant] also advertises and promotes its numeric trademarks at tradeshows and on its website, which costs, on a yearly basis, approximately $13,000.
>
> [Applicant] spent an additional $6,000 in advertising expenses for numeric trademarks in 2004 alone.

The examining attorney, in countering applicant's evidence, submitted an excerpt of a page from applicant's website on the Internet (www.burcoinc.com). This page shows applicant's use of ten different 4-digit numbers under the heading "Part Number"; to the left of the

respective part numbers is a description of the product (e.g., “12" mirror for Domestic Vehicles” and “Lighted mirror with switch and harness”).[3]

There is no question, as applicant readily concedes, that the numerical designations sought to be registered are model or part numbers. See In re Cabot Corp., 15 USPQ2d 1224 (TTAB 1990) [claiming benefits of Section 2(f) is “tantamount to an admission that this [designation] lacks inherent distinctiveness”]. See also Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). It is applicant’s position, however, that the evidence of record establishes that the designations have acquired distinctiveness.

On the Section 2(f) issue, applicant has the burden of proving that its numerical designations have acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294 (CCPA 1954). Upon consideration of applicant’s evidence, we find that the evidence is insufficient to show that the numerical designations serve a trademark function.

Applicant’s use of its numerical designations and the

[3] The listed numbers are: 2301, 2302, 2303, 2304, 2305, 2315, 2328, 2329, 2330 and 2331. The involved numeric designations sought to be registered herein are not listed on the particular page submitted by the examining attorney.

sales figures set forth by Mr. Mervenne indicate that applicant has had a relatively modest degree of success. The sales fall short, in our view, of Mr. Mervenne's claim of "significant commercial success." In saying this, we readily recognize the difficulty in accurately gauging the level of applicant's success in the absence of additional information such as applicant's market share or how it ranks in terms of sales in the industry. In any event, to the degree that applicant's goods have been popular, popularity of a product is not synonymous with acquired distinctiveness; popularity does not necessarily indicate that buyers associate the designation with only one source. In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Simply put, the volume of sales is irrelevant if purchasers regard the numerical designations as part or model numbers rather than as trademarks.

The advertising expenditures likewise are not impressive. Applicant's annual expenses of $150,000 covers the cost of producing applicant's catalog wherein, presumably, the numerical designations are listed as part numbers, as is the case with applicant's website. Further, Ms. Mervenne cites to annual expenditures of $13,000 to attend trade shows and maintain its website, yet this

amount would appear to cover expenses that, only incidentally, involve promotion of applicant's numerical designations. The additional $6,000 for advertising expenses cited by Ms. Mervenne is hardly a substantial number. None of the advertising figures is broken down to reflect promotion for the specific numerical designations, and it is assumed that the figures apply to applicant's entire collection of numerical designations, not just the ones sought to be registered herein. In any event, the salient issue is the achievement of acquired distinctiveness and not the effort in the attempted achievement. In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

Moreover, there is no evidence that applicant has promoted the numerical designations as trademarks. Applicant has failed to submit any promotional materials showing how the marks are promoted, whether by way of its catalogs, its appearances at tradeshow, its website, or otherwise. There is no evidence that applicant has featured the numeric designations as trademarks in its advertising or other promotional efforts such that it can be inferred that buyers and viewers of the advertising have come to regard the designations as trademarks of applicant. What little evidence we do have, taken from applicant's web

site, shows the use of similar designations strictly as part numbers. We cannot conclude that the exposure of applicant's numerical designations in applicant's catalog or at a trade show has had any significant impact on buyers' minds such that they perceive the designations as source indicators of applicant's goods.

The fact that others in the trade have stopped their uses of purportedly similar marks when confronted with applicant's cease and desist letters is of little probative value. Applicant claims that the cessation of use is an acknowledgement by these competitors of the distinctiveness of applicant's numeric designations. Without additional evidence on this point, we are not able to reach the conclusion urged by applicant. These competitors may simply have wanted to avoid costly litigation with applicant. In re Wella Corp., 565 F.2d 143, 196 USPQ 7, 8 n.2 (CCPA 1977)["Appellant argues that various letters (of record) from competitors indicating their discontinuance of use of its mark upon threat of legal action are evidence of its distinctiveness, but we agree with the TTAB that such evidence shows a desire of competitors to avoid litigation rather than distinctiveness of the mark."].

Finally, the fact that Mr. and Ms. Mervenne, both officers of applicant, state that the numerical

designations are perceived as trademarks in the trade is hardly convincing given the self-serving nature of their statements. In re David Crystal, Inc., 296 F.2d 771, 132 USPQ 1 (1961); and Kayser-Roth Corp. v. Greene, Tweede & Co., 159 USPQ 494 (TTAB 1968).

The remainder of the evidence in support of registration comprises the two declarations from dealers of applicant's goods. These individuals, one a purchasing agent and the other a vice president, both employed by glass companies that buy applicant's replacement glass for mirrors, state that they recognize applicant's numerical designations as source indicators for applicant's goods.

Although it is not entirely clear from the record, it would appear from the declarations of Messrs. Hayward and Rommell that there are two classes of prospective purchasers for applicant's goods, namely dealers and auto retailers. There is no direct evidence that any auto retailer that buys applicant's replacement glass for outside rear-view mirrors recognizes the numerical designations as source indicators. See In re Seaquist Valve Co., 169 USPQ 245 (TTAB 1971) [statements in affidavit or declaration referring to the opinion of others is entitled to little or no probative value]. With respect to the dealers' declarations, the fact that the declarants

order applicant's products by the numerical designations is not surprising given that they are ordering the products directly from applicant, and that the designations are also part numbers. Lastly, these declarations represent the views of only *two* consumers. Although it is not incumbent upon an applicant to conduct an exhaustive survey or submit hundreds of declarations in order to prove acquired distinctiveness, two declarations of purchasers are insufficient in this case.

Under the circumstances, we find that the Section 2(f) evidence as a whole is insufficient to show that applicant's numerical designations would be perceived by purchasers as marks for applicant's replacement glass for mirrors rather than merely as part numbers for such goods.

Decision: The refusal to register is affirmed in each application.