

This Opinion is not a
Precedent of the TTAB

Hearing: January 18, 2018

Mailed: February 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
—————

In re NuWave, LLC
—————

Serial No. 86761651
—————

Nicholas S. Lee of Bishop Diehl & Lee, Ltd.
for NuWave, LLC.

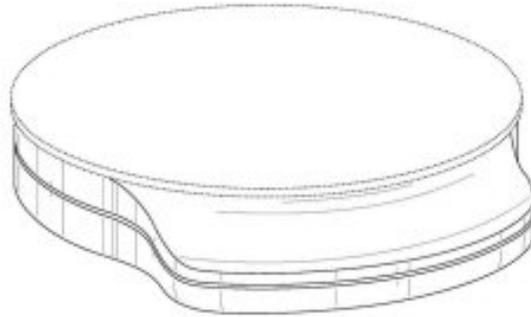
Daniel Stringer, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

—————
Before Zervas, Kuhlke and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

NuWave, LLC (“Applicant”) seeks registration as a mark on the Principal Register of the product design shown below for “electric induction cooktops” in International Class 11:¹

—————
¹ Application Serial No. 86761651 was filed on September 18, 2015, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as August 6, 2011.



The Application includes a description of the applied-for mark as follows:

The mark consists of a three-dimensional configuration of a portable cooktop in which the overall appearance of the cooktop is circular. The lining in the drawing consisting of vertical lines around the base of the cooktop are intended to show the approximate three-dimensional shape of the cooktop body and are not claimed as a feature of the mark. The broken lines depicting the circular cooking surface of applicant's goods serve to show positioning of the mark and are not claimed as part of the mark.

Applicant's specimen depicts its electric induction cooktop:



2

As Applicant explains, induction cooktops, which may be placed on kitchen counters, “work without getting hot; rather they generate a magnetic field which causes the pan itself to get hot,” as demonstrated by a screenshot from one of Applicant's infomercials:

² Sept. 18, 2015 specimen.



The Trademark Examining Attorney has refused registration of Applicant's applied-for mark under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the applied-for mark, as used in connection with the identified goods, is a nondistinctive configuration of the goods that has not acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Nondistinctive Product Configuration

Product configurations are not inherently distinctive because consumers are not predisposed to equate such configurations with particular sources: "even the most unusual of product designs--such as a cocktail shaker shaped like a penguin--is intended not to identify the source, but to render the product itself more useful or

³ Nov. 9, 2015 Response to Office Action Trademark Status and Document Retrieval (TSDR) p. 16. All references to the TSDR are to the pdf version.

more appealing.” *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068-1069 (2000), *cited in In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1467 (TTAB 2017).

Hence, product designs may be registered as marks only upon a showing of acquired distinctiveness. *E.g.*, *In re Slokevage*, 78 USPQ2d at 1398-99; *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1837 (TTAB 2013); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1986 (TTAB 2009).

Applicant conceded as much at oral argument and in the course of prosecution, acknowledging that its product configuration is not inherently distinctive, and arguing that it has acquired distinctiveness.⁴ *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”); *Yamaha Int’l. Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact.”).

II. Acquisition of Distinctiveness

Applicant bears the burden of proving acquired distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); *In re Fantasia*

⁴ *See* Nov. 9, 2015 Response to Office Action TSDR p. 17 *et seq.*; April 18, 2016 Response to Office Action TSDR p. 2 *et seq.*; Nov. 4, 2016 Request for Reconsideration TSDR p. 3.

Dist., Inc., 120 USPQ2d 1137, 1143 (TTAB 2016). To show that a proposed mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the matter as identifying the *source* of a product or service rather than the product or service itself. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n. 11 (1982); *In re Slokevage*, 78 USPQ2d at 1398. This burden is particularly heavy where an applicant seeks to establish the distinctiveness of a product configuration, which consumers are predisposed to view as useful or appealing, not source-indicating. *Yamaha v. Hoshino Gakki*, 6 USPQ2d 1001, at 1008; *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1504 (TTAB 2017).

To support a claim of acquired distinctiveness, an Applicant may submit evidence of copying by others, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies. On this list, no single factor is determinative. The evidence must relate to the promotion and recognition of the specific configuration embodied in the applied-for mark, and not to the goods in general. *In re Change Wind*, 123 USPQ2d at 1467; 37 C.F.R. § 2.41(a)(2),(3).

Applicant contends, in essence, that the rounded shape of its cooktop distinguishes it from its competitors' cooktops, most of which are rectangular. In support of this claim of acquired distinctiveness, Applicant relies primarily upon its Executive Vice President, Gene H. Kim's declaration, with exhibits.⁵

⁵ Kim declaration, 9/15/2015, Nov. 9, 2015 Response to Office Action TSDR pp. 22-24.

The Examining Attorney notes that affidavits and declarations of an applicant's employees, officers, and attorneys are usually self-serving, and carry little weight.⁶ But as Applicant notes, Mr. Kim's declaration is not based solely on conclusory assertions, but on facts offered to support a finding of secondary meaning, such as Applicant's length and exclusivity of use of the design, on its advertising and sales, on its unsolicited media coverage, and on its design patent, as well as on others' copying of the design.⁷ We consider these factors in turn.

Length and Exclusivity of Use

According to the Kim declaration, Applicant began selling its round cooktop configuration at least as early as August 6, 2011, and has continuously used this product design since then.⁸ From then until August 2015 (when Applicant filed suit against a competitor for marketing a rounded induction cooktop), Mr. Kim avers that he was not aware of any other person, company or association using its rounded cooktop shape on any induction cooktops in the United States. "In fact," he states, "all other major sellers of portable induction cooktops appear to utilize a square or rectangular cooktop shape."⁹

In this case, the Examining Attorney observes, cooktops are commonly offered in a variety of different shapes, including rounded and rectangular shapes, such that

⁶ Examining Attorney's brief, 13 TTABVUE 12 *citing In re David Crystal, Inc.*, 296 F.2d 771, 773, 132 USPQ 1, 2 (C.C.P.A. 1961); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987); *In re Cent. Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); TMEP §1212.06(c) (Oct. 2017).

⁷ April 18, 2016 Response to Office Action TSDR p. 2; Kim declaration, 9/15/2015, Nov. 9, 2015 Response to Office Action TSDR pp. 22-24.

⁸ Kim declaration, 9/15/2015 ¶¶ 2, 4, Nov. 9, 2015 Response to Office Action TSDR p. 22.

⁹ Kim decl. ¶ 11, Nov. 9, 2015 Response to Office Action TSDR p. 24.

consumers would not find Applicant's rounded shape particularly exclusive, distinctive, or source-indicating.¹⁰ This point is corroborated by competing induction cooktops made of record. For example:



Another example of a competitor's rounded cooktop shape:



These third-party uses do not have to be identical to Applicant's configuration to vitiate its claim of substantially exclusive use. *Saint-Gobain Corp v. 3M Co.*, 90 USPQ2d 1425, 1440 (TTAB 2007). As the Examining Attorney points out, all of the cooktops have round cooking surfaces, on which pots and pans are placed; they differ

¹⁰ Nov. 18, 2016 Office Action TSDR pp. 1-2.

¹¹ Magneticcooky.com, Dec. 2, 2015 Office Action TSDR p. 41.

¹² MaxiMatic B Elite Platinum Induction Cooker, Dec. 2, 2015 Office Action TSDR p. 40.

only in the shape of the base under the cooking surface, e.g.:

The image displays a grid of 15 product listings for portable induction cooktops and burners. Each listing includes an image of the product, a title, a price, and a 'Get Quotations' button. The products vary in color (black, purple, blue, red) and shape (square, round). The listings include:

- NESCO NESPIC14B Nesco PIC-14 1500-Watt Portable Induction Cooktop \$77.95
- Oyama - Portable Induction Cooktop - Black \$79.99
- The best portable induction cooktop
- Fagor Portable Induction Cooktop 149.95
- Elite Platinum - 7 Portable Induction Cooktop Burner - Purple \$44.99
- Fagor 670040610 Eco-Friendly Portable Induction Cooktop 99.99
- Max Burton 6000 1800-Watt Portable Induction Cooktop, Black \$79.04
- Infrared gas cooker gas cooktop desktop double cooktop gas furnace pulse log stove natural gas cooktop US \$177.44 / piece
- Fagor 670040610 Eco-Friendly Portable Induction Cooktop 99.99
- Elite Platinum - 7 Portable Induction Cooktop Burner - Black \$44.99
- DUXTOP 1800-Watt Portable Induction Cooktop Countertop Burner 8100MC 59.99
- Elite Platinum - 7 Portable Induction Cooktop Burner - Blue \$44.99
- Electric pottery stove induction cooker induction stove kitchen appliance induction cooktop US \$370.00 / piece
- Elite Platinum - 7 Portable Induction Cooktop Burner - Red \$44.99
- without safety device gas cooker gas cooktop built in cooktop kitchen stainless steel table gas stove gas hob kitchen appliance US \$85.00/piece without safety device 36" inch gas cooktop 3 burner gas...
- induction cooker induction cooktop 4 burner induction cooker kitchen appliance US \$386.00 / piece

https://guide.alibaba.com/shopping-guides/portable-cooktop.html

1:06:38 PM 11/18/2016

13

Media coverage of Applicant’s cooktop confirms that, “[u]nlike the majority of portable induction cooktops that are a square or a rectangle, this one is round...”¹⁴

But the media reviews tend to focus on the usefulness and aesthetic appearance of

¹³ Guide.alibaba.com/shopping-guides/portable-cooktop 11/18/2016, Nov. 18, 2016 Office Action TSDR p. 3.

¹⁴ magneticcooky.com/nuwave-titanium-pic-2-vsduxtop-8300st/, April 18, 2016 Response to Office Action TSDR p. 46.

Applicant's rounded product design. According to one review, for example, "NuWave PIC introduces to you a rather pretty looking semi-spherical shaped induction cooktop.... It's a cool looking, compact black color cooktop which has its controls on the front side along the panel."¹⁵ According to another review, "Aside from flexibility, its visual appeal is another reason for its popularity. In fact, even if it is served at the middle of the dining table, it can look like an elegant centerpiece, which is also functional at the same time."¹⁶ So just as *Wal-Mart v. Samara* predicted, those viewing Applicant's product are not predisposed to equate its configuration with a particular source, but to view the product itself as more useful or appealing. *Wal-Mart v. Samara*, 54 USPQ2d at 1069; *see also In re Change Wind*, 123 USPQ2d at 1468.

As the Examining Attorney correctly observes, the length of time needed to acquire distinctiveness in the mind of the consuming public is proportional to the nondistinctiveness of the applied-for mark.¹⁷ *See In re Udor*, 89 USPQ2d at 1986 ("We also agree with the Trademark Examining Attorney that given the nature of this alleged mark, a mere claim of five years of use is insufficient to overcome this showing. Analogizing to the possible registrability of highly descriptive terms which may nevertheless acquire distinctiveness, we note that the lesser the degree of inherent distinctiveness, the heavier the burden to prove it has acquired

¹⁵ Expert.com, April 18, 2016 Response to Office Action TSDR p. 13.

¹⁶ Top5-Reviews.com/best-portable-induction-cooktop-reviews/ 4/6/2016 April 18, 2016 Response to Office Action TSDR p. 31.

¹⁷ Examining Attorney's brief, 13 TTABVUE 10-11.

distinctiveness.”). Because the applied-for mark in this case is a nondistinctive product configuration, which consumers may appreciate for its utility or appearance rather than its source, a showing of five or more years’ use is insufficient. *See In re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1186 (TTAB 2014). Indeed, in similar cases involving product configurations, far longer periods of use have been found insufficient. *See, e.g., In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) (eight years’ use not sufficient evidence of acquired distinctiveness for configuration of pistol grip water nozzles); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1766 (TTAB 2011) (16 years’ use not conclusive or persuasive to show acquired distinctiveness of motorcycle stands); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) (27 years’ use insufficient to show acquired distinctiveness for dual bands on flashlight).

For these reasons, Applicant has not demonstrated substantially exclusive use of its product design for a sufficient duration to acquire distinctiveness.

Advertising and Sales

According to the Kim declaration, Applicant has advertised its product with the rounded cooktop shape in trade shows, conferences, conventions, catalogs, brochures, flyers, websites, TV infomercials, and magazine ads. Its annual advertising and marketing figures are:

<u>Year</u>	<u>Amount</u>
2011	\$59,000
2012	\$22,400,000

2013	\$39,800,000
2014	\$28,900,000
2015	\$13,200,000 (to date of declaration)

Total advertising and marketing expenditures during this period were approximately \$100,000,000.¹⁸

During that same time period, sales of Applicant's product line increased steadily, in wholesale dollar volume of sales to retailers and distributors:

<u>Year</u>	<u>Amount</u>
2011	\$57,000
2012	\$63,700,000
2013	\$117,000,000
2014	\$84,000,000
2015	\$36,000,000 (to date of declaration)

Total dollar sales during this period were over \$300,000,000.¹⁹

These advertising and sales numbers are respectable. But we note that Applicant's advertising and packaging consistently identify Applicant's product by the word mark "Nuwave," as indicated below:

¹⁸ Kim decl. ¶ 6, Nov. 9, 2015 Response to Office Action TSDR p. 23.

¹⁹ Kim decl. ¶ 8, Nov. 9, 2015 Response to Office Action TSDR p. 23.

9/11/2015

Amazon.com: Nuwave Precision Cooktop: Electric Countertop Burners: Kitch

Try Prime Kitchen & Dining

Shop by Department Your Amazon.com Today's Deals Gift Cards Sell Help Hello, Sign in Your Account

Kitchen & Dining Best Sellers Wedding Registry Small Appliances Kitchen Tools Cookware Bakeware Cutlery

Home & Kitchen > Kitchen & Dining > Small Appliances > Countertop Burners



Nuwave Precision Cooktop
by NuWave PIC

287 customer reviews
| 130 answered questions

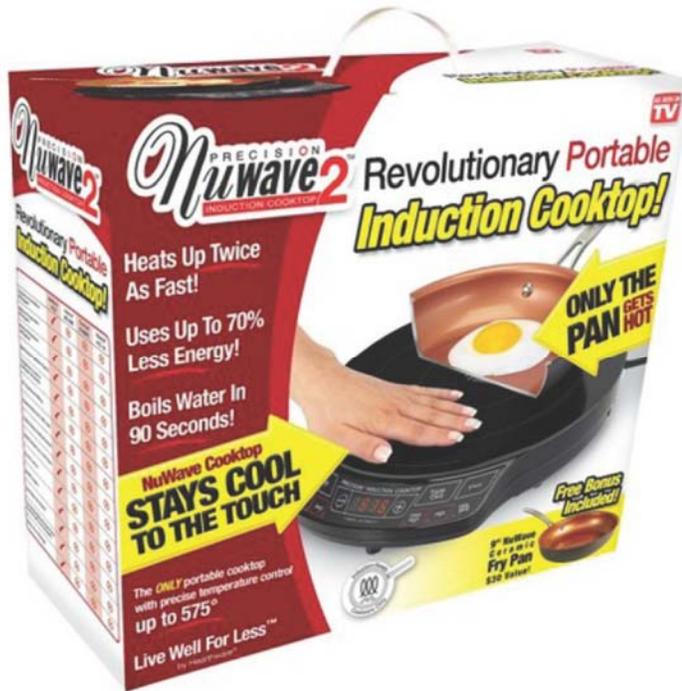
List Price: \$169.99
Price: **\$77.29 & FREE Shipping.** Details
You Save: \$92.70 (55%)

In Stock.
Sold by FW Sales and Fulfilled by Amazon. Gift-wrap available.

Want it tomorrow, Sept. 12? Order within 3 hrs and choose Saturday Delivery at checkout. Details

- Heats up twice as fast
- Uses up to 70% less energy
- Boils water in 90 seconds

20



21

²⁰ Amazon.com 9/11/2015, Nov. 9, 2015 Response to Office Action TSDR p. 32.

²¹ Target.com 9/1/2015, Nov. 9, 2015 Response to Office Action TSDR p. 50.

“It is well-settled that, where, as here, a party’s advertising and sales data is based on materials and packaging in which the mark at issue is almost always displayed with another mark, such data does not prove that the mark at issue possesses the requisite degree of consumer recognition.” *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1245 (TTAB 2015) (citing *In re Bongrain Int’l*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990)); *see also In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967) (promotion of a bottle design bearing other trademarks insufficient to show that the public views the bottle design alone as a trademark); *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (advertising of soccer ball design with word marks “provide[s] no indication of a nexus between [the] design per se and a single source.”) *cited in In re Koninklijke Philips Elecs.*, 112 USPQ2d at 1180-81.

Similarly, the sales figures merely demonstrate the popularity of the product as a product bearing the “Nuwave” word mark; they do not demonstrate that the purchasing public recognizes the product design as a source indicator. *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121, 1131 (Fed. Cir. 1992) (“Similarly, the fact that there was an apparently large consumer demand for Braun’s blender does not permit a finding the public necessarily associated the blender design with Braun.”); *Stuart Spector Designs, Ltd. v. Fender Musical Instr. Corp.*, 94 USPQ2d 1549, 1572 (TTAB 2009) (“...mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source.”).

Applicant asserts that its rounded design further promotes and leverages its existing customer association with its existing products, such as its “well-known” and “highly successful” countertop convection oven line, which is round, e.g.:



22

But Applicant provides no supporting evidence of the extent of advertising, sales, or public recognition of the shape of its countertop convection oven line. Hence, Applicant’s advertising and sales figures also fail to evince the development of consumer recognition of the induction cooktop product shape as denoting origin.

Intentional Copying

Mr. Kim declares that “In August 2015, I learned that a third party, Farberware Licensing Company, LLC, was selling a portable induction cooker bearing a product design that is almost identical to our ... product design.” ... Applicant filed suit against Farberware and its manufacturer/supplier in U.S. District Court on September 15, 2015.²³ Farberware quickly settled, and its product is no longer for sale.²⁴ The manufacturers’ respective cooktops are depicted as follows:

²² Nov. 9, 2015 Response to Office Action TSDR pp. 18, 100.

²³ Kim decl. ¶¶ 9, 13, Nov. 9, 2015 Response to Office Action TSDR p. 24.

²⁴ Applicant’s reply brief pp. 4-5.

NuWave



Farberware



25

But hasty settlement of a lawsuit evinces a desire to avoid litigation, not necessarily an acknowledgment that Applicant’s product configuration has acquired distinctiveness. *See In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 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.”) *cited in In re Ennco Display Sys., Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (“We are unable to determine from the record whether the parties entered into the license agreements in recognition of the acquired distinctiveness of applicant’s product configurations, in view of applicant’s patents on the configurations, or in order to settle litigation.”).

Further, the complaint claimed that Farberware infringed not only Applicant’s trade dress, but also Applicant’s design patent for its cooktop shape, among other causes of action.²⁶ So it is difficult to discern whether Farberware’s quick settlement

²⁵ NuWave LLC v. Farberware Licensing Co., LLC, complaint ¶2 (Civil Action No. 1:15-cv-08101 in the Northern District of Illinois, Eastern Division), Nov. 9, 2015 Response to Office Action TSDR p. 76.

²⁶ U.S. Design Patent No. US D651,448, issued Jan. 3, 2012, Count Three of Applicant’s U.S. District Court complaint ¶¶ 80-86, Kim decl. ¶ 3, Nov. 9, 2015 Response to Office Action

was prompted by the trade dress claim, or by the other claims. We note in passing that Applicant’s ownership of a design patent for the cooktop shape does not indicate that the shape is recognized by the consuming public as a source indicator. “[T]he fact that a device is or was the subject of a design patent does not, without more, bestow upon said device the aura of distinctiveness or recognition as a trademark.” *In re R.M. Smith*, 222 USPQ at 3 (quoting *In re Honeywell*, 187 USPQ 576, 578 (TTAB 1975)); *see also In re Slokevage*, 78 USPQ2d at 1396 (finding lack of acquired distinctiveness for clothing design configuration, despite applicant’s ownership of a design patent for the design).

Furthermore, “[c]opying is only evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his product as the plaintiff’s.” *Stuart Spector v. Fender*, 94 USPQ2d at 1575. There is no evidence of that in the record, as Farberware prominently displayed its own word mark on its packaging:



TSDR pp. 22, 41-46, 93-94. The complaint also claimed common law unfair competition and violation of the Illinois Deceptive Trade Practices Act.

²⁷ Applicant’s U.S. District Court complaint ¶63, Nov. 9, 2015 Response to Office Action TSDR p. 91.

“In any event, it is more common that competitors copy product designs for desirable qualities or features.” *In re Ennco Display Systems*, 56 USPQ2d at 1286. “The fact that competitors are selling ‘knock-offs’ of comparable design may be indicative of their aims to exploit desirable functional features of the design, rather than to confuse purchasers as to the source of the goods.” *In re Edward Ski Prods.*, 49 USPQ2d 2001, 2005 (TTAB 1999). Thus, this alleged copying does not prove the acquired distinctiveness of Applicant’s design.

Applicant argues that “the Examining Attorney appears to have not taken ... the evidence in its totality. Instead, the Examining Attorney appears to have taken each factor individually and found that the evidence submitted for each factor is not sufficient on its own for a finding of acquired distinctiveness.”²⁸ We have, however, considered the evidence of record in its totality, and find that it fails to satisfy Applicant’s burden of proving acquired distinctiveness. *See In re La. Fish Fry Prods., Ltd.*, 116 USPQ2d at 1264.

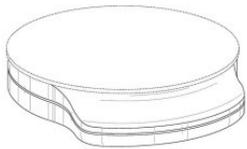
III. Conclusion

Ultimately, the critical question is the effectiveness of Applicant’s efforts in “creating a consumer association between the product configuration and the producer.” *In re Ennco Display Systems*, 56 USPQ2d at 1285. The record in this case does not reveal that the claimed product configuration has acquired distinctiveness under Section 2(f) of the Trademark Act. Accordingly, based upon consideration of all

²⁸ Applicant’s reply brief p. 4, 18 TTABVUE 5.

the evidence of record, we find that the applied-for mark is a nondistinctive product configuration that has not acquired distinctiveness. 15 U.S.C. §§ 1051, 1052, 1127.

Decision: The refusal to register Applicant's applied-for mark



is affirmed.