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

Trademark Trial and Appeal Board

In re Parkway Machine Corporation

Serial No. 74/595,979

Maurice U. Cahn of Cahn & Samuels, LLP for Parkway Machine Corporation.

Angela Lykos, Trademark Examining Attorney, Law Office 102 (Myra Kurzbard, Managing Attorney).

Before Hohein, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On March 30, 1999 the Board issued a decision affirming the refusal to register in this case. For the reasons discussed below, the decision is hereby vacated.

On November 7, 1994, applicant, Parkway Machine Corporation, filed the above-identified application to register the mark shown below for coin-operated vending machines.

After the Examining Attorney initially refused registration on the basis that the proposed mark was merely a configuration of the goods which was not inherently distinctive, applicant submitted a response arguing that applicant's use for more than five years and three declarations of applicant's customers were sufficient to present a prima facie case of acquired distinctiveness. Each of these declarations referred to applicant's Victor 88 machine, which is reproduced below:

As can be seen, however, this machine does not show the asserted mark presented in the original drawing. The Examining Attorney, in her next Office Action (August 22, 1995), did not point out this discrepancy. However, the Examining Attorney did require applicant to submit a description of the asserted mark and to present a three-dimensional view of the product, displaying its asserted mark in solid lines. Applicant complied by submitting the following drawing:

However, it appears that Patent and Trademark Office personnel placed this substitute drawing in the wrong file—Serial No. 74/595,978, which covers a different configuration for coin-operated vending machines.

Unfortunately, the Examining Attorney, who was handling both cases, did not notice that the substitute drawing for this case (Serial No. 74/595,979) presented a different mark from that originally sought to be registered herein. The Examining Attorney eventually issued a final refusal and applicant appealed. Applicant's brief, as well as the Examining Attorney's brief[1] for this case each reproduced the mark of the substitute drawing that was at the time placed in the file for Serial No. 74/595,978. The Board issued its decision herein on the basis of the mark shown on the second page of the March 30, 1999 opinion, which mark was the subject of the substitute drawing that had mistakenly been placed in this file. As the result of a telephone call from applicant's attorney after the release of our decision, the Board learned of these errors. Accordingly, the files for Serial Nos. 74/595,978 and 74/595,979 have been reconstructed so that all papers bearing the same serial number have been placed in the appropriate file. This required moving the substitute drawing and the Examining Attorney's appeal briefs from one file to the other. Because of the incorrect placement of these papers in the wrong file, the decision of March 30,

[1] The Examining Attorney's brief for this application was at the time filed in the wrong file, Serial No. 74/595,978.

1999 has been vacated, as noted previously, and the following decision is substituted therefor:

This is an appeal from the Trademark Examining Attorney's final refusal to register the design depicted below for "coin[-]operated vending machines."[2]

[2] Application Serial No. 74/595,979, filed November 7, 1994, which alleges dates of first use as early as July 1, 1987. In the application, applicant states that the dotted lines of the drawing depict the position of the mark and do not comprise part of the mark. Also, applicant states that its machines are commonly known as "gumball machines."

In an amendment, applicant describes its mark as follows:

> The mark consists of the beveled facing of a coin operated bulk vending machine incorporating a coin receiving mechanism and merchandise chute cover located laterally from the coin receiving mechanism.[3]

Registration has been refused pursuant to Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §1051, 1052, and 1127, on the ground that the design is not inherently distinctive, and applicant's evidence of acquired distinctiveness is insufficient to permit registration. Inasmuch as applicant has amended its application to seek registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), and because applicant does not seriously argue that the design is inherently distinctive, the only issue herein is whether the design sought to be registered has acquired distinctiveness.

In support of its claim of acquired distinctiveness, applicant points to its use of the design for over five years. In addition, applicant submitted three declarations

[3] We note that the Examining Attorney, in certain instances, has characterized applicant's asserted mark as simply "beveled facing." Applicant takes issue with this characterization, arguing that its asserted mark comprises not just beveled facing, but a coin receiving mechanism and merchandise chute cover as well. We recognize that applicant adopted the above description of the mark after discussions with the Examining Attorney. In any event, we have considered the asserted mark to include those elements set forth in the description of the mark, i.e., the beveled facing, a coin receiving mechanism and a merchandise chute cover located laterally from the coin receiving mechanism.

of bulk purchasers of coin-operated vending machines. The declarations are essentially identical and each declarant states in pertinent part that:

> I am fully familiar with the coin-operated bulk vending machine industry and the coin-operated bulk vending machines previously made and sold by Victor Vending Corporation and now made and sold by its successor, Parkway Machine Corporation, doing business as A & A Company under the designation Victor and/or Victor 88, that the configuration of the Victor 88 machine includes a unique front base configuration where the front plate includes a flat face with a textured surface, a raised beveled coin mechanism cover incorporating the same surface texture, and a partially recessed merchandise chute cover mounted to the side of the coin mechanism cover.
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> . . . . .
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> By reason of the unique configuration of the [applicant's] Victor 88 machines and further in view of the promotional materials and advertising featuring the uniquely configured machines, the configuration is distinctive and has become synonymous with [applicant] as the source of the machines and indicates to me that coin-operated machines so configured are manufactured by [applicant] and originate with that company.

Further, in support of registration, applicant submitted copies of three registrations which it owns covering different configurations of coin receiving mechanisms and merchandise chute covers; and a product catalog which, in addition to depicting the design sought

to be registered here, features a variety of applicant's different coin-operated vending machines with different configurations of the coin receiving mechanism and merchandise chute cover. Applicant maintains that the purchasers of its products are bulk vending machine operators and vending equipment distributors, who are sophisticated purchasers, and thus less proof is required to show acquired distinctiveness of the involved design. Further, applicant argues that inasmuch as it has obtained registrations covering other configurations, it is desirable for the Office to avoid different and inconsistent results in connection with its various applications.

The Examining Attorney, on the other hand, argues that because applicant's design is typical of vending machines, use of this design for five years and a mere three declarations are insufficient to permit registration under Section 2(f) of the Trademark Act. Further, the Examining Attorney points out that applicant has failed to provide sales and advertising figures to indicate the level of exposure of its design to the relevant public. Nor, according to the Examining Attorney, has applicant made of record product literature or advertising wherein applicant has encouraged purchasers to identify the design as a

trademark. Thus, the Examining Attorney contends that prospective purchasers are not likely to view the beveled facing on applicant's machines as a trademark. In support of the refusal, the Examining Attorney submitted evidence of third-party use of similar product designs from on-line catalogs of competitors which assertedly show similar beveled facing used on coin-operated vending machines. Two of those designs are reproduced below. (Others would not adequately reproduce.)

After careful consideration of the record and arguments herein, we find that applicant's evidence is insufficient to permit registration. In particular, the declarations fail to indicate what it is about the design of applicant's coin receiving mechanism and merchandise chute cover that is particularly unique or distinctive. It would have been helpful, for example, if applicant's declarations had indicated what particular feature or features of the design is or are unique or unusual, as well as what it is about these vending machines that signifies origin in applicant. See, for example, In re Sandberg and Sikorski Diamond Corp., 42 USPQ2d 1544 (TTAB 1996). Also, the declarations are not representative of the relevant class of purchasers as a whole, that is, bulk purchasers of coin-operated vending machines, and vending equipment distributors and retail outlets which purchase and/or use vending machines.

With respect to the existence of applicant's other registrations, we note that those registrations depict matter having different and arguably recognizable features (e.g., octagonal coin receiving mechanisms) not present in the instant application. Thus, these registrations are not particularly probative of whether the design sought to be registered here has acquired distinctiveness.

Further, although this record does not contain any examples of competitors using the exact configuration applicant seeks to register, a particular configuration does not become distinctive simply because no other manufacturer uses that particular configuration. As stated by the Board in In re S. Robbins Corp., 30 USPQ2d 1540, 1542 (TTAB 1992):

> Thus, while applicant's applied for design may be unique in the sense that it is a "one and only," the record demonstrates that said design is not unique in the sense that it has an original, distinctive, and peculiar appearance."

In view of the relatively nondistinctive nature of the asserted mark, we believe that the level of proof needed for acquired distinctiveness is substantially higher than if the features were more unusual in nature.

Further, applicant's evidence of acquired distinctiveness does not relate to the promotion and recognition of the specific configuration sought to be registered. As noted, the declarations of a small number of bulk purchasers who allegedly associate this design with applicant are not particularly probative, and the advertising depicts a number of applicant's various vending machines with different coin mechanisms and merchandise chute covers. Where as here, applicant uses a number of

different configurations of coin mechanisms and merchandise chute covers, applicant's evidence of acquired distinctiveness must establish recognition of this particular design with applicant.

Also, applicant has not promoted the asserted mark herein as a trademark and does not mention or direct attention to the asserted mark in its product catalogs. While the design may appear in advertisements, there is nothing to indicate that purchasers would view the features in question as more than a part of the goods depicted. In re Pingel Enterprises Inc., 46 USPQ2d 1811 (TTAB 1998). Although applicant may want purchsers and prospective purchasers to view the coin receiving mechanism and merchadise chute cover as its trademark, there is simply no reliable and probative evidence of the effectiveness of applicant's alleged efforts to promote recognition of these features as its trademark. Finally, applicant has submitted no sales and advertising figures from which we might judge the level of exposure of applicant's asserted mark.

For the foregoing reasons, we find that the evidence presented in this case is insufficient to permit registration under Section 2(f).

Decision: The refusal to register is affirmed.

G. D. Hohein

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board