

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 28, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **SRAM Corporation**

Serial No. 74/675,153
74/719,970

Ralph C. Francis of Francis Law Group for Sram Corporation

Richard A. Straser, Trademark Examining Attorney, Law
Office 114 (**Margaret Le**, Managing Attorney)

Before **Simms**, **Quinn** and **Walters**, Administrative Trademark
Judges.

Opinion by **Simms**, Administrative Trademark Judge:

SRAM Corporation (applicant), an Illinois corporation,
has appealed from the final refusals to register in
applications Serial Nos. 74/675,153 and 74/719,970, filed
May 16, 1995 and August 24, 1995, respectively. These
applications seek registration of the asserted mark GRIP
SHIFT and the mark shown below

for bicycle gear shifting mechanisms in Class 12 in the first application, and bicycle components, namely, gear shifting mechanisms, derailleurs, control cables, control cable sealing mechanisms, handlebar grips, shifter grip covers, brakes and brake levers, in Class 12, in the second application.¹ These cases were consolidated by the Board on February 10, 1999. We shall decide the issues in one opinion.

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.²

We reverse.

Examining Attorney's Evidence and Argument

The Examining Attorney argues that, according to dictionary evidence, patents and excerpts from the Nexis computer database, "grip shift" has been used as a term to identify handlebar-mounted bicycle gear shifting mechanisms available from more than one manufacturer and that the

¹ These applications originally included items of clothing in Class 25 but, pursuant to a request to divide, those goods were removed from these applications.

² With its brief, applicant submitted additional declarations and evidence. We have excluded this evidence and will decide this case on the basis of the record at the time these appeals were filed. See Trademark Rule 2.142(d). Although this material was filed within six months of the final refusal in Serial No. 74/719,970, and therefore within the time for submitting a timely request for reconsideration, we believe that this material should have been submitted with a request for reconsideration rather than as an attachment to applicant's brief. The declarations of

relevant public associates this asserted mark with a class or category of product and not with applicant. According to the Examining Attorney, three patents issued to different inventors use this term generically (two of these patents were subsequently acquired by applicant). Although applicant subsequently indicated that it has requested a correction in its patents to delete this improper usage and to substitute therefor the term "twist shifter," the Examining Attorney also contends that, during the course of this proceeding, applicant itself has changed its position concerning the generic name for its goods from "shift actuators" and "manually rotational actuators" to "twist shifters". Some of this evidence, as well as the Nexis excerpts, are set forth below:

Hand brake actuator

A hand grip 24 is provided on the bicycle handlebar 14 which can be a standard rubberized grip or preferably a grip shift for shifting the gears of the bicycle. One aspect of the present invention is that the clearance between the hand lever 12 in position A and the grip 24 of the bicycle is the minimum distance required by the Consumer Protection and Safety Commission and yet provides enough room to operate the grip shift 24.

Patent No. 5,176,042, Jan. 5, 1993

Mr. Brian Benzer and Mr. Ralph Francis, dated January 11 and March 1, 1999, respectively, have therefore been excluded.

* * * *

Bicycle gear shifting method and apparatus

...according to the invention which is particularly suitable for mountain bikes is mounted over the handlebar inboard of the handlebar end so as to leave room for a fixed handgrip proximate the end of the handlebar. In this form of grip shift actuator, a tubular support body is slipped over the outside of the handlebar and keyed to the handlebar...

Patent No. 4,938,733, July 3, 1990.

* * * *

Bicycle derailleur

...This makes the derailleur of the invention much more suited for use with twist grip shift actuators of the kinds referred to herein.

Patent No. 5,533,937, July 9, 1996

* * * *

Trans-axle with integral braking

Selection among the various gear ratios is provided by the speed selector designated generally by the numeral 40. Referring to FIG. 1, a twist grip shift handle is used to provide operator control of the gear ratio to be used...

Patent No. 3,905,457, September 16, 1975

* * * *

The stolen bike stolen [sic] is described as a blue and purple 16-inch, 5-speed Kent Trailblazer with a grip shift, worth \$110.

The Hartford Courant, August 27, 1998

* * * *

Nowadays, 24-speed bikes are increasingly common, and the gear shift ("grip-shift" or "shifter," strictly speaking) tends to be on the frame while the brake levers are on the bike handlebar.

The Washington Post, May 1, 1998

* * * *

...who races for Jogmate, a liquid nutritional supplement, and Sram Racing, a grip shift manufacturer and supplier...

The Daily Oklahoman, April 17, 1998

* * * *

...features the RST 280 suspended front end, oversized chrome-moly frame, Shimano Alivio/Acera drive train and SRAM Grip Shift MRX twistgrip shifters...

Bicycling, April 1998

* * * *

...Voyager II, with the "Rock Shox Indy S" front suspension for a smoother ride on rough terrain, and Grip Shift shifters for easy shifting with a twist of the wrist.

The Plain Dealer, March 30, 1998

* * * *

...Spyder Fork and a choice of either STX-RC shifters with the STX-RC front derailleur and LX rear derailleur or Grip Shift 700 shifters with 7.0 rear derailleur...

Women's Sports and Fitness, January 11, 1998

* * * *

...the two had the first draft of their new product, the grip shift. With a third partner Scott King, a friend of Day's, they launched the company in December, 1987. The name SRAM... Sales of SRAM's bike components are expected to double to \$50 million this year, thanks to the grip shift, which lets riders shift with a simple twist instead of moving a thumb off the grip to shift gears...

Chicago Sun-Times, October 22, 1995

* * * *

Grip Shift, which changes gears with a simple twist of the handlebar, has garnered more than half the market for better-quality bikes since its...

Crain's Chicago Business, September 25, 1995

* * * *

He says he's leaning toward a Gary Fisher model, "because of the way it looks, and it is affordable. I liked the grip-shift gears. They're kind of like a motorcycle grip.

The Atlanta Journal, September 4, 1995

* * * *

Grip Shift. This is a collar that encircles each handlebar, forming part of the grip. Rotating it one way shifts to a higher gear, the other to a lower. The left collar shifts the front gears; the right, the rear. The Grip Shift was easy to use and could shift through the full range of gears in one motion - a handy feature on hilly...

Consumer Reports, June 1995

* * * *

The big advance to announce in equipment, especially for the less-than-gearheads, is the proliferation of the grip shift. It's just about the simplest gear-shifting system you could hope for, and half of the bikes in the \$300 to \$400 range... now come fitted with a grip shift.

Anchorage Daily News, May 5, 1995

* * * *

"Grip shifts" are handlebar gear-shifting mechanisms. They should not be confused with "key grips," which are the last people in movie credits, or "thrift shops," which is where...

The Seattle Times, January 13, 1994

* * * *

...Coaster and hand brakes on lower-priced bikes; "mag wheels" and hand brakes on mid-priced models and grip-shift gears, six speeds and aluminum wheels on premium models.

The New York Times, October 9, 1992

* * * *

The 252 uses Grip Shift to operate the derailleurs. These shifters are standard issue on many '92 hybrids, providing a clean look because no levers...

Bicycling, August 1992³

³ Some of the material submitted by the Examining Attorney, not quoted here, is from news wires without any indication that the stories had appeared in any publication or were from clearly identified foreign publications. That evidence has been accorded little weight. See Men's International Professional Tennis Council, 1 USPQ2d 1917 (TTAB 1986).

If this term is not determined to be generic but only merely descriptive, the Examining Attorney's position is that applicant's evidence of acquired distinctiveness, pursuant to Section 2(f) of the Act, is insufficient because, among other things, the use by others shows that applicant is not the exclusive user of this term.

Applicant's Evidence and Argument

Essentially, it is applicant's position that this record shows that the words GRIP SHIFT are primarily used and understood by the relevant purchasing public to refer not to the class of goods but rather to the producer - - applicant. Applicant maintains that this term is not in common use as the name of a category of product.

Applicant indicates that its goods essentially translate hand rotation into control cable displacement; that is, applicant's goods are a cable pulling device which actuates the derailleur shift mechanism. According to applicant, one does not shift gears by the mere act of gripping alone. It is applicant's position that the Examining Attorney's proof of generic usage is insufficient.

According to declarations of record, from 1988 through 1995, applicant was the only significant manufacturer of rotatable twist-shift actuators, or twist-shifters. During

the 6-year period when applicant was the only source of such goods, over 7 million products bearing this mark were sold by applicant. Now, over 25 million twist-shifters have been sold and are in use in this country. Applicant argues that the trademark function of its asserted mark is demonstrated by over 8 years of extensive, substantially exclusive and continuous use of the mark for its goods; total sales over the years of over \$120 million in the United States; advertising and promotional expenses over the years exceeding \$18 million; unsolicited publicity through articles in the media evidencing the success of its products bearing the mark; direct evidence of recognition, such as letters from bicycle manufacturers, distributors, dealers, magazine editors and customers showing their understanding of this asserted mark; a consumer survey showing that nearly 80 percent of the respondents understood the term "twist shifter" and made reference to the asserted mark primarily or exclusively as a brand name;⁴

⁴ In particular, nearly 60 percent of the respondents recognized and used the term sought to be registered as a "brand indicator" and an additional 20 percent used the term in a manner that, according to applicant, showed perception of its mark as a term identifying a product from a single source. The report stated:

Almost 3/5 (59% = 45% + 14%) of the respondents not only understood what was being asked for when the interviewer mentioned twist shifter, but any reference they did make to Grip Shift was either predominantly or exclusively as a brand

applicant's "aggressive" policing efforts to stop others from misusing its asserted mark; and applicant's ownership of a Supplemental Register registration for this mark for bicycle gear shifting units (Registration No. 1,621,763, issued November 6, 1990).

Applicant has submitted letters showing trademark recognition from some of the largest bicycle manufacturers in the world. For example, the letter from Raleigh-USA states that

it is our understanding that the "Grip Shift" trademark has acquired in the trade the meaning of bicycle gear shifting mechanisms produced only by SRAM."

Similarly, letters from bicycle dealers attest to the fact that applicant's asserted mark has come to be identified with bicycle gear shifting mechanisms produced only by applicant. An affidavit from an expert in the field further attests to the fact that the mark sought to be registered is "well known in the industry and among the

name.

An additional 20% of the respondents dealt with Grip Shift as an interchangeable term, that is as both a brand and type of shifter. In the great majority of these cases, Grip Shift was the only brand name mentioned.

The method of this survey was the so-called "mystery shopper" method, whereby the interviewers masquerade as shoppers in

public knowledgeable about bicycles as a brand name for SRAM products, particularly twist shifters." Letters from editors of leading industry publications also tend to indicate that the mark sought to be registered is understood in the bicycle industry as indicating applicant's products. For example, a letter from the editor of Mountain Bike Magazine, with a circulation of 160,000, states that the asserted mark "would indicate that it is manufactured and distributed by SRAM Corp. and no other company." A letter from the editor of Bicycle Dealer states that since 1988 applicant's asserted mark has "indicated rotatable shifters made by SRAM Corp."

Applicant has also used its mark in connection with its sponsorship of several successful and internationally recognized racing teams.

Applicant's attorney recognizes that there have been "several" instances where its asserted mark has been improperly used in a generic or descriptive sense. However, applicant states that this use has been the focus of its "aggressive" policing efforts and that, in any event, this fact does not necessarily show that the term is or has become generic. It is applicant's position that

selected bicycle stores seeking information on "twist-shifters" under the pretext of wanting to purchase the product.

such random, inconsistent, casual and "non-purchasing" use does not negate the trademark function of the mark GRIP SHIFT. Moreover, applicant points to over 100 Nexis articles which have used the asserted mark properly and over 300 articles which have used the term "twist shifter" as the generic term for these bicycle shifting devices. For example, applicant points to an article appearing in the Chicago Sun-Times, wherein the writer states:

Sales of SRAM's bike components are expected to double to \$50 million this year thanks to Grip Shift... The company has skyrocketed the last few years, gaining roughly 60% of this shift market.

In an article appearing in Crain's Chicago Business, the author indicates:

The success of Stan Day and his innovative bicycle shifter is a David and Goliath saga. Grip Shift, which changes gears with a simple twist of the handle bar, has garnered more than half the market for better-quality bikes since its start in 1987.

Applicant's record also consists of listings in OEM (original equipment manufacturer) catalogs, trade journals and at various Web sites wherein the term GRIP SHIFT is used correctly, with few exceptions.

With respect to its policing efforts, applicant indicates that a third party agreed, after suit was filed, to cease its use of the term "Turbo Grip Shifter."

Opinion

With respect to the issue of genericness, we must attempt to determine the primary significance of the term sought to be registered to the relevant public. Under a test articulated by our reviewing court in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986):

Determining whether a mark is generic...involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered...understood by the relevant public primarily to refer to that genus of goods or services.

Evidence of the public's perception of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. In *re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985). The Examining Attorney must prove genericness with "clear evidence." See *In re Merrill Lynch Pierce Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ 1141, 1143 (Fed. Cir. 1987).

Upon careful consideration of this record and the arguments of the attorneys, we agree with applicant that

the Examining Attorney's record is an insufficient one on which to hold that applicant's asserted mark is generic. While some of the evidence, including materials from patents and general-circulation publications, use this term generically, others, including some submitted by the Examining Attorney, capitalize the asserted mark in an apparent attempt to demonstrate that it is a trademark. Considering this record as a whole, including the letters from bicycle manufacturers and dealers, and resolving any reasonable doubt in favor of applicant, we believe that the Examining Attorney has not demonstrated that the primary significance of the term sought to be registered is a category of product rather than an indication of origin. See *In re Merrill Lynch Pierce Fenner & Smith, Inc.*, *supra*. Moreover, we believe that this same evidence demonstrates that, if the asserted mark is considered merely descriptive, it has become distinctive as an indication of origin of applicant's bicycle gear-shifting devices. In this regard, we have given substantial weight to the letters from those in the industry.

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Decision: The refusal of registration is reversed;
applicant's marks will be published for opposition.

R. L. Simms

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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