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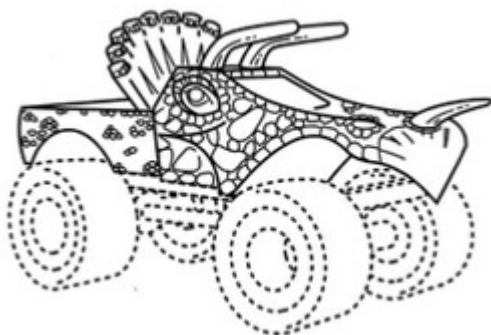
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UNITED STATES: Monster Truck Design Found to Be Distinctive

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In a precedential decision, the Trademark Trial and Appeal Board (Board) reversed the refusal of the U.S. Patent and Trademark Office (USPTO) to register a design mark on grounds that the design failed to function as a service mark. *In re Frankish Enterprises, Ltd.*, Serial No. 85494703 (February 27, 2015) [precedential].



Frankish Enterprises, Ltd. (applicant), applied to register a design mark consisting of a “truck cab body in the design of a fanciful, prehistoric animal” for entertainment services in the nature of competing at motor sports events and monster truck exhibitions.

The USPTO refused registration of the mark, arguing that the proposed mark was trade dress, which is not inherently distinctive and would not be perceived as a source indicator for the services to identify and distinguish the applicant’s services from those of any other monster truck designs because “monster trucks normally appear in a wide variety of designs.” The USPTO also rejected the specimens of use on grounds that they included the words JURASSIC ATTACK and therefore disagreed with the drawing of the mark.

The Board stated that “it is settled that while trade dress in the nature of product design can never be inherently distinctive, product packaging trade dress and trade dress for services can be inherently distinctive.” In this case, the applicant was not seeking registration of its design as a product, but rather for services.

In next determining whether the applicant’s trade dress was in fact inherently distinctive, the Board recited a four-part test to determine the inherent distinctiveness of trade dress that involved inquiring whether the trade dress is:

- A common basic shape or design;
- Unique or unusual in the particular field;
- A mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or
- Capable of creating a commercial impression distinct from the accompanying words.

The Board noted that the elements of the test are merely different ways to ask whether the design, shape or combination of elements are so unique, unusual or unexpected in the market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin.

The Board concluded that the applicant’s three-dimensional, fanciful prehistoric animal design mark met the test for inherent distinctiveness and was unique and unusual in the monster truck field. As such, it would be “readily perceived as identifying” the applicant’s monster truck services.



The Board also found the specimens of use acceptable because the three-dimensional design mark was distinctive, unique and created a commercial impression as an indication of origin separate and apart from the words JURASSIC ATTACK found in the specimens.

The Board reversed the failure to function refusal and the specimen refusal.

Although every effort has been made to verify the accuracy of items in the *INTA Bulletin*, readers are urged to check independently on matters of specific concern or interest.

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