

Mark: TULIP  
Serial No.: 88442160

The Examining Attorney has preliminarily refused to register Applicant's mark TULIP on the ground that it is confusingly similar to a prior registration for the mark LITTLE TULIP, Reg. No. 4424182 and that it may be confusingly similar to a prior pending application for the mark THE TULIP, Ser. No. 79258445. The Examining Attorney also issued a supplemental office action refusing to register Applicant's mark on the ground that it is merely descriptive.

**A. Section 2(d) Refusals**

As a preliminary matter, Applicant notes that the applicant for the pending application for the mark THE TULIP has deleted "furniture" from its application (see Response to Office Action, entered October 4, 2019). As the remaining goods listed in the application are not in any way related to Applicant's goods, Applicant requests that the Examining Attorney withdraw the citation of application Serial No. 79258445 as the basis for a refusal to register Applicant's mark.

Regarding the citation of LITTLE TULIP, Reg. No. 4424182, Applicant respectfully disagrees with the Examining Attorney's conclusion that it is confusingly similar to Applicant's TULIP mark, as these marks identify iconic mid-century modern furniture and have coexisted in the marketplace for 55 years, as reflected in Applicant's first use date of 1956 and the claimed first use date of 1965 for the LITTLE TULIP mark. Despite such an extensive period of coexistence, Applicant is not aware of any instances of actual confusion between the parties' marks.

A history of these marks and the very famous furniture that they identify illustrates their fame and, by extension, their ability to coexist in the marketplace and on the federal register.

In 1943, the famed architect and industrial designer Eero Saarinen began a long-lasting collaboration with Applicant. Eero Saarinen's more well-known architectural works include the Gateway Arch in St. Louis, Dulles International Airport in Washington D.C., the TWA Flight Center at New York's John F. Kennedy Airport, the CBS Building in New York City, and the Kresge Auditorium at the Massachusetts Institute of Technology. In 1956, Eero Saarinen created the Pedestal design, which, as described by Eero Saarinen, was inspired by a drop of high-viscosity liquid. The Pedestal design includes the tapered stand and base of a single-legged table, shown below:



These iconic designs have always borne the TULIP brand name and Applicant has been continuously selling products bearing the TULIP brand name and Pedestal Trade Dress for over sixty years. Over the past fifteen years alone, Applicant has derived over \$100 million in revenue from the sale of products bearing the TULIP brand name and Pedestal Trade Dress. Applicant has extensively advertised products bearing the TULIP mark to remind consumers that Applicant is the exclusive source of products bearing this famous design.

For decades, Applicant's TULIP furniture has been featured in many books as one of the signature, iconic designs of 20th Century. For example, *Design in America*

*The Cranbrook Vision 1925-1950; Architectural Graphic Standards* by Ramsey and Sleeper; *Classic Midcentury Modern at Home* by Deborah K. Kietsch. Applicant's TULIP furniture also is part of the permanent collections of, or has been featured at, many renowned art museums for its distinctive, unique, path-breaking design. This includes the Museum of Modern Art in New York, the Los Angeles County Museum of Art, and the Dallas Museum of Art. As a result of the widespread use and display of Applicant's TULIP furniture, the public has come to recognize and identify products bearing the TULIP mark and Pedestal Trade Dress as emanating from Applicant.

Similarly, the LITTLE TULIP mark identifies an iconic mid-century modern furniture design, created by designer Pierre Paulin in 1965:



Paulin's furniture designs have been featured in many museum exhibitions, including the Museum of Modern Art in New York, City.

In addition to their 50 years' coexistence and iconic nature, the TULIP and LITTLE TULIP furniture are sold at price points that ensure consumers make careful purchasing decisions. A single, authentic LITTLE TULIP chair retails for \$1,267 (<https://hivemodern.com/pages/product192/artifort-little-tulip-chair-pierre-paulin>), and a single, authentic TULIP chair retails for over \$1900 (<https://www.knoll.com/product/tulip-arm-chair>).

Taken together, these facts ensure that consumers have long understood that the TULIP and LITTLE TULIP marks identify distinct and iconic lines of furniture, offered by well-known companies.

**B. Section 2(e)(1) Objection**

The Examining Attorney also objected to the registration of Applicant's mark on the ground that it is merely descriptive or possibly generic, based on a series of articles located through a Google search and attached as exhibits to the supplemental office action issued on August 26, 2019. Applicant respectfully disagrees, as a closer review of these articles reflects that they refer either to Applicant's iconic Saarinen-designed TULIP furniture line or to knock-off and counterfeit copies of Applicant's authentic Saarinen-designed furniture, as reflected in the listed prices.

By describing their furniture designs in relation to Applicant, the furniture's designer (Eero Saarinen), and Applicant's long-used TULIP brand name, these websites rely upon consumers' familiarity with Applicant, Applicant's designer, Applicant's brand, and Applicant's trade dress to sell their own, infringing products. Rather than undermine Applicant's claim that its TULIP mark is distinctive, the cited websites actually support Applicant's claim.

In the trade dress context, the Board and the federal courts have regularly found that evidence of third party copying should not undermine an Applicant's claim of distinctiveness. See In re Change Wind, 23 USPQ2d 1453, 1467 (TTAB 2017) (finding that Applicants may submit evidence of copying to support a claim of acquired distinctiveness); In re Hershey Chocolate & Confectionary Corp., Serial No. 77809223 (TTAB June 28, 2012) (not precedential) (finding evidence of a third-party's use of trade dress of Hershey bar supported Hershey's claim of acquired distinctiveness for the design because third-party referenced the Hershey bar design, calling it "a classic confectionary icon"). Just as the brownie pan maker in the Hershey trade dress case referenced the trade dress of the classic Hershey chocolate bar, the websites cited in this case referenced the trade dress of Applicant's table and thus support, rather than diminish, the conclusion that Applicant's trade dress has acquired secondary meaning sufficient to support federal trademark registration.

Indeed, the Federal Circuit has found that the phrase "substantially exclusive" use in TMEP § 1212.05(b) allows for use of a design by others that "may be inconsequential or infringing and which therefore does not necessarily invalidate the applicant's [trade dress] claim." L.D. Kichler Co. v. Davoil Inc., 52 USPQ2d 1307, 1309 (Fed. Cir. 1999); see also In re General Mills IP Holdings II, LLC, 124 USPQ2d 1016 (TTAB 2017) (discussing the Federal Circuit's ruling in L.D. Kichler, the Board ruled that it must "consider all relevant market evidence, including evidence of an applicant's efforts to promote public perception of its mark as a source-indicator and evidence indicating whether such efforts have succeeded."). Third party use of the color yellow on cereal boxes ultimately defeated the Applicant's claim to the trade dress of a yellow

rectangular box in In re General Mills IP Holdings II, LLC, because they evidenced use of the color yellow for different types of cereals, without any reference to the applicant or its goods. The Board thus found that the applicant “had not put forward any evidence to indicate that we should consider these product packages ‘inconsequential or infringing’”. Id. In contrast to the facts of that case, Applicant here has substantial evidence that the third party uses that the Examining Attorney cited are infringing. The third party uses at issue here directly reference Applicant, Applicant's designer Eero Saarinen, Applicant's trade dress and Applicant's TULIP trademark, and rely upon consumers' familiarity with that trade dress to sell their competing goods.

Accordingly, Applicant requests that the Examining Attorney withdraw this descriptiveness refusal.