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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044014
Party	Plaintiff NAOS SRL ,
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Submission	Opposition to Registrant's Motion To Suspend
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Attachments	opposition barcelona chair.pdf (55 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

_____)	
NAOS Srl,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92044014
)	
KNOLL, INC.,)	
)	
Registrant.)	
_____)	

**PETITIONER'S OPPOSITION TO
REGISTRANT'S MOTION TO SUSPEND**

Petitioner Naos Srl ("Naos"), through its undersigned attorneys, files this opposition to Registrant's ("Knoll") motion to suspend proceedings. The Trademark Trial and Appeal Board ("the Board") should exercise its discretion to continue the prosecution of the above-styled petition for cancellation and thereby cancel a registration that should never have been issued but for a clear Trademark Office mistake. Both the quality and quantity of evidence filed during the prosecution of the Knoll application was woefully insufficient to establish secondary meaning. Knoll, armed with its improperly issued registration, has subsequently embarked on a program of harassing competitors and using its wrongfully obtained registration to unfairly

compete in the market for classic furniture.¹ Furniture retailers, furniture manufacturers, and the furniture buying public benefit if the Board uses its expertise and specialized knowledge to review Knoll's scant evidence of purported secondary meaning in connection with the product configuration at issue in this proceeding. This is a role that is fundamentally best ascribed to the Board, rather than a federal court that is far removed from the registration process.

I. FACTS

On October 22, 2003, Knoll filed an application to register the configuration of the Barcelona chair. The Barcelona chair was designed by Ludwig Mies van der Rohe for the German Pavilion at the 1929 Barcelona International Exposition.² To claim secondary meaning, Knoll filed the Declarations of Carl G. Magnusson, **Knoll's** Executive Vice President and Director of Design, and Terence Riley, the Philip Johnson Chief Curator of Architecture and Design of The Museum of Modern Art (hereinafter "MoMa"), and accompanying exhibits.³ Despite the fact that there is a heavy evidentiary

¹ Knoll is using its registration to chill legitimate competition by filing meritless lawsuits and threatening competitors. Gottlieb Declaration, Exhibits B, E, and F (Exhibit 2).

² Magnusson Dec., ¶4. the Magnusson Declaration is part of the prosecution history of Registration No. 2,893,025.

³ **MoMa receives a royalty for every one of the Barcelona chairs sold by Knoll.** (Riley Dec., Exhibit C, "Chair of Chairs", *New York Newsday*, February 20, 1986, p. 2, column 2, second full paragraph).

burden for establishing secondary meaning for product configurations,⁴ the application was inexplicably approved for publication (and subsequently registered).

A review of the Magnusson and Riley Declarations demonstrates that the evidence of secondary meaning was clearly insufficient to properly warrant registration of the product configuration at issue under Section 2(f) of the Lanham Act, 15 U.S.C. §2(f).

A. The Magnusson Declaration

At the outset, it should be noted that since Carl G. Magnusson is the Executive Vice President and Director of Knoll, Inc. his bias is evident and that the opinions in his Declaration should be discounted accordingly.

⁴ See, *In re Ennco Display Systems, Inc.*, 56 U.S.P.Q.2d 1279, 1283-84 (T.T.A.B. 2000), citing, *In re Sandburg & Sikorski Diamond Corp.*, 42 U.S.P.Q.2d 1544, 1548 (T.T.A.B. 1996) ("In view of the ordinary nature of these designs and the common use of gems in descending order of size on rings, applicant has a heavy burden to establish that its product configuration designs have acquired distinctiveness and would not be regarded as an ordinary arrangement of gems."); and *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 32 U.S.P.Q.2d 1001, 1008 (Fed.Cir. 1998) (evidence required to show acquired distinctiveness is directly proportional to the degree of nondistinctiveness of the mark at issue). The Supreme Court noted that product designs invariably serve purposes other than source identification and that consumers are aware that even the most unusual product design is not intended to identify source, but to render the product itself more useful. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 213-214, 54 U.S.P.Q.2d 1065, 1069 (2000). Since the mark at issue is a chair design, Knoll had a heavy evidentiary burden in seeking registration of that design under Section 2(f) of the Lanham Act.

PARAGRAPH	STATEMENT	FACT
4	"The public has come to refer to this chair as the 'Barcelona Chair'."	<p>The public reference to the Barcelona chair is derived from the fact that the chair was designed for the 1929 Barcelona International Exposition. It is not a reference to source.</p> <p>Even Magnusson admits the public refers to the chair as the Barcelona chair, not the "Knoll chair".</p>
5	"By an agreement dated November 1, 1965, Mies van der Rohe assigned all rights, title and interest in and to the design of the Barcelona chair to Knoll Associates, Inc."	<p>The purported agreement was not available for review because it was not attached to the Declaration.</p> <p>Because there were no patents or copyrights on the design of the Barcelona chair, Mies van der Rohe did not transfer any rights Knoll Associates, Inc.⁵ This explains why Knoll did not include the Agreement the Magnusson Declaration.</p>

⁵ "The design of the Barcelona Chair is not subject to any patent protection or application." (Magnusson Dec., ¶17). Likewise, since the Barcelona chair is a "useful article", it was never the subject of copyright protection. The Copyright Act excludes from copyright protection any "useful article", defining such an article as "having an intrinsic utilitarian function that is not merely to portray the appearance of the article to convey information." 17 U.S.C. §101. *Superior Form Builders, Inc. v. Chase Taxidermy Supply Co.*, 74 F.3d 488, 493 (4th Cir. 1996) ("Thus, the industrial design of a unique, aesthetically pleasing chair cannot be separated from the chair's utilitarian function and, therefore is not subject to copyright protection."); *Magnussen Furniture Inc. v. Collezione Europa USA Inc.*, 43 U.S.P.Q.2d 1218 (4th Cir. 1997) (iron tables denied copyright protection because they are "useful articles").

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