ESTTA Tracking number: **ESTTA25452**

Filing date: **02/09/2005**

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

Proceeding	92044025
Party	Plaintiff NAOS SRL ,
Correspondence Address	MARC. A. BERGSMAN DICKINSON WRIGHT PLLC 1901 L STREET N.W. SUITE 800 WASHINGTON, DC 20036
Submission	Opposition to Registrant's Motion to Suspend
Filer's Name	Marc A. Bergsman
Filer's e-mail	MBergsman@dickinsonwright.com
Signature	/Marc A. Bergsman/
Date	02/09/2005
Attachments	opposition barcelona stool.pdf (52 pages)

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

NAOS Srl, Petitioner, v. **KNOLL, INC.,** Registrant.	**Cancellation No. 92044025**

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 stool. The Barcelona stool 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. 2,894,977.

[3] **MoMa receives a royalty for every one of the Barcelona stools sold by Knoll**. (Riley Dec., Exhibit B, "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 stool 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 stool as the 'Barcelona Stool."	The public reference to the Barcelona stool is derived from the fact that the stool was designed for the 1929 Barcelona International Exposition. It is not a reference to source. Even Magnusson admits the public refers to the stool as the Barcelona stool, not the "Knoll stool".
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 Stool to Knoll Associates, Inc."	The purported agreement was not available for review because it was **not** attached to the Declaration. 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.

[5] "The design of the Barcelona Stool is not subject to any patent protection or application." (Magnusson Dec., ¶16). Likewise, since the Barcelona stool 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").

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.