

Hearing:
July 19, 2005

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailed:
June 22, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Richemont International, S.A., assignee of Manufacture
Jaeger-LeCoultre SA

Serial Nos. 76413051 and 76413157

Milton Springut and Tal S. Benschar of Kalow & Springut LLP
for Richemont International, S.A.

Nicholas K.D. Altree, Trademark Examining Attorney, Law
Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

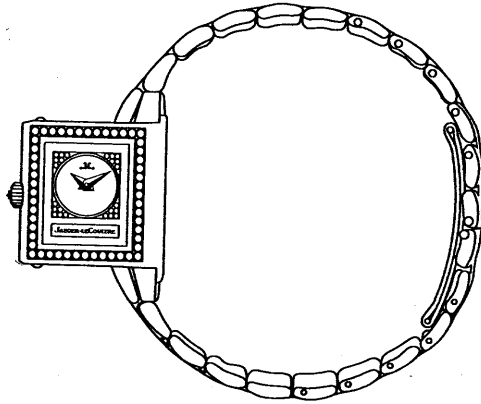
This appeal involves two applications filed by
Manufacture Jaeger-LeCoultre SA¹ on May 29, 2002 to register
product design marks for "horological and chronometric
instruments, namely watches."

¹ On July 16, 2003, during the course of prosecution, applicant advised the Examining Attorney that the original applicant had been acquired by and became a division of Richemont International, S.A., and that a copy of the assignment had been recorded in the Assignment Branch of the USPTO on December 20, 2002.

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Application Serial No. 76413051,² for the mark shown below, includes the following description, as amended:

The mark consists of a configuration of a rectangular watch case in one position from a series of movements whereby the watch case may be inverted. The watch case border design and the terms JAEGER-LECOULTRE and JL are claimed as features of the mark.



Application Serial No. 76413157,³ for the mark shown below, includes the following description, as amended:

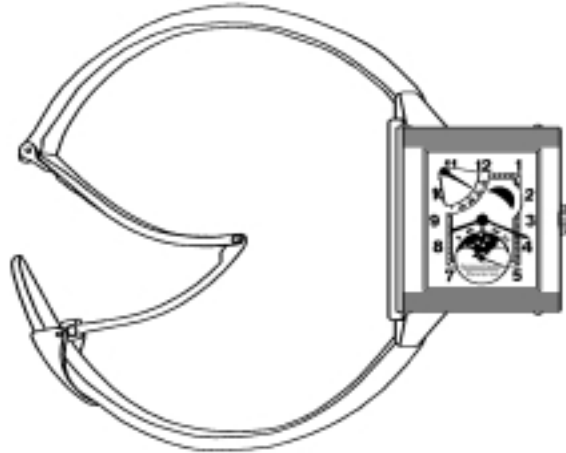
The mark consists of a configuration of a rectangular watch case in one position from a series of movements whereby the watch case may be inverted. The raised horizontal lines and the terms JAEGER-LECOULTRE and REVERSO[®] are claimed as features of the mark.

² The application was originally filed pursuant to Section 1(b) of the Act, based on an asserted bona fide intention to use the mark in commerce; applicant subsequently filed, on July 16, 2003, an amendment to allege use in which it asserted first use and first use in commerce between Switzerland and the United States on June 1, 1997.

³ This application was originally based on use in commerce, Section 1(a), with 1998 asserted as the date of first use and use in interstate commerce. Applicant subsequently amended the basis of the application to Section 44(e), relying on its Swiss registration and an asserted intention to use the mark in commerce.

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Applicant also submitted a statement in this application that the lining in the mark is a feature of the mark and is not intended to indicate color, and that the English translation of REVERSO is "I reverse."



Both applications contain the following disclaimer:

No claim is made to the exclusive right to use the configuration of the watchcase, the hour and minute dials appearing on the watch face, the crown for adjusting the hour and minute dials, and the watch band apart from the mark as shown.

Registration of both marks has been refused pursuant to Section 2(e)(5) of the Trademark Act, on the ground that the "pivot motion" portion of the configuration is de jure functional, and pursuant to Trademark Rule 2.37, on the basis that applicant has failed to submit an acceptable description of each mark.

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The appeals were consolidated for purposes of the oral argument, and because they involve the same issues and evidence, we are deciding both in a single opinion. Because the prosecution histories of the applications are very similar, with the same evidence and arguments and even the same sentences used in the Office actions and responses in both, we will discuss them using the papers and dates in Application Serial No. 76413051.

Prosecution history

In the first Office action, the Examining Attorney simply requested information, including, inter alia, whether the mark has been the subject of a design or utility patent. Prior to receiving a response by applicant, the Examining Attorney issued a second Office action in which he refused registration on the ground that the mark merely describes applicant's watches. After reviewing applicant's response to this action, the Examining Attorney issued another Office action in which he stated that it was not clear whether applicant was seeking to register a two-dimensional or a three-dimensional mark; if the latter, registration was refused on the ground that the mark was functional or, in the alternative, not inherently distinctive. An acceptable drawing, a description of the mark, and a disclaimer were

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also required. If the mark sought to be registered was intended to be two-dimensional, a disclaimer was required.

On July 16, 2003, applicant filed a response in which, inter alia, it indicated that its mark was a three-dimensional configuration of the goods.⁴ As a result, on January 13, 2004, the Examining Attorney issued an Office action in which he made final the refusal of registration pursuant to Section 2(e)(5) of the Trademark Act, 15 U.S.C. 1052(e)(5), on the ground that applicant's mark is functional. The Examining Attorney then issued, on July 13, 2004, a further Office action in which he found that the amended description of the mark and the disclaimer previously submitted by applicant were unacceptable, and required an acceptable description of the mark and an acceptable disclaimer. He also continued the refusal under Section 2(e)(5). This action included the "six-month response" clause, and appeared to be a non-final action.

⁴ Applicant also asserted acquired distinctiveness, in connection with Application Serial No. 76413051, as to "the configuration of a watch face in one position in a series of movements whereby the watch face is reversed as well as the terms JL and Jaeger-Le Coultre that appear on the watch face" (response filed July 16, 2003) and, in connection with Application Serial No. 76413157, with respect to "the configuration of a watch face in one position in a series of movements whereby the watch face is reversed as well as the terms Reverso and Jaeger-Le Coultre that appear on the watch face" (response filed July 14, 2003). The Examining Attorney accepted the acquired distinctiveness claims in the Office actions mailed January 13, 2003.

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However, applicant appealed from this action on January 4, 2005.

We note at the outset that the appeal in both applications was proper. Trademark Rule 2.141 provides that upon final refusal by the Examining Attorney, an applicant may appeal to the Trademark Trial and Appeal Board, and that "a second refusal on the same grounds may be considered as final by the applicant for purpose of appeal." Requirements for an acceptable description of the mark and for an acceptable disclaimer, as well as the refusal under Section 2(e)(5), had previously been raised by the Examining Attorney, and it was therefore appropriate for applicant to treat them as "second refusals on the same grounds" and file its notices of appeal.

In both of its appeal briefs, which applicant timely filed on March 2, 2005, applicant included a proposed amendment of the description of its mark, as well as a new disclaimer. We point out that the proper procedure to have such amendments considered would have been for applicant to have filed with the Board a request for remand, which the Board would then have considered and, if granted, would have suspended action on the appeal and remanded the application to the Examining Attorney for consideration of such

amendments.⁵ Although proper procedure was not followed in this case, it appears from the Examining Attorney's briefs that he has treated the description and the disclaimer as those that were set forth in applicant's briefs. It is also clear from the Examining Attorney's briefs that the Examining Attorney did not find the amended description and disclaimer acceptable.

At the oral hearing held in this consolidated appeal, the Board indicated that it had concerns about whether the descriptions adequately conveyed what applicant was claiming as its marks, and the Board indicated that it would look favorably on a request for remand if applicant and the Examining Attorney could reach a mutually acceptable solution with respect to the description and disclaimer requirements. Applicant subsequently filed such a request in each appeal, which was accompanied by a proposed amended description and a proposed disclaimer. The Board granted

⁵ In its brief, applicant claims that there was no need to remand the file to the Examining Attorney because the requirement as to an acceptable disclaimer and description of the mark were previously raised by the Examining Attorney in two different Office actions. Although the Examining Attorney's repeating these requirements made proper applicant's notice of appeal, despite the fact that the Examining Attorney had not made these requirements final, the raising of these requirements did not avoid the need for applicant to request a remand, rather than simply proffering amended descriptions and disclaimers in its brief, particularly in view of the fact that applicant did not submit a description and disclaimer that was in accord with the language suggested by the Examining Attorney.

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the requests, but noted that, because of the advanced stage of the proceeding, if the proposed amendments were found to be not acceptable, the Examining Attorney need only indicate this and return the file to the Board.

The proposed disclaimer is the same for both applications. The Examining Attorney, on remand, stated that he "accepts the applicant's amended disclaimer." We view the Examining Attorney's statement as a finding that the disclaimer is acceptable, and that the requirement in each application for a disclaimer has been withdrawn. We therefore treat the applications as containing the following disclaimer:

No claim is made to the exclusive right to use the configuration of the watchcase, the hour and minute dials appearing on the watch face, the crown for adjusting the hour and minute dials, and the watch band apart from the mark as shown.

With respect to the description of the marks, however, the Examining Attorney stated, in both applications, that he "rejects the applicant's amended description of the mark." In view thereof, we consider the operative description of each mark to be the one that was set forth in applicant's appeal briefs, as these were the descriptions that were the subject of the issue briefed by applicant and the Examining

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Attorney.⁶ To do otherwise would result in further briefing on the issue of the acceptability of the latest proposed description of the mark. In this connection, we note that, in his refusal to accept the proposed descriptions, the Examining Attorney asserted that each description would be a material alteration of the respective marks, which would raise a new issue. The Board's remand of the application after the appeal had been fully briefed and oral argument had been held was limited to a consideration of whether the proposed amended description would obviate this requirement. Thus, we have given no consideration to the proposed amendments to the descriptions in applicant's requests for remand. For Application Serial No. 76413051, the issue of the acceptability of the description of the mark concerns the following description:

⁶ In the Office action rejecting applicant's latest proposed amendment to the description of the mark, the Examining Attorney gave extensive reasons as to why the proposed amendment to the description was unacceptable. Applicant claimed that the Examining Attorney violated the Board's order by providing such reasons, since the Board order stated that "the Examining Attorney need only indicate in an Office action...that the proposed amendments are unacceptable." The Board thereupon issued an action stating that the Examining Attorney did not violate the Board's order by explaining why he found the proposed amended description unacceptable, and that the Board intended by the above-quoted language only to advise the Examining Attorney that he was not required to provide such reasons, not that he was prohibited from providing reasons for his decision. However, in view of the fact that the operative language for the description of the mark is that set forth in applicant's appeal brief, the Examining Attorney's comments as to why the later proposed description is unacceptable has no real effect on our decision.

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The mark consists of a configuration of a rectangular watch case in one position from a series of movements whereby the watch case may be inverted. The watch case border design and the terms JAEGER-LECOULTRE and JL are claimed as features of the mark;

while, for Application Serial No. 76413157, the applicable description is:

The mark consists of a configuration of a rectangular watch case in one position from a series of movements whereby the watch case may be inverted. The raised horizontal lines and the terms JAEGER-LECOULTRE and REVERSO[®] are claimed as features of the mark.

There are, thus, two issues before us on appeal. One is whether, in view of the above description in each application, the Examining Attorney's requirement for an acceptable description must be affirmed pursuant to Trademark Rule 2.37, and the second is whether each applied-for mark is de jure functional under the provisions of Section 2(e)(5) of the Trademark Act, and is therefore prohibited from registration.⁷

The appeals have been fully briefed and, as indicated above, an oral hearing was held for the consolidated

⁷ The Examining Attorney had, in an early Office action, stated that, even if the configuration were not de jure functional, it was not inherently distinctive. As noted in footnote 4, applicant then asserted acquired distinctiveness, and the Examining Attorney, in the Office action dated January 13, 2004, accepted applicant's acquired distinctiveness claim.

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appeals. In applicant's appeal briefs, it has raised an objection to "ten pages from the United States Patent Office database [submitted with the January 13, 2003 Office action] referencing five of Applicant's United States design patents." Applicant points out that copies of the actual patents were not provided, merely two-page summaries from the United States Patent and Trademark Office ("USPTO") records and, citing *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974), asserts that the failure of the Examining Attorney to submit complete copies of these patents bars consideration of them by the Board. Duofold stands for the proposition that the Board will not take judicial notice of USPTO records. While the Board will not take judicial notice of the contents of the patents themselves, since they have not been submitted, the USPTO summaries are properly of record and therefore may be considered by the Board for whatever limited probative value they may have. We also point out that, if applicant believed the summaries did not correctly reflect the subject matter of the patents, applicant could have submitted the actual patents. However, it does not appear that applicant believes that the patents undermine its position, as it has stated that "none support[s] a finding of functionality." Brief, p. 17.

Acceptability of the Descriptions of the Marks

It appears from the arguments and evidence of record, as well as the statements made at the oral hearing, that applicant seeks to register the configuration of a watch in which the watchcase can be turned so that the "face" of the watch can be placed directly against the wrist, and the other side of the watch, whether consisting of a metal back, or another watch face, would be the side that can be viewed. The fact that the watchcase can and does turn is a feature of the mark. Applicant states in its reply brief that the mark is "a specific configuration of a particular wristwatch during its motion." p. 10. While applicant states that it is not attempting to register the mechanism or the means that creates the motion, applicant is attempting to register the configuration of a watch as it makes the pivoting motion.

We must confess that, as we view the drawings of the marks shown in the applications, we could not determine that what is sought to be registered is a watch that makes a pivoting motion.⁸ Because the drawings do not clearly show

⁸ The issue of the sufficiency of the drawings, however, is not before us. The Examining Attorney had previously required, in the Office actions dated April 4, 2003, an acceptable drawing, but did not maintain this requirement. Thus, because the issue of the acceptability of the drawing in each application has already been considered, we have no basis to remand the applications to the Examining Attorney for further consideration

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that applicant is claiming a watch with a reversing motion for the watchcase, it is important that the description of the mark clearly reflects the mark that is being claimed. Applicant did not address the requirement for an acceptable description of the mark in its appeal brief, apparently believing that the amended description of the mark that was offered in each brief would satisfy this requirement. The Examining Attorney, in his briefs, does not discuss why the description of the mark is unacceptable, although he does clearly state that the refusal under Trademark Rule 2.37 should be affirmed. The Office actions in which the Examining Attorney repeated the requirement for an acceptable description state that the description "is inadequate because it does not clearly describe the mark." Office action mailed July 13, 2004.

Application Serial No. 76413051

In the Office action mailed July 13, 2004, the Examining Attorney suggested the following description:

The mark consists of a configuration of a rectangular watchcase with an attached watchband. The watchcase includes a border design consisting of multiple

of this issue. See Trademark Rule 2.142(f); TBMP §1209.01. Moreover, at the oral hearing the Examining Attorney was specifically asked about the sufficiency of the drawings, and he stated that he considered them an accurate representation of the respective marks. Therefore, even if it were permissible for us to remand the applications on this issue, there would be no point in our doing so.

adjacent circles, a crown for adjusting the hour and minute dials, and a pivot mechanism that permits the watchcase to be turned over, so that either side of the watchcase may be visible based upon how the user positions the watchcase. The watch face displays the wording JL and JAEGER-LECOULTRE. The watchcase border design, the terms JL and JAEGER-LE COULTRE, and the pivot mechanism are claimed as features of the mark.

Applicant has explained, in its reply brief, that it has not adopted the Examining Attorney's proposed description of the mark as a "pivot mechanism" because applicant is not seeking to register the mechanism that creates the motion, only the configuration of the watch as it makes the pivoting motion. Thus, as indicated, the description offered by applicant is:

The mark consists of a configuration of a rectangular watch case in one position from a series of movements whereby the watch case may be inverted. The watch case border design and the terms JAEGER-LECOULTRE and JL are claimed as features of the mark.

We find that the above description offered by applicant does not provide adequate notice of the nature of applicant's mark.⁹ See *In re R. M. Smith Inc.*, 219 USPQ

⁹ Although the amended description of the mark as proposed by the applicant after the oral hearing is closer to that suggested by the Examining Attorney, it refers to a pivot motion, rather than a pivot mechanism, and it includes a reference to "multiple adjacent jewels," which were not in the Examining Attorney's suggestion nor, in fact, were jewels mentioned by either applicant or the Examining Attorney in prior incarnations of the description, or suggestions regarding the description. As we stated above, because we remanded the application to the Examining Attorney only to consider whether the amendment would

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629, 633-34 (TTAB 1983), aff'd. 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984) (" ... registration of the instant configuration without any formal description of applicant's mark or explanation of the elements which applicant claims function as its mark would, we believe, hinder competitors who would not know if the features which they are using in their products, whose overall configurations are not dissimilar from that of the applicant, subject them to a suit for trademark infringement.") One simply reading the description of the mark, in conjunction with viewing the drawing, would not understand the mark to be what was discussed by applicant at the oral hearing. In particular, one would not recognize that the claimed mark includes not only a watchcase that can be reversed by a series of movements, but also that the particular movements that are involved in reversing the watchcase are claimed as features of the mark.

The requirement for an acceptable description of the mark, made pursuant to Trademark Rule 2.37, is therefore affirmed.

obviate the requirement for an acceptable description, and not, after briefing and oral argument had been completed, to reopen examination and briefing, we have not considered the acceptability of the proposed amendment.

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Application Serial No. 76413157

The Examining Attorney suggested the following description in the Office action mailed July 13, 2004:

The mark consists of a configuration of a rectangular watchcase with an attached watchband. The watchcase includes three raised horizontal lines above and below the watch face, a crown for adjusting the hour and minute dials, and a pivot mechanism that permits the watchcase to be turned over, so that either side of the watchcase may be visible based upon how the user positions the watchcase. The watch face displays the wording JAEGER-LE COULTRE and REVERSO. The raised horizontal lines, the term JAEGER-LE COULTRE and REVERSO, and the pivot mechanism are claimed as features of the mark.

As with Application Serial No. 76413051, applicant has stated in its reply brief that it has not adopted the Examining Attorney's proposed description of the mark as a "pivot mechanism" because applicant is not seeking to register the mechanism that creates the motion, only the configuration of the watch as it makes the pivoting motion. Thus, as indicated, the description at issue, i.e., the one offered by applicant in its appeal brief, is:

The mark consists of a configuration of a rectangular watch case in one position from a series of movements whereby the watch case may be inverted. The raised horizontal lines and the terms JAEGER-LECOULTRE and REVERSO® are claimed as features of the mark.

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For the same reasons we set forth in finding that the description in Application Serial No. 76413051 is unacceptable, we also find that the proposed description of the mark in this application is not acceptable.

This description does not provide adequate notice of the nature of applicant's mark.¹⁰ One reading the description of the mark, in conjunction with viewing the drawing, would not understand that the particular movements that are involved in reversing the watchcase are claimed as features of the mark. We also point out that the use of the "®" registration symbol is not appropriate to include in the description of a mark.

Accordingly, the requirement for an acceptable description of the mark, made pursuant to Trademark Rule 2.37, is affirmed.

¹⁰ We note that the amended description of the mark as proposed by the applicant after the oral hearing is closer to that suggested by the Examining Attorney, but as we pointed out in our discussion regarding Application Serial No. 76413051, that description refers to a pivot motion, rather than a pivot mechanism, which was not in the Examining Attorney's suggested description. As stated previously, the application was remanded to the Examining Attorney only to consider whether the amendment would obviate the requirement for an acceptable description, and not, after briefing and oral argument had been completed, to reopen examination and briefing. Therefore, we have not considered the acceptability of the latest proposed amendment.

Functionality of Proposed Marks

Although applicant has not submitted satisfactory descriptions of the marks, as we stated previously, the arguments and evidentiary submissions made during examination/prosecution, and at the oral hearing, have made it clear to us what the true nature of the marks are. In particular, we note that Exhibit 15 of applicant's July 16, 2003 response is an article which, as the Examining Attorney points out, "contains a series of sequential photographs showing how the watch case can be turned over to display a second watch face." Brief, unnumbered p. 4. Thus, we can make a determination as to whether applicant's mark is functional and therefore prohibited from registration by Section 2(e)(5) of the Trademark Act.

Section 2(e)(5) of the Trademark Act prohibits the registration of a mark that comprises any matter that, as a whole, is functional. 15 U.S.C. §1052(e)(5). In *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), the Court of Customs and Patent Appeals (the predecessor to our primary reviewing Court) set out four factors to consider in determining whether a configuration is de jure functional:

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;

(2) advertising materials in which the originator of the design touts the design's utilitarian advantages;

(3) the availability to competitors of functionally equivalent designs; and

(4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

In *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 US 23, 58 USPQ2d 1001 (2001), the Supreme Court discussed de jure functionality in the context of a trade dress infringement case. (The term "trade dress" is often used to refer to product features, such as configuration marks, to which trademark rights are claimed. See *American Flange & Manufacturing Co., Inc. v. Rieke Corp.*, __USPQ2d__ (Ops. 91153479 & 91154680 (TTAB June 5, 2006))). It stated that a prior, expired utility patent:

is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

TraFFix Devices, supra, 58 USPQ2d at 1005. The Court also said that the functionality of the spring design in that case "means that competitors need not explore whether other spring juxtapositions might be used," and that there was no need to engage in speculation about other design possibilities. This statement raised a question about whether the Morton-Norwich factor of the availability of alternative designs still played a role in the functionality analysis.

Subsequently the Court of Appeals for the Federal Circuit, our primary reviewing Court, explained that the Supreme Court's decision in TraFFix did not alter the Morton-Norwich analysis. "Nothing in *TraFFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in *TraFFix* as rendering the availability of alternative designs irrelevant." *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002). The Federal Circuit recognized the Supreme Court's finding that once a product feature is found functional based on other considerations, there is no need to consider the availability of alternative designs, but said that the availability of alternative designs could still be a

legitimate source of evidence to determine whether a feature is functional in the first place.

In view thereof, we consider whether the applied-for configuration is de jure functional by looking to the *Morton-Norwich* factors.

Applicant has supplied certain background information about how its watch configuration came to be designed. According to applicant, in 1931, in response to the request of British polo players, applicant commissioned Rene-Alfred Chauvot to design a watchcase that would protect the timekeeping mechanism of a wristwatch. The watch that he designed became known as the "Reverso," and according to applicant it "has remained essentially unchanged for over sixty-five years." Response filed July 16, 2003.¹¹

In both applications, the portion of the configuration which is under dispute in terms of its functionality is the

¹¹ The advertising materials submitted by applicant show several versions of the watch; therefore, although applicant has stated that the "Reverso" watch has remained essentially unchanged, we must assume that applicant is referring either to a specific watch style known as the "Reverso" per se, which is different from the styles shown in the drawings of the applications, or to the reversing watchcase feature of its various watches. In this connection, we note that there are several styles of watches shown in applicant's literature which are identified by such names as "Reverso Florale Tiaré," "Reverso Florale," "Reverso Neva," "Reverso Duetto," and "Reverso Sun Moon," as well as "Reverso" per se. Further, applicant's response includes the statement, "The case for the Reverso, a feature of which is the subject of the instant application"; this is a further indication that the configuration for which registration is sought is not the specific watch style known as the "Reverso."

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part of the watchcase that can be turned in order to effect a reversing motion by which one side of the watchcase is flipped to the other side. Although the drawings include depictions of the faces and bracelets for the watches, it is clear that the primary feature applicant seeks to register, and the feature that the Examining Attorney contends is functional, is the reversing nature of the watchcase. Thus, it is this feature that we consider in our application of the Morton-Norwich factors. If that feature is de jure functional, applicant's marks cannot be registered. In re R. M. Smith, Inc., supra; Petersen Mfg. Co. v. Central Purchasing, Inc., 740 F.2d 1541, 222 USPQ 562, 569 (Fed. Cir. 1984); American Flange & Manufacturing Co., Inc. v. Rieke Corporation, supra.

The first factor is the existence of a utility patent. Applicant has made of record a utility patent, No. 1,930,416, which issued on October 10, 1933 to Rene Alfred Chauvot, the designer of applicant's Reverso watch. The patent is for a "sliding and pivoting wristlet watch" whose movements make "it possible to wear same either with the dial exposed or entirely protected." The drawing of the invention shows a configuration of a watch that can be moved in the same manner as the configuration in the subject trademark applications. The invention states that its

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object "is to provide an extremely simple construction of this kind of watch, particularly suitable for people practising sports or doing manual work." The patent goes on to state that by turning over the watchcase in this fashion, "it is possible to place the watch in its support, dial uppermost, as in ordinary watches, or to place it face downwards in such a way that it becomes as a metal case entirely closed and in the inside of which all the delicate parts of the watch are perfectly protected." In discussing the way the movement works, the patent points out that "the fact that during the sliding movement the watch case is slightly raised in relation to its support is very important in that it facilitates the pivoting. It is easier to pass with the finger under the case in order to turn it." It is clear that the features fundamental to the invention disclosed in the patent have been carried forward into each of the configurations sought to be registered as trademarks. See *In re Visual Communications Co.*, 51 USPQ2d 1141 (TTAB 1999).

Applicant has also made of record a Swiss patent, No. 159982, for the same device, which issued to Rene Alfred Chauvot in 1933, and which states, *inter alia*:

The advantage of this watch resides in the fact that, in one of the positions of the case that is being turned over, in which the watch face comes to be

located inside the support, the latter is entirely protected; the entire device then has the appearance of a small metal box that protects all the sensitive parts of the watch, while, in its other position of being turned over, it presents the appearance of a normal wristwatch.

... It is intended to be worn like a normal wristwatch which, however, has the advantage that it can be turned over in a so-called protection position when there is a risk of it being subjected to shocks or inclement weather, for example, when its wearer engages in sports or manual labor.

As noted previously, in TraFFix the Supreme Court stated that great weight is to be accorded a utility patent, including an expired utility patent, in the analysis of whether a mark is de jure functional. Despite this, applicant argues that its expired utility patent does not require a finding that the reversing movement of the watchcase is functional. Rather, applicant asserts that technological advances since the time the patent was issued, in particular, advances in the design of watch crystals, has made the utilitarian advantages disclosed in the patent superfluous and obsolete. Applicant has conceded that, at the time the patents issued, the ability to reverse the watchcase was a de jure functional feature of the watch. "Applicant concedes that in, say, 1933, its design was functional." Reply brief, p. 4. Applicant has also

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explained that "[o]riginally, the Reverso was designed as a means for sportsmen, specifically polo players, to protect the delicate time keeping mechanism of their watches from any damage that might occur during the course of a match." Response filed July 16 2003, p. 9. However, applicant asserts that intervening changes in watch technology have rendered the design of no significant utilitarian advantage.

As the Supreme Court stated in TrafFix, 58 USPQ2d at 1005, and as quoted at length supra, the existence of an expired patent is strong evidence that the features therein claimed are functional. Applicant has acknowledged that it has a "heavy burden" under TrafFix to rebut the evidence of functionality shown by the expired patent. Reply brief, p. 4. To do so, applicant has explained that "in 1932, one year after the original Reverso design was manufactured, watch manufacturers, including Jacques David LeCoultre [applicant's predecessor], began using scratch resistant, virtually unbreakable, sapphire glass in the crystals of high quality watches." Response filed July 16, 2003, p. 13. Applicant submitted an excerpt from "Reverso The Living Legend" that includes the following statement:

By now the production of sapphire glass for watch applications had become operational. Jacques-David LeCoultre was in fact one of the first in the industry to use this improvement. As of about 1932 a "de luxe" version of the

Reverso was already fitted with sapphire glass. Although this might appear to deprive the still-young "reversible watch" of its raison d'être, its Art Deco shape was highly fashionable and customers liked the discreet charm of its reverse.

p. 4.

In addition, applicant has provided an excerpt from the glossary on the Macy's website that defines "sapphire crystal" as "the hardest crystal available for watches and used in high-quality time pieces, sapphire crystal is virtually scratchproof and shatter-resistant," while the website The Village Jewellers.com says "Transparent sapphire is used for scratch-proof watch glasses."

The Examining Attorney, on the other hand, has submitted pages from third-party Internet websites, as well as newspaper articles, that indicate that the reversing ability of applicant's watch still protects the watch and thereby retains its utilitarian value.

The Reverso is the perfect accessory as it is capable of standing up to the rigours of many a sport. The watch is mounted on a solid carriage so that it can be turned over to protect the glass and dial.

"New Straits Times," (Malaysia) Nov. 2, 2002

This is a recently introduced version of the class JLC Reverso. Like its predecessors, it has the movement mounted on a hinged mechanism so that it can be rotated to protect the crystal

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and dial during sports activities, or in this case, to provide two different dials.

The Watchseller

Reverso Gran' Sport

A reinvention of the Reverso watch-the Gran' Sport is designed for vigorous activity.

The Jaeger LeCoultre Society

...they conceived and pioneered the idea of the Reverso watch, which allows the watch face to be pivoted and turned upside down so the dial of the watch faces the wrist and the back of the watch faces upwards. This is so the watch remains undamaged if using for any kind of activity.

Third party advertisement for "Jager [sic] Le Coultre Master Reverso Gran' Sport"

[website address not provided]

In addition, an advertisement on the E-Bay website for the Rotary Reverso Elite, described as a "cheaper alternative to the LeCoultre Reverso," states:

Like the LeCoultre Reverso the ROTARY REVERSO ELITE watch flips over to protect the face if you are participating in some kind of vigorous activity where the face of your watch may be in danger, but you don't want to take it off or you have no place to store it away OR if you want to show off the spectacular movement exposed by an observation back.

It appears from applicant's statements, as well as other materials of record, that sapphire glass for watch crystals prevents scratching and shattering, such that, with the advent of the use of such crystals, there was an

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alternative to reversing the watchcase in order to protect the crystal. The fact that applicant's own watches use sapphire crystals so that, when in the reversed position, some of the watches reveal a second face, while in others the crystal allows the wearer to see the mechanism, demonstrates the protective quality of the crystal. However, while applicant may employ sapphire glass for the crystal in its watch, the configuration it seeks to register is not limited to watches with such crystals. Thus, competitors might wish to make a reversing watch that does not use a sapphire glass crystal, relying on the reversing ability of the watchcase alone to provide protection for the watch crystal and mechanism.

Moreover, we note that, notwithstanding the protection provided by the crystal, applicant still touts in some of its advertising the protection provided by the reversing nature of the configuration. For example, applicant's brochure, "The Manufacturer's Book of Timepieces," (Exhibit 14) contains an advertisement for the Reverso Art Deco, a watch reported to first have been introduced in 1992. In a bullet list of information about the watch is the heading "Special features of the case," followed by the statement "Pivoting case optimally protects the wristwatch; sapphire crystal back; solid silver dial." Thus, the reversing

feature was still being touted as providing protection to the watch in 1992, sixty years after applicant has argued herein that the feature became obsolete. Moreover, it appears that newspaper reporters and sellers of the watch are under the impression that the reversing feature still has a protective function.

In view of this mixed information, and considering the heavy burden on applicant to rebut the evidence of the utility patent that the design protects the watch mechanism, we cannot say that applicant has shown that the reversing nature of the watch is now non-functional.¹²

¹² Further, in view of this mixed information, it is not necessary for us to consider applicant's argument that, despite the expiration of its utility patent over 50 years ago, competitors have chosen not to copy the configuration. In any event, we point out that in *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997), the applicant made a similar argument, namely, that in the time since its patents expired, no one else in the industry had adopted the particular design for its tractors and that, if competitors considered applicant's design to be superior, then others in the industry would have adopted the design for their own competing tractors. The Examining Attorney raised a number of contrary theories, including: 1) since applicant continued to assert rights in the configuration design, competitors might be unwilling to get into a dispute with the industry leader; 2) competitors might believe that the level of sales of elevated sprocket tractors did not justify, despite the functional superiority of applicant's design, a redesign of their own conventional tractors; and 3) that, because a lengthy period of research and development is necessary to manufacture new heavy machinery, insufficient time had elapsed from the expiration of the utility patent six years earlier. (This latter explanation would not apply in the present situation, since the patents had expired more than 50 years ago.) The Board recognized that it could only speculate as to why no one else had adopted the design, but that "[w]hatever the reason, although no one in the industry apparently has copied the elevated sprocket configuration design, this fact is outweighed by the clear

Moreover, even if, arguendo, sapphire glass crystals now fulfill the protective function of the reversing watchcase, it is not clear to us that the availability of this alternative is sufficient to overcome the evidence of

evidence of functionality of the configuration." 43 USPQ2d at 1340.

Because there are many reasons why a competitor may choose not to copy a utilitarian design, we cannot conclude that a previously patented configuration is no longer functional from the fact that competitors have not copied it. Moreover, the two cases cited by applicant, *In re Honeywell, Inc.*, 8 USPQ2d 1600 (TTAB 1988), and *In re Zippo Mfg. Co.*, 50 USPQ2d 1852 (TTAB 1999), are readily distinguishable from the present situation. In Zippo, the Board found that the claims in the patent were for the internal mechanism of the product, and did not relate to the configuration for which registration was sought, which accommodated the internal mechanism, but was not shown by the patent to have utilitarian value. In the present case, on the other hand, applicant seeks to register the configuration of a watch that makes a particular reversing motion, and it is a configuration of a watch that can make this reversing motion that is the subject of the patent. Zippo also referred to a difference in circumstances from the time the applicant's lighter had been found functional by the Court in 1963 in *Zippo Manufacturing Company v. Rogers Imports, Inc.*, 216 F.Supp 670, 137 USPQ 413 (SDNY 1963), and the Board's decision in 1999, specifically, evidence of several alternative designs, as a result of which the Board found that other manufacturers could compete effectively without adopting applicant's design. Zippo was decided prior to the Supreme Court's decision in TraFFix and it is doubtful, in view of the Court's statement therein, that if Zippo were decided today the Board would have relied so heavily on the evidence of alternative designs to distinguish the Southern District's decision. As for Honeywell, the Board made the comment therein that a number of years had elapsed since the expiration of a design patent, rather than a utility patent; further, this comment was made in terms of whether the Board could revisit the issue of the registrability of a configuration that had previously been found de jure functional. In the actual analysis of the Morton-Norwich factors, the Board specifically found that applicant's expired utility patents did not demonstrate the utility of the circular, round cover, that the claims related only to the inner workings of the thermostat. In the present case, of course, the expired utility patents are for the configuration that applicant seeks to register.

functionality shown by the utility patent. That is, we cannot determine from the record herein whether sapphire glass crystals would add more to the cost of manufacture of watches than it would otherwise cost to manufacture watches that have the reversing apparatus/motion claimed by applicant. Obviously using sapphire glass for a watch crystal adds a certain cost to the manufacture of a watch. Equally obviously, manufacturing a watch with the reversing apparatus would be more expensive than making a watch that does not have this apparatus. In this connection, we note applicant's assertion that its watches "are assembled by hand by highly skilled watchmakers." Response filed July 16, 2003, p. 12. However, even though applicant chooses to assemble its watches by hand, we do not know whether it would be possible to employ a more automated manufacturing process, such that it might provide a cost benefit to use the reversing apparatus rather than to use a sapphire glass watch crystal.¹³ However, we need not engage in such speculation because, as discussed below, the reversing

¹³ It appears that manufacturers of high-end watches generally use sapphire glass crystals. Even applicant uses such a crystal on its Reverso watch and therefore, it is certainly possible that, even if the reversing mechanism were less expensive to manufacture, watchmakers would still use the sapphire glass crystal.

apparatus/motion offers benefits other than that of protecting the watchcase.

Therefore, even if, *arguendo*, we were to find that the reversing feature of the watch is no longer necessary to protect the watch crystal or watch mechanism, the inquiry does not end there. The fact that applicant's watch can be reversed provides a significant competitive advantage other than protecting the watch crystal or mechanism. Under the second Morton-Norwich factor, we consider whether or not applicant's advertising materials tout the design's utilitarian advantages. As applicant's advertising materials show, the ability to reverse the watch face allows one to change the appearance of the watch. For example, one model of applicant's watch presents a watchface with a style for day, while when the watch is reversed it can be used for evening. Watches with dual dials, on front and back, can also be used to show different time zones. Another version of the watch may be used with the watch side up, or can be reversed to look like a bracelet with an engraved case. Applicant's website, www.jaeger-lecoultre.com, advertises the Reverso Duetto as: Exclusively feminine, the Reverso Duetto mirrors a vision of time dedicated to beauty and a passion for fine watchmaking. ... With subtle duality, it reveals its everyday charm on one side and flirts with the

evening glow on the other. (Exhibit 5). Applicant's brochure (Exhibit 14), states that with the use of the sapphire case-back, the Reverso was "re-invented" in 1991 "to use the second side either for additional functions or as a 'living' work of technical art."

Articles about the Reverso by third parties also point out the advantages of the reversing capability:

Having another side opens all sorts of creative design opportunities, and JLC has exploited them aggressively, with numerous Reverso models. The metal back is often engraved, although there are also enameled backs (in a series showing pictures of the four seasons, for example) and jeweled backs.

Or, the reverse side can be used for another dial, as in the Duetto, which has dressy and sporty dials. The Duo uses the back to show another time zone, along with a night-or-day indicator on a 24-hour subdial, in place of the small seconds dial. Also, the front dial is white, and the back is black, giving you a choice of color.

The front dial is silver in color...with black numerals and markers. ... Both the main and seconds dials echo the rectangle of the case-note that the tick marks and the numerals follow a rectangular layout.

... The back dial is black, and looks to me even more Art Deco than the front. Now the dial is round and the hands are thicker. ... So, the back side, in addition to being for a different time zone, also doubles as the night side. In addition, since the dial is another color and has a different design, reversing the Duo also gives you a

change of pace. Truly two watches in one.

I find the idea of a watch with two faces, set to different time zones, very compelling...

What I like about the Reverso is that it is incredibly well finished, it has two time zones, and it has both dressy and less-dressy faces.

M. J. Rochkind, Review of the Jaeger-Le Coultre Reverso Duo © 1998,
www.basepath.com

...the watch's special about-face feature appealed to non-athletes, too. People started monogramming the case backs and even illustrating them.
The Jaeger-LeCoultre Reverso,
www.bidtheewell.com

In addition, The Watchseller advertisement, quoted previously, points out that the reversing movement of the Reverso provides two different dials.

We also note that advertisements for the third-party Rotary reversible watch, which applicant describes as an alternative design, touts the fact that the reversible case reveals "a second dial or a decorative case back."

The third Morton-Norwich factor is the availability to competitors of functionally equivalent designs. Applicant states that it has identified three watch manufacturers that market watches with rotating cases, and asserts that each watch "has a case motion that is entirely different from that of Applicant's mark." Brief, p. 13.

The first watch is the Cartier Basculante watch. The advertisement shows that this watch pivots in a vertical motion, as opposed to the horizontal motion used in applicant's watch. The second watch is called the Doppio, and applicant describes the motion as "a movement forward and out of the case and a subsequent pivoting or twisting of the watch face." Response filed July 16, 2004. Although the motion is not identical to that used by applicant's watch, it is essentially a horizontal turn. The third watch is the Rotary reversible watch. Applicant describes this watch's motion as being "a forward and twisting motion similar to that of de Grisogono's Doppio and not at all like Applicant's mark." Id.

Essentially, then, applicant has provided only two alternative designs to the applied-for configuration. Moreover, it appears to us that, while there may be minor variations in how the watch may be reversed, there are only two basic ways: horizontally or vertically. We note that applicant considers that the sliding motion of its watch as the case is reversed is unique. However, in practical terms, if applicant were to obtain a registration for its watch configuration and the motion that it makes, it would effectively preclude any other watchmaker from being able to register a watch configuration that turned in a horizontal

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manner. And such a registration might well be used to preclude another watchmaker from using a watch configuration with a horizontal reversing motion. In any event, even if we were to consider the three watch configurations submitted by applicant as alternative designs, there are still a very limited number of designs available to competitors. See *In re Lincoln Diagnostics Inc.*, 30 USPQ2d 1817 (TTAB 1994) (seven alternative designs considered very limited).

Moreover, applicant's expired U.S. utility patent shows the functional superiority of its particular design in reversing the watchcase. As noted previously, the patent points out that "the fact that during the sliding movement the watch case is slightly raised in relation to its support is very important in that it facilitates the pivoting. It is easier to pass with the finger under the case in order to turn it." Thus, the motion made by the watch in reversing the watchcase—a motion that applicant has made clear it seeks to register as part of the configuration—is dictated by functional considerations. Applicant's expired patent also states, as noted previously, that the object of the invention is "to provide an extremely simple construction of this kind of watch."

Applicant's own literature also refers to the superiority of its design in that the watchcase can be reversed using a small turning radius:

One need only consider the small "turn" which affords so much pleasure but which has its price—mechanically speaking. If it were any other way, the "genius watchmakers" in Le Sentier would not have watched so casually the many attempts that have been made to imitate the unique Reverso principle in more than sixty years.
"Reverso—The Living Legend," p. 174
(Exhibit 10)

The fourth Morton-Norwich factor is cost—whether the asserted functional feature is a result of a cheaper or simpler method of manufacturing the product. We cannot determine from the evidence of record that this is the case. As noted above, applicant's expired utility patent stated that the object of the invention is "to provide an extremely simple construction of this kind of watch." However, it is clear from the materials that are of record that applicant's watch is expensive, and that to create it applicant uses master watchmakers, and the work is done by hand. As stated previously, we cannot ascertain whether applicant's reversing watch configuration can only be manufactured by hand, or whether it is applicant's choice to manufacture it

in this manner.¹⁴ Because we cannot determine whether applicant's reversing configuration can be manufactured more easily or cheaply, and because the evidence we do have shows that the actual manufacture of applicant's product is done by hand, we treat this factor as neutral.

Although this last factor does not show that applicant's configuration is de jure functional, it is not necessary that all four Morton-Norwich factors be met in order to find a configuration de jure functional. See *In re Edward Ski Products Inc.*, 49 USPQ2d 2001 (TTAB 1999). Here, the evidence shows that the ability of the watch configuration to reverse provides the owner with, in effect, two different watches, either by creating a watch with a different style on each side, or a watch showing different time zones on each side, or a watch with a timepiece on one side and an decorative piece of jewelry on the other. If applicant were to obtain exclusive rights to this two-watches-in-one configuration, competitors would be at a significant, non-reputation-related disadvantage. As we have also stated, applicant's patent shows the utilitarian advantage of the manner in which its watch makes the

¹⁴ As we also stated, supra, we cannot ascertain whether the cost of sapphire glass crystals to protect the watch crystal or watch mechanism would be less expensive than the cost of manufacturing the watch using the reversing configuration.

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reversing motion, such that, even if we were to consider the Cartier, Doppio and Rotary watches to be three different alternative reversing watches, they cannot be said to be equal alternatives. Accordingly, in view of all the evidence with respect to the Morton-Norwich factors, we find that applicant's configuration is de jure functional, and is not entitled to registration.

Decision: For each application, the requirement for an acceptable description of the mark and the refusal on the basis that the configuration is functional are affirmed.