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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re George Tash

Serial No. 76577156
Serial No. 76577157

Richard T. Lyon of Lyon & Harr, LLP for George Tash

Nelson Snyder, Trademark Examining Attorney, Law Office 107
(J. Leslie Bishop, Managing Attorney).

Before Hohein, Holtzman, and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

George Tash has filed applications to register the following marks for "drain plungers for use with drains such as found in toilets, sinks and tubs" in Class 21. Each application contains a description of the mark as indicated below.

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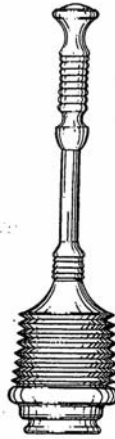
The mark consists of the three-dimensional configuration of a plunger with a handle top consisting of a quarter-circle cap that slopes concavely down to a series of eight close packed ridges above an asymmetrical octagon ringed with two parallel lines, attached to a straight smooth form ending with seven spiral ridge lines, and a bellows element consisting of a two level sloped design ending with eight uniformly-spaced, continuous and parallel pleats, above a bulbous seal ending with a flared ridge as shown in the drawing accompanying the Application.

¹ The application was filed on February 23, 2004, pursuant to Section 1(a) of the Trademark Act, 15 USC §1051(a), asserting that the mark has acquired distinctiveness under Section 2(f) of the Act and claiming December 1, 1995 as a date of first use anywhere and in commerce.

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The mark consists of the three-dimensional configuration of a plunger with a handle top consisting of a convex quarter-circle cap above a wider annular form sloping concavely down to a series of nine close packed ridges attached to another smaller concave form then forming a larger three-quarter circle form, flat side up, above a straight smooth form ending with five close packed ridges, and a bellows element, consisting of eight uniformly-spaced, continuous and parallel pleats above a seal consisting of an annular form above two successively smaller forms, the smallest ending with a slight annular flare, as shown in the drawing accompanying the Application.

The trademark examining attorney has refused registration of both applications on the same two grounds. In both cases the examining attorney has refused

² The application was filed on February 23, 2004, pursuant to Section 1(a) of the Trademark Act, 15 USC §1051(a), asserting that the mark has acquired distinctiveness under Section 2(f) of the Act and claiming September 1, 1987 as a date of first use anywhere and in commerce.

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registration under Section 2(e)(5) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(5), on the ground that applicant's proposed mark is functional and thus unregistrable; and on the alternative ground that, if the mark is not functional, the mark nonetheless consists of a nondistinctive configuration of the goods that does not function as a mark under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127 and has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f). Since the applicant, the grounds for refusal, and the issues are the same, and both cases contain common questions of law and fact, the Board has consolidated the appeals.

2(e)(5) Functionality

A product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). Functional matter cannot receive trademark protection. At its core, the functionality doctrine serves as a balance between

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trademark and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Products Co., Inc.*, supra at 1163:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

The following four factors are used to determine the functionality of a proposed mark:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) advertising by the applicant that touts the utilitarian advantages of the design;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982).

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The Supreme Court has decreed that it is not necessary to consider all four *Morton-Norwich* factors, nor must they all point toward functionality. *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001). Rather, evidence that the proposed mark is the subject of a utility patent that discloses the utilitarian advantages of the configuration at issue can be sufficient by itself to support a functionality refusal. *TraFFix*, 532 U.S. at 33, 58 USPQ2d at 1007.

In the present case, both of applicant's proposed marks are subject to utility patents covering the configuration applicant seeks to register. By applicant's admission, the product configuration in Serial No. 76577156 is claimed by applicant in U.S. Patent No. 7013499.

(Appl's March 21, 2005 Amend. and Resp. to Office Action, p.2). The claims of the issued patent are more broad-based than the product configuration at issue here. But nevertheless, this product configuration is subsumed in the patent claims, which cover generally: "A toilet and sink drain plunger comprising: a) a handle; b) a bellows secured to said handle; and c) toilet and sink drain hole sealing rings" (Claim 9). See *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987) (where a utility patent claims more than what is sought to be registered,

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this fact does not establish the non-functionality of the product design, if the patent shows that the part claimed as a trademark is an essential or integral part of the invention and has utilitarian advantages.)). Furthermore, applicant's description in the patent points specifically to the utility and benefit of this configuration, stating:

Accordingly, there is a need for an improved type of toilet and sink drain plunger which can seat securely over or in the toilet or sink drain hole, regardless of the curvature of the area around the drain hole. Such plunger should be simple, efficient, capable of being easily fabricated and used and be inexpensive and durable.

("Background of the invention").³

Similarly, the product configuration in Serial No. 76577157 is claimed by applicant in U.S. Patent No. 4745641. (Appl's March 21, 2005 Amend. and Resp. to Office Action, p. 2). Here, too, the claims subsume the product configuration, describing "an elongated handle, to the bottom of which is preferably releasably connected a pleated bellows." ("Summary of the Invention"). Although the patent term has expired, it is no less relevant to the determination of functionality. See *In re Howard Leight*

³ The "Summary of the Invention" for U.S. Patent No. 7013499 continues by asserting that "the present invention satisfies all of the foregoing needs," thus speaking to the utility of this product configuration.

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Industries, LLC, 80 USPQ2d 1507, 1515 (TTAB 2006) (“[W]e find that applicant's expired utility patent, which specifically discloses and claims the utilitarian advantages of applicant's earplug configuration and which clearly shows that the shape at issue ‘affects the . . . quality of the device,’ is a sufficient basis in itself for finding that the configuration is functional, given the strong weight to be accorded such patent evidence under *TrafFix*.”). Furthermore, applicant’s description in the patent points specifically to the utility and benefit of this configuration, repeatedly referring in the claims to his “improved” device.

For both applications, this evidence weighs heavily toward a finding of functionality, since not only is the product configuration subject to a utility patent, but applicant specifically touts the benefits considered under the fourth *Morton-Norwich* factor. Applicant argues that his ownership of a design patent allegedly covering the 76577156 configuration cancels out the functional effect of his utility patent. We find that argument is not convincing. Although the referenced design patent may cover some of the same design aspects, the presence of the utility patent is significantly more weighty in indicating

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the utilitarian aspects of the configuration. *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997) (existence of utility patent covering product configuration significantly outweighs design patent), citing *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) (ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination.).

Applicant's advertisements of record add further weight to our determination of functionality in accordance with the second *Morton-Norwich* factor. See *In re N.V. Organon*, 79 USPQ2d 1639, 1645 (TTAB 2006) ("applicant's promotional materials touting the utilitarian advantages of the orange flavor, is particularly significant in assessing functionality in this case."). Applicant's advertisements for the 76577156 configuration tout utilitarian benefits such as "provides more results with less effort"; "delivers more plunge power per push"; "splashproof"; and "clears clogged toilets faster and better." Similarly, advertisements for the 76577157 configuration tout benefits such as "the first major technological improvement in nearly 100 years"; and "[g]reatest plunging capacity on the

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market today." Clearly, these advertisements are intended to persuade consumers of the alleged benefits of the utilitarian aspects of applicant's product configurations.

Applicant argues that his advertisements merely indicate that all belloyed designs are better, not just applicant's. However, the advertisements are clearly intended to indicate the superiority of applicant's designs over those of his competitors. Furthermore, in order for a mark to be held functional, the evidence need not establish that the configuration at issue is the very best design for the particular product or product packaging. Rather, a finding of functionality is proper where the evidence indicates that the configuration at issue provides specific utilitarian advantages that make it one of a few superior designs available. *See, e.g., In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Finally, applicant argues that each of his marks "consists of an arbitrary combination of functional parts." (Appl's Brief at 7). Where the evidence shows that the overall design is functional however, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 224 USPQ 625, 628-629

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(Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985).

In view of the foregoing, we find that the designs are functional and that applicant's marks are therefore unregistrable. Nevertheless, for purposes of a complete record, we will decide the issue of whether, assuming the designs are not functional, the designs have acquired distinctiveness and hence function as marks.

2(f) Acquired Distinctiveness

A product design cannot be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000). Accordingly, in both applications, applicant provided evidence intended to show acquired distinctiveness based on the following: an assertion of substantially exclusive and continuous use for a period of over 5 years prior to registration; advertisements that reference applicant's "exclusive" designs; and third-party declarations attesting to the uniqueness of the configurations. However, this evidence is insufficient to persuade us that applicant's marks have acquired distinctiveness.

The advertisements, as observed previously, simply depict applicant's plunger designs, and serve to persuade consumers of the allegedly superior nature of the designs.

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The advertisements promote the functional benefits of the products; they do not promote the product designs as a mark. Furthermore, applicant has not provided information regarding the amount or extent of advertising that might support a finding of acquired distinctiveness, except to say generally that the products have been advertised over a period of years.

The declarations, meanwhile, are not from the ultimate consumers of applicant's products. Rather, they are from industry insiders with an apparent interest in applicant's sales, either as an employee, a sales distributor, a retailer, a plumbing instructor, or the applicant himself. Thus the declarations are of limited probative value.

Simply stated, the advertisements and declarations submitted by applicant serve only to emphasize the allegedly desirable and functional features of the configurations. They do not, however, provide sufficient evidence that the product configurations are viewed as source-identifying. Applicant has therefore not shown sufficient proof of acquired distinctiveness.

Decision: The refusals to register in both cases are affirmed.