

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
November 16, 2009

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Brayco Products, Ltd.

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Serial No. 77296052

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Richard L. Schwartz of Whitaker, Chalk, Swindle & Sayer,  
L.L.P.

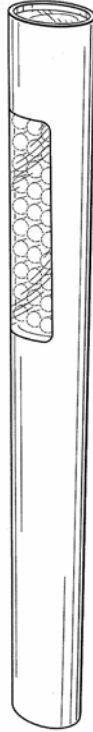
Yat-sye I. Lee, Trademark Examining Attorney, Law Office  
107 (J. Leslie Bishop, Managing Attorney).

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Before Quinn, Taylor and Bergsman, Administrative Trademark  
Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Brayco Products, Ltd. ("applicant") filed an intent-  
to-use application to register the "configuration of an  
elongated oval light casing," shown below, for goods  
ultimately identified as "portable lighting equipment,  
namely flashlights," in Class 12.



During the prosecution of the application, applicant filed an amendment to allege use claiming dates of first use anywhere and first use in commerce at least as early as April 1, 2008. In addition, applicant clarified the description of its mark as "the configuration of an elongated oval light casing having one end featuring a similarly formed transparent window for covering an array of lights beneath the transparent window." In other words, applicant's product design is a cylinder with an elliptical cross-section (oval shape) rather than a circular cross-section.

The Examining Attorney refused registration on the grounds that the subject matter sought to be registered is

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functional pursuant to Section 2(e)(5) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(5), and that the design sought to be registered has not acquired distinctiveness.

### **Functionality**

The design or trade dress of a product is functional if it is essential to the use or purpose of a product or if it affects the cost or quality of the product. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). In analyzing whether the subject sought to be registered is functional, we determine whether the design of the flashlight is functional, not whether applicant's flashlights are functional.

Accordingly, we must determine whether the design of the flashlight is essential to its use or purpose or if it affects the cost or quality of the products (*i.e.*, whether granting trademark protection to the design will hinder competition). *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 12-15 (CCPA 1982). In other words, the issue is whether the design of the product works better in the shape at issue. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984).

In determining whether the product design is functional, we focus on the overall design of the product. We cannot dissect the design into its individual elements

and analyze the utility of each feature separately. *In re Teledyne Industries, Inc.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982).

A determination of functionality normally involves consideration of the following factors:

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.*, 213 USPQ at 15-16.

A. Utility patent.

The record does not contain any utility patents referencing the utilitarian advantages of the design sought to be registered.

B. Applicant's advertising.

In determining whether applicant's advertising touts the utilitarian advantages of a product configuration, the advertising should clearly emphasize specific utilitarian

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features of the design claimed as a mark. *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) ("This copy clearly indicates that the particular features of the applicant's configuration . . . provide certain acoustical advantages in terms of the sounds the guitar makes"); *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1716-1717 (TTAB 1998), quoting *In re Witco Corp.*, 14 USPQ2d 1557, 1559-1561 (TTAB 1989) (specific statements focusing directly on the advantages of the product design); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260-1261 (TTAB 1993) (applicant's advertising repeatedly and specifically emphasizes the utilitarian advantages of the conical shape of its product design). In *Gibson Guitar*, the Board found the design of a guitar body to be functional, noting that applicant's literature clearly indicated that the shape of applicant's guitar produced a better musical sound. Applicant's advertisements stated that "[t]his unique body shape creates a sound which is more balanced and less 'muddy' than ordinary dreadnought acoustics." 61 USPQ2d at 1951. Accordingly, we are looking for statements in applicant's advertising and promotional materials that state that the elongated oval design of applicant's flashlight produces a better product.

The Examining Attorney contends that applicant's advertising touts that the product design allows the flashlight to simultaneously function as both a flashlight and a floodlight.<sup>1</sup> The relevant advertising and promotional materials discussed below have been made of record.

1. Applicant's product brochure touts the "Dual-Mode Multi-Function." The brochure provides the following information:

All NIGHTSTICK dual-mode multi-function lights utilize housings made from advanced engineered polymers. This approach allows for maximum design flexibility where size, shape and weight are optimized to produce a professional lighting product that is ergonomic in shape while providing high resistance to impact and exceptional resistance to chemicals.

Applicant also describes its product as "pocketable" and "thin shaped."

2. The *Amazon.com* website promotes applicant's product "[w]ith its thin shape, it easily fits into your pants or shirt pocket."

3. An excerpt, shown below, from an unidentified website attached to the November 5, 2008 Office Action that

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<sup>1</sup> Examining Attorney's Brief, pp. 4-5.

the Examining Attorney contends "touts the utilitarian advantages of the design."<sup>2</sup>

## Innovative Design

### DUAL-MODE MULTI-FUNCTION™

- Optimized flashlight beam for maximum target identification
  - Super-bright beam color approx 6500K°, similar to sunlight
- Broad beam floodlight for maximum scene illumination
  - Excellent workplace illumination
- Dual-Mode flashlight and floodlight operation
  - Simultaneous illumination, close-in and long range
  - Expanded visible safety zone
  - Maximum safety while walking
  - Maximum workplace illumination



While applicant's advertising and promotional materials promote the thin shape and "dual-mode multi-function" capability of the product, there is nothing in applicant's advertising and promotional materials that associates the product design with utilitarian advantages offered by applicant's product: that is, there is nothing that indicates that the elongated cylindrical oval design produces a superior flashlight or that the elongated cylindrical oval design offers utilitarian advantages.

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<sup>2</sup> Examining Attorney's Brief, pp. 4-5.

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With respect to the dual-mode functionality, many of the alternative product designs discussed below have multiple functions; and the Examining Attorney has failed to demonstrate that the flashlight's touted features of being "pocketable," "thin shaped" and ergonomic are attributed to the elongated oval design.

C. Alternative designs.

The availability of alternative designs is relevant to show that the design sought to be registered will not hinder competition. *In re Morton-Norwich Products, Inc.*, 213 USPQ at 16. Where the evidence indicates that the applicant's configuration is the best or one of a few superior designs available, then this evidence will strongly support a finding of functionality. *In re Bose Corp.*, 772 F.2d 866, 27 USPQ 1, 5 (Fed. Cir. 1985) (the availability of alternative designs does not detract from the functional character of the product design where the subject matter sought to be registered is "the preferred or a superior design"); *In re Dietrich*, 91 USPQ2d 1622, 1636 (TTAB 2009) (the issue is whether alternative designs work equally as well); *In re Gibson Guitar Corp.*, 61 USPQ2d at 1951 ("applicant has not shown that there are alternative guitar shapes which can produce the same sound as applicant's configuration").



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Applicant submitted the flashlights shown below as evidence of alternative designs.<sup>3</sup>

Applicant's Alternative Flashlights



The photograph below depicts applicant's NIGHTSTICK flashlights. The design sought to be registered is depicted on the far left.



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<sup>3</sup> Applicant's August 4, 2008 response.

Maglite Flashlights



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Black & Decker SnakeLight<sup>4</sup>



Montus Lighting Products<sup>5</sup>



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<sup>4</sup> The SnakeLight functions as a flashlight and a "work light." The SnakeLight has a 14 LED work light and a 3 LED flashlight.

<sup>5</sup> The Montus 9011 lights have three functions: work light, flashlight and S.O.S. signal light. The 903-C light has two functions: work light and flashlight.

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The Examining Attorney made photographs of the flashlights shown below of record.<sup>6</sup>

Inova



A Generic Flashlight from DealExtreme.com<sup>7</sup>



Powerizer Flashlight<sup>8</sup>



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<sup>6</sup> November 5, 2008 Office Action.

<sup>7</sup> This light has dual functions. There are three LEDs on the side that act as an emergency strobe light and signal light and there are four LEDs on the front that act as a flashlight.

<sup>8</sup> The Powerizer emits light from the side panel and from a head beam.

A Generic Flashlight from Wal-Mart



All of the flashlights and portable lights made of record, including the multi-functional lighting designs (SnakeLight, Montus 903-C, DealExtreme and Powerizer), share a cylindrical shape similar to the design sought to be registered. However, only applicant's product has an elliptical cylindrical design. Thus, there are alternative designs: for example, there are flashlights with traditional cylinders with a circular cross-section, the SnakeLight appears to be more of a rectangular tube, and applicant's other products have triangular heads. Because there are alternative product designs, the elongated oval design applicant seeks to register does not appear to be essential to competition.

D. Ease or economy of manufacture.

As indicated above, a product feature or design is functional if its affects the cost or quality of the product. Applicant stated for the record that "the expense of manufacturing Applicant's design is at least comparable

to, if not more expensive, than alternative competitive designs.”<sup>9</sup>

E. Balancing the factors.

Applicant described the design of the flashlight sought to be registered as “the configuration of an elongated oval light casing having one end featuring a similarly formed transparent window for covering an array of lights beneath the transparent window.”<sup>10</sup> In other words, the mark is the elliptical cylindrical shape of the flashlight. There is no utility patent disclosing the utilitarian advantages of the elongated oval design. Applicant’s advertising does not state that the elongated oval design produces a superior product or offers utilitarian advantages. Alternative product designs have been made of record demonstrating that the elongated oval design sought to be registered is not essential to competition. There is no evidence of record to show that the elongated oval design sought to be registered is easier or more inexpensive to produce. In view of the foregoing, we find that the design sought to be registered is not functional.

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<sup>9</sup> Applicant’s August 4, 2008 response.

<sup>10</sup> Applicant’s August 4, 2008 response.

**Acquired Distinctiveness**

Because the subject matter sought to be registered is a product design, it is not inherently distinctive, and it is registrable only with a showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1067 (2000). An applicant faces a heavy burden in establishing the distinctiveness of a product design. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988); *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000).

The Examining Attorney's position is quite simple: applicant has failed to demonstrate that the product design is recognized as a trademark.

Applicant did not provide any financial records, expenditures on advertising devoted to the promotion of the applied-for mark, or any dealer and consumer statements that would establish the recognition of the applied-for mark as a source identifier for the recited goods.<sup>11</sup>

On the other hand, applicant contends that it "has been actively marketing and promoting its mark, since at least as early as April 1, 2008 in a wide variety of trade shows and customer meetings in multiple industries in the

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<sup>11</sup> Examining Attorney's Brief, p. 11.

United States and abroad."<sup>12</sup> According to applicant's summary of activity, applicant has displayed its product at nine trade shows in the United States, made numerous sales presentations, and generated a few sales and some interest pending further investigation.<sup>13</sup>

Applicant's evidence of acquired distinctiveness is far from convincing. Applicant has been selling its product for little more than a year. The Examining Attorney correctly noted that there is no evidence regarding sales in terms of revenues or units, advertising expenditures, or any other indicia of consumer recognition. It appears that applicant is in a "start-up" mode. In considering the totality of the probative evidence, we find that the evidence is insufficient to show that the design of applicant's flashlight has acquired distinctiveness.

**Decision:** The refusal to register on the ground that applicant's product design is functional is reversed.

The alternative refusal on the ground that, even if the design is not functional, applicant's evidence is insufficient to demonstrate acquired distinctiveness under Section 2(f) is affirmed and therefore, registration is refused.

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<sup>12</sup> Applicant's Brief, p. 8.

<sup>13</sup> Applicant's August 4, 2008 response, Exhibit 7.