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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77324270

MARK: USN



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Navy Exchange Service Command
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EXAMINING ATTORNEY'S APPEAL BRIEF

Issue on Appeal

Applicant has appealed the Examining Attorney's refusal to register the trademark for the applicant's design mark on the grounds that the mark is functional under Trademark Act Section 2(e)(5), 15 U.S.C. Section 1052(e)(5).

Procedural History

Pursuant to its application filed on November 8, 2007, the applicant seeks registration of the design mark consisting of a bald eagle perched, with wings spread, on an anchor in front of a schooner ship with "USN" below the design. This design is set against irregular block-shaped pixels in a four-color pattern of black, deck grey, light grey and navy blue, which pattern repeats and covers the entire surface of the goods for "cotton, nylon blends, and nylon fabrics which will all be used in the manufacture of

merchandise, including but not limited to clothing, to be sold to authorized patrons of the military exchanges pursuant to Armed Services Exchange Regulations” in Class 24. The application was filed Intent to Use. On April 29, 2008, applicant’s mark was published for opposition. No opposition having been filed, a Notice of Allowance was issued on July 22, 2008. On December 30, 2008, applicant filed a Statement of Use.

On March 24, 2009, the examining attorney refused registration on the grounds that the applied for mark is functional under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5) and the mark is a decorative or ornamental feature of the goods under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052.

In its Response to Office Action, dated September 19, 2009, the applicant argued that the mark is not functional nor is it ornamental. The applicant asserted that even if the applied-for mark is considered ornamental, it has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f). Applicant provided evidence in support of this assertion.

On November 19, 2009, the examining attorney issued a subsequent Office Action rejecting the applicant’s claim of acquired distinctiveness stating the applicant’s evidence of acquired distinctiveness was insufficient. The examining attorney maintained the Functional and Ornamental Refusals and raised as new issues a requirement for a description of the mark which refers to the repeating pattern and a requirement for a substitute specimen of use which shows the proposed mark applied to the actual goods.

In its Response to Office Action, dated May 12, 2010, the applicant again argued that the mark is not functional, nor is it ornamental. In addition, applicant submitted

acceptable substitute specimens of use and amended the description of the mark to indicate that the mark consists of a repeating pattern.

Upon discussing the application with the applicant's attorney, the examining Attorney issued an Examiner's Amendment on September 17, 2010, amending the identification of goods. Accordingly, the Section 2(f) claim of acquired distinctiveness was accepted and the Ornamental Refusal was found to be moot. The examining attorney noted that the Functional Refusal was maintained.

On October 26, 2010, the examining attorney issued a Final Office Action maintaining the refusal to register under Trademark Act Section 2(e)(5).

On April 7, 2011, Applicant filed a timely notice of appeal of the final action.

Argument

APPLICANT'S MARK IS FUNCTIONAL BECAUSE IT SERVES A UTILITARIAN PURPOSE.

The examining attorney refused registration under Trademark Act Section 2(e)(5), 15 U.S.C. Section 1052(e)(5) because the mark is functional.

A feature is functional as a matter of law if it is "essential to the use or purpose of the product or if it affects the cost or quality of the product." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982).

Determining functionality normally involves consideration of one or more of the following factors, commonly known as the "*Morton-Norwich* 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.

Valu Eng'g Inc. v. Rexnord Corp., 278 F.3d 1268, 1278, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982)); TMEP §1202.02(a)(v).

However, it is not necessary to consider all the *Morton-Norwich* factors in every case. The Supreme Court held that “[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001). Moreover, there is no requirement that all four of the *Morton-Norwich* factors weigh in favor of functionality to support a refusal. See *Valu Engineering*, 278 F.3d at 1276, 61 USPQ2d at 1427 (“once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs”); *In re UDOR U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (affirming a functionality refusal of “a round disk head on a sprayer nozzle” where the third and fourth factors showed that applicant’s competitors manufactured and marketed spray nozzles with similar features, the shape was preferred in the industry, and it appeared efficient, economical, and advantageous, even though applicant’s utility patent and advertising did not weigh in favor of functionality); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006) (orange flavor found functional based on applicant’s touting of the

utilitarian advantages of the flavor and the lack of evidence of acceptable alternatives, even though the mark was not the subject of a patent or patent application and there was no evidence that the flavor affected the cost of the product); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001) (where there was no utility patent, and no evidence that applicant's guitar configuration resulted from a simpler or cheaper method of manufacture, these factors did not weigh in Board's decision).

Accordingly, the issue here is whether the applied for mark is functional, i.e., essential to the use or purpose of the product, or has a utilitarian purpose. If the mark is functional, there is no need to proceed further to consider if there is a competitive necessity for the feature or alternate designs available. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001).

Applicant's mark is comprised of a repeating series of colors (navy blue, black, deck gray and light gray) in a pixilated pattern with a small logo featuring an eagle, a ship and the letters "USN" (the logo also repeats). The mark is applied to fabric in Class 24, namely, "cotton, nylon blends, and nylon fabrics."

A color that is functional for specific goods is not registrable on the Principal Register under Trademark Act Section 2(f) or on the Supplemental Register, regardless of evidence of acquired distinctiveness. TMEP §1202.05(b); *see Brunswick Corp. v. British Seagull Ltd.*, 35 F. 3d 1527, 1534, 32 USPQ2d 1120, 1125 (Fed. Cir. 1994).

A color is functional if it yields a utilitarian or functional advantage, e.g., yellow or orange for safety signs make the signs more visible. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994) (holding the color

black functional for outboard motors because it provides competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1446-48 (TTAB 2007) (holding the color dark purple functional for sand paper because color serves a myriad of functions in the coated abrasives industry, including maintaining a uniform appearance of the product and color coding for grit size or coarseness); *In re Ferris Corp.*, 59 USPQ2d 1587 (TTAB 2000) (holding the color pink functional for use on surgical wound dressings because the actual color of the goods closely resembles Caucasian human skin). A color mark can also be functional if it provides competitive advantages, such as being more economical with respect to the manufacture or use of the goods. See TMEP §§1202.02(a)(viii), 1202.05(b); cf. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1983).

Although this mark differs slightly from marks which feature a single color, the analysis for functionality of color marks still applies and reliance on single-color cases is appropriate. There is nothing in the cases regarding single colors that precludes applying their principles to marks with more than one color. Be it one or more than one color, a mark will be deemed functional “if it yields a utilitarian or functional advantage.”

In this case, the applicant’s mark -- a series of colors in pixilated form -- is functional because it masks stains and wear-and-tear, thereby fulfilling the essential requirements for a neat and clean Navy uniform.¹ Applicant states in its “Navy Working

¹ Prior to the Final Action, the Examining Attorney also argued that the mark was functional because it served as camouflage which would protect wearers from detection by hostile people. Applicant argued that the uniforms were not intended to serve as camouflage and, in support thereof, attached a list of Frequently Asked Questions about the uniforms. The FAQ’s explain: “The concept uniforms (as opposed to tactical or combat uniforms) are not intended to be ‘camouflage’ uniforms...We have no need for

Uniform (NWU) Concepts Frequently Asked Questions”: “A ‘multicolored pattern’ was chosen because solid colors show heavy wear and wrinkles more predominantly” and “the specific Navy-related colors, including ‘deck gray’ and ‘navy coverall blue’ were thought appropriate to further identify the uniforms to their Navy source since they are colors associated with a maritime environment.” Response to Office Action, September 19, 2009, at p.7.

The letters “USN” and the ship/eagle/anchor logo appear as a small design in shades of grey set on a light grey portion of the irregular block-shaped pixel pattern. These non-functional features do not change the overriding functional purpose of the mark as a whole. *See Textron, Inc. v. U.S. Int’l Trade Commission*, 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985). (“Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result.”)

Article 1501.5 of the United States Navy Uniform Regulations – Uniform Review and Development states:

The Chief of Naval Operations charged the Navy Uniform Board to continually review Navy uniform matters and use the following specific qualitative factors, applicable to all uniforms, to evaluate suitability of current uniforms and those proposed for replacement.

- a. Versatility. Flexibility and adaptability in terms of:
 - (1) Number of personnel wearing uniforms.
 - (2) Varied climates
- b. Safety. The ability to protect and not present a hazard to personnel.

camouflage.” Exhibit B in the 9/19/09 response (TICRS p. 7). Based on these assurances by the applicant, the Examining Attorney made no further argument that the mark is functional because it serves a camouflage purpose.

- c. Ease of Maintenance. Laundering, cleaning, upkeep, and tailoring requirements.
- d. Storage. Amount of space required for storage.
- e. Cost. Purchase price and maintenance costs.
- f. Durability. Ability to present a neat appearance over a long period of time.
- g.
- h.
- i. Military Appearance. How well the uniform displays a smart, crisp image....

Final Office Action, October 22, 2010, at pp. 9-11, hereinafter referred to as “Final.”

This regulation shows the significance the U.S. Navy places on the appearance, durability, ease of maintenance, storage needs and cost to maintain uniforms.

Additionally, Article 1101.3 of the Uniform Regulations of the U.S. Navy highlights the Navy’s emphasis on the importance of the display of the uniform:

“Navy uniforms are distinctive visual evidence of the authority and responsibility vested in their wearer by the United States...Navy personnel must present a proud and professional appearance that will reflect positively on the individual, the Navy and the United States.”

Final at p. 14.

Furthermore, the recruiting website of the U.S. Navy, www.usnavy.com, describes the Navy uniform policy in great detail, emphasizing the importance of properly maintained uniforms. It specifically provides:

“Commanding officers of the US Navy inspect the clothing of E1/E2/E3 personnel at regular intervals and those of E4/E5/E6 is subject to individual inspection.

All naval personnel of the US Navy need to maintain neat and clean Navy uniforms and wear their respective badges, decorations, ribbons and insignias as the case may be.

Final at pp. 7-8.

The applicant asserts that “[t]o the extent the Navy may sometimes indicate that a color pattern was chosen to minimize the effects of heavy wear and wrinkles, this is tantamount to puffery merely promoting the roll out of the new Navy uniforms.” Brief at p. 8. However, it is not merely puffery because the above referenced regulations and policies show the importance of uniform display to the U.S. Navy. It is highly important to the U.S. Navy to develop uniforms that present a neat and clean appearance, to maintain regulations that promote the wear of neat and clean uniforms and to regularly enforce the regulations through individual inspections.

In developing the Navy Working Uniform, the “more than 40,000 Sailors who took part in the fleetwide survey told the Navy that the previous working uniforms were not practical for the Navy working environment, were too costly and difficult to maintain, and did not reflect a professional military appearance.” *See* Navy Working Uniform (NWU) Concepts Frequently Asked Questions, Task Force Uniform Public Affairs Press Release, released January 13, 2005, retrieved July 23, 2010 from www.navy.mil. Final at p.2.

The Task Force found that “by learning from our past working uniforms as well as the uniforms from other services, the Navy realized that a solid cover uniform shows heavy wear areas much more predominantly than a multicolored pattern. The solid color uniforms also show wrinkles in the fabric more predominantly, and often a small stain or spot of paint renders a solid colored uniform not wearable. A multicolored uniform alleviates those problems, as well.” *See* Navy Working Uniform (NWU) Concepts Frequently Asked Questions, “Why the camouflage pattern?”, Task Force Uniform

Public Affairs Press Release, released January 13, 2005, retrieved July 23, 2010 from www.navy.mil. Final at p.3.

Additionally, “the camouflage pattern will permit mending of small rips in uniform fabric, saving Sailors considerably in replacement costs.” *See* Navy Working Uniform (NWU) Concepts Frequently Asked Questions, “What about maintenance/care of these uniforms”, Task Force Uniform Public Affairs Press Release, released January 13, 2005, retrieved July 23, 2010 from www.navy.mil. Final at p. 4.

In an article entitled “New Navy Working Uniform and Service Uniform Concepts Approved,” Chief of Naval Operations Adm. Mike Mullen noted, with respect to the New Navy Working Uniform: “Durability, safety, ease of wear and cleaning were all factors that weighed heavily on my mind, as did quite frankly, survey data and the opinion of wear testers.” Additionally, Master Chief Petty Officer of the Navy Terry Scott stated: “[W]e’ve created a uniform that’s...easier to maintain, is longer lasting, helps reduce the size of the sea bag, while at the same time recognizing the tradition and heritage of serving in the Navy.” Final at p. 5.

These statements regarding applicant’s four-color pixilated pattern exemplify applicant’s commitment to consider and meet the qualitative factors for uniform development set out in Article 1501.5 of the United States Navy Uniform Regulations. Specifically, the four-color pixilated pattern meets the following requirements: ease of maintenance including ease of laundering, cleaning, upkeep, and tailoring; storage including the amount of space required for storage; cost including purchase price and maintenance costs; durability including ability to present a neat appearance over a long

period of time; and military appearance, that is how well the uniform displays a smart, crisp image.

Again, applicant argues that to the extent the color pattern in applicant's mark provides an advantage of hiding stains or wear-and-tear, this attribute is merely an incidental feature inherent to any patterned material. Brief at pp. 10-11. Applicant points to several registrations for marks that are comprised of patterns applied to clothing to contend that "[t]he U.S. Patent and Trademark Office does not generally deny registration of marks that are patterns on clothing simply because patterns help hide stains better than solids." Brief at p. 11. Specifically, applicant notes the existence of registrations for professional sports team uniforms (Reg. Nos. 2565444 and 1534709), U.S. Postal Service uniforms (Reg. Nos. 3061546 and 30615510) and United Parcel Service uniforms (Reg. No. 2901090). Brief at pp. 11-12.

As the applicant notes, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Applicant argues:

presumably, all the owners of the above-mentioned marks hope that their clothing and colors are able to better withstand wear and stains. Nonetheless, the USPTO has clearly determined that such colors are not functional because any feature that would allegedly improve the products' ability to withstand wear and stains is merely incidental and not "essential" to the use or

function of the clothing and/or because any alternatively-patterned colors providing the same alleged benefits are readily available.

Brief at p. 12.

Applicant's presumption is not supported by evidence. There is no evidence to support that neat and clean football and basketball uniforms are valued by the individual users or their teams. In particular, the nature of the game of football contradicts this suggestion. Additionally, while it is presumed that companies that provide or require uniforms to be worn by their personnel also care that the presentation of the uniform reflects positively on their company, it is unlikely that they have such detailed regulations or perform regular inspections of the uniforms in the manner the Navy does.

Furthermore, there is no evidence that the color brown on the United Parcel Service, Inc. (UPS) uniform or the colors blue and gray on the U.S. Postal Service (USPS) uniforms were chosen to hide stains and wrinkles. First, the uniforms are of solid color (or predominantly solid with a stripe for the USPS uniform). As indicated by the Navy, solid color uniforms show wear and wrinkles more predominantly than multi-colored patterns. *See Navy Working Uniform (NWU) Concepts Frequently Asked Questions*, Task Force Uniform Public Affairs Press Release, released January 13, 2005, retrieved July 23, 2010 from www.navy.mil. Final at p. 3. Additionally, the evidence shows that the color brown was adopted by UPS for company uniforms and delivery trucks because it reflected "class, elegance, and professionalism". See the complaint in *United Parcel Service, Inc. vs. Samuel Z. Brown*, Complaint filed March 19, 2008 in the

U.S. District Court, Southern District of New York, Facts Giving Rise to Action, Nos. 9 and 10. Final at p. 20.

While it may be incidental to civilian clothing that patterns help hide stains, the U.S. Navy regulations, policies, press releases and news articles discussed herein and attached to the Office Actions show that one of the purposes of the design of applicant's mark is to hide stains and wear-and-tear. For that reason, the evidence supports a finding that the applied-for mark achieves the Navy's uniform requirements of neat appearance, durability, ease of maintenance, minimal storage needs and lower cost and as such serves a utilitarian purpose in relation to the applicant's goods.

The applicant cites cases which it claims support the proposition that multi-color marks, such as the one at issue, are protectable. Brief at p. 6. In fact, these cases simply state, and restate, that when making a case for functionality, the proposed mark cannot be broken down into individual elements, but must be considered in its entirety.

In *Sportsac Inc. v. K-Mart Corp*, defendant argues that certain features of the plaintiff's bags--hollow zipper pull, cotton carpet tape and repeating logo--are functional. The Court stated that the defendant cannot break down the trade dress into individual elements and then attack those elements as functional. The trademark protection extends to the particular combination and arrangement of design elements that identify its bags and distinguishes them from others. 754 F2d 71 (2nd Cir. 1985). Of particular note, color was not even at issue in this case. In *Vaughn Mfg Co. v. Brikam Intern, Inc.* the mark at issue consisted of a folding table which has specific colors on specific parts of the table. The Court rejected the Defendant's functionality argument, again, because it focused on the individual elements of the table, including the individual colors on the specific

surfaces, rather than the overall trade dress. (814 F2d 346, 1 USPQ2d 2067 (7th Cir. 1987). In *Clicks Billiards, Inc. v. Sixshooters, Inc.*, a trade dress infringement case regarding pool halls, the defendant parsed out a long list of arbitrary elements, e.g., the size, placement, and layout of the pool tables, the color combination, including the contrast between the carpet and the dark wood, the lighting; the neon beer signs, bar tap handles, the cue racks, etc. The District Court stated, and the 9th Circuit agreed, that any of these elements, “considered in isolation,” may be functional. “The issue, however, is whether, taken as a whole, the overall look and feel of the establishment is functional.” 251 F3d 1252, 1259, 58 USPQ2d 1881 (9th Cir. 2001).

Finally, applicant cites *In re American Home Products*, 226 U.S.P.Q. 327 (TTAB 1985). This application was not refused under Trademark Act Section 2(e)(5) and the Court did not analyze the functionality of the multiple colors used in the mark. The sole issue considered on appeal was whether applicant's tricolored design mark identified and distinguished the commercial source/origin of applicant's analgesic and muscle relaxant. Reliance on this case appears to be misplaced.

As stated above, the mark as applied to applicant's goods is “essential to the use or purpose of the product” and therefore functional. Although it is not necessary to consider each of the *Morton-Norwich* factors in light of the foregoing, these factors nevertheless support a finding of functionality. There is no utility patent for the colors appearing in pixilated form, and the record does not establish that the mark involves a “simple or inexpensive method of manufacture.” However, extensive evidence of the applicant promoting the benefits of the mark applied to the goods is in the record. As already stated, the Navy publicized to its members that one of the reasons it chose this

repeating pattern for applying to the goods is to hide stains, wrinkles and wear and tear. This will prevent the need for multiple uniforms (supporting the goal of durability and reducing costs and storage needs) and will make it easier for members of the Navy to appear neat and clean, even when stains are present on the uniforms (supporting the goal of easy maintenance because laundering and tailoring needs are reduced). Moreover, there is competitive need for this design because alternative designs are limited; other armed services, such as the United States Army, also use colors in pixilated patterns for their own uniforms. These may be to hide stains and wear, like the Navy, and also to camouflage troops in harms way. The Navy should not have a monopoly on colors in pixilated patterns for uniforms, when other branches of the military have needs for similar designs.

Conclusion

For the foregoing reasons, the refusal to register on the basis of Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5) should be affirmed.

Respectfully submitted,

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