

THIS OPINION
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THE TTAB

Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 3M Company

Serial No. 77701886
Serial No. 77701928

Scott M. Oslick of Merchant & Gould PC for 3M Company.

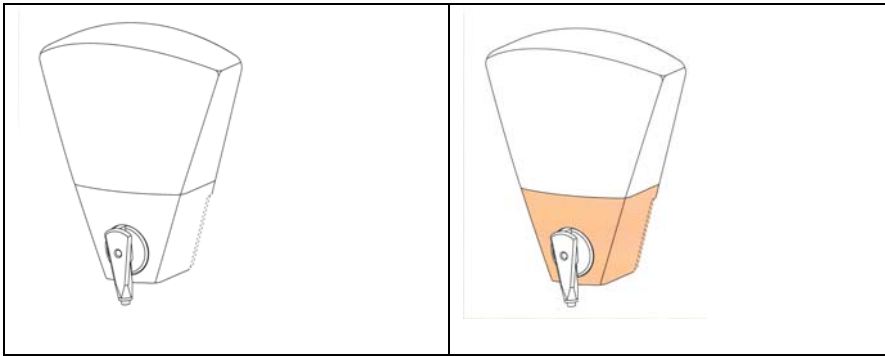
Brendan McCauley, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Quinn, Grendel, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On March 30, 2009, 3M Company, applicant, applied to register the two configuration marks shown below on the Principal Register for goods identified as "hand-sanitizing antiseptic with moisturizers" in International Class 5.

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The mark appearing above-left (subject of application Serial No. 77701886) does not claim color as a feature of the mark; the mark appearing above-right (subject of application Serial No. 77701828) is depicted in the colors "peach and white" which applicant claims as a feature of the proposed mark. Otherwise, the marks are the same and the descriptions thereof, as amended, essentially are the same.

The descriptions of the marks currently read as follows in the respective application files:

The mark consists of a three dimensional configuration as depicted in the drawing with claimed features drawn in solid lines that can be generally described as a wedge-shaped container with a curved top, a curved front, a flat back, a flat bottom, concave sides, and a three-dimensional, smaller wedge-shaped covering on a circular background in the lower portion of the container. The dotted lines represent indentations and are not claimed as features of the mark.

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and

The mark consists of a three dimensional configuration as depicted in the drawing with claimed features drawn

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in solid lines that can be generally described as a wedge-shaped container with a curved top, a curved front, a flat back, a flat bottom, concave sides, and a three-dimensional wedge-shaped covering on a circular background in the lower portion of the container. The dotted lines represent indentations and are not claimed as features of the mark. The colors peach and white are claimed as features of the mark. The top portion of the wedge-shaped container and the three-dimensional, smaller wedge-shaped covering on the circular background are in the color white, and the bottom portion of the wedge-shaped container is in the color peach.

[Application Serial No. 77701928]

Both applications are based on an allegation of first use anywhere and in commerce on November 30, 1999, and contain a claim that the mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

The two proposed marks are hereinafter collectively referred to as the "dispenser configuration marks."

The trademark examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that applicant's dispenser configuration marks are functional designs for the packaging of the goods. The examining attorney also refused registration on the alternative ground that, if the marks are not functional, they nonetheless consist of non-distinctive configurations of packaging for the goods that do not function as marks under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127, and have not

acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f). Finally, the examining attorney also refused registration based on applicant's alleged failure to provide acceptable descriptions of the marks, as required by Trademark Rule 2.37.

When the refusals were made final, applicant concurrently appealed and filed requests for reconsideration. The examining attorney denied the requests for reconsideration. Applicant and the examining attorney then filed briefs, including applicant's reply briefs. In addition, applicant and the examining attorney presented arguments at an oral hearing held before this panel on January 24, 2012. Because the matter on appeal in both applications is based upon common issues of law and fact, and further because the evidence of record and briefs are nearly identical, we will decide both appeals herein in a single opinion.¹

The Marks and the Goods

As to the dispenser configuration marks, there is no dispute that they depict a configuration of a container for the identified goods, *i.e.*, dispensers for hand-sanitizing antiseptic with moisturizers. The goods are sold in the

¹ Unless otherwise noted, all references to the dates of correspondence between applicant and the examining attorney

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dispensers under the trademarks AVAGARD and 3M. They are, according to applicant, "primarily intended for use in critical care settings, such as for use in surgery, emergency rooms, neonatal care, intensive care, cath[ether] labs and other such settings." Response to Office Action, December 19, 2009.

Functionality

We first determine whether the proposed marks are functional. A product or product packaging 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 Prods. Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., 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 trademark and patent law. As the Supreme Court explained in *Qualitex*:

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

during prosecution of these applications and evidence attached thereto refer to application Serial No. 77368754.

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).

34 USPQ2d at 1163.

In making our determination as to whether a proposed mark is functional, the following four factors are considered:

- (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). See also, *In re Becton, Dickinson and Co.*, ___ F.3d___, 102 USPQ2d 1372 (Fed. Cir. 2012); and *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002). Upon consideration of these factors, our determination of functionality is ultimately a question of fact, and depends on the totality of the evidence presented in each

particular case. *Valu Engineering*, 278 F.3d at 1273, 61 USPQ2d 1424; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); see also, TMEP §1202.02(a)(iv) (8th Edition 2011).

In his brief, the examining attorney concentrates on the first Morton-Norwich factor in asserting that applicant's marks comprise functional designs. While apparently conceding that the other three factors favor a finding of a non-utilitarian design, the examining attorney believes that the utility patents outweigh those factors:

Although existence of a utility patent does not per se establish functionality, it is the strongest *Morton-Norwich* factor in this case which supports the Section 2(e)(5) refusal for which applicant has not successfully rebutted. With respect to the second *Morton-Norwich* factor, outside of the web shape of the applied-for mark, applicant's advertising does not expressly tout utilitarian advantages associated with the packaging nature of the applied-for mark. With respect to *Morton-Norwich* factors three and four, the fact that applicant has shown that the dispenser is one of many alternative feasible designs which is more expensive to manufacture bears little resolution on the issue of functionality in light of U.S. Patent Numbers 5,897,031 and 5,799,841 owned by applicant.

Brief, (unnumbered) p. 5.²

We disagree with the examining attorney's interpretation of and ultimate reliance on the utility

² In all, applicant submitted copies of its two design patents and two utility patents with its December 19, 2009 response to an Office action. They are: Des. 383,631 (issued September 16, 1997); Des. 386,640 (issued November 25, 1997); 5,799,841 (issued September 1, 1998); and 5,897,031 (issued April 27, 1999).

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patents. Upon review of these patents, we do not find that they disclose utilitarian advantages or features found in applicant's dispenser configuration marks. The particular patent excerpts referenced by the examining attorney in his brief provide a general description of the overall shape of the dispenser's reservoir; however, there is no explanation or claims in the patents divulging any utilitarian purpose for such design or configuration. Specifically, the examining attorney relies on the language in the patents regarding a "preferable geometry" for the dispensers, but does not point to any further language in the patents illustrating how this "preferable geometry" actually provides a utilitarian advantage.

As to the nozzle feature found in both dispenser configuration marks, the examining attorney correctly notes that applicant's utility patent 5,897,841 ("Drip Resistant Nozzle for a Dispenser") contains a description of the nozzle area as including "...grasping surfaces that are sized and shaped to be manually grasped...As described in greater detail below, the knob can be turned to permit or prohibit flow of product." While this description clearly indicates that the nozzle (or knob area) has been designed to be "manually grasped," the actual functional nature of the nozzle is within the dispenser or nozzle assembly. The

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mere fact that the nozzle may be handled is secondary to the function that it performs, i.e., being able to be turned so as to place the dispenser in an "open" or "locked" position. The inner-workings of the nozzle are shown in the applications' drawing pages and thus cannot be claimed as features of applicant's proposed dispenser configuration marks. Even if we were to allow for or find some utilitarian advantage in the dispenser configuration marks' nozzle and that it is somehow easier to grasp and turn, we could not find the entire mark to be functional based on this feature by itself.

Accordingly, we are not persuaded that the existence of applicant's utility patents involving the dispenser and its nozzle weighs in favor of finding the proposed dispenser configuration marks as being functional.

We further acknowledge that applicant owns two design patents for designs which we cannot say are identical in shape to the proposed dispenser configuration marks, but are nearly visually indistinguishable. Des. 383,631 is for an "ornamental design for a reservoir assembly for a product dispenser" and Des. 386,640 is for the "ornamental design for a support and reservoir assembly for a product dispenser." The court in *Morton-Norwich* stated that when a party owns a design patent, this "at least presumptively,

indicates that the design is not de jure functional," and thus registrable. *In re Morton-Norwich Products, Inc.*, 213 USPQ at 11, footnote 3 (citations omitted). Accordingly, applicant's design patents are evidence of non-functionality because they are recognition of the ornamental features of the dispenser configuration marks.

As to the other *Morton-Norwich* factors, there is no evidence that applicant touts any utilitarian advantages associated with its dispenser configuration. Applicant has also submitted evidence showing several examples of third-party dispensers which the examining attorney concedes are "feasible" alternatives. Finally, the examining attorney has accepted applicant's contention that the dispensers are more expensive to manufacture.

Ultimately, based on all of the record evidence and arguments in relation to the *Morton-Norwich* factors, we find that the examining attorney has not met his burden in establishing a prima facie case that the dispenser configuration marks are functional and, thus, are not registrable on that basis. While there is some evidence that the shape of the dispenser's nozzle in the proposed marks may have some utilitarian value, it does not follow that the entire mark is necessarily functional. Indeed, our primary reviewing court very recently has instructed

that the "Morton-Norwich inquiry is to weigh the elements of a mark against one another to develop an understanding of whether the mark as a whole is essentially functional and thus non-registrable. Whenever a proposed mark includes both functional and non-functional features, ...the critical question is the degree of utility present in the overall design of the mark." *In re Becton, Dickinson and Co.*, 102 USPQ2d at 1376. Here, we find that the overall design of applicant's proposed dispenser configuration marks is not dictated by utilitarian concerns.

Acquired Distinctiveness

We now address the examining attorney's refusal to accept applicant's Section 2(f) acquired distinctiveness showing for each mark. Here, applicant admits that the dispenser configuration marks are not inherently distinctive by seeking registration under Section 2(f). *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007) (application under § 2(f) is a concession that the mark is not inherently distinctive). Thus, the issue is not whether the proposed marks are inherently distinctive, but whether the designs have acquired distinctiveness, *i.e.*, whether the relevant consumers view the configurations as trademarks. And, on this issue, it is applicant's burden to prove that the proposed marks have

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acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant").

In support of its argument that the dispenser configuration marks have acquired distinctiveness, applicant relies on, *inter alia*, a few copies of advertisements for the goods that highlight the wedge-shape of the dispensers and/or can be characterized as "look for" advertising inasmuch as there is a tagline ("get the wedge") used that references the dispenser's configuration. Applicant also submitted a copy of a wedge-shaped (same shape as reservoir in the dispenser configuration marks) note pad that advertises applicant's Avagard brand "antiseptic with moisturizers." Applicant also asserts that the aforementioned advertisements have been placed in "numerous industry journals" and applicant specifically has identified six such journals; that the dispenser configuration marks have been used in commerce for "over 10 years"; that it currently "holds more than 70% of the market share within the waterless, brushless category of hand sanitizing antiseptics with moisturizers, and more than 50% of the overall market share of all types of competitive products, including water-based brush

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products"; and that its "packaging at issue was purposely designed to be distinctive and serve to identify the source of the goods." In addition, applicant submitted 9 signed affidavits containing the following, identical statement:

I *use* and/or *purchase* (circle one or both) hand-cleaning and sanitizing products. I *work* or *do not work* (circle one) as a medical or healthcare professional.

I associate the wedge-shaped bottle/dispenser for hand sanitizing antiseptic, depicted below with and without color, with AVAGARD and/or 3M brands. This wedge-shaped bottle/dispenser, both with and without color, has become distinctive to me and I associate it to identifying a single source for a hand-cleaning and sanitizing product. I know of no other similar bottle/dispenser for any other hand-cleaning or sanitizing product.

[The marks depicted in the application drawing pages are placed below each statement, followed by, "I verify that the foregoing is true and correct" and the declarant's name, title, and signature.] All declarations were signed; however, 4 of the 9 statements were incomplete inasmuch as the declarant did not circle or indicate information requested in the uniform statements, *i.e.*, they did not indicate if they "use and/or purchase" the product and whether "work or do not work as a medical or healthcare professional."

We initially address the manner in which applicant supported its claim that the dispenser configuration marks

have acquired distinctiveness. Specifically, applicant makes several key factual assertions without any supporting declarations or affidavits from a person who attests to these facts based on personal knowledge or information personally ascertained. For example, and as identified above, applicant states that it has advertised in several journals and that it possesses a certain percentage of market share without any supporting affidavit or declaration.

The Board generally takes a more permissive stance with respect to the admissibility and probative value of evidence in *ex parte* proceedings, and focuses instead on the spirit and essence of the rules of evidence. See TBMP § 1208 (3d ed. 2011). However, when it comes to advertising, sales or market presence, we have long stated that it is the better practice to provide such evidence by affidavit or declaration. See *Id.* In this proceeding, applicant did not support the factual representations made by its counsel concerning its advertising efforts and market share with declarations or affidavits.³

³ In its reply brief, applicant refers to its December 19, 2009 response to an Office action as an "extensive declaration of Applicant's Assistant Chief Intellectual Property Counsel, James F. Voegeli." While the response to the Office action is signed by Mr. Voegeli, it is not in the form of a declaration; specifically, the response does not make clear that the information or representations being made by "applicant" in the

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Nevertheless, throughout the prosecution and in his brief, the examining attorney did not object to the lack of evidentiary support for applicant's counsel's factual assertions. Moreover, there is no evidence contradicting applicant's factual assertions. Accordingly, and under these circumstances, we decide to consider and accept this information and applicant's attorney's factual representations concerning applicant's advertising efforts and market share. See *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997). In the *EBSCO Industries* decision, which also involved the issue of whether a configuration mark has acquired distinctiveness, the Board considered and accepted specific sales and advertising figures as represented by applicant's counsel and not supported by affidavits or declarations, in light of the examining attorney's failure to object to or otherwise rebut such representations.

Upon careful consideration of all of the submissions by applicant, in addition to the arguments set forth on appeal, we find that the record does not establish that the dispenser configuration marks have acquired distinctiveness

response are based on Mr. Voegeli's personal knowledge. Rather, the factual representations in the response are being made by applicant, not the individual authorized to sign the response on behalf of applicant. Thus, the response to the Office action cannot be construed as a declaration.

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as identifying the source of the identified goods. There is simply insufficient evidence in this regard; notably, we have no evidence regarding the sales numbers for applicant's identified goods that are sold in the containers which bear the same shape as the dispenser configuration marks. Remarkably, there is no evidence showing the number of dispensers sold or dollar figures for such sales. Likewise, there is no evidence regarding advertising figures and the degree of advertising efforts made to associate applicant's proposed dispenser configuration marks with the identified goods. While we have several examples of "look for" advertising and we accept counsel's statements that these advertisements were placed in industry journals with a relevant and sizable circulation, there is no evidence how many times or with what regularity over certain years such advertisements were placed in the journals. As to the "wedge-shaped" notepads, we have no evidence indicating the circulation of such notepads - the Board is left to guess if there were 10 notepads distributed to potential consumers or if there were 25,000.

As to applicant's market share and over 10 years of use of the dispenser configuration marks, this information is insufficient to establish a prima facie showing of

acquired distinctiveness. Specifically, applicant's stated market shares only reflect a certain degree of popularity of applicant's goods within the limited realm of the medical scrub markets; however, the application's identification of goods is not so limited and covers "hand-sanitizing antiseptic with moisturizers" in general. In other words, the identification of goods is broadly worded and covers hand-sanitizing antiseptics sold over-the-counter and to the general public, whereas applicant's stated market shares are for a subset or niche market. We have no information showing whether or not the medical scrub hand-sanitizing antiseptic market is a large subcategory of the broader market for hand-sanitizing antiseptics.

Finally, as to the 9 declarations submitted by applicant, these are insufficient by themselves or in conjunction with the totality of the record, to demonstrate that the proposed marks have acquired distinctiveness. First, the number of declarations is not impressive and presumably represents a very small sample of the relevant consumers; further, there is no evidence to suggest the declarations resulted from a random selection of possible declarants. And, as already noted, 4 of the 9 statements were incomplete because the declarants did not carefully

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complete their declarations by indicating if they "use and/or purchase" the product and whether "work or do not work as a medical or healthcare professional." In sum, while the declarations have been considered, their probative value is minimal.

Upon review of all of the evidence and arguments in this case, we affirm the examining attorney's alternative refusal that applicant has not met its burden in establishing that its marks have acquired distinctiveness.

Description of the Marks Requirement

Finally, we turn to the examining attorney's requirement for acceptable descriptions of the proposed marks.

The examining attorney did not accept applicant's originally-submitted descriptions of its marks and, during the prosecution, he suggested to applicant several possible acceptable descriptions. Applicant declined to accept any of the proposed descriptions, but amended more than once to descriptions that were ultimately not accepted by the examining attorney. The descriptions of the marks currently read as recited at the beginning of this decision.

Trademark Rule 2.37 provides that "a description of the mark must be included if the mark is not in standard

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characters." Section 808.01 of the TMEP further provides guidelines for requiring a description of the mark if "the mark is three-dimensional, or is a configuration of the goods or packaging." TMEP 808.02 further allows, "the description should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission. The description should describe all *significant* aspects of the mark, including both literal elements and design elements. Insignificant features need not be included in a description." (emphasis in original).

With the above in mind and upon reviewing the descriptions of the marks in the applications, we find that they comply with Rule 2.37 and the corresponding guidelines provided in the TMEP. While perhaps not as succinct as possible, applicant's descriptions of the proposed marks, as amended, suffice for purposes of the requirement. Moreover, we note that the examining attorney's most recent suggested descriptions of marks contain the inaccurate statement that the marks depict "packaging for a dispenser for hand-sanitizing antiseptics."⁴

⁴ As previously noted, the configuration marks actually depict dispensers for the identified goods; they may be characterized as packaging for the identified goods but certainly not "packaging for a dispenser."

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We find that applicant's descriptions of the marks, as amended and currently reflected in the application, provide accurate characterizations of the marks. In view of the foregoing, the examining attorney's requirement for acceptable descriptions of the marks is not well-taken and the refusal to register the marks based thereon is reversed.

Decision: We reverse the refusals to register the asserted marks under Trademark Act Section 2(e)(5) on the ground of functionality. We further reverse the examining attorney's refusals to register the marks based on improper descriptions of the marks.

However, we find the marks have not acquired distinctiveness and are not entitled to registration under Section 2(f). We affirm the examining attorney's refusals to register on this ground.