

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

Mailed:
May 16, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mars, Incorporated

Serial No. 77727119

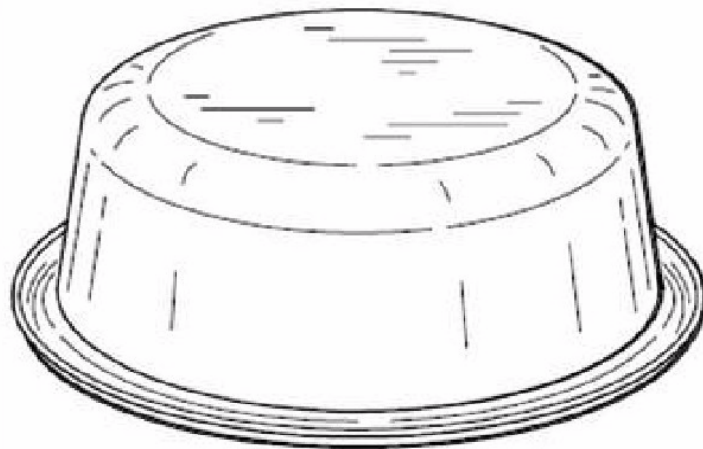
Cristina A. Carvalho of Arent Fox LLP for Mars,
Incorporated.

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

Before Quinn, Bergsman and Wolfson,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mars, Incorporated ("applicant") filed an intent-to-
use application for the mark shown below for "pet food," in
Class 31.



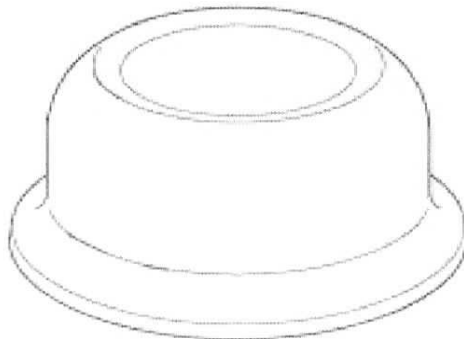
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Applicant adopted the description of the mark, set forth below, suggested by the Examining Attorney in the June 24, 2009 Office Action.

The mark consists of a three-dimensional configuration of packaging for pet food that consists of a round bowl-shaped, inverted and lacquered pet food container. The top of the container has a center circle with rounded edges tapering to the sides with a wider larger lip at the bottom with various placement lines representing a lacquered finish. The inverted nature of the container and the lacquered finish are claimed as features of the mark.

Although the applicant is the owner of Registration Nos. 3220575, 2052069 and 2052071 for similar marks, shown below, for pet food, applicant did not claim ownership of those registrations and the Examining Attorney did not require applicant to claim ownership of the registrations.¹

1. Registration No. 3220575 for pet food.²



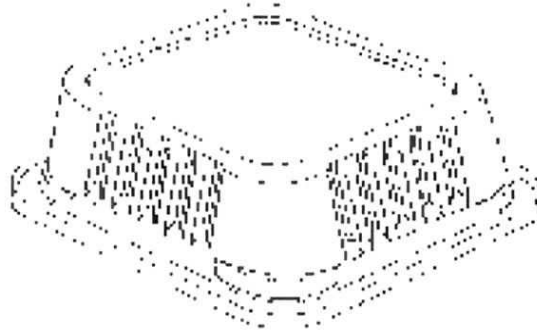
¹ Applicant submitted copies of those registrations as part of its evidentiary showing in its December 14, 2009 response.

² Issued March 20, 2007 on the Principal Register.

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Applicant described this mark as "the design of a unique pet food container."

2. Registration No. 2052069 for dog food and Registration No. 2052071 for cat food.³



In the December 14, 2009 response to the June 24, 2009 Office Action, applicant also submitted photographs of the product packaging comprising Registration No. 3220575, shown below, to display the inverted nature of the mark which applicant explained "is completely arbitrary and serves absolutely no purpose other than to act as a unique feature that stand out to consumers and identifies source."⁴ The photographs also display the lacquer finish claimed as a feature of the subject matter sought to be registered.

³ Issued April 15, 1997 on the Principal Register under the provisions of Section 2(f); renewed. No description of the mark is printed on the registrations.

⁴ December 14, 2009 Office Action, pp. 6-7. Applicant stated that these photographs suggest how the subject matter sought to be registered would appear. *Id.* at p. 6.



Applicant explained the affect of the lacquer finish as follows:

Applicant's product packaging design features a lacquered finish that also is unlike anything in the pet food marketplace. Traditional canned pet food packages simply feature paper labels affixed to standard cans. ... In contrast the lacquered finish of Applicant's packaging design creates a unique and unusual display that sets Applicant's product apart from products offered by others. The lacquered finish not only gives Applicant's packaging a different look, it also results in a different feel.⁵

Registration was refused on the ground that the subject matter sought to be registered "consists of a nondistinctive configuration of product packaging for pet food that is not registrable without sufficient proof of acquired distinctiveness."⁶ Sections 1, 2, and 45 of the Trademark Act 1946, 15 U.S.C. §§1051, 1052, and 1127. The examining attorney contends that the subject matter sought

⁵ Applicant's December 12, 2009 Response, p. 7.

⁶ Examining Attorney's Brief, p. 1.

to be registered is a common basic shape or design for pet food packaging.⁷ The Examining Attorney specifically argues that the evidence proves that "a round shape for pet food packaging containers is common,"⁸ that "the round and lip features of applicant's applied-for mark are not unique in the field of pet food packaging field (sic),"⁹ and that "[t]he rounded tapering side edges, lacquered, inverted opening and lip features of applicant's mark are merely refinements to the common round shape for the container."¹⁰

Thus, on the whole, applicant's mark is a mere refinement of a commonly adopted and well-known form or ornamentation for product packaging for pet food viewed by the public dress or ornamentation for the packaging of the goods, namely, a round shape container.¹¹

The Examining Attorney submitted excerpts from websites displaying various pet food containers to support his contention that the subject matter sought to be registered is a common, basic shape. The containers set forth below are representative.

⁷ Examining Attorney's Brief, p. 7.

⁸ Examining Attorney's Brief, p. 7.

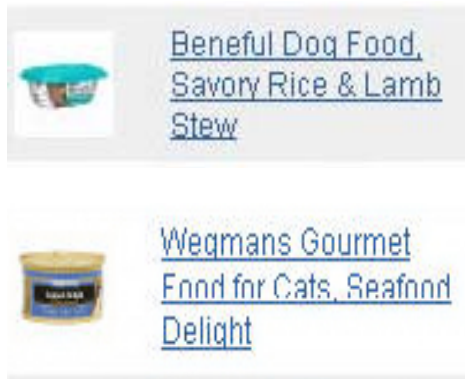
⁹ Examining Attorney's Brief, p. 9.

¹⁰ Examining Attorney's Brief, p. 10.

¹¹ Examining Attorney's Brief, p. 10.

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1. Wegmans.com¹²



2. Walmart.com¹³

[Fancy Feast Appetizers: Flaked Skipjack Tuna Cat Food, 2 oz](#)



[Newman's Own: Turkey Formula For Cats, 3 oz](#)



¹² June 24, 2009 Office Action.

¹³ January 19, 2010 Office Action.

3. Petsmart.com¹⁴



**Meow Mix Market Select
Cat Food**



**KMR Liquid Milk Replacer
for Kittens**



**By Nature Goldleaf Selects
Cat Food**



**Pro Plan Total Care Kitten
Formula Cat Food in Cans**

As indicated above, applicant made of record its three previously registered product packages for pet food: Registration Nos. 2052069 and 2052071 under the provisions of Section 2(f), and Registration No. 3220575 on the Principal Register without a showing of acquired distinctiveness. If an applicant initially seeks registration based on acquired distinctiveness or amends its application to seek registration based on acquired

¹⁴ January 19, 2010 Office Action.

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distinctiveness without expressly reserving its right to argue that its mark is inherently distinctive, registration under Section 2(f) is an admission that the mark is not inherently distinctive. *Yamaha International Corporation v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *Kasco Corp. v. Southern Saw Services, Inc.*, 27 USPQ2d 1501, 1506 n.7 (TTAB 1993) ("By amending (without reservation) its application to claim that its green wrapper had become distinctive of its saw blades, [defendant] conceded that the green wrapper was not inherently distinctive of its saw blades ... when [defendant] amended its application to claim the benefits of Section 2(f), it did not reserve its right to argue in the alternative that its green wrapper was, from the outset, inherently distinctive"); see also TMEP §1212.02(c) (7th ed. 2010). An applicant can avoid the admission that its mark is not inherently distinctive if it makes the claim of acquired distinctiveness in the alternative and files an appeal of the final refusal on the basis that the mark is not inherently distinctive. Of course, if an appeal of a descriptiveness refusal with a claim of acquired distinctiveness in the alternative results in a finding that the mark is descriptive and also that the claim of acquired distinctiveness is sufficient, then a finding that

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the mark is descriptive or, in this case, that the mark is not inherently distinctive, though not conceded by the applicant, would be present.

During the prosecution of this application, the better practice would have been for the examining attorney to have reviewed the files for applicant's Registrations Nos. 2052069 and 2052071, issued under Section 2(f), to determine whether applicant had previously conceded that the particular product package was not inherently distinctive or, perhaps, on appeal, that the Board found that the product packaging was not inherently distinctive. The Examining Attorney would have known the particulars of the Section 2(f) claims in the prior registrations which may have aided in the prosecution of this case by providing information regarding whether applicant had conceded that arguably similar product packaging was not inherently distinctive, the evidence supporting a finding that arguably similar product packaging was not inherently distinctive or a decision by the Board explaining why under potentially similar circumstances arguably similar product packaging was not inherently distinctive. Because that was not done, the Examining Attorney missed an opportunity to fully develop the record.

Product packaging may be inherently distinctive and registrable on the Principal Register if its intrinsic nature serves to identify a particular source. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992). In other words, the issue before us is whether the subject matter sought to be registered can function independently of any words as a trademark to identify and distinguish applicant's pet food. *Seabrook Foods, Inc. v. Bar-Well Foods Limited*, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977). In determining whether a design is arbitrary or distinctive, the Board should consider the following factors:

1. Whether the subject matter sought to be registered is a "common" basic shape or design;
2. Whether the subject matter sought to be registered is unique or unusual in a particular field;
3. Whether the subject matter sought to be registered is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods; or

4. Whether the subject matter sought to be registered is capable of creating a commercial impression distinct from the accompanying words.

Seabrook Foods, Inc. v. Bar-Well Foods Limited, 196 USPQ at 291. See also *In re Chippendales USA Inc.*, 622 F3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010).

Although the Examining Attorney suggested the description of the mark adopted by applicant, the Examining Attorney focused his evidence and argument on the round shape of the product packaging (e.g., "the applied for mark is the round bowl-shaped pet food packaging").¹⁵ The subject matter sought to be registered is "a three-dimensional configuration of packaging for pet food that consists of a round bowl-shaped, inverted and lacquered pet food container." Thus, the Examining Attorney improperly dissected the subject matter sought to be registered by placing too much attention on the round bowl shape to the exclusion of the other elements of the proposed mark, particularly the inverted nature and lacquered finish.

Applicant's product packaging at issue is a derivative of the product packaging displayed in Registration No. 3220575 and as displayed in the photographs of that product

¹⁵ Examining Attorney's Brief, p. 7.

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packaging, shown above, displaying the inverted nature and lacquered finish; the subject matter sought to be registered is more than just a round shaped bowl with minor refinements. The proposed mark engenders the commercial impression of a serving platter and cover holding a gourmet meal for a pet. This conclusion is corroborated by the fact that none of the product packaging by competitors is similar.

In applying the *Seabrook* test for inherent distinctiveness, we are not persuaded that the Examining Attorney has made a *prima facie* case that consumers would not perceive and rely on the product packaging at issue as an indication of source for applicant's pet food. Specifically, the evidence fails to show that the subject matter sought to be registered is a common design, that it is not an unusual container for pet food, that it is simply a refinement of a well-known design or ornamentation, or that the proposed mark fails to function as a mark without accompanying words.

Decision: The refusal to register is reversed.