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Subject: U.S. TRADEMARK APPLICATION NO. 77809223 - 29985- - EXAMINER  
BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**APPLICATION SERIAL NO.** 77809223

**MARK:**



**CORRESPONDENT ADDRESS:**

PAUL C LLEWELLYN  
KAYE SCHOLER LLP  
425 PARK AVENUE  
NEW YORK, NY 10022

**GENERAL TRADEMARK INFORMATION:**

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

**TTAB INFORMATION:**

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

**APPLICANT:** Hershey Chocolate & Confectionery  
Corpor ETC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

29985-

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**STATEMENT OF THE CASE**

The applicant has appealed the examining attorney's final refusal to register the proposed mark for a configuration of a candy bar. Registration was refused on the grounds that the applied for mark is functional pursuant to Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5), and non-distinctive trade dress pursuant to Trademark Act §§1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127. Applicant's claim of acquired distinctiveness under Trademark Act §2(f) was found insufficient to overcome the non-distinctive trade dress refusal.

**STATEMENT OF FACTS**

Applicant filed this use-based application on August 20, 2009, applying to register on the Principal Register the mark consisting of a configuration of a candy bar that consists of twelve (12) equally-sized recessed rectangular panels arranged in a four

panel by three panel format with each panel having its own raised border within a large rectangle for “Candy; Chocolate,” in Class 30.

In the first Office action dated November 24, 2009, registration was refused under Trademark Act §2(e)(5), on the grounds that the applied-for mark, which consists of a three-dimensional configuration of the goods, appears to be a functional design for such goods and also under Trademark Act §§1, 2 and 45, because the applied-for mark consists of a non-distinctive product design or non-distinctive features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. The applicant was also required to submit information regarding the goods and to clarify the description of the mark.

On May 3, 2010, applicant argued against the refusals to register the mark under Trademark Act §2(e)(5), and Trademark Act §§1, 2 and 45, proposed amending the application to seek registration under Trademark Act §2(f), acquired distinctiveness, submitted information regarding the goods and mark, and amended the description of the mark.

In the second Office action dated May 28, 2010, the examining attorney accepted the information regarding the goods, accepted the amended description of the mark, maintained and continued the refusals to register the mark under Trademark Act §2(e)(5), and Trademark Act §§1, 2 and 45, and issued a new refusal based upon insufficient evidence to establish acquired distinctiveness.

On November 25, 2010, the applicant again argued against the refusals to register the mark under Trademark Act §2(e)(5), and Trademark Act §§1, 2 and 45,

and submitted additional evidence and arguments in support of amending the application to seek registration under Trademark Act §2(f), acquired distinctiveness.

On December 28, 2010, the refusals to register the mark under Trademark Act §2(e)(5), and Trademark Act §§1, 2 and 45, and the determination that the applicant failed to establish that the mark has acquired distinctiveness, were maintained and made final.

On February 11, 2011, applicant a notice of appeal. On April 12, 2011, applicant filed an appeal brief. The file was forwarded to the examining attorney on April 14, 2011.

#### ISSUES

The issues on appeal are whether the mark is a functional design under Trademark Act §2(e)(5), whether the mark is a non-distinctive configuration of the goods under Trademark Act §§1, 2 and 45, and whether the applicant has established that the mark has acquired distinctiveness under Trademark Act §2(f).

#### ARGUMENT

- I. THE APPLIED-FOR MARK IS FUNCTIONAL BECAUSE THE DESIGN FEATURES OF THE CONFIGURATION PROVIDE A UTILITARIAN ADVANTAGE TO THE USER, AND THEREFORE, REGISTRATION IS PROPERLY REFUSED UNDER TRADEMARK ACT §2(e)(5).

The proposed mark comprises the configuration of design features of the identified goods that serve a utilitarian purpose, and registration must be refused under Trademark Act §2(e)(5), 15 U.S.C. §1052(e). *See Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1

(Fed. Cir. 1985); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984); TMEP §§1202.02(a) *et seq.*

A mark comprising the configuration of goods or their packaging is held functional, and thus unregistrable, where the evidence shows that the product design or product packaging design provides identifiable utilitarian advantages to the user – i.e., where the product or container “has a particular shape because it works better in that shape.” *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002) (citation and internal quotation marks omitted); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984); see also *In re Virshup*, 42 USPQ2d 1403, 1405 (TTAB 1997); *In re Cabot Corp.*, 15 USPQ2d 1224, 1227 (TTAB 1990).

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each case. *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997).

Evidence of functionality cases normally involves consideration of the following four factors, commonly known as the “*Morton-Norwich* factors,” in reference to the Federal Circuit decision in which they were first articulated:

- (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 (C.C.P.A. 1982).

Applying the *Morton-Norwich* factors to this case, as will be explained in more detail below, the examining attorney has established that the proposed mark is functional for the identified goods.

In summary, (1) the overall flat rectangular shape of the candy bar is easier and more cost effective to mass produce and wrap than irregularly shaped candy bars, (2) large numbers of flat rectangular candy bars can be more efficiently packed in boxes for shipping than irregularly shaped bars, and (3) scoring the bar into smaller evenly sized rectangular shapes facilitates the easier breaking off of equal-sized smaller pieces, both for eating and for measuring for cooking purposes.

The determination that a proposed mark is functional constitutes an absolute bar to registration either on the Principal Register or the Supplemental Register, regardless of evidence showing that the proposed mark has acquired distinctiveness.

Trademark Act §§2(e)(5) and 23(c), 15 U.S.C. §§1052(e)(5) and 1091(c); See *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001); *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422 (Fed. Cir. 2002); *In re Control Corp. of America*, 46 USPQ2d 1308, 1311 (TTAB 1998).

1. Patent protection was previously provided disclosing a utilitarian advantage to a functional feature highly similar to a feature at issue here.

A utility patent claiming the design features at issue is strong evidence of functionality, and the party seeking trademark protection for the configuration bears a heavy burden of establishing that the features are not functional – e.g., by showing that they are merely ornamental, incidental, or arbitrary aspects of the product or product

packaging design. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001).

In response to the initial application, applicant was required to indicate whether the proposed mark is the subject of a utility patent. Applicant indicated that it was not. While that is correct, the examining attorney discovered on his own a utility patent for another similar configuration that includes a highly similar design feature to those claimed in the present mark. As an attachment to the December 28, 2010 final Office action, the examining attorney included patent records for US Patent No. 1,613,231.

US Patent No. 1,613,231, a patent for “candy confection and process of making the same,” discloses utilitarian advantages of a feature of the design sought to be registered.

Specifically, the scoring of the bar makes the bar easier to break into smaller, equal-sized pieces. This is useful when cooking because it facilitates proper measuring of the chocolate, and also when simply eating the chocolate where one does not desire to eat the entire bar or desires to share the bar with others.

The patent “invention relates to candy confections and to an improved process of making the same. The object of the invention is to produce a candy confection comprising a layer of hard, frangible candy, which may be cut into pieces when cold, without dislodgement of pieces of said frangible sheet or layer of appropriate size, even though it is broken in pieces in the cutting operation, and without affecting the size and shape of the pieces into which the mat, as initially formed, is cut.”<sup>1</sup>

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<sup>1</sup> Attachments to final Office action dated December 28, 2010, at pages 2-6.

Specifically, lines 75-92 provide, “Heretofore, as far as we are aware, it has been considered impracticable, if not impossible, to cut layers of hard, frangible candy of the character of the layer 2 shown in the drawing, for the reason that the action of the knives or cutters would break the candy into irregular pieces; and, *where it is desired to subdivide a layer of such hard, frangible candy into pieces of desired small size, the universal practice, so far as we are aware, has been to score said layers on lines corresponding to the desired shapes and sizes of the pieces, before it is thoroughly cooled and while it is sufficiently plastic that it may be scored without breaking. The candy is then permitted to cool and may then readily be broken into pieces along the lines on which it is scored.*”

While this patent claims a different process, it still discloses a utilitarian advantage of a feature of the design sought to be registered. Specifically, the candy and chocolate has been scored during the manufacturing process so that it may be broken into the desired preformed shapes and sizes rather than into irregular shapes and sizes.

Both of the applicant’s identified goods, namely, candy and chocolate, can be brittle or designed to be easily broken. In addition, the creases which subdivide the chocolate bars into twelve equal-sized pieces are a form of scoring.

The examining attorney notes that Patent No. 1,613,231 is expired. However, statements in a utility patent application or expired patent which refer to utilitarian advantages of the design features at issue are persuasive evidence of functionality. The evidentiary significance of such statements is not affected by whether the patent application is pending or abandoned, whether a utility patent issued from the application, or whether the resulting patent has expired. *See TrafFix Devices, Inc. v.*



*Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001); TMEP §1202.02(a)(v)(A).

The examining attorney also notes that Patent No. 1,613,231 was owned by a third party, however, a third-party utility patent is relevant evidence of functionality when the patent discloses the utilitarian advantages of the applied-for product or product packaging configuration sought to be registered. *See In re Dietrich*, 91 USPQ2d 1622, 1627 (TTAB 2009); TMEP §1202.02(a)(v)(A).

In this case, a utility patent discloses utilitarian advantages of the scoring feature of the design sought to be registered. Accordingly, the first *Morton-Norwich* factor should weigh heavily in favor of affirming the functionality finding.

2. While applicant's advertising does not promote utilitarian advantages of the design, unsolicited reviews of the applicant's goods promote utilitarian advantages of the design, and various competitor's advertising touts the utilitarian advantages of the design features.

As to the second *Morton-Norwich* factor, applicant avers that it has never promoted the design features as having utilitarian advantages. The examining attorney acknowledges that applicant's advertising of record does not promote the design features in any way, not even as a mark.

However, in *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001), the Board considered an advertisement obtained from the website of a *competitor*. Here the record contains examples of advertisements for competitors' goods that tout the functional advantages of design features very similar to the applicant's, namely, flat, rectangular, and scored so as to create equal-sized smaller pieces. Specifically:

- (1) Pages 31-32 of the examiner's final Office action dated December 28, 2011, from [www.godiva.com](http://www.godiva.com), shows a flat, rectangular and scored candy bar and

provides, “It is scored into ten signature squares so you can break off a little piece of Godiva every day.”

- (2) Page 56 of the examiner’s final Office action dated December 28, 2011, from [www.farawayfoods.com](http://www.farawayfoods.com), shows a flat and rectangular candy bar and provides, “Available in semisweet, Scharffen Berger’s Home Chef Chocolate Bars are pure dark chocolate, scored for easy measuring.”
- (3) Pages 47-51 of the examiner’s final Office action dated December 28, 2010, from [www.bizrate.com](http://www.bizrate.com), shows a flat, rectangular and scored candy bar and provides, “Blocks of rich dark chocolate made by Asher’s. Each bar is scored so it’s easy to break.”

Moreover, while applicant’s own advertising does not promote the utilitarian advantages of the design features, unsolicited reviews of the applicant’s goods promote utilitarian advantages of the design features. Specifically:

- (1) Pages 27-29 of the examiner’s final Office action dated December 28, 2010, from [www.epinions.com/review/Hershey\\_s\\_Milk\\_Chocolate\\_Bar](http://www.epinions.com/review/Hershey_s_Milk_Chocolate_Bar), provides: “Hershey’s milk chocolate bar is a flat, thin candy bar with a standard size of 1.55 oz. (43 grams). The flat bar is made entirely from milk chocolate and it is divided into twelve rectangular ‘pieces.’ These pieces are all attached to each other in a 3 by 4 fashion to form the candy bar. This design makes it easy to break off smaller pieces and share them with others.”
- (2) Pages 33-35 of the examiner’s final Office action dated December 28, 2010, from [www.epinions.com/review/Hershey\\_Special\\_Dark\\_Chocolate\\_Bars\\_1\\_45\\_Oz\\_36\\_Bars](http://www.epinions.com/review/Hershey_Special_Dark_Chocolate_Bars_1_45_Oz_36_Bars), provides: “Just like with the milk chocolate Hershey’s Bar, this one is also scored so that you can easily break off small sections of the candy bar. ... the small shapes makes it easy to break the bar into smaller pieces, both for sharing and baking. With these rectangular indentations, it is easy to make a clean break.”

While applicant does not have advertising referencing the design features in the mark, some of applicant’s competitors have produced highly similar looking candy bars and have advertised the usefulness of the scoring as enabling the breaking-off of

equal-sized smaller pieces. In addition, unsolicited third parties have reviewed the applicant's goods and touted the utilitarian advantages of the design features. Therefore, this factor should also weigh in favor of a functionality finding.

3. While there may be multiple ways to design a candy bar, many of applicant's competitors have also chosen to adopt configurations featuring overall flat and rectangular shapes, with scoring, leading to a conclusion that these have utilitarian advantages.

While there are alternative designs available for candy and chocolate, it is clear that applicant's design embodies the most functional and popular features, as there are many candies and chocolates made by competitors that appear to employ identical or highly similar design features, namely, an overall flat and rectangular shape with scoring. Below are some examples:

- (1) Page 45 of applicant's response dated November 25, 2010, shows a candy bar by R. M. Palmer Candy Co. that is flat, rectangular and scored with raised lines to create twelve smaller, equal-sized, rectangles arranged in a four panel by three panel format.
- (2) Pages 5-7 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Storz Nougat Praline as a flat, rectangular, and scored candy bar.
- (3) Pages 7-9 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Dagoba Dark Chocolate as a flat, rectangular, and scored candy bar.
- (4) Pages 10-11 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Kingsbury Chocolate Nib as a flat, rectangular, and scored candy bar.
- (5) Pages 11-13 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Lake Champlain Peppermint Crunch as a flat, rectangular, and scored candy bar.
- (6) Pages 21-22 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Lake Champlain Milk Chocolate Sea Salt and Almond Bar as a flat, rectangular, and scored candy bar.
- (7) Pages 33-34 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Choxie

- Dark Chocolate Key Lime Truffle Bar as a flat, rectangular, and scored candy bar.
- (8) Pages 36-37 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Chuao SpicyMaya as a flat, rectangular, and scored candy bar.
  - (9) Pages 42-43 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Dagoba Dark Chocolate Lime and Macademia Nuts as a flat, rectangular, and scored candy bar.
  - (10) Pages 51-53 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Nestle Kit Kat Muscat of Alexandria as a flat, rectangular, and scored candy bar.
  - (11) Pages 54-55 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Nestle Aero Mint as a flat, rectangular, and scored candy bar.
  - (12) Pages 31-32 of the examiner's final Office action dated December 28, 2010, from [www.godiva.com/product/large-31-cacao-milk-chocolate-crispy-crunch-holida/id/2505.gdv](http://www.godiva.com/product/large-31-cacao-milk-chocolate-crispy-crunch-holida/id/2505.gdv), shows a flat, rectangular, and scored candy bar with a corresponding description that provides, in part, "It's scored into ten signature squares so that you can break off a little piece of Godiva every day."
  - (13) Pages 47-48 of the examiner's final Office action dated December 28, 2010, from [www.bizrate.com/candy/oid1822216008](http://www.bizrate.com/candy/oid1822216008), shows a flat, rectangular, and scored candy bar with a corresponding description that provides, in part, "Each bar is scored so it's easy to break up!"
  - (14) Page 56 of the examiner's final Office action dated December 28, 2010, from [www.farawayfoods.com/baking](http://www.farawayfoods.com/baking), shows a flat, rectangular, and scored candy bar with a corresponding description that provides, in part, "Bars are pure chocolate, scored for easy measuring."
  - (15) Pages 9-10 of applicant's response dated May 3, 2010, and page 69 of applicant's response dated November 25, 2010, demonstrate Theo produces several candy bars in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes
  - (16) Page 11 of applicant's response dated May 3, 2010, and page 71 of applicant's response dated November 25, 2010, demonstrate Endangered Species Chocolate produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
  - (17) Pages 12-13 of applicant's response dated May 3, 2010, and pages 71-72 of applicant's response dated November 25, 2010, demonstrate Divine Milk Chocolate produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.

- (18) Page 15 of applicant's response dated May 3, 2010, and page 73 of applicant's response dated November 25, 2010, demonstrate Doctor's CarbRite Diet produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
- (19) Pages 16-17 of applicant's response dated May 3, 2010, and pages 73-74 of applicant's response dated November 25, 2010, demonstrate Wegmans produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.

The fact that competitors choose to make candy bars that appear to embody the same or a highly similar design consisting of an overall flat and rectangular shape with scoring speaks to the functionality of these design features. Anyone who has ever wrapped presents knows that a flat and rectangular shape is easier to wrap than an irregular shape. Flat and rectangular shapes are also more efficient for packing and shipping because it fits neatly in square and rectangular boxes and thereby eliminates wastage of space when packing the candy bars in. This maximizes the amount of candy bars which can be fit in a box. The more candy bars that are shipped together spreads the cost of shipping out among more candy bars and reduces the shipping cost associated with each individual candy bar. Scoring a candy bar facilitates easier breaking off of equal-sized smaller pieces, both for eating and for measuring for cooking purposes.

To the extent that any of the referenced competitor candy bar designs are different, the differences appear to be mere refinements of the same basic design, e.g., bigger or smaller rectangles, slight curvatures of the corners or tops, scoring accomplished by means other than raised and beveled lines, or scoring in more or less than twelve smaller pieces.

Accordingly, the third *Morton-Norwich* factor weighs in favor of the functionality finding because the evidence of record demonstrates a competitive need for the design features embodied in the applied-for trade dress. Moreover, the Supreme Court has clearly indicated that if the record shows that a design is essential to the use or purpose of a product, it is unnecessary to consider whether there is a competitive need for the product feature. See *TrafFix*, 532 U.S. at 32-34, 58 USPQ2d at 1006-1007.

4. Applicant does not claim that the product design entails a more costly method of production, but only addresses one feature of the design, the scoring, and ignores the rectangular and flat design features.

While evidence showing that the product feature results from a comparatively simple or inexpensive method of manufacture supports a finding that the design is functional, the opposite is not necessarily the case. That is, assertions by the applicant that its design is more expensive or more difficult to make, or that the design does not affect the cost, will not establish that the configuration is not functional. *In re Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) (“Even at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially, as claimed in patents, a superior quality wheel.”); *In re N.V. Organon*, 79 USPQ2d (TTAB 2006).

Applicant asserts only that the tooling and moulds for the framed segments of the design are more expensive to create than are the tooling and moulds for other chocolate bar designs. However, applicant clearly states at page twenty of the brief that “the particular configuration of the Hershey design is no less costly to manufacture than other alternative segmented bar designs.” This conspicuously does not allege that applicant’s product design entails a more costly method of production. Applicant is in the best position to provide evidence regarding its manufacturing costs. If the applicant’s

design were more expensive to manufacture, applicant would have presented evidence of such, rather than obfuscate the issue by only discussing the cost of tools and dies for the scoring feature of the design.

Applicant's evidence and arguments only address one feature of the design, namely, the tooling and moulds used to create the scoring. Applicant's arguments do not address the overall flat and rectangular shape of the of the candy bars. Packaging is part of the manufacturing process. As discussed above, a flat and rectangular shape is easier to wrap than an irregular shape, and flat and rectangular shapes are also more efficient for packing and shipping because they fit neatly into rectangular boxes and eliminate wastage of space when packing the candy bars in.

Applicant does not argue that the applied-for mark is more costly to manufacture than other alternative segmented bar designs. Accordingly, the fourth *Morton-Norwich* factor weighs neither for nor against the functionality finding.

In this case, the evidence shows that the applied-for mark comprises the configuration of design features of the goods that serve a utilitarian purpose and the first, second and third *Morton-Norwich* factors weigh in favor of affirming the functionality finding.

II. APPLICANT'S APPLIED-FOR MARK IS NON-DISTINCTIVE PRODUCT DESIGN, AND APPLICANT'S CLAIM OF ACQUIRED DISTINCTIVENESS UNDER TRADEMARK ACT §2(F) IS INSUFFICIENT. THUS, REGISTRATION IS PROPERLY REFUSED UNDER TRADEMARK ACT §§1, 2 AND 45

1. Applicant's applied-for mark is non-distinctive product design.

Assuming that the configuration is not functional, registration must be refused because the applied-for mark consists of a nondistinctive product design or nondistinctive features of a product design that would not be perceived as a mark. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); *see* TMEP §1202.02(b)(i).

The Supreme Court distinguished between two types of trade dress – product design and product packaging. If the trade dress falls within the category of product design, it can never be inherently distinctive and will always require evidence of acquired distinctiveness or secondary meaning. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000); TMEP §1202.02(b)(i).

Product design almost invariably serves purposes other than source identification, and consumers are aware that even the most unusual product design is intended not to identify the source of the goods, but to render the product itself more useful or appealing. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. at 213, 54 USPQ2d at 1069 (2000); *In re Slokevage*, 441 F.3d 957, 962, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006); *see* TMEP §1202.02(b)(i).

In this case, applicant's configuration mark is considered product design because it comprises the shape of applicant's candy and chocolate and consumers would not perceive it as a source indicator but merely the design of applicant's goods. Applicant's configuration mark falls squarely within the parameters of product design, and thus, in accordance with *Wal-Mart*, applicant bears the burden of proving the



applied-for mark has acquired distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 949, 122 USPQ 372, 374-75 (C.C.P.A. 1959); TMEP §1212.01. Applicant has failed to meet this burden.

2. Applicant's applied-for mark is a variation of common trade practices in the candy and chocolate industry, namely, shaping the candy bars flat and rectangular and including scoring so that they may be broken into equal-sized pieces.

An applicant bears the burden of proving that a mark has acquired distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 949, 122 USPQ 372, 374-75 (C.C.P.A. 1959); TMEP §1212.01.

Applicants face a heavy burden in establishing distinctiveness in an application to register trade dress. *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009).

Moreover, the subdividing of a flat, rectangular candy bar into smaller, equal-sized, rectangular pieces with scoring is a very common trade practice in the candy and chocolate industry. Therefore the degree of evidence to establish acquired distinctiveness is higher. *See generally, In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490 (TTAB 1989); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985); *Ex parte Fox River Paper Corp.*, 99 USPQ 173 (Comm'r Pats. 1953); TMEP §§1212.01, 1212.04(a) & 1212.05(a)

The examining attorney has made extensive evidence of record documenting that the use of flat rectangular shapes and the inclusion of scoring to create

segments of smaller equal-sized shapes are common trade practices in the candy and chocolate industry.

The examining attorney makes reference to and incorporates herein by reference a sample of representative web pages obtained in a search of the Internet using the Google® computerized search engine for “chocolate” and/or “candy bars” in relation to “bite sized segments” and attached to the first Office action dated November 24, 2009, and “chocolate candy bars” in relation to “scored” or “break-off” and attached to the final Office action dated December 28, 2010. The referenced and/or excerpted articles demonstrate that producing candy bars in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes is a common trade practice in the candy and chocolate industry. Examples of flat, rectangular and scored candy bars of other chocolate and candy manufacturers include:

- (1) Pages 5-7 of the examiner’s Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Storz Nougat Praline as a flat, rectangular, and scored candy bar.
- (2) Pages 7-9 of the examiner’s Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Dagoba Dark Chocolate as a flat, rectangular, and scored candy bar.
- (3) Pages 10-11 of the examiner’s Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Kingsbury Chocolate Nib as a flat, rectangular, and scored candy bar.
- (4) Pages 11-13 of the examiner’s Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Lake Champlain Peppermint Crunch as a flat, rectangular, and scored candy bar.
- (5) Pages 21-22 of the examiner’s Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Lake Champlain Milk Chocolate Sea Salt and Almond Bar as a flat, rectangular, and scored candy bar.
- (6) Pages 33-34 of the examiner’s Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Choxie Dark Chocolate Key Lime Truffle Bar as a flat, rectangular, and scored candy bar.

- (7) Pages 36-37 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Chuao SpicyMaya as a flat, rectangular, and scored candy bar.
- (8) Pages 42-43 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Dagoba Dark Chocolate Lime and Macademia Nuts as a flat, rectangular, and scored candy bar.
- (9) Pages 51-53 of the examiner's Office action dated November 24, 2009, from [www.candybarlab.com/tag/hazelnut/](http://www.candybarlab.com/tag/hazelnut/), shows Nestle Kit Kat Muscat of Alexandria as a flat, rectangular, and scored candy bar.
- (10) Pages 31-32 of the examiner's final Office action dated December 28, 2010, from [www.godiva.com/product/large-31-cacao-milk-chocolate-crispy-crunch-holida/id/2505.gdv](http://www.godiva.com/product/large-31-cacao-milk-chocolate-crispy-crunch-holida/id/2505.gdv), shows a flat, rectangular, and scored candy bar with a corresponding description that provides, in part, "It's scored into ten signature squares so that you can break off a little piece of Godiva every day."
- (11) Pages 47-48 of the examiner's final Office action dated December 28, 2010, from [www.bizrate.com/candy/oid1822216008](http://www.bizrate.com/candy/oid1822216008), shows a flat, rectangular, and scored candy bar with a corresponding description that provides, in part, "Each bar is scored so it's easy to break up!"
- (12) Page 56 of the examiner's final Office action dated December 28, 2010, from [www.farawayfoods.com/baking](http://www.farawayfoods.com/baking), shows a flat, rectangular, and scored candy bar with a corresponding description that provides, in part, "Bars are pure chocolate, scored for easy measuring."

The applicant's own evidence of record further documents that the use of flat rectangular shapes and the inclusion of scoring to create segments of smaller equal-sized shapes are common trade practices in the candy and chocolate industry.

Specifically, eleven of the thirteen photographs of third-party candy bars included as exhibits in the applicant's responses display flat, rectangular candy bars with scoring to create segments of smaller equal-sized shapes.

The examining attorney makes reference to and incorporates herein by reference a sample of representative exhibits attached to the applicant's responses dated May 3, 2010, and November 25, 2010. The referenced exhibits further demonstrate that

producing candy bars in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes is a common trade practice in the candy and chocolate industry. Examples of flat, rectangular and scored candy bars of other candy and chocolate manufacturers include:

- (1) Page 45 of applicant's response dated November 25, 2010, shows a candy bar by R. M. Palmer Candy Co. that is flat, rectangular and scored with raised lines to create twelve smaller, equal-sized, rectangles arranged in a four panel by three panel format.
- (2) Page 8 of applicant's response dated May 3, 2010, and page 6 of applicant's response dated November 25, 2010, demonstrate Newman's Own produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
- (3) Pages 9-10 of applicant's response dated May 3, 2010, and page 69 of applicant's response dated November 25, 2010, demonstrate Theo produces several candy bars in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes
- (4) Page 11 of applicant's response dated May 3, 2010, and page 71 of applicant's response dated November 25, 2010, demonstrate Endangered Species Chocolate produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
- (5) Pages 12-13 of applicant's response dated May 3, 2010, and pages 71-72 of applicant's response dated November 25, 2010, demonstrate Divine Milk Chocolate produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
- (6) Page 15 of applicant's response dated May 3, 2010, and page 73 of applicant's response dated November 25, 2010, demonstrate Doctor's CarbRite Diet produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
- (7) Pages 16-17 of applicant's response dated May 3, 2010, and pages 73-74 of applicant's response dated November 25, 2010, demonstrate Wegmans produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.
- (8) Page 18 of applicant's response dated May 3, 2010, and page 74 of applicant's response dated November 25, 2010, demonstrate Green & Black's produces a candy bar in a flat and rectangular shape with scoring to create segments of smaller equal-sized shapes.

Given the nature of the applicant's product trade dress mark and trade practices in the candy and chocolate industry, applicant bears a very heavy burden in establishing acquired distinctiveness.

3. Applicant's claim of acquired distinctiveness is insufficient.

Applicant bases its Section 2(f) claim on (1) length and exclusivity of use of the mark in commerce; (2) ownership of prior US Reg. No. 3668662; (3) advertising expenditures; (4) sales success; (5) unsolicited media coverage; (6) attempts to plagiarize; and, (7) public recognition as purported to be demonstrated by the results of a consumer survey. As explained further below, applicant has failed to establish acquired distinctiveness.

- a. Applicant's claim of acquired distinctiveness based upon five or more years' continuous and exclusive use is insufficient.

With regard to the allegation of five years' use, the Office has consistently found in relation to product design that a mere statement of five years' use is generally not sufficient. *See In re Ennco Display Systems Inc.*, 56 USPQ2d, 1279, 1284 (TTAB 2000).

Moreover, applicant's claim of exclusivity of use is without merit. The evidence of record demonstrates that use of the applied-for design does not appear to be exclusive to the applicant. Applicant's November 25, 2010, response included, at page 45, a photograph of a candy bar by the R. M. Palmer Candy Co.<sup>2</sup> that is flat and rectangular, and scored by raised lines to create twelve smaller, equal-sized, rectangles arranged in a four panel by three panel format. These features of the Palmer' candy bar are identical to the applicant's applied-for mark.

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<sup>2</sup> Hereinafter "Palmer".

Applicant characterizes this as an attempt to plagiarize and avers that the R. M. Palmer Candy Co. ceased making this design upon the insistence of the applicant. However, applicant made no evidence of record documenting this. That is, the evidence is silent as to how long Palmer used the design, what percentage of the market the Palmer candy bar has/had, and whether Palmer still makes and markets the design.

Moreover, even assuming that Palmer ceased using the design at the demands of applicant, acquiescence to demands of competitors to cease use of a term can be equally viewed as simply a desire to avoid litigation. *See, e.g., In re Wella Corp.*, 565 F.2d 143, 144 n.2, 196 USPQ 7, 8 n.2 (C.C.P.A. 1977); *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989).

Based upon the evidence of record, the Palmer' candy bar may more appropriately be viewed as evidence that the applicant's use of the applied-for design was not exclusive.

- b. Applicant's claim of acquired distinctiveness based upon prior Registration Number 3668662 is inapposite.

Applicant's claim of acquired distinctiveness based on ownership of prior US Reg. No. 3668662 is inapposite because the mark in the prior registration is not the same mark as the applied-for mark and therefore does not support applicant's claim of acquired distinctiveness.

A claim of acquired distinctiveness may be based on an applicant's ownership of one or more prior registrations of the *same mark* on the Principal Register. 37 C.F.R. §2.41(b); TMEP §1212.04. An applied-for mark is considered the same mark if it is the legal equivalent of the previously-registered mark. *In re Dial-A-Mattress*

*Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); TMEP §1212.04(b).

To be legal equivalents, the applied-for mark must be indistinguishable from the previously-registered mark or create the same, continuing commercial impression such that the consumer would consider them both to be the same mark. *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1423 (TTAB 2010); *In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547 (TTAB 2010); *see In re Dial-A-Mattress Operating Corp.*, 240 F.3d at 1347, 57 USPQ2d at 1812; *In re Binion*, 93 USPQ2d 1531, 1539 (TTAB 2009); TMEP §1212.04(b).

In the present case, the applied-for mark and the mark in the prior registration are clearly distinguishable as not the same mark, and thus are not legal equivalents, because the removal of the term HERSHEY from each smaller rectangle in the applied-for mark creates a different commercial impression. Specifically, in Reg. No. 3668662, the four panel by three panel format was merely a border or carrier for the now-distinctive surname HERSHEY that appeared within. *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (claim of ownership of prior registrations held insufficient to establish acquired distinctiveness where registration was refused on ground that the subject matter was merely an ornamental border or “carrier” for words and symbols appearing within).<sup>3</sup>

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<sup>3</sup> Moreover, it is not even clear from the record whether Reg. No. 3668662 is a three-dimensional trade dress mark or a two-dimensional design logo. If the latter, this is yet another reason the marks are not legal equivalents. *See, In re Brouwerij Bosteels*, \_ USPQ2d \_, Ser. No. 77357895 (TTAB August 26, 2010)(three-dimensional product packaging trade dress is not the legal equivalent of a two-dimensional design logo).

Therefore, the prior registration does not support applicant's claim of acquired distinctiveness because the applied-for mark and the registered mark create different commercial impressions.

- c. Applicant's allegations of high sales figures, allegations of extensive advertising, and samples of advertising, are of limited probative value.

Applicant's allegations of high sales figures, allegations of extensive advertising, and samples of advertising, are of limited probative value in determining how the applied-for mark is used in advertising, the commercial impression created by such use, and the significance the applied-for mark would have to perspective purchasers. *See In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984); TMEP §1212.06(b).

Applicant's allegations of high sales figures provide no additional information to place those figures in context or evaluate them. That is, the applicant has not indicated what percentage of the candy and chocolate market those figures represent. Moreover, extensive sales may demonstrate the commercial success of applicant's goods, but not that relevant consumers view the matter as a mark for such goods. *See In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

Applicant's advertising evidence consists of three copies each of the story boards from three television commercials, and sixteen pages of print and/or online advertising.

Applicant's three story boards are not actual advertisements as viewed by consumers. There is no information provided regarding when the advertisements



aired on television, for how long they were aired, how large of audience may have been exposed to the commercials, or what percentage of viewers may have actually viewed the commercials. Moreover, there is nothing in how the applied-for mark appears in the proffered storyboards which corroborates that the mark was used in applicant's actual advertisements in such a way that it would be recognized as a source identifier for candy and chocolate. That is, in each storyboard, buried amidst numerous photographs or artist's drawings, is the occasional photograph or artist's drawing of a candy bar bearing the applied-for configuration. Under each of the pictures there is wording, but none of the wording discusses, or even notes, the configuration.

Of the remaining sixteen pages of print and/or online advertising, the first fifteen pages either do not display the mark applied-for, or only display incomplete portions of the mark. The sixteenth page is from the applicant's website and depicts an unwrapped candy bar with a bite taken out of it. There is no other explanation of what this picture is, whether and/or how it is even advertising, who would see it, and under what circumstances it would be seen. With regard to all sixteen pages of print and/or online advertising, there is nothing which corroborates that the applied-for mark is used as a mark and/or would be recognized as a source identifier for candy and chocolate.

#### d. Unsolicited Media Coverage

The applicant's reliance on alleged unsolicited media coverage is unfounded. To establish secondary meaning, an applicant must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 N. 11, 214 USPQ 1, 4 n. 11 (1982). The issue is

whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public. *In re Reden Laboratories, Inc.*, 170 USPQ 526(TTAB 1971); *In re Fleet-Wing Corp.*, 122 USPQ 335 (TTAB 1959).

Page 59 of applicant's response dated November 25, 2010, from *The Patriot News Co.*, discusses souvenirs relating to the Dave Matthews Band. It provides, in relevant part, "..., there's always the 2008 poster, which was designed to look like a Hershey chocolate bar." The poster is attached at page 60 of applicant's response. While the poster does indicate that the concert was at Hersheypark in Hershey, Pennsylvania, neither the applied-for mark nor chocolate are promoted by the poster. There is no promotion of a scored candy bar as a mark. The article may demonstrate an association between the name Hershey and chocolate, but there is simply nothing about this article that demonstrates public association of the applied-for mark as a source identifier for candy and chocolate.

Pages 56-58 of applicant's response dated November 25, 2010, from *Nextex Web Blogs*, provides, in relevant part, "That's when the finished product's silver metal slug approximately the size and shape of a Hershey's chocolate bar drops into a galley tray... ." The article does not discuss the applied-for mark. The article references a "Hersheys chocolate bar." Hershey's makes many different shapes and sizes of chocolate bars. There is no indication that the author is discussing the design features at issue in the applied-for mark. Again, there is nothing about this article that demonstrates public association of the applied-for mark as a source identifier for candy and chocolate.

Pages 52-54 of applicant's response dated November 25, 2010, from *Caro's Ramblings*, discusses shopping at Williams-Sonoma and provides, in pertinent

part, “I can’t just get cake pans; gotta do the brownies too!! The Chocolate Bar Brownie Pan: It’s like a Hershey’s Bar with individual brownies.” This article deals extensively with Williams-Sonoma, the retailer of the brownie. The article is directed to potential purchasers of brownie pans, not candy bars. The article does not discuss the applied-for mark’s features of being flat, rectangular, and sub-divided into twelve smaller pieces in a four panel by three panel format. This article contains little or nothing that demonstrates a public association of the applied-for mark as a source identifier for candy and chocolate.

The remaining article, at pages 47-51 of applicant’s response dated November 25, 2010, is from *Baking Bites*, and provides, in part, “... a flat, rectangular bar divided up into bite-sized pieces that are easy to snap off. I don’t know that Hershey’s was the first chocolate maker to use this design, ... .” This article is also about the Williams-Sonoma brownie pan and is also directed to purchasers of brownie pans, not candy bars. Moreover, the article indicates the author is aware that other chocolate makers also use the design. An article by and/or for purchasers of brownie pans, that acknowledges use of the applied-for mark by competitors for identical goods, is of limited probative value in determining whether purchasers of candy and chocolate primarily identify the applied-for mark as the source of candy and chocolate.

In short, the applicant’s proffered unsolicited media coverage is of limited or no probative value in evaluating whether, in the minds of the purchasing public, the primary significance of the applied-for mark is to identify the source of candy and chocolate.

e. Attempts to Plagiarize

Applicant's arguments regarding the Williams Sonoma brownie pan are misplaced. *In re Carl Walther GmbH*, Serial No. 77096523 (T.T.A.B. Oct. 26, 2010), is not precedential. Moreover, brownie pans are not replicas of candy bars. They are separate and distinct goods.

As discussed previously, the applicant's allegations regarding the Palmer' candy bar are not documented. The evidence is silent as to how long Palmer used the design, what percentage of the market the Palmer candy bar has/had, and whether Palmer still makes and markets the design. Therefore, the evidence currently of record regarding the Palmer' candy bar merely evidences that the applicant's use of the applied-for mark was not exclusive.

f. Results of a consumer survey

With respect to survey evidence, applicant must document the procedural and statistical accuracy of this type of evidence and carefully frame the questions contained therein. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 YSPQ2d 1420, 1424 (Fed. Cir. 2005). In this case, it is unclear whether the survey results are statistically accurate. Pertinent information is not provided or is unclear, including, whether the survey results were audited by a reliable third party. Furthermore, survey results regarding public perception of the applied-for mark were based upon responses from only 406 responses, but there is no explanation if or why this is a statistically significant sampling of customers. Thus, while applicant's survey evidence is relevant to establishing acquired distinctiveness and secondary meaning, it is not dispositive. *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 37, 59 USPQ2d 1720, 1730 (1<sup>st</sup> Cir. 2001); TMEP §1212.06(d).

For all of the foregoing reasons, applicant's claim of acquired distinctiveness under Trademark Act §2(f) is insufficient, and registration is properly refused under Trademark Act §§1, 2 and 45 on the ground that the applied-for product design is non-distinctive trade dress.

#### CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the function refusal under Trademark Act §2(e)(5), 15 U.S.C. §1052(e)(5), and the non-distinctive product design refusal under Trademark Act §§1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, be affirmed.

Respectfully submitted,

/John Dwyer/  
Examining Attorney  
Law Office 116  
Telephone 571-272-9155  
John.Dwyer1@uspto.gov

Michael W. Baird  
Managing Attorney  
Law Office 116