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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Delta T Corporation

Serial No. 77839055

Andrew D. Dorisio of King & Schickli, PLLC for Delta T Corporation.

Richard F. White, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Quinn, Ritchie, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On October 1, 2009, applicant Delta T Corporation applied to register the design shown below:



for “ventilating fans for commercial and industrial use” in International Class 11.¹

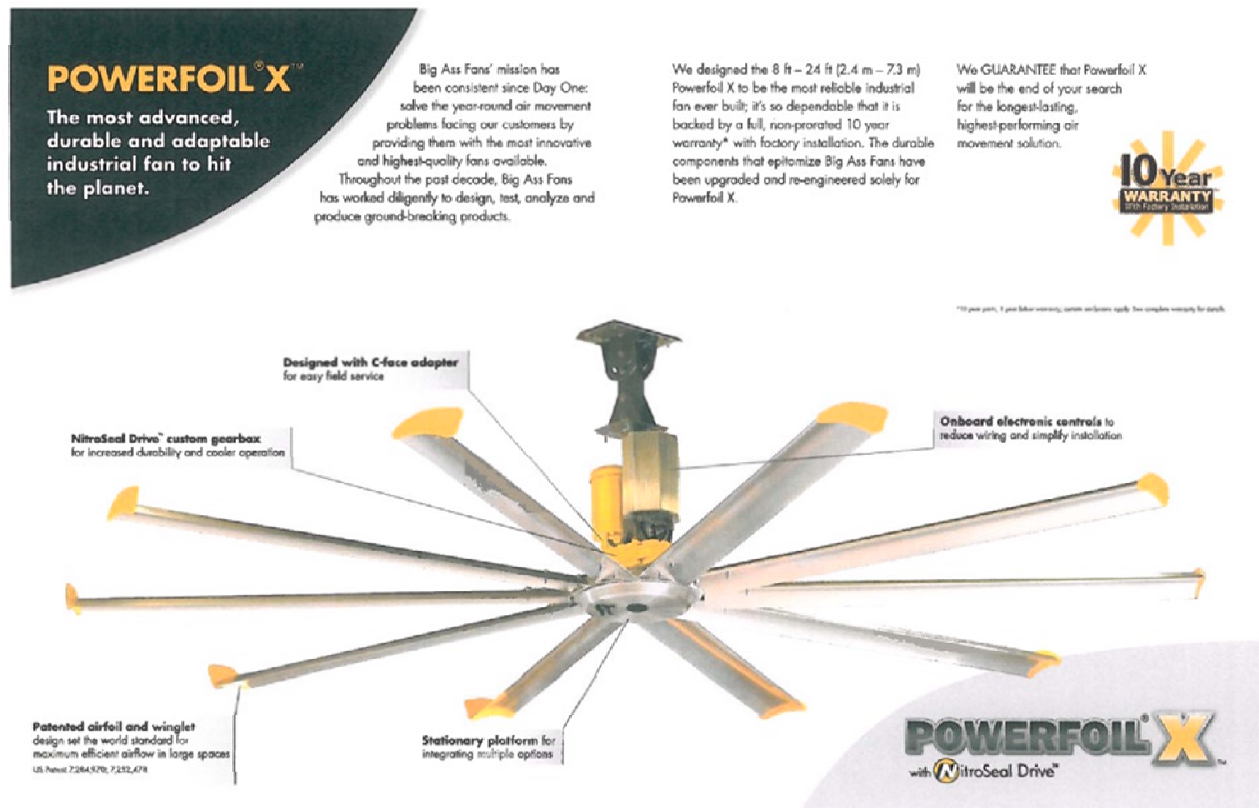
The design was described in the application as follows: “The mark consists of a

¹ Application Serial No. 77839055.

triangular shape with two curved sides and rounded corners.” The application was filed pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of a bona fide intention to use the mark in commerce.

During prosecution, the application was amended to add applicant’s claim for the color yellow to the description of the mark, so that it now reads: “The mark consists of a yellow triangular shape with two curved sides and rounded corners.”²

The proposed mark was published for opposition on October 5, 2010 and a Notice of Allowance issued on November 30, 2010. On January 25, 2011, applicant submitted a specimen of use, pursuant to Trademark Act § 1051(d), consisting of a seven-page catalog. The page from the catalog showing the design appears below:



² See July 12, 2010 response to Office action; August 19, 2010 Examiner’s Amendment.

In a series of Office actions, registration was refused on the grounds that the applied-for mark is functional and consists of a nondistinctive product design, and that the mark on the specimen disagrees with the mark on the drawing.³ The examining attorney also required the applicant to submit additional information regarding the nature of the mark, how the mark is used on the identified goods, and how it appears on the specimen of use.

After applicant submitted a declaration of acquired distinctiveness pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f), the refusal on the basis of nondistinctive trade dress was withdrawn. However, the other three grounds for refusal were made final, as follows:

1. Applicant failed to provide a specimen that showed the applied-for mark in use in commerce as a trademark under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127. The mark on the specimen is displayed in three dimensions and thus disagrees with the mark in the drawing, shown in two dimensions.
2. The applied-for mark is a functional design for applicant's goods under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5).
3. Applicant failed to provide information as required under Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b).

Applicant's request for reconsideration was denied on May 23, 2013. This appeal followed.

³ Registration also was refused on the ground that the applied-for color mark is not inherently distinctive, but that refusal subsequently was withdrawn.

Analysis

We address each of the three grounds for refusal in turn.

A. Failure To Provide Required Information

Trademark Rule 2.61(b) states: “The Office may require the applicant to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the application.”

In its January 11, 2012 response to an Office action, applicant characterized its mark as “a yellow triangular shape which may be placed on any portion of the goods, packaging, displays, websites, etc.,” and stated that its mark is a two-dimensional symbol which “is simply ***placed*** on the tip of the wing of a fan in the embodiments submitted as specimens.” In response, the examining attorney required the following in a February 28, 2012 Office action:

[T]he applicant must provide a picture of the mark existing as an attachment, decal, sticker, or other form of appliqué, etc., prior to being attached onto the “tip of the wing of a fan” or being displayed in any manner other than on the “tip of the wing of a fan”. This is because when viewing the submitted specimens it is ***impossible*** for the examining attorney to differentiate between the use of the mark “on” the “tip of the wing of a fan” and “the wing of the fan” itself.

After first asserting that the requirement was “superfluous and unnecessary,”⁴ applicant ultimately stated as follows:⁵

⁴ August 28, 2012 response to Office action.

⁵ Request for Reconsideration.

Presumably, the Examining Attorney's impression of the nature of the use of the mark is derived from Applicant's description of the mark being "placed on" the tip of the wing of a fan. Applicant apologizes for the confusion, as this terminology was used in the broader sense of the mark being *applied to* a location on the goods. In practice, the mark does not exist in the form of a decal, sticker, or applique prior to its application to the goods, and therefore Applicant cannot comply with the request for this particular information. Rather, the mark is formed directly on the goods. Accordingly, Applicant has provided a specimen which shows the two dimensional mark as it has been formed on the goods, which is completely within compliance with 15 U.S.C. 1127, *supra*, allowing for the mark to be placed on the goods **in any manner**.

The facts of this case are thus distinguishable from refusals to register under Rule 2.61(b) in which the applicant fails to comply with (or even acknowledge) a request for information. *See, e.g., In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1700-02 (TTAB 2003); *In re SPX Corp.*, 63 USPQ2d 1592, 1597 (TTAB 2002). Nor did applicant submit an evasive or otherwise insufficient response. *Cf. In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013) (applicant's responses were equivocal and evasive); *In re Planalytics Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004) (applicant's only response to requirement was to refer examining attorney to its website). Instead, applicant referred to the specimen and responded in essence that it was impossible to comply with the request because the material the examining attorney sought – "a picture of the mark existing as an attachment, decal, sticker, or other form of appliqué, etc., prior to being attached onto the 'tip of the wing of a fan' or being displayed in any manner other than on the 'tip of the wing of a fan'" – does not exist.

The examining attorney's request was proper, in view of the fact that the applied-for mark as shown in its specimen appears to merge with the design of applicant's product, as will be discussed further *infra*. However, we do not find refusal of registration appropriate on this ground, given that applicant acknowledged and responded to the request, and explained that it was unable to comply because the requested materials do not exist.⁶

Therefore, we reverse the refusal to register under Trademark Rule 2.61(b), and accept as facts that applicant's mark "is formed directly on the goods" and also is not "displayed in any manner other than on the 'tip of the wing of a fan.'"

B. Functionality

A product 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.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (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. The functionality doctrine maintains the 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

⁶ We wonder whether other materials could have been requested or offered by applicant that would have provided the information needed here, for example, a photographic close-up of the design as used on the goods or a physical sample of one of applicant's winglets displaying the design. Such materials should have been available, given applicant's statements in its "Declaration under Section 2(f) of the Trademark Act" that approximately 61% of its 65,000 fans and 390,000 winglets distributed over the past eight years have borne the applied-for mark. August 28, 2012 response to Office action at 10 ¶¶ 5-6.

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 inventors a monopoly over new product designs or functions for a limited time, 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 (internal citations omitted).

In making our determination whether a proposed mark is functional and therefore not registrable as a trademark, we consider the following four factors identified in the seminal case *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (Fed. Cir. 1982), known as the “*Morton-Norwich*” factors:

1. the existence of a utility patent disclosing the utilitarian advantages of the design;
2. advertising materials in which the applicant touts the design's utilitarian advantages;
3. the availability to competitors of functionally equivalent designs; and
4. facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

In re Becton, Dickinson & Co., 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (quoting *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002)) (citing *Morton-Norwich*, 213 USPQ at 15-16). It is not required that all four factors be proven in every case; nor do all four factors have to weigh in favor of functionality to support a refusal. Nevertheless, in reaching our decision, we will review all four factors. See *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833 (TTAB 2013).

The first *Morton-Norwich* factor pertains to the existence of a utility patent disclosing utilitarian advantages of the design applicant seeks to register. A utility patent claiming the design features at issue is strong evidence that those features are functional. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001); *see also Kistner Concrete Prods. Inc. v. Contech Arch Techs. Inc.*, 97 USPQ2d 1912, 1924 (TTAB 2011) (finding utility patents sufficient to establish prima facie that design is functional). Accordingly, absent a contrary showing, this factor can be dispositive. *See In re Howard Leight Indus. LLC*, 80 USPQ2d 1507, 1515 (TTAB 2006) (finding utility patent sufficient basis in itself for holding configuration functional).

In this case, the examining attorney made of record a utility patent owned by applicant, U.S. Patent No. 7,252,478, for fan blade modifications.⁷ The abstract of the patent states:

A winglet includes a vertical member and a mounting member. The mounting member is configured to facilitate the mounting of the winglet to the tip of a fan blade. The vertical member is configured to extend perpendicularly relative the [sic] tip of a fan blade. ***Adding winglets to fan blades may improve the aerodynamics of the fan blades, and thereby increase efficiencies of a fan.***

(emphasis added).

Applicant argues that, in this application, it is not seeking trademark protection for the three-dimensional winglets claimed in this and a second utility

⁷ October 14, 2012 final Office action at 2-11.

patent.⁸ Instead, it “seeks trademark protection for a **2-D** yellow triangular shape with two curved sides and rounded corners.”⁹ Applicant contends that its two-dimensional mark cannot have any functional effect, and that registration has been wrongly refused simply because the mark is positioned on winglets, a functional element of its goods. Thus, “[a]ny reference to Applicant’s airfoil and winglet design [is] irrelevant with respect to the functionality of Applicant’s mark.”¹⁰

In analyzing applicant’s argument, we do not write on a blank slate. It has long been held that the fact that a drawing of a mark is in two dimensions will not preclude the mark from being refused as functional. As the Board said in *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1792 (TTAB 2006):


No drawing of a trademark that is the subject of an application for registration is presented in true three-dimensional form. Even an application to register a configuration of a product depicts a mark in two-dimensional form, perhaps from a view that yields a perspective of depth The fact that a drawing of a mark is in two dimensions will not preclude the mark from being refused as functional. See *In re Deister Concentrator Co., Inc.*, 289 F.2d 496, 129 USPQ 314 (CCPA 1961) (Mark described as a “substantially rhomboidal outline” “applied to the goods” by fashioning the ore concentrating and coal cleaning table in such

⁸ U.S. Patent No. 7,284,970, which is referenced *infra* but is not of record.

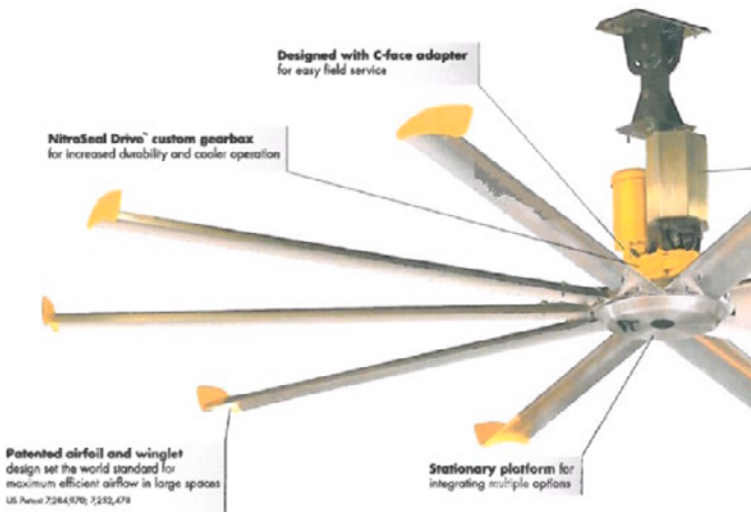
⁹ Appeal Brief at 8, 16 TTABVUE 9. Applicant also states in a footnote to this sentence that it owns two foreign trademark registrations for the mark it seeks to register, but those registrations are not of record and not relevant to this matter.

¹⁰ *Id.* Although the drawings associated with applicant’s patents are not of record, we note that applicant does not argue that the patents would not cover the shape in three dimensions of the design it seeks to register. The patent claims of record are consistent with applicant’s design, essentially describing an aerodynamic winglet with a vertical member in a rounded triangular shape. Moreover, an application for another patent assigned to applicant does include a drawing highly similar to applicant’s design. See May 23, 2013 response to Request for Reconsideration at 13-14.

shape refused registration as functional; depiction of mark in two dimensions by four lines forming a rhomboid); and *In re North American Phillips Corporation*, 217 USPQ 926 (TTAB 1983) (Mark described as a “triangularly shaped plate having smoothly rounded corners and having three circular openings therein” and which was a configuration of the face plate of an electric razor refused registration as functional; depiction of mark in two dimensions, as if viewed directly from the front, with no perspective of depth).

As demonstrated by applicant’s specimen, we agree with the examining attorney that applicant’s design  as it is exclusively located on the winglets of applicant’s goods is essentially utilitarian. Therefore, allowing registration of applicant’s proposed mark would improperly extend the limited duration patent protection applicant has already received for its winglet design, and potentially would prohibit competitors from adopting that useful winglet design when the patents expire. Thus, the record evidence pertaining to the first *Morton-Norwich* factor provides strong evidence that applicant’s design is functional.

We next turn to the second *Morton-Norwich* factor: advertising by the applicant that touts the design’s utilitarian advantages. The catalog submitted as applicant’s specimen clearly touts the utilitarian advantages of its winglet design, as seen in this excerpt:



The illustration in the catalog appears to point to the fan blade or airfoil just behind the winglet, which is in the shape and color of applicant's proposed mark, and states: **"Patented airfoil and winglet** design set the world standard for maximum efficient airflow in large spaces[.] US Patent 7,284,970; 7,232,478."

The examining attorney also made of record a page from applicant's website featuring the pop-up window shown below:¹¹



Under the title **"Patented Airfoil & Winglet,"** near a picture of a winglet corresponding to the shape and color of applicant's proposed mark, the following text appears: "Our patented airfoil and winglet design sets the world standard for efficient airflow in large spaces. The unique aerodynamic design enhances energy efficiency and airflow by eliminating vortex formation at airfoil tips. U.S. Patents 7,284,970; 7,252,478."

¹¹ March 28, 2011 Office action at 6.

These two examples in particular, among others of record, provide strong evidence under the second *Morton-Norwich* factor that applicant's advertising touts the utilitarian advantages of the design it seeks to register.

Neither applicant nor the examining attorney addressed in their briefs the third and fourth *Morton-Norwich* factors, respectively, the availability to competitors of functionally equivalent designs and facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. There is no record evidence relating to the fourth factor, which we therefore find to be neutral. There is some evidence that applicant itself and third parties use winglets in different shapes, although we have little information regarding whether they are functionally equivalent to the applied-for design.¹² This evidence of potentially functionally equivalent designs weighs slightly against functionality. We note, however, that the mere fact that other designs may be available does not necessarily mean that applicant's design is not functional. *See TrafFix*, 58 USPQ2d at 1007; *In re Bose*, 772 F.2d 866, 227 USPQ 1, 5-6 (Fed. Cir. 1985); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1763 (TTAB 2011).

In sum, the first and second *Morton-Norwich* factors strongly support a finding that applicant's design is functional, the third factor weighs slightly against finding that applicant's design is functional, and the fourth factor is neutral.

¹² *See, e.g.*, applicant's specimen at 3; July 14, 2011 Office action at 14; response to Request for Reconsideration at 2. In its January 11, 2012 response to Office action, applicant stated: "Color photographs and advertisements showing competitive goods of several different manufacturers of high volume, low speed fans are attached (see 'Competitor Advertising')." However, there was no attachment with that title. If applicant is referring to "Exhibit D," a single page with five images of fans, it includes insufficient information for us to evaluate the availability to competitors of functionally equivalent designs. *Id.* at 23.

Applicant argues in the alternative that even if the shape of its mark is functional, the overall mark is not because it is yellow.¹³ It is well-established, however, that the presence of some non-functional elements does not save a mark from being functional overall. “Whenever a proposed mark includes both functional and non-functional features, as in this case, the critical question is the degree of utility present in the overall design of the mark.” *In re Becton, Dickinson & Co.*, 102 USPQ2d at 1376. The functional feature of applicant’s mark – a shape that increases the efficiency of its goods – outweighs its non-functional element, the color yellow. *See id.*

For these reasons, we find that applicant’s mark in its entirety is functional overall and affirm the refusal of registration under Trademark Act Section 2(e)(5).

C. Disagreement Between Mark and Specimen


Finally, we turn to the refusal on the ground that applicant’s specimen displays its design in three dimensions and thus disagrees with the two-dimensional design in applicant’s drawing. Trademark Rule 2.52(b)(4) states:

If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must describe the mark and explain the purpose of the broken lines.

¹³ Appeal Brief at 9, 16 TTABVUE 10.

We reiterate our finding *supra* that applicant's proposed mark as shown in its specimen is coextensive with and inseparable from applicant's patented winglet design, which is obviously three-dimensional. Indeed, the specimen shows that applicant's design appears on both sides of its winglets. A consumer viewing one of applicant's fans from below can see the design in three dimensions, on both sides of the winglets (albeit partially obscured on the interior side), as demonstrated in this page from applicant's advertising:¹⁴

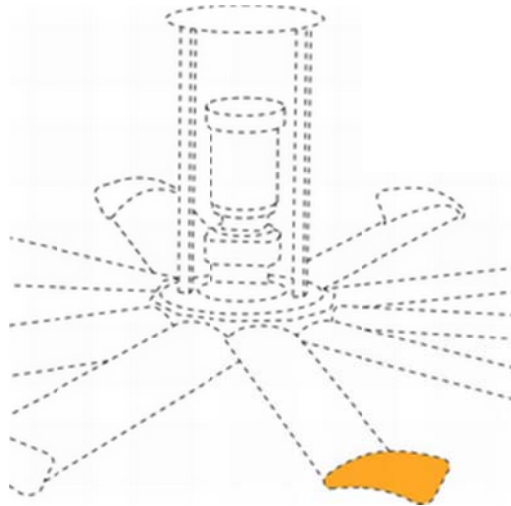


Perhaps the clearest illustration of the disagreement between applicant's specimen and its drawing of the applied-for mark  can be seen in an existing registration made of record by applicant. Applicant owns a registration on the Supplemental Register for a mark described as follows:

¹⁴ August 28, 2012 response to Office action at 20, "Declaration under Section 2(f) of the Trademark Act," Exhibit C. Applicant's DBA is "Big Ass Fan Company."

The mark consists of the color yellow applied to an end of a blade on the goods. The broken line indicates placement of the mark on the goods and the outline of the goods is not claimed as part of the mark.¹⁵

The identified goods are the same as in the instant application, “ventilating fans for commercial and industrial use.” The drawing for applicant’s mark on the Supplemental Register appears as follows:



Applicant argues that there is no disagreement between the mark in the application before us and the specimen of use because applicant seeks to register only a two-dimensional shape, which takes on a three-dimensional appearance when applied to the curved surface of a three-dimensional fan. Applicant contends that: “The drawing is not in disagreement with the specimen at all, but rather the geometric shape of the surface upon which it is applied causes the mark itself to take the shape of said surface.”¹⁶

¹⁵ January 11, 2012 response to Office action at 2, Registration No. 3801325.


¹⁶ Reply Brief at 2-3, 19 TTABVUE 3-4.

Applicant also made of record several third-party registrations in which the marks are drawn in two dimensions and used on three-dimensional objects in the specimens. Applicant relies in particular on a registration for the stylized mark

Spalding for rubber balls, with the following specimen submitted with an affidavit of continued use under Trademark Act Section 8:¹⁷



Among the other examples submitted by applicant is the Nike “swoosh” design

 registered for athletic shoes and uniforms; one of its specimens appears below:¹⁸



¹⁷ Request for Reconsideration at 2-3, Registration No. 2305965.

¹⁸ August 28, 2012 response to Office action at 3-5, Registration No. 977190.

We do not find applicant's arguments persuasive. We view the examples *supra* to be readily distinguishable from applicant's mark because they remain essentially two-dimensional marks even if they take on a curved appearance when applied to the identified goods. In contrast, the design applicant seeks to register is not only formed directly onto its three-dimensional goods, as admitted by applicant,¹⁹ but indeed as formed on applicant's fans constitutes an important functional component of those goods. Therefore, we agree that applicant's drawing does not match the mark and affirm the refusal to register on the ground that applicant failed to provide a specimen showing the applied-for mark in use in commerce as a trademark under Trademark Act Sections 1 and 45.

Decision: We affirm the refusals to register on the grounds that applicant's mark is functional and the specimen of use does not match the drawing. We reverse the refusal on the ground that applicant failed to submit required information.

¹⁹ See Request for Reconsideration.