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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pelco Products, Inc.

Serial No. 78485818

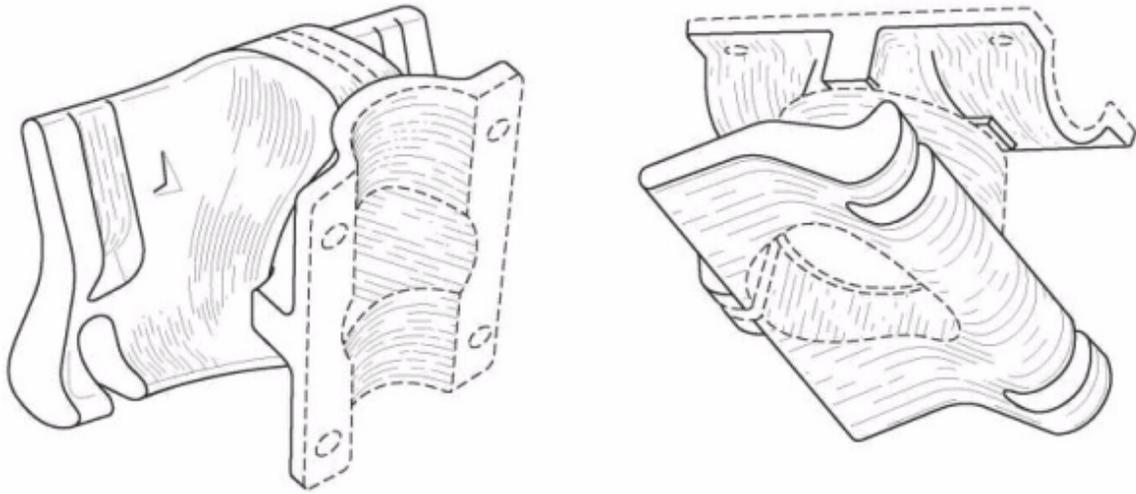
Mary M. Lee, Esq. for Pelco Products, Inc.

Midge F. Butler, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Hairston, Drost, and Bergsman, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 18, 2004, Pelco Products, Inc.
(applicant) applied to register the design shown below on
the Principal Register for goods ultimately identified as
"brackets made of metal for attaching traffic signals to
mast arms" in Class 6.

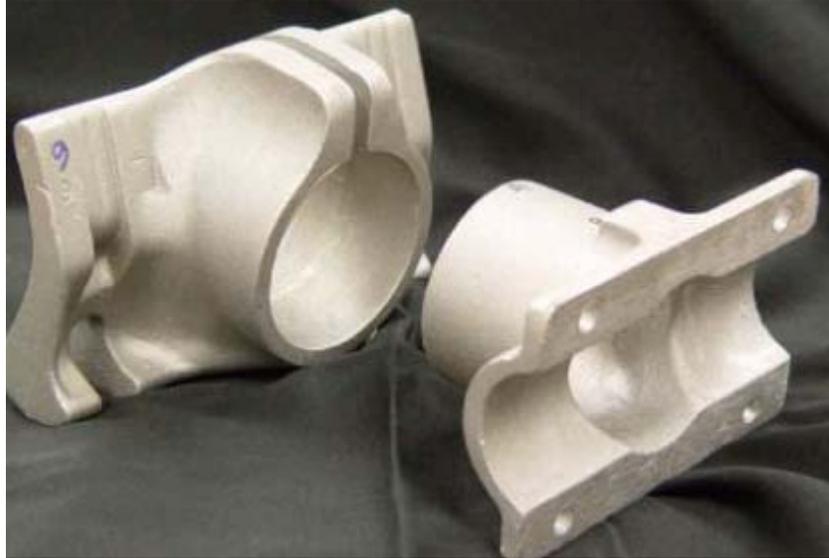


The application alleges a date of first use and first use in commerce of June 1986. The application contains the following paragraph description of the mark (punctuation in original):

Color is not claimed as a feature of the mark. "The mark consists of the three-dimensional configuration of a two-part bracket (male and female members) for attaching a traffic signal to a mast arm, presented in the drawing in two views. The mark resides in the contours of the opposing faces of the two members, that is, the surfaces that are external and plainly visible in the assembled, installed unit as shown. The surfaces of the components that contact the structures to which the bracket attaches, the bolt holes, the band recesses, and the inner cylindrical surfaces are not claimed as part of the mark."

The application sought registration on the Principal Register under the provision of Section 2(f) of the Trademark Act.

A picture of the goods is set out below:



The examining attorney (Brief at 1) has refused registration on the grounds that the "mark is functional under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5)... and because there is a[n] insufficient showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §2(f)."

Applicant argues that its "mark is embodied in the curvaceous contours of the surfaces of the bracket that are exposed during the use of the assembled bracket." Brief at 6. A photograph that emphasizes that section of the goods follows.



A photograph of applicant's goods in use is also set out below.



After the examining attorney made the refusals final, this appeal followed. We will discuss the evidence and the arguments as we address these issues in the case.

Functionality

The first question in this appeal is whether applicant's mark is functional under the Trademark Act.

The Trademark Act, as amended, provides that an application may be refused registration if it "comprises any matter that, as a whole, is functional." 15 U.S.C. § 1052(e)(5). The Supreme Court has addressed the issue of functionality in several cases both before and after this statutory change.

Discussing trademarks, we have said "[i]n general terms, a product 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 Products Co.*, 514 U.S. 159, 165 (1995) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n. 10 (1982)). Expanding upon the meaning of this phrase, we have observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." 514 U.S., at 165. *TraFFix Devices Inc. v. Marketing Displays Inc.*, 523 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The Federal Circuit looks at four factors when it considers the issue of functionality:

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design 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.

Valu Engineering Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982).

We will analyze the issue of functionality using the four factors set out in *Valu Engineering*.

(1) Existence of a Utility Patent

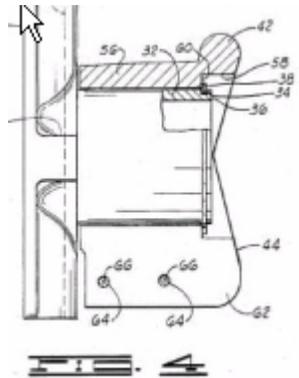
The existence of a utility patent for the feature for which trademark protection is sought is often critical to a determination that a feature is functional.

A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

TrafFix, 58 USPQ2d at 1005.

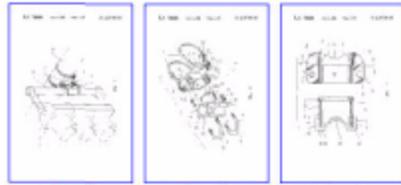
The examining attorney references applicant's Patent No. 4659046 and argues (Brief at unnumbered p. 8) that a "review of the patent demonstrates that the shape of the proposed mark has practical or functional value." A

drawing from that patent does not clearly show (see below) the mark for which applicant now seeks registration.



The examining attorney also refers to "previously attached printouts of other patents claimed by the applicant for a traffic control device consisting of mast arm brackets. Specifically note Patent No. 6,357,709, handled by Mary Lee, the attorney of record in the present application." Brief at 8. General references to "previously attached patents" without any specific discussion of the feature that allegedly show that applicant's mark is functional are not very helpful. Applicant's declarant maintains that "[n]one of the features comprising the Mark are contained in any of the patents." A. Parduhn dec. dated June 19, 2006 at 3. See also S. Parduhn dec. dated October 31, 2005 at 4 ("[N]one of these patents has claimed or even fully disclosed the unique and attractive configuration of the exposed surfaces found in the actual brackets. Since these contours were

not relevant to the patented structures, there was no need to depict them, even in the figures"). Even the '709 patent to which the examining attorney refers does not show the allegedly relevant feature clearly. Reproductions of three drawings from the '709 patent, in approximately the size that they appear in the record, follow.



It would be sheer speculation on our part to conclude that this patent claims the subject matter for which applicant is now seeking trademark registration. Applicant argues that a "comparison of the patent drawings to the trademark drawing reveals that the features of Applicant's mark are not even shown in any detail in either of these patents. This makes sense as the features being claimed in the patent were unrelated to the features being claimed by Applicant as a trademark." Brief at 10. We cannot agree with the examining attorney that the patents, whether they are owned by applicant or a third party,¹ demonstrate "that

¹ The patents in the record identify the inventor as A. Philip Parduhn and Alfred P. Parduhn. Applicant's president is identified as A. Philip Parduhn. *In re Virshup*, 42 USPQ2d 1403, 1405 (TTAB 1997) ("[T]he fact that the applicant is not the owner of the utility patents submitted by the Examining Attorney is not a proper basis for their exclusion as evidence in this appeal... [T]he patents were submitted to show that the features of the

the shape of the proposed mark has practical or functional value." Brief at 8.

(2) Advertising Materials Disclosing Utilitarian Advantages

"If a seller advertises the utilitarian advantages of a particular feature, this constitutes strong evidence of functionality." 1 *McCarthy on Trademarks and Unfair Competition* § 7:74 (4th ed. 2008). The examining attorney argues that the "advertising material previously provided by the applicant clearly touts the utilitarian aspect of the design. The advertising material indicates that the bracket provides the most versatile and universal signal mounting system available." Brief at 9 (emphasis omitted). It "touts that the clamp assembly, the upper and lower arms and the vertical support tube allows for vertical, horizontal and rotational adjustments that give complete control to signal mounting and aiming not possible with other types of rigid mounting." *Id.* at 9-10 (emphasis omitted). Applicant responds by arguing that the advertising statements "refer to features not claimed as part of Applicant's mark" and that this case "is similar to

design configuration applicant seeks to register as a trademark provide functional advantages") and *American Flange & Mfg Co. v. Rieke Corp.*, 80 USPQ2d 1397, 1404 (TTAB 2006) ("Any expired patent is potentially relevant if it covers the feature at issue, regardless of the owner").

the case of *In re Browning*, [217 USPQ 933 (TTAB 1982)], in which the Board held that the design of the receiver portion of a shotgun was not functional, noting that the advertising touting sighting advantages did not relate to that part of the design sought for registration." Brief at 11. Applicant's declarant said that: "Never, in any of its patents or its advertisements, has Pelco ever referred to any to the design features forming the Mark as having functional advantages." A. Parduhn dec. dated June 19, 2006 at 3. A sample of applicant's advertising follows.



We agree with applicant when it argues that the advertising does not address the features for which applicant is seeking to registration. Undoubtedly, the mounting bracket itself has utilitarian features that applicant's advertising touts. However, those features are

not relevant to applicant's design for which it is seeking registration. We cannot find that applicant's "advertising touts the design for its desirable, superior utilitarian qualities." *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1340 (TTAB 1997).

(3) Alternative Designs

Regarding the third factor, the Federal Circuit has explained that:

We did not in the past under the third factor require that the opposing party establish that there was a "competitive necessity" for the product feature. Nothing in *TraFFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in *TraFFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

Valu Engineering, 61 USPQ2d at 1427 (footnote omitted).

The examining attorney "does not dispute the applicant's argument that there are alternative designs available in the marketplace. However, there is nothing that the applicant has submitted which indicates that the features claimed are not utilitarian in nature." Brief at

11. Again, we cannot conclude that applicant's design makes applicant's bracket work better. Therefore, we conclude that the availability of other alternative designs that appear to work "equally well" (*Valu Engineering*, 61 USPQ2d at 1427) does not support the examining attorney's argument that applicant's mark is functional.

- (4) Facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product

There is no evidence that applicant's design results from a simple or cheaper method of manufacturing the product and, thus this fact does not favor applicant or the examining attorney. *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006) ("While evidence that a product feature makes the product cheaper to manufacture may be probative in showing functionality, evidence that it does not affect its cost is not necessarily proof of non-functionality"). Applicant has submitted evidence in an affidavit from its vice president that discussed the manufacturing of applicant's brackets:

Today, modern computer technology would make the formation of the molds to make the ASTRO-BRAC practically as easy as a more conventional shaped bracket. However, when this unique configuration first was designed, it did make manufacturing more complicated; the molds had to be hand made because the surfaces were not simply planar or radiused, but rather were free-formed.

S. Parduhn dec. dated October 31, 2005 at 4-5.

Functionality Analysis

We must now consider whether applicant's design as a whole is functional. 15 U.S.C. § 1052(e)(5). The Supreme Court has made it clear that a "functional feature is one the exclusive use of which would put competitors at a significant non-reputation-related disadvantage." *TrafFix*, 58 USPQ2d at 1006 (internal quotation marks omitted). See also *Valu Engineering*, 61 USPQ2d at 1425 ("De jure functionality means that the product has a particular shape because it works better in this shape") (internal quotation marks omitted).

Under the facts of this case, we cannot conclude that the examining attorney has met her burden of establishing a prima facie case of functionality. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984). See also *In re Howard Leight Industries LLC*, 80 USPQ2d 1507 (TTAB 2006 ("In ex parte proceedings before the Board, by contrast, the Office has the initial burden of establishing a prima facie case of functionality"). It is not clear what utilitarian function the feature that is described by the "curvaceous contours of the surfaces of the bracket" performs. Therefore, the examining attorney's refusal under Section 2(e)(5) is reversed.

Acquired Distinctiveness

We now turn to the issue of acquired distinctiveness. The Supreme Court has explicitly held that product "design, like color, is not inherently distinctive." *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). Furthermore, applicant, by seeking registration under Section 2(f), has admitted that its mark is not inherently distinctive. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact"). Inasmuch as applicant's design is part of a product design for applicant's brackets, it is not registrable on the Principal Register unless applicant shows that the design has acquired distinctiveness.

Applicant has the burden of proving that its mark has 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"). "[L]ogically that standard becomes more difficult as the

mark's descriptiveness increases." *Yamaha Int'l*, 6 USPQ2d at 1008.

However, the statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.

As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Id. (quotation marks, brackets, and citations omitted).

Applicant argues that "[g]iven the unique design features comprising Applicant's mark, minimal actual evidence is required." Brief at 14. We cannot agree. Applicant's design is a feature of its product and, while "there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, the burden is heavier in this case because it involves product configurations." *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1283-84 (TTAB 2000).

"In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use,

unsolicited media coverage, and consumer studies (linking the name to a source)." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). To meet its burden of showing that its mark has acquired distinctiveness, applicant has submitted the following evidence.

"Since at least 1985, all the ASTRO-BRAC mast arm brackets sold by Pelco have embodied the design features shown in the photographs attached." S. Parduhn dec. dated October 31, 2005 at 4.

Applicant's sales of its brackets have averaged about 51,000 units between 2001 and 2005 and its gross revenues over that period have averaged about \$3.9 million dollars. A. Parduhn dec. dated June 19, 2006 at 2. Applicant's advertising expenses for its products that include the ASTRO-BRAC products varied during that period from between \$5,583 to \$9,033. *Id.* Furthermore, the declarant indicated that "about half [of] all mast arm brackets now in service across the United States are AstroBrac brand products." *Id.*

Applicant has also submitted declarations from more than 16 "independent distributors ... installers, and ... a contractor." See Corrected dec. of A. Parduhn dated August 25, 2006 and A. Parduhn dec. dated June 19, 2006

(attachments). These declarants report that they "have never seen another bracket with the free-formed curving external surface found in the ASTRO-BRAC. The pawl-shaped portions on the female component are especially unusual." See, e.g., Martz dec.

Applicant's vice president maintains that its products are sold almost exclusively to municipalities and other government bodies responsible for roadway equipment and maintenance and that "there are a relatively limited number of potential customers for [its] mast arm brackets, as compared to consumer products." S. Parduhn dec. dated October 31, 2005 at 6.

When we view all the evidence of record as a whole, we do not find that it demonstrates that the design has acquired distinctiveness. The mere fact that applicant has sold products with the feature now claimed as a trademark on it does not establish acquired distinctiveness. If that was the case, virtually any non-functional feature on a popular product would almost automatically have acquired distinctiveness. This is not the test. See *In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2023 (TTAB 2008) ("After careful consideration of the evidence submitted in this case, we are not persuaded that the earpiece design sought to be registered has become distinctive of

applicant's eyewear. The chief reason is the absence of evidence of the advertising and/or promotion by applicant of the earpiece design as a trademark"); *In re Parkway Machine Corp.*, 52 USPQ2d 1628 (TTAB 1999) ("Applicant has not promoted the asserted mark herein as a trademark and does not mention the asserted mark in its product catalogs. While the product design in question may appear in advertisements, there is nothing to indicate that purchasers would view the features in question as more than a part of the goods depicted"); *Ennco Display*, 56 USPQ2d at 1285 (In "a product configuration case, the critical question is the effectiveness of the advertisements in creating a consumer association between the product configuration and the producer"); and *In re Upper Deck Co.*, 59 USPQ2d 1688, 1692 (TTAB 2001) ("Promotional and advertising expenditures for the cards per se are similarly unconvincing without concurrent evidence of promotion of the hologram device as a trademark"). We add that this is not a case where applicant has established that "look for" advertising or promotion is not needed because there is an industry practice of using flourishes on brackets by manufacturers to distinguish their products. *In re Black & Decker Corp.*, 81 USPQ2d 1841, 1844 (TTAB 2006).

Also, applicant's sales figures alone are not enough to show that its mark has acquired distinctiveness. See *Howard Leight*, 80 USPQ2d at 1517 ("Moreover, although the sales figures might demonstrate that applicant has been successful in marketing its earplugs and that customers find applicant's earplugs to be quality merchandise worth purchasing, we cannot determine, from the sales figures, that purchasers view the shape of the earplug as a mark"); *Upper Deck*, 59 USPQ2d at 1692 ("While sales figures may be indicative of the commercial success of applicant's products, they do not demonstrate that the holograms used thereon have acquired distinctiveness as an indication of the source of the cards"); and *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998) ("[A]pplicant's use of such design for over 16 years and the general growth in its annual sales figures and advertising expenditures during that period simply do not suffice to establish that the purchasing public for motorcycle fuel valves has come to view applicant's petcock configuration as a trademark"). Also, the mere fact that design appears in advertising along with a display of the product does not translate into acquired distinctiveness. *Ennco Display Systems*, 56 USPQ2d at 1286 ("A number of other advertisements submitted by applicant display the subject configurations attached to or

encompassed within other designs. It is difficult to imagine that consumers viewing these advertisements can draw any distinction between the subject product configurations and other miscellaneous designs, let alone attribute trademark significance”).

Furthermore, the fact that applicant has claimed that it has been selling its products with the design for approximately twenty years does not by itself provide significant evidence that its mark has acquired distinctiveness. See *Howard Leight*, 80 USPQ2d at 1517 (15 years) and *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years). We have little evidence that would permit us to conclude that customers have come to recognize applicant’s design as a trademark for applicant’s goods. *Parkway Machine*, 52 USPQ2d at 1633.

In addition, the fact that some distributors and installers identify the feature as “especially unusual” hardly shows that actual customers would view the feature as a trademark. *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (“The affidavit of the retailer, which states that he associates appellant’s design only with appellant, should also be considered for what might be inferred about consumer reaction. However, we cannot agree with appellant that the affiants are

equivalent to a large class of purchasers. Giving due consideration to the four affidavits, they do not establish an association of appellant's design with a single source by other than a small number of purchasers"). As the Federal Circuit has pointed out in a case involving the question of acquired distinctiveness:

The affidavits of Petersen are devoid of facts from which a conclusion of secondary meaning could be drawn. No evidence came from consumers that they rely on shape alone, rather than on the prominently displayed word mark VISE-GRIP, to identify the source of the product. More particularly, there was simply no attempt by Petersen to show that consumers identify the source of the tool by one or more of the features, such as the curve of the raised portion surrounding the teeth, which Petersen claims are arbitrary and allegedly give the tool a unique appearance.

Petersen Mfg. Co., Inc. v. Central Purchasing, Inc., 740 F.2d 1541, 222 USPQ 562, 569 (Fed. Cir. 1984). See also *In re ic! berlin brillen GmbH*, 85 USPQ2d at 2024 (The "statements of ten retailers do not establish an association of the earpiece design with applicant by other than an extremely small number of the purchasing public").

The statements by applicant's distributors and installers that a feature of its goods is "especially unusual" or "unique and distinctive" does not establish that purchasers will recognize the feature as a trademark.

Applicant has used its design for more than twenty years but there is a lack of any evidence that the ultimate

purchasers of its products rely on its claimed design as a trademark. A trademark includes any "device ... used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods." 15 U.S.C. § 1127. When we consider each individual piece of evidence and the evidence in its entirety, we conclude that, while there is evidence that applicant has used the mark, there is simply insufficient evidence that consumers view applicant's design as an indicator of the source of applicant's goods or that applicant has even encouraged consumers to consider the design as its trademark. The fact that applicant has sold and advertised its products with the design does not indicate that any consumers distinguish its goods based on the design. Therefore, applicant has not met its burden of demonstrating that its mark has acquired distinctiveness.

Decision: The examining attorney's refusal to register applicant's design on the Principal Register on the basis that it is functional is reversed. The examining attorney's refusal to register applicant's mark on the ground that it is non-distinctive and that it has not acquired distinctiveness is affirmed.