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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/867933

MARK: [spray nozzle configuration]



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APPLICANT: UDOR U.S.A., INC.

**BEFORE THE
TRADEMARK TRIAL AND APPEAL
BOARD ON APPEAL**

CORRESPONDENT'S REFERENCE/DOCKET NO:

1325.8-US-01

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the following refusals issued by the trademark examining attorney: (1) a Trademark Act Section 2(e)(5) refusal on the ground that the proposed mark, which consists of a three-dimensional configuration of a spray nozzle, is a functional design for the goods, Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); and (2) a refusal under Trademark Act Sections 1, 2, and 45 on the ground that the proposed mark consists of a non-distinctive product design, and the evidence in support of the claim of acquired distinctiveness is insufficient to overcome the refusal. Trademark Act Sections 1, 2, and 45, 5 U.S.C. §§1051, 1052 and 1127.

FACTS

On April 24, 2006, applicant, Udor U.S.A., Inc., filed an application under Section 1(b) of the Trademark Act to register on the Principal Register a three-dimensional configuration mark comprising a spray nozzle head. The goods identified in the application are “metal spray nozzles.”

On October 31, 2006, registration was refused pursuant to Trademark Act Section 2(e)(5) on the ground that the three-dimensional configuration mark is functional for the identified goods, and pursuant to Trademark Act Sections 1, 2, and 45 on the ground that the proposed mark fails to function because it comprises a three-dimensional configuration of the goods that is not inherently distinctive and will not be perceived as a trademark. In addition to the two refusals, a requirement for a signed and verified

statement in support of the Section 1(b) filing basis and an information requirement were issued. The information requirement called for submission of the following information:

- (a) a written statement indicating whether the proposed mark has been the subject of a design or utility patent;
- (b) advertising, promotional, and/or explanatory materials concerning the configuration of the proposed mark;
- (c) a written explanation accompanied by relevant evidence regarding whether alternative designs are equally efficient and/or competitive and regarding designs used by competitors; and
- (d) a written statement as to whether the product design results from a simple or inexpensive method of manufacture in relation to alternative designs for the product, with a request for relevant information regarding the method and/or cost of manufacture.

On April 30, 2007, applicant filed a “Response to Office Action” (hereinafter “Response 1”) and an Amendment to Allege Use. In Response 1, applicant argued that the proposed configuration mark is not functional and has acquired distinctiveness. Along with Response 1, applicant submitted a copy of utility Patent No. 7,108,204, which is owned by applicant and contains 24 claims covering a spray nozzle configuration that closely resembles, and is potentially identical to, the spray nozzle configuration that is the subject of the present trademark application. In addition, applicant submitted a Declaration from Thomas Les Johnson, co-owner of applicant Udor U.S.A., Inc., advertising materials from applicant that discuss spray nozzles, and a properly signed and verified declaration under 37 C.F.R. §2.20.

On June 19, 2007, a final refusal of registration was issued pursuant to Trademark Act Section 2(e)(5) on the ground that the proposed mark is functional for the identified goods, and Trademark Act Sections 1, 2, and 45 on the ground that the proposed mark is comprised of a non-distinctive configuration of the goods that does not function as a trademark to identify and distinguish applicant's goods from the goods of others and to indicate their source. In addition, a substitute specimen request was issued.

On December 19, 2007, applicant filed a "Request for Reconsideration after Final Action" (hereinafter "Reconsideration Request") along with substitute specimens, an amended drawing that disclaims the orifice in the nozzle configuration, four statements in "form letter" format from individuals from various companies discussing the uniqueness of applicant's spray nozzle, advertising from applicant, a copy of a shopping cart page and other information pages from distributors of applicant's goods, including a third party distributor based in Canada.

On January 14, 2008, applicant's request for reconsideration of the refusals was denied, but the drawing amendment disclaiming the orifice in the configuration mark and the substitute specimens were accepted.

ISSUES

1. Whether the proposed three-dimensional configuration mark is functional for the identified goods pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).
2. Whether applicant's evidence in support of the claim of acquired distinctiveness is sufficient to overcome the refusal under Trademark Act Sections 1, 2 and 45 on the ground that the proposed three-dimensional mark comprises a non-distinctive product design.

ARGUMENT

I. THE PROPOSED SPRAY NOZZLE CONFIGURATION MARK IS FUNCTIONAL.

Registration of applicant's proposed three-dimensional spray nozzle configuration mark must be refused because the overall design is functional. Section 2(e)(5) of the Trademark Act provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it-- (e)(5) comprises any matter that, as a whole, is functional.
15 U.S.C. §1052(e)(5).

'[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,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.
Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (quoting *Inwood Laboratories v. Ives Laboratories*, 456 U.S. 844 (1982)).

The Office must establish a prima facie case that the three-dimensional configuration mark sought to be registered is functional. The burden then shifts to the applicant to present sufficient evidence to rebut the prima facie case. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993); TMEP §1202.02(a)(iv).

If the applied-for configuration mark is determined to be functional, such a determination constitutes an absolute bar to registration on the Principal or Supplemental Registers, regardless of any evidence of acquired distinctiveness. Trademark Act Sections 2(e)(5) and 23(c), 15 U.S.C. §§1052(e)(5), 1091(c); *see Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001, 1006 (2001); *In re Controls Corp. of Am.*, 46 USPQ2d 1308, 1311 (TTAB 1998); TMEP §1202.02(a)(iii)(A).

A determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); TMEP §1202.02(a)(iv).

Evidence of functionality need not establish that the configuration at issue is the very best design for the particular product or product packaging. A configuration can be held functional when the evidence shows that it provides a specific utilitarian advantage that makes it one of a few superior designs available. *See In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (holding shape of a loudspeaker system enclosure functional because it conforms to the shape of the sound matrix and is thereby an efficient and superior design); *In re Am. Nat'l Can Co.*, 41 USPQ2d 1841 (TTAB 1997) (holding metal beverage containers with vertical fluting functional because vertical fluting is one of a limited number of ways to strengthen can sidewalls and it allows for an easier way to grip and hold the can); TMEP §1202.02(a)(v), (a)(v)(C).

On the other hand, where the evidence shows that the specific product configuration at issue provides no real utilitarian advantages to the user, but is one of many equally feasible, efficient and competitive designs, then it may be registrable. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982). However, a product configuration cannot be registered on the Principal Register without a showing of acquired distinctiveness. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); TMEP §1202.02(b)-(b)(i).

A determination of functionality normally involves consideration of one or more of the following factors, commonly known as the “Morton-Norwich factors”:

- (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 Prods., Inc., 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); TMEP §1202.02(a)(v).

In the present case, the following factors are determinative of the issues: (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered; and (2) advertising by the applicant and third parties that touts the utilitarian advantages of the design.

A. Utility Patent No. 7,108,204 discloses the utilitarian advantages of the design sought to be registered.

A careful review of applicant's utility patent warrants a conclusion that the proposed three-dimensional configuration mark is functional because the utility patent claims the design features in the proposed configuration trademark. A utility patent claiming the design features at issue is strong evidence of functionality. The party seeking trademark protection for a three-dimensional configuration mark then bears the burden of establishing that the features are not functional, such as by providing evidence that they are merely ornamental, incidental, or arbitrary aspects of the product or packaging.

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

In Utility Patent No. 7,108,204, which is owned by applicant, the overall design features of the proposed spray nozzle are claimed. Claims 1 and 6, *inter alia*, of Utility Patent No. 7,108,204 claim the following relevant sections of the proposed configuration trademark: (1) a spray nozzle head; (2) a spray nozzle body; (3) a discharge surface; (4) an impingement surface; and (5) a deflection ridge. The language of Claim 6 includes the following claim: “[a] *spray nozzle system, comprising: a body comprising a discharge surface*, an orifice¹ disposed on the discharge surface, and a fluid fitting in fluid connection with the orifice, the fluid fitting adapted to receive a pressurized fluid; *and a spray head removably mounted to the body, the spray head comprising: an impingement*

¹ The orifice was initially included in the portion of the proposed trademark configuration for which applicant now seeks trademark protection, but it was subsequently disclaimed in applicant's Reconsideration Request.

surface, the impingement surface oppositely facing the discharge surface, the impingement surface oriented at an impingement angle measured relative to a centerline of the orifice, the impingement angle being 90 degrees or less; and a deflection ridge, the deflection ridge bridging a gap between the impingement surface and the discharge surface, the deflection ridge defining a spray angle which limits the discharge of fluid wherein the deflection ridge comprises a filleted corner and a sharp corner, the filleted corner and the sharp corner intersecting at an angle defining the spray angle.” (U.S. Patent No. 7,108,204 at Column 7, Line 26.) (emphasis supplied)

In Figure 1 of Patent No. 7,108,204, the spray nozzle head is identified as Reference No. 8², and is claimed in Claim 6 in the statement: “*a spray head* removably mounted to the body” (U.S. Patent No. 7,108,204, Column 7, Line 31.) (emphasis supplied) This spray nozzle head is also shown in the proposed configuration mark.

In Figure 1 of Patent No. 7,108,204, the spray nozzle body is identified as Reference No. 10 and the discharge surface, which is part of the spray nozzle body, is identified as Reference No. 4, both of which are claimed in Claim 6 in the statement: “[a] *spray nozzle* system, *comprising: a body comprising a discharge surface*, an orifice disposed on the discharge surface, and a fluid fitting in fluid connection with the orifice, the fluid fitting adapted to receive a pressurized fluid” (U.S. Patent No. 7,108,204, Column 7, Line 26.) (emphasis supplied) The spray nozzle body and the discharge surface are also shown in the proposed configuration trademark. Although applicant disclaimed the

² An explanation of the various reference numbers in Figure 1 can be found in the section of the utility patent entitled “Detailed Description Of The Various Embodiments.” For instance, Column 4, Line 20 indicates that Reference No. 8 is “the body of the spray head.”

orifice (Reference No. 3 in Figure 1) and the fluid fitting (Reference No. 2 in Figure 1), applicant is attempting to receive trademark protection for the discharge surface, which is part of the nozzle body.

In Figure 1 of Patent No. 7,108,204, the impingement surface oppositely facing the orifice is identified as Reference No. 5, and is claimed in Claim 1 in the statement: “[a] spray nozzle, comprising: a substantially flat discharge surface lying in a single plane; an orifice disposed on the discharge surface; *an impingement surface oppositely facing the orifice, the impingement surface oriented at an impingement angle measured relative to a centerline of the orifice, the impingement angle being 90 degrees or less . . .*” (U.S. Patent No. 7,108,204, Column 6, Line 62.) (emphasis supplied) Although the impingement surface in Figure 1 is oriented at an impingement angle less than 90 degrees, Line 59 of Column 3, which is part of the “Detailed Description of the Various Embodiments” in the utility patent, states: “[o]pposite the discharge surface 4 is the impingement surface 5. The impingement surface 5 is oriented at an angle 6 relative to the centerline of the orifice 3. Orienting the impingement surface 5 at an impingement angle 6 less than 90 degrees provides a restriction for fluid flowing between the discharge surface 4 and impingement surface 5. *It is understood that a range of angles can be defined between an arbitrarily oriented line and surface (e.g. plane), and the impingement angle 6 is the smallest angle that can be formed between the orifice centerline and the impingement surface 5. Fluid exiting the orifice 3 will impact the impingement surface 5. The impinging fluid forms an impingement flow upon striking the impingement surface 5. Impingement flow is an external flow (e.g. stream or jet) that is*

redirected due to impacting a surface at an impingement point. The impingement flow appears as a thin sheet of fluid that spreads out in all directions across the impinged surface from the impingement point. Part of the impingement flow in the nozzle 1 is forced directly out the gap between the impingement surface 5 and the discharge surface 4. Fluid is blocked in other directions by the deflection ridge 7. The deflection ridge 7 bridges the gap between the impingement surface 5 and the discharge surface 4, thereby limiting the flow to a partial circumferential angle (i.e. less than 360 degrees) around the nozzle 1.” As stated above in Claim 1, applicant claims an impingement angle of “90 degrees or less,” and the impingement angle is measured from the orifice centerline to the impingement surface. Therefore, although applicant’s proposed configuration mark does not show a surface at an angle less than 90 degrees, the surface that is shown opposite the orifice in the proposed trademark would function generally in the same manner as the impingement surface shown in Figure 1 of applicant’s utility patent, because the surface in the proposed trademark is at a 90 degree angle from the orifice centerline shown in Figure 1 of the patent, which means that the fluid exiting the orifice would still impact the surface oppositely facing the orifice in the proposed trademark, causing it to form an impingement flow upon striking that surface and ultimately creating a fluid plume or flat fan flow much the way water disperses from a garden hose when the thumb is placed over the garden hose leaving just enough room for the water to emerge. Although the configuration in the proposed trademark would result in a less precise dispersion of fluid, the fluid flow would nonetheless be similar because the water exiting the orifice would hit the surface above the orifice causing a flat, fan-like dispersion.

Lastly, in Figure 1 of Patent No. 7,108,204, the deflection ridge is shown as Reference No. 7, and is claimed in Claim 1 in the statement: “a deflection ridge, the deflection ridge bridging a gap between the impingement surface and the discharge surface, the deflection ridge defining a spray angle which limits the discharge of fluid” (U.S. Patent No. 7,108,204, Column 7, Line 3.) (emphasis supplied) Although the deflection ridge in Figure 1 contains a filleted corner and a sharp corner that intersect at an angle, the area of the spray nozzle head immediately behind Reference No. 7 would serve the same overall function as the deflection ridge in Figure 1 because it still limits the flow of the fluid emerging from the orifice to an angle less than 360 degrees, as discussed in Column 4, Line 7 of the patent. The equivalent of this area is shown in the proposed configuration trademark.

Thus, the proposed configuration trademark readily identifies the spray nozzle head, the spray nozzle body, and the discharge surface that are claimed in applicant’s utility patent. Moreover, the impingement surface and the deflection ridge in the proposed configuration trademark, while not identical in design to the impingement surface and deflection ridge shown in the various embodiments of the utility patent, serve the same general function, albeit with less precision, because they direct the water emerging from the orifice outward in a fluid plume or flat fan shape in a circumferential angle less than 360 degrees. In fact, applicant states in the utility patent that “[i]t will, of course, be understood that various modifications and additions can be made to the preferred embodiments discussed hereinabove without departing from the scope of the present invention. Accordingly, the scope of the present invention should not be limited by the

particular embodiments described above, but should be defined only by the claims set forth below *and equivalents thereof.*” (U.S. Patent No. 7,108,204, Column 6, Line 54.) (emphasis supplied) Thus, applicant includes within the scope of its invention, “equivalents” of the embodiments shown in the drawings. Since the proposed configuration trademark shows a functional equivalent of the impingement surface and the deflection ridge, these areas, in addition to the spray nozzle head, body, and discharge surface, are encompassed by the utility patent and serve the utilitarian functions outlined by applicant in the following language of the utility patent: “[a] nozzle according to the present invention can provide a very even dispersion of fluid over the coverage area 27. This characteristic of even dispersion over a given area is highly advantageous when precise amounts of fluid are to be distributed.” *Id.* at Column 6, Line 13.

Applicant argues that the functional features of the nozzle are hidden from view and that the trademark drawing includes only the non-functional features. However, the drawings in the utility patent readily identify many of the same portions of the proposed trademark, e.g. the spray nozzle head and body and the discharge surface, and the specifications of the patent further clarify these areas.

Applicant also argues that it could have designed the nozzle top “in number of various ways” and claims that the evidence attached to the various Office actions supports this conclusion. To the contrary, the evidence attached to the Office actions supports the conclusion that the nozzle design is functional. For instance, the evidence attached to the October 31, 2006, Office action from AllSpray.com discusses three different nozzle

types, one of which is highly similar in design to applicant's configuration trademark, and states that the "Flat Spray Flooding nozzles mount at a right angle to the pipe and produce a spray at an angle from the pipe. In addition, the round orifice and large, unobstructed flow passages minimize clogging problems." (See evidence attached to Office action dated October 13, 2006, at Page 11) The evidence attached to the October 31, 2006, Office action from Bex Spray Nozzles discusses the spray characteristics for each type of spray nozzle that they sell. (See evidence attached to Office action dated October 13, 2006, at Page 17) For instance, in discussing the Flooding nozzles, it states that "[a] wide, flat fan-shaped spray with low impact. The spray is deflected 75° away from the centerline of the pipe connection, as shown . . . Wherever a low impact, wide angle spray is required." *Id.* The same piece of evidence describes the "FP Series" nozzle by stating: "A flat and thin fan-shaped spray with sharp definition on all edges. This spray delivers very high impact over the area covered. The spray is deflected by angle D away from the centerline of the spray nozzle." *Id.* This evidence shows that the various nozzle designs are not aesthetic, but rather affect the spray pattern of the fluid being passed through the nozzle. These discussions about the functional differences between the various nozzle designs are also shown in the evidence from Spraying Systems Co., which was attached as Page 18 of the final Office action of June 19, 2007, as well as the Factsheet from the Ontario Ministry of Agriculture, Food and Rural Affairs (attached as Page 23 to the final Office action of June 19, 2007), the paper entitled "Sprayer Nozzles," authored by Donald R. Daum and Thomas F. Reed (attached as Page 24 to the final Office action of June 19, 2007), and the article written by Tom Dorn entitled "Sprayer Nozzle Tip Selection" (attached as Page 13 to the Denial of Request for

Reconsideration of January 14, 2008). This evidence coupled with applicant's utility patent, applicant's advertising, and the advertising of third parties discussing applicant's nozzle, establishes that applicant's proposed configuration mark is overall functional. Consequently, the burden has shifted to applicant to rebut this evidence. However, a mere statement from applicant's co-owner and three of applicant's distributors and an employee of a distributor is insufficient to overcome this strong evidence of functionality.

Applicant further argues that none of the claims of the utility patent refer to a "rounded head" and that the claimed elements are hidden under the head and that the head has no utilitarian function. Applicant then repeatedly refers to Figure 6 in the utility patent in support of this statement. However, as indicated previously, Claim 6 of applicant's utility patent unmistakably claims "a spray head removably mounted to the body, the spray head comprising: an impingement surface, the impingement surface oppositely facing the discharge surface . . . ; and a deflection ridge" (Column 7, Line 26 of Patent No. 7,108,204.) (emphasis supplied) Figure 6, which is one of several embodiments of the nozzle, focuses on the impingement surface and the deflection ridge only. Nonetheless, the description of Figure 6, which can be found at Column 5, Line 44 of the patent, begins with the language, "a spray head," and the "spray head" in Figure 6 is identified as Reference No. 8. Reference No. 8 (i.e. the spray head) is shown in its entirety in Figure 1 and encompasses not just the impingement surface and deflection ridge, but also encompasses the round head that is part of the present trademark application. Thus, the utility patent does, in fact, claim the entire nozzle head which appears in a round design. It is also important to note that applicant states in the patent,

immediately preceding the first claim, that “the scope of the present invention should not be limited by the particular embodiments described above, but should be defined only by the claims set forth below and equivalents thereof.” (Column 6, Line 57 of Patent No. 7,108,204.) Thus, Figure 6, while it may show one embodiment of the impingement surface and deflection ridge in the spray nozzle, does not represent the entire configuration for which applicant received patent protection.

Since the proposed three-dimensional nozzle configuration that is the subject of the present trademark application was, as a whole, claimed in the utility patent with a statement that such nozzles are useful in agricultural applications because they can evenly disperse a liquid agent, a prima facie case that the proposed mark is functional was established. Consequently, applicant bore the burden of establishing that the features of the proposed spray nozzle configuration, e.g. the spray head, the spray body, the discharge surface, etc., are not functional, such as by providing evidence that they are merely ornamental, incidental, or arbitrary aspects of the product or packaging. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001); *see* TMEP §1202.02(a)(v)(A), (a)(iv). Figure 6 of the utility patent does not indicate that the portions of the nozzle shown in the trademark application are merely ornamental, incidental, or arbitrary. Moreover, the evidence submitted by applicant is not sufficient to warrant a conclusion that the portions of the nozzle shown in the trademark application are merely ornamental, incidental, or arbitrary. As requested in the information requirement in the first Office action, applicant could have presented explanatory materials concerning the configuration of the proposed mark and relevant evidence

regarding the alternative designs that are available. The evidence of record simply does not address the issue of how or why the spray nozzle head, the spray nozzle body, the discharge surface, the impingement surface (i.e. the surface opposite the orifice), and the deflection ridge are non-functional.

Therefore, a review of Utility Patent No. 7,108,204 warrants a conclusion that the proposed configuration trademark is functional.

B. The advertising materials of record tout the utilitarian advantages of the design.

Applicant's advertising and the advertising materials of third-party distributors referring to applicant's nozzles, tout the utilitarian advantages of the proposed configuration mark. Applicant's own advertising is strong evidence that the matter sought to be registered is functional when it extols specific utilitarian advantages of the applied-for product or packaging configuration. TMEP §1202.02(a)(v)(B); *see, e.g., In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001).

The specimens of record submitted by applicant with its Amendment to Allege Use tout the utilitarian advantages of the nozzle design. First, the specimen submitted by applicant refers to the nozzle as a "boomless" spray nozzle, which indicates that the

nozzle as a whole is useful because it is designed to be used without a spray boom, which eliminates the cost and maintenance of spray booms. In fact, applicant states further down in the specimen that the nozzles “eliminate cumbersome boomarms.” (Specimen at 1.) Additionally, the evidence from NStock.biz also states, in reference to applicant’s nozzle, that it “eliminates the cost of spray booms and all boom maintenance.” (See evidence attached to the Office action dated October 31, 2006, at Page 14.) Therefore, applicant’s proposed nozzle configuration is useful because it eliminates the cost and maintenance requirements of spray booms.

Additionally, applicant’s advertising specimen, attached to the Amendment to Allege Use, specifically states that “[a]ll nozzles feature a multi patented round covered orifice design which improves spray pattern & distribution.” (See specimen attached to Amendment to Allege Use) Applicant suggests that the wording “round covered orifice design” refers to the orifice and not the nozzle top and suggests that the examining attorney is confused about the orifice versus the spray nozzle top, or head. However, a logical reading of that language indicates that the wording “round covered” refers to the cover over the orifice and not the orifice itself, with the round cover being the nozzle head that was claimed in the utility patent, as discussed previously. Thus, it is the round cover, i.e. the nozzle head, that is multi-patented and not the orifice that is multi-patented. Moreover, applicant’s utility patent does not mention or claim any usefulness due to the fact that the orifice is round as opposed to square or rectangular. Thus, the statement that “[a]ll nozzles feature a multi patented round covered orifice design which improves spray pattern & distribution” refers to the cover over the orifice, which is the spray head.

Consequently, applicant's own specimens tout the utilitarian advantages of the spray nozzle.

Applicant's advertising specimen also states that "[a]ll nozzles produce a very even large droplet spray pattern." *Id.* Further down under the listing of benefits, applicant states that the nozzles "eliminate cumbersome boomarms," "reduce manufacturing costs," "reduce packaging costs," "reduce freight damage," and "simplify end user final assembly." *Id.* Thus, each of these statements in applicant's advertising materials tout the utilitarian advantages of applicant's proposed spray nozzle configuration.

In addition to applicant's advertising materials, the advertising materials of third parties discussing applicant's nozzle tout the utilitarian advantages of the nozzle configuration. The evidence of record from NStock.Biz, in referring to applicant's spray nozzle, states: "[p]roduces heavy droplet pattern for minimal drift and better crop penetration. Easily spray around obstacles and over uneven terrain. Superior spray pattern with even distribution over the entire pattern. Eliminates the cost of spray booms and all boom maintenance." (See Pages 14 and 15 attached to the Office action dated October 13, 2006.)

Consequently, applicant's own advertising materials and the advertising materials of third parties referring to applicant's proposed nozzle configuration tout the utilitarian advantages of applicant's proposed spray nozzle configuration.

Based on the evidence shown in applicant's utility patent and the advertising materials of applicant and third party distributors of applicant's goods, the proposed configuration trademark is functional, and the refusal of registration should be affirmed on that basis pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5).

II. THE EVIDENCE IN SUPPORT OF THE CLAIM OF ACQUIRED DISTINCTIVENESS IS INSUFFICIENT TO OVERCOME THE NON-INHERENTLY DISTINCTIVE CONFIGURATION REFUSAL.

The evidence submitted by applicant in support of the claim of acquired distinctiveness is insufficient to overcome the refusal on the basis that the mark fails to function due to its non-inherently distinctive nature because the proposed mark is functional, the claim of substantially exclusive and continuous use for five years is inappropriate for a product design mark, and the actual evidence does not show that the public perceives the proposed mark as a source-identifier.

Product design marks may only be registered upon a showing of acquired distinctiveness. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores Inc. v. Samara Brothers 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).

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.

An applicant can present any competent evidence to establish that a mark has acquired distinctiveness. However, the amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985); TMEP §1212.01.

There are generally three types of evidence that can be used to establish acquired distinctiveness:

- (1) A **claim of ownership of one or more prior registrations** on the Principal Register of the same mark for goods and/or services that are the same as or related to those named in the pending application. 37 C.F.R. §2.41(b); *see* TMEP §§1212.04 *et seq.*;
- (2) A verified statement by the applicant that the mark has become distinctive of the applicant's goods and/or services by reason of substantially exclusive and continuous **use in commerce by the applicant for the five years** before the date when the claim of distinctiveness is made. 37 C.F.R. §2.41(b); *see* TMEP §§1212.05 *et seq.*; or

- (3) **Actual evidence** of acquired distinctiveness. 37 C.F.R. §2.41(a); TMEP §1212.06. Such evidence may include the following: examples of advertising and promotional materials that specifically promote the applied-for mark as a trademark or service mark in the United States; dollar figures for advertising devoted to such promotion; dealer and consumer statements of recognition of the applied-for mark as a trademark or service mark; and any other evidence that establishes recognition of the applied-for mark as a source-identifier for the goods and/or services. *See* TMEP §§1212.06 *et seq.*

TMEP §1212.

In most cases, applicant can provide one or any combination of these types of evidence. Depending on the type of mark and the facts in the record, a claim of ownership of a prior registration or a claim of five years' substantially exclusive and continuous use in commerce *may* be insufficient to establish a prima facie case of acquired distinctiveness. Actual evidence of acquired distinctiveness can be submitted regardless of the length of time the mark has been used. *See Ex parte Fox River Paper Corp.*, 99 USPQ 173 (Comm'r Pats. 1953).

In the present case, applicant's statement of substantially exclusive and continuous use in commerce for at least five years and the actual evidence submitted by applicant are insufficient for a claim of acquired distinctiveness because (1) the mark is functional, (2) applicant's proposed mark is a non-distinctive product shape, and (3) the actual evidence

does not show that *in the minds of the public* applicant has become associated with the nozzle configuration.

A. No amount of evidence of acquired distinctiveness is sufficient to overcome a functionality refusal.

The evidence of acquired distinctiveness is unnecessary because no amount of evidence is sufficient to overcome a functionality refusal. “Evidence of distinctiveness is of no avail to counter a de jure functionality rejection.” *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). As discussed previously, applicant’s proposed configuration trademark is, as a whole, functional because several features of the proposed trademark are useful in that they enable the nozzle to disperse fluids in a shape that is beneficial for agricultural uses. Since the proposed trademark is functional, no evidence of acquired distinctiveness, regardless of the quality or amount, will be sufficient to overcome the refusal under Trademark Act Section 2(e)(5).

B. The statement by applicant that the mark has become distinctive of the applicant’s goods by reason of substantially exclusive and continuous use in commerce for five years is insufficient.

The statement by applicant that the mark has become distinctive of the goods by reason of substantially exclusive and continuous use in commerce for at least five years is not sufficient to establish acquired distinctiveness in product design cases. “For matter that does not inherently function as a mark because of its nature (e.g., nondistinctive product

container shapes, overall color of a product, mere ornamentation), evidence of five years' use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness." TMEP §1212.05(a) (citing *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142 (TTAB 1990); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990); *In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985); *In re Craigmyle*, 224 USPQ 791 (TTAB 1984)). As stated previously, product designs are inherently non-distinctive. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores Inc. v. Samara Brothers 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). Therefore, since applicant's proposed mark is a non-distinctive product shape or design, applicant's statement that the mark has become distinctive of the goods by reason of applicant's substantially exclusive and continuous use in commerce for five years has no bearing on the non-inherently distinctive product design refusal and should not be considered.

Moreover, even if this statement were to be considered, the evidence of record shows that the nozzle top configuration shown in applicant's proposed mark is frequently used by other manufacturers and even appears to be identified as a type or class of nozzles. For instance, the evidence from Spraying Systems Co. shows a nozzle with a "round covered" orifice design under the class of nozzles termed "Flat Spray" nozzles. (See

evidence attached to Office action dated June 19, 2007, Page 18.) Likewise, the evidence from AllSpray.com shows the same round covered orifice design in connection with a class of nozzles termed “Flooding” nozzles, which are “Flat Spray Flooding nozzles.” (See evidence attached to Office action dated June 19, 2007 Page 3.) The evidence from nozzle manufacturers Bete Products and Bex Spray Nozzles also shows a similar nozzle. (See evidence attached to Office action dated June 19, 2007, Pages 14 and 10, respectively.) Therefore, the evidence of record shows that applicant’s use of the nozzle configuration has not been substantially exclusive.

For the foregoing reasons, applicant’s statement of five years’ use should be deemed insufficient to show acquired distinctiveness.

C. The actual evidence submitted by applicant does not warrant a conclusion that acquired distinctiveness has been established in the minds of the public.

Applicant’s actual evidence in support of the claim of acquired distinctiveness is not sufficient to overcome the refusal because it fails to show that the public associates the nozzle configuration with applicant exclusively. “An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner’s method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985).

Applicant's evidence of acquired distinctiveness consists of a statement from applicant's co-owner, Thomas Les Johnson, the statements of three sprayer equipment manufacturers/distributors and one employee of a sprayer equipment manufacturer/distributor, and advertising material from six spray nozzle retailers, including a retailer based not in the United States but in Canada. This evidence does not establish that the mark has acquired distinctiveness indicating the origin of the goods *in the minds of the public* because spray nozzle distributors and retailers do not constitute the "public." The "public," in this case, would be the buyers of the spray nozzles, such as local and industrial farmers/ farms and similar agricultural businesses.

Moreover, the evidence simply does not show that applicant is viewed as the source of the nozzle configuration shown in the proposed mark, particularly since other manufacturers such as Bete Products and Bex Spray Products manufacture the same round head nozzle. Instead, applicant's actual evidence merely shows that distributors and retailers sell applicant's nozzles.

Therefore, applicant's evidence in support of the claim of acquired distinctiveness is insufficient to overcome the finding that applicant's proposed configuration mark fails to function.

Consequently, the refusal of registration of the proposed configuration mark on the ground that the proposed mark comprises a configuration of the goods that is not

inherently distinctive should be affirmed because the proposed mark fails to function as a source-identifier. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127.

CONCLUSION

Based on the evidence of record, the examining attorney respectfully requests that the refusal of registration pursuant to Trademark Act Section 2(e)(5) on the ground that the proposed configuration mark is functional be affirmed. Additionally, based on the evidence of record, the examining attorney respectfully requests that the refusal under Trademark Act Sections 1, 2, and 45 on the ground that the proposed configuration mark fails to function be affirmed.

Respectfully submitted,

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