

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed:
July 17, 2009
jtw

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Woodlink, Ltd.

Serial No. 78971622

Christine Lebron-Dykeman of McKee, Voorhees & Sease, PLC
for Woodlink, Ltd.

Drew Leaser, Trademark Examining Attorney, Law Office 112
(Angela Bishop Wilson, Managing Attorney).

Before Holtzman, Walsh and Ritchie, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Woodlink, Ltd. (applicant) has applied to register the
mark shown below on the Principal Register for goods
identified as "bird feeder" in International Class 21.¹



The application includes the following statements:

¹ Application Serial No. 78971622, filed September 11, 2006, claiming first use anywhere and first use in commerce in 1986.

Serial No. 78971622

The mark consists of a configuration of a bird feeder that comprises a cylindrical feeding tube and a top and bottom base.

Color is not claimed as a feature of the mark.

and

The lining in the drawing serves only to show contours and not to indicate color.

Applicant also submitted a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), although the electronic record does not reflect the claim. For clarity, we will refer to applicant's mark as the Cylindrical Tube Bird Feeder Design.

The Examining Attorney has issued a final refusal, first under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the grounds that the Cylindrical Tube Bird Feeder Design is functional,² and also, under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, on the grounds that the Cylindrical Tube Bird Feeder Design is not distinctive. That is, the Examining Attorney also determined that applicant has failed to show that the Cylindrical Tube Bird Feeder Design has acquired

² The use of the term "functional" in this opinion means "de jure functional" as discussed in cases, such as, *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). As the Board has stated, "... if the design of a product is so utilitarian as to constitute a superior design which others in the field need to be able to copy in order to compete effectively, it is de jure functional and is precluded from registration as a matter of public policy." *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1338 (TTAB 1997) (citations omitted).

Serial No. 78971622

distinctiveness under Trademark Act Section 2(f) in the event the Cylindrical Tube Bird Feeder Design is found not functional.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs.³

We affirm on both grounds.

Functionality

Trade dress, including product designs, may be protected and registered as trademarks subject to certain conditions. *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1004 (2001). The Supreme Court has consistently proceeded with caution in according trademark protection to product designs. In *TraFFix* the Supreme Court states: "And in *Wal-Mart, supra*, we were careful to caution against misuse or over-extension of trade dress. We noted that product design almost invariably serves purposes other than source identification." *Id.*, citing, *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000).

In this case we must consider whether the Cylindrical Tube Bird Feeder Design satisfies the most basic condition to qualify for registration as a trademark, the

³ The current examining attorney assumed responsibility for the application at the time of this appeal.

"functionality" test. As we noted, the functionality doctrine guards against the "misuse" or "over-extension" of trademark protection for product designs.

In *Valu Engineering*, the Court of Appeals for the Federal Circuit confirmed that its long-standing test for determining whether a particular product design is functional remained viable after *TrafFix*, stating, "We do not understand the Supreme Court's decision in *TrafFix* to have altered the *Morton-Norwich* analysis." *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002). See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

The Federal Circuit and its predecessor court, the Court of Customs and Patent Appeals, have applied the *Morton-Norwich* test in functionality determinations for more than twenty-five years. *Morton-Norwich* identifies the following factors to consider in determining whether a particular product design is functional: "(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.”

Morton-Norwich, 213 USPQ at 15-16.

In *TrafFix*, the Supreme Court addressed and clarified the proper weight to be accorded utility patents in that analysis, as well as the role of alternative designs. *TrafFix Devices Inc. v. Marketing Displays Inc.*, 58 USPQ2d at 1005. The Supreme Court notes, “A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features claimed therein are functional... 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.” *Id.* As to the role of alternative designs, the Federal Circuit observes in *Valu Engineering*:

Nothing in *TrafFix* suggests that consideration of alternative designs is not properly a 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 1428 (footnote omitted).

Accordingly, in this case we must analyze the Cylindrical Tube Bird Feeder Design according to the *Morton-Norwich* factors to determine whether the Cylindrical Tube Bird Feeder Design is functional.

The "Mark" at Issue

As a starting point, we note that applicant has described its Cylindrical Tube Bird Feeder Design mark broadly. The drawing of the Cylindrical Bird Feeder Design likewise provides limited detail as to the mark claimed.

In fact, the Examining Attorney asked applicant to provide greater detail as to the mark it claimed, but applicant declined to do so. Applicant stated, "Applicant respectfully submits that the mark as provided intentionally reflects that all elements of the mark as depicted are claimed. Therefore, Applicant did not submit a substitute drawing, as it accurately reflects the claimed configuration." Applicant's Response of October 11, 2007. Consequently, we must construe applicant's claimed mark to include any bird feeder within applicant's broad depiction and description in determining whether the Cylindrical Tube Bird Feeder Design is functional. See 37 C.F.R.

Serial No. 78971622

§ 2.52(b)(4). See generally *In re Controls Corp. of America*, 46 USPQ2d 1308, 1312 (TTAB 1998); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983).

In a previous case this Board has noted the serious problems with the issuance of a registration for a product-design mark with ambiguities in either the description of the mark or the features claimed. The Board stated, "A registration of the instant configuration without any formal description of applicant's mark or explanation of the elements which applicant claims function as its mark would, we believe, hinder competitors who would not know if the features which they are using in their products, whose overall configurations are not dissimilar from that of the applicant, subject them to a suit for trademark infringement." *In re R. M. Smith, Inc.*, 219 USPQ 629, 633-34 (TTAB 1983), *aff'd*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). The lack of detail regarding the specific features applicant claims presents a similar concern in this case.

The bird feeder applicant depicts and describes corresponds to a category of feeders delineated as "tube feeders" as distinct from other types, such as, platform feeders and hopper feeders. The Examining Attorney has provided descriptions of various types of bird feeders from several sources, including the birds.cornell.edu web pages.

Serial No. 78971622

See Attachment to Office Action of November 15, 2007. The birds.cornell.edu web pages, in relevant part, state:

Tube feeder

A tube feeder is a hollow cylinder, often made of plastic with multiple feeding ports and perches. Tube feeders keep seeds fairly dry, and they are somewhat squirrel resistant. Their attractiveness to various bird species depends on the size of the perches under the feeding ports.

...

Nyjer Feeder

Nyjer feeders are special tube feeders designed with extra small openings to dispense tiny nyjer seeds, also known as thistle seeds. These feeders attract a variety of finches.

Thus, the Cylindrical Tube Bird Feeder Design in this application, described simply as "a bird feeder that comprises a cylindrical feeding tube and a top and bottom base," encompasses virtually any bird feeder in the "tube feeder" category.

Applicant's specimen shows an example of the specific type of tube feeder applicant offers, as depicted in the drawing:



The functional aspects of applicant's Cylindrical Tube Bird Feeder Design are apparent from a simple examination of the specimen. The cylindrical tube of wire mesh not only holds the feed but keeps it dry; it also provides a perch from which birds may access the feed. As shown, the birds extract the feed through the holes in the wire mesh. The wire-mesh tube also protects the feed from hungry squirrels and other rodents. In fact, applicant's drawing and description of its mark are broad enough to encompass other types of tube feeders, potentially even extending to those with plastic tubes. The "top" of the feeder covers the tube with a pitched, somewhat bell-shaped or bulbous lid which also protects the feed from both the elements and

hungry squirrels and other rodents. The "bottom base" provides another perch.

Applicant also submitted literature related to the product. It states, "One of the most versatile and squirrel-proof feeders available." See Attachment to Applicant's Response of August 3, 2007. Literature applicant submitted from "Backyard Chirper" also discusses the advantages of wire mesh: "These mesh feeders are surrounded by wire or mesh and have several benefits over traditional feeders. They attract both clinging and perching birds, are resistant to squirrel damage and help protect birds from avian diseases. The mesh design also allows rain and snow to drain easily through the feeder, keeping your birdseed fresh and dry."⁴ *Id.*

The functional aspects of applicant's Cylindrical Tube Bird Feeder Design are readily apparent even without a detailed technical analysis of the claimed mark. This is true whether we view the identified features alone or as a whole. With that background, we will proceed to consider the *Morton-Norwich* factors.

⁴ In his brief, the Examining Attorney also references numerous descriptions of the features and advantages of tube feeders from various sources. Examining Attorney's Brief at 6-7.

Utility Patents

The Examining Attorney argues that the Cylindrical Tube Bird Feeder Design incorporates features covered by U.S. Patent Nos. 5207180 ("the '180 Patent"), 2591126 (the '126 Patent) and 7302911 ("the '911 Patent"). See Attachments to Final Office Action of July 14, 2008.

Applicant has not addressed the patents the Examining Attorney references, as such, in its brief or elsewhere in the record. Applicant merely argues in its brief that neither applicant nor its predecessor have ever held a design patent for the Cylindrical Bird Feeder Design. In an affidavit applicant also states, "The design of this present application has never been the subject of either a design or utility patent, including existing and/or expired patents, nor has it ever been the subject of a design or utility patent application, including pending or expired applications." Affidavit of David Nylén, Applicant's President, dated August 2, 2007, attached to Response of August 3, 2007.

Applicant is not the owner of the utility patents the Examining Attorney references, but as the Examining Attorney correctly asserts, this in no way detracts from their relevance. *In re Virshup*, 42 USPQ2d 1403, 1405 (TTAB

Serial No. 78971622

1997). The patents are nonetheless probative of the potential functionality of the Cylindrical Tube Bird Feeder Design.

The Summary of the Invention in the '180 Patent states, in relevant part, "An object of the invention is to provide a squirrel proof bird feeder by providing a container with s shaped bulbous roof... disposed above the bird feeder that prevents squirrels and other rodents from climbing down an outside portion of the bell-shaped construction, but which allows birds to use their slender beaks to enter openings or feed presenters in a lower more tapered portion of the feeder housing to get access at the feed." This patent illustrates the utility of the protective top portion of applicant's Cylindrical Tube Bird Feeder Design, as well as the utility of the mesh tube to provide selective access to the feed - birds only.

The Summary of Invention in the '911 Patent states, in relevant part:

Two embodiments of a bird feeder of the tube-type are disclosed. In one embodiment, the feeder includes an elongated, hollow tubular member having upper and lower ends, adapted to have animal feed inserted therein. The upper end of the tubular member is open, but is selectively closed by a closure member such as a cap or cover. The tubular member is comprised of a mesh material which defines a plurality of square or rectangular feed openings formed therein.

Serial No. 78971622

In the Description of Related Art, the '911 Patent states, "Many types of bird feeders of the tube type have been previously provided wherein the feeder body is comprised of a relatively rigid screen material or mesh material which define rectangular or square openings not only to enable birds to cling thereto but to permit birds to feed therefrom."

Here too, the patent demonstrates the utility of the top and of the mesh tube to provide a perch and selective bird access to the feed.

Accordingly, we conclude that the referenced patents are clear evidence that applicant's Cylindrical Tube Bird Feeder Design is functional. Furthermore, we conclude that this is a case like *TraFFix* where the patents provides "strong evidence" that the product design is functional. *TraFFix Devices Inc. v. Marketing Displays Inc.*, 58 USPQ2d at 1005. Although the patent evidence by itself could suffice to establish that applicant's mark is functional, we will examine the other *Morton-Norwich* factors. Before doing so, we also hasten to add that, even without the patent evidence, based on other evidence, we would conclude that applicant's Cylindrical Tube Bird Feeder Design is functional.

Advertising

Under this factor, we consider materials in which applicant may tout the utilitarian advantages of the product design. This evidence related to this factor is not voluminous in this case, but it is unambiguous and telling. First, as we noted above, applicant itself identifies its product in a way which touts the utilitarian advantages of the design. In its advertising applicant states, "One of the most versatile and squirrel-proof feeders available." See Attachment to Applicant's Response of August 3, 2007.

Also, the sunriseseds.com web pages provide descriptions of applicant's various tube feeders and other products. One product description related to the "Woodlink Mini-Magnum Thistle Feeder" states, "Birds may perch at the feeder tray or cling to the feeder tube while enjoying the protection of the ... metal feeder roof. The screen tube is made of durable, black wire mesh. The wire mesh keeps the seed level visible at all times and the feeder tray's drainage holes keep seed fresh and dry." Attachment to Final Office Action of July 14, 2008. This description also touts the utilitarian advantages of the product

Serial No. 78971622

design. *See In re Caterpillar Inc.*, 43 USPQ2d 1335, 1340 (TTAB 1997).

Accordingly, we conclude that the advertising evidence shows that applicant's product design is functional.

Alternative Designs

Next, for completeness, we consider evidence related to "the availability to competitors of functionally equivalent designs."

Applicant argues that there are numerous alternative designs for bird feeders. Applicant has provided numerous examples of feeders other than tube feeders, as well as tube feeders which differ somewhat in appearance from the Cylindrical Tube Bird Feeder Design. However, tube feeders as a group offer distinct utilitarian advantages over other types of feeders, as the description of tube feeders we noted above demonstrates. Furthermore, again, applicant's drawing and description of its claimed mark are sufficiently broad to cover virtually any tube-type feeder. Furthermore, the sum of the features incorporated in applicant's Cylindrical Tube Bird Feeder Design result in an overall design which is functionally superior.

Accordingly, based on all relevant evidence of record we conclude that there are no significant alternative

Serial No. 78971622

functionally equivalent designs to the Cylindrical Tube Bird Feeder Design.

Simpler or Cheaper Method of Manufacture

Applicant has provided an affidavit from its president which states, "The design of this particular bird feeder is no less costly or labor intensive than the design of any other bird feeder, but is instead designed to be simply more aesthetically pleasing." Affidavit of David Nysten, Applicant's President, dated August 2, 2007, attached to Response of August 3, 2007. Apparently, this evidence is offered to establish that applicant's product design does not result in a "comparatively simple or cheap method of manufacturing the product." Even if applicant's design is no more expensive to manufacture than other bird feeders, the functional advantages of applicant's product nonetheless afford applicant a competitive advantage. *Cf. In re American National Can Co.*, 41 USPQ2d 1841, 1844-45 (TTAB 1997). Therefore, we conclude that this factor is neutral.

Applicant's Other Functionality Arguments

Applicant also argues that the Cylindrical Tube Bird Feeder Design mark is not functional because the USPTO previously permitted the registration of essentially the same mark in Registration No. 1767500. Applicant's

Serial No. 78971622

predecessor owned the registration applicant references. The registration issued on April 27, 1993 and expired at the end of the first 10-year term. In general, a canceled registration has no probative or other value. Cf.

Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989). Furthermore, we must decide each case on its unique facts and record.

Actions by examining attorneys in other applications do not dictate our determination in this case. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Accordingly, we reject applicant's arguments based on the prior, expired registration.

Applicant also argues that the Cylindrical Tube Bird Feeder Design is registrable because a competitor has recognized this product design as a mark. Specifically, applicant states that its predecessor filed a legal action against a competitor alleging, among other things, violation of its trademark rights in the product design at issue here. Applicant also provided evidence that the competitor entered into a license agreement in the settlement of the case which provides for the competitor's use of the product design for a royalty. See Attachment to Response of August 3, 2007. In view of the entire record here, we do not find this evidence probative of the

Serial No. 78971622

functionality of the Cylindrical Tube Bird Feeder Design. The fact that applicant was able to settle a case based on this agreement lacks probative value. Accordingly, we also reject this argument.

The Cylindrical Tube Bird Feeder Design is Functional

Finally, based on all of the evidence of record we conclude that the Cylindrical Tube Bird Feeder Design is functional. We conclude so whether we view the Cylindrical Tube Bird Feeder Design as a whole or according to the particular elements applicant depicts and describes in the application. As the Federal Circuit has stated, "The case law of this court and its predecessor also establishes that before an overall product configuration can be recognized as a trademark, the *entire* design must be arbitrary or non de jure functional. *Petersen Mfg. Co. v. Central Purchasing Inc.*, 740 F.2d 1541, 1550, 222 USPQ 562, 569 (Fed. Cir. 1984); *In re Minnesota Mining and Mfg. Co.*, 335 F.2d 836, 142 USPQ 336 (CCPA 1964). The reason for this rule is self evident - the right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were accorded trademark protection because they included a few arbitrary and nonfunctional features. See *Petersen Mfg. Co.*, 740 F.2d at 1550, 222 USPQ at 569; *In re R. M. Smith*, 734 at 1484, 222

Serial No. 78971622

USPQ at 2-3." *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985). See also *In re Vico Prods. Mfg. Co., Inc.*, 229 USPQ 364 (TTAB 1985). In this case, applicant has not identified, nor can we identify, any arbitrary and nonfunctional features which would render the Cylindrical Tube Bird Feeder Design nonfunctional. Thus, we conclude that the Cylindrical Tube Bird Feeder Design mark is functional.

Acquired Distinctiveness

As we indicated, the Examining Attorney also evaluated applicant's evidence that the Cylindrical Tube Bird Feeder Design had acquired distinctiveness under Section 2(f) in the event we found the Cylindrical Tube Bird Feeder Design not functional. The Examining Attorney found the evidence insufficient. We have also considered that evidence and concur with the Examining Attorney. Applicant has devoted only one paragraph in its brief to this issue.⁵ To afford applicant its due, we assume applicant wishes to rely on all relevant evidence of record for the purpose of our consideration of its claim of acquired distinctiveness,

⁵ To the extent applicant had argued during prosecution of the application that the Cylindrical Tube Bird Feeder Design is inherently distinctive, we note that trade dress for products can never be inherently distinctive. *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000).

Serial No. 78971622

including evidence it does not specifically discuss in its brief.

In its attempt to show acquired distinctiveness, applicant relies on its long use and repeat sales of its product, as well as eleven affidavits from bird-feeder retailers.

With respect to sales, applicant has not even provided information regarding the level of sales, only the assertion that there are "repeat sales." *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1987 (TTAB 2009). Even a high level of sales is of little probative value in a case such as this; high sales do not necessarily translate into recognition of trade dress as a mark. *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992); *Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998).

With regard to applicant's claim of use since 1986, a mere statement of long use is not generally accepted in applications to register trade dress; applicants face a heavy burden in such cases. *See In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000) and cases cited therein. Under the circumstances of this case, where applicant asserts use for about twenty-three years, the claim of long use, by itself or in combination with

Serial No. 78971622

applicant's other evidence, has little probative value. *Stuart Spector Designs Ltd. et al. v. Fender Musical Instruments Corp.*, __ USPQ2d __, Opposition No. 91161403 et al., Slip Opinion at 60 (TTAB, March 25, 2009) (fifty years use held insufficient to show guitar design mark had acquired distinctiveness). As we noted, the burden for the purpose of showing acquired distinctiveness is especially high in this case due to the broad description of applicant's claimed mark.

With regard to the retailer affidavits, we first note that each affidavit follows the exact same form. The most relevant paragraphs state:

5. That, to the best of my personal knowledge, the Magnum Feeder such as depicted above has been on sale for a number of years and has met with success in this market and has generated repeat sales.

6. That I have customers who have indicated to me that they recognize the distinct shape depicted above and have bought this feeder because of the good will they associated with the unique and distinctive configuration.

Attachments to August 3, 2007 Response. We find this evidence lacking in probative value in both quality and quantity. While we do not reject form statements of this type out of hand, we must examine the details to weigh their probative value. We find that much of the wording in the form affidavits to be in the form of legal conclusions,

for example, "... good will they associated with the unique and distinctive configuration." This detracts from the probative value; it suggests that the affiants may not have fully understood the import of this language. *Cf. In re Ferris Corp.*, 59 USPQ2d 1587, 1692 (TTAB 2000).

Furthermore, the fact that the affidavits are not directly from the ultimate purchasers of applicant's goods further diminishes their probative value. *In re Udor U.S.A. Inc.*, 89 USPQ2d at 1987. Rather, the retailers are reciting what their customers have allegedly said to them. This too diminishes the probative value. Also, the affidavits are relatively few in number. Overall, we find the affidavits are insufficient to show acquired distinctiveness, whether considered alone or along with the other evidence.

Accordingly, we conclude that applicant has failed to show that the Cylindrical Tube Bird Feeder Design has acquired distinctiveness.

Decision: We affirm the refusal to register the Cylindrical Tube Bird Feeder Design mark under Trademark Act Section 2(e)(5), and we also affirm the refusal to register based on applicant's failure to show acquired distinctiveness for the Cylindrical Tube Feeder Design under Trademark Act Sections 1, 2, and 45.