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Subject: U.S. TRADEMARK APPLICATION NO. 85065887 - N/A - EXAMINER
BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85065887

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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the proposed mark, a three-dimensional configuration of an exercise hoop, for use with "exercise and toy hoop." Registration was refused because the proposed mark was functional under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5). In response to the examining attorney's final requirement, the applicant submitted an acceptable mark description.

FACTS

The applicant applied for registration, on the Principal Register, of a three-dimensional configuration of an exercise hoop having wavy ridges on inner circumference for use with "exercise and toy hoop" in International Class 28. The

examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), on the ground that the proposed mark is functional, or alternatively, that applicant's configuration has not acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f) and would not be perceived as a mark under §§ 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127. The examining attorney also required the applicant to submit an acceptable description of the mark. The applicant traversed the refusals and argued, therein, that the mark was not functional and that the configuration had acquired distinctiveness based on exclusive use, sales, and advertising expenditures, and therefore, was entitled to registration under Section 2(f). The applicant also submitted an unacceptable mark description. Thereafter, the examining attorney accepted the applicant's claim of acquired distinctiveness, but issued a final refusal with regards to the refusal under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5). The examining attorney also made final the requirement for an acceptable mark description. The applicant timely appealed. The applicant's appeal brief included an amended mark description, which upon review, obviates the requirement specified in the final Office action. Therefore, the sole issue on appeal is the refusal under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5).

ARGUMENTS

I. APPLICANT'S WAVY RIDGE DESIGN IS FUNCTIONAL UNDER SECTION 2(e)(5) OF THE TRADEMARK ACT

Registration is refused because the applied-for mark, which consists of a three-dimensional configuration of the goods, appears to be a functional design for such goods. Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); *see* TMEP §1202.02(a)-(a)(ii). A

feature is functional if it is “essential to the use or purpose of the [product]” or “it affects the cost or quality of the [product].” *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); TMEP §1202.02(a)(iii)(A).

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).

The proposed mark is the “the configuration of the goods, namely a circular exercise hoop, with the unique shape of the wavy ridges on the inner circumference of the exercise hoop,” and the goods are identified as “exercise and toy hoop.”

Applicant avers that the present application has never been the subject of a utility patent, but has been the subject of a design patent. According to the applicant, the existence of a design patent provides presumptive evidence that the applicant’s design is not merely functional. The examining attorney must respectfully disagree for a number of reasons.

First, a configuration of a product or product packaging that has been the subject of a design patent is evidence of nonfunctionality; however, this can be outweighed by other evidence of functionality. TMEP §1202.02(a)(v)(A); *see In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Am. Nat'l Can Co.*, 41 USPQ2d at 1843. Indeed, the functionality doctrine exists to encourage legitimate competition by retaining the proper balance between trademark law and patent law. The Supreme Court stated in *Qualitex*:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the [*4] province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity). That is to say, the Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

514 U.S. at 164-165, 34 USPQ2d at 1164.

Despite the fact that applicant contends that it seeks to register the “non-functional design features” of its product, the design features of its product do in fact appear to serve a utilitarian purpose based upon matter contained in the design patent as well as applicant’s marketing materials, which repeatedly tout the utilitarian advantages

of the proposed hoop design. The applicant's design patent, U.S. Design Patent No. 399969, is entitled "MASSAGE HOOP;" the patent covers the ornamental design of a massage hoop; and Figure No. 3 in the patent depicts a person moving or exercising with the hoop with a wavy or ridged inner surface. *See* TICRS Incoming May 30, 2011, pages 13-14. These factors, when combined, suggest that there are utilitarian aspects of the design which are essential to the purpose of the massage hoop and are more central to the product's purpose than its appearance.

As additional evidence of functionality, in the examining attorney's June 23, 2011 final office action, the examining attorney made of record advertisements that tout the utilitarian functions of the wavy ridges of the applicant's hoops. According to an advertisement for the applicant's ACU LOOP goods:

Unique wavy design inside the loop makes the hoop easier to stay on your body and better workouts to your muscles.

Emphasis added. See TICRS Office action Outgoing, June 23, 2011, page 3, attached Google's cache of <http://beauty008.en.made-in-china.com/product/MolnOzyKQBkS/China-Weighted-Massage-Hula-Hoop-HL-612-1-.html>.

Applicant's website touts the utilitarian feature of the hoops, noting that

The ACU hoop is made from plastic and is covered in foam rubber padding. It has ridges on the inside lining of the hoop. *The ridges are designed to be helpful to the user to maintain the hoop on their body consistently.*

Emphasis added. See TICRS Office action Outgoing, June 23, 2011, page 5, attached GOOGLE cache from Applicant's website's Frequently Asked Questions Section.
http://www.sports-hoop.com/product_sportshoop/page_sh_frequentlyasked.aspx.

The applicant's video introduction for the goods also demonstrates that the applicant touts the utilitarian features specified in the trademark application. See link shown at TICRS Office action Outgoing, page 7, http://www.sports-hoop.com/product_sportshoop/page_sh_productfeature.aspx.

The video introduction for the POWER HOOP includes the following narrative:

POWER HOOP. Function, design and material. *The ridges designed inside the hoop make the POWER LOOP much easier to swing. It stays on your waist longer than the traditional HULA HOOP. The ridges also work like fingers, massaging your waist while you use the hoop.* It trims your waist quickly and effectively.

Emphasis added.

The video introduction for the WAVY HOOP includes the following narrative:

WAVY HOOP. Function, design and material. The *ridges* and rough surface *design inside the hoop makes the WAVY HOOP easier to use than the traditional HULA HOOP. The ridges also work like fingers, massaging your waist while you are using the loop.*

Emphasis added.

Similarly, the applicant's references to patents covering the design also suggest that the applicant's wave design is superior or works better than other similar devices.

An advertisement on the packing for the goods touts that the:

Patent Acu-Punch wave design, grasp and massage your waist while you use.

See TICRS Incoming, May 30, 2011, page 45.

Another advertisement indicates that the:

Patent Wave design, grasp and massage your body while you use.

See TICRS Incoming, May 30, 2011, page 46.

The applicant's own advertising touting the utilitarian aspects of its design is often strong evidence supporting a functionality refusal. *See, e.g., In re N.V. Organon*, 79 USPQ2d 1639, 1645 (TTAB 2006) ("applicant's promotional materials touting the utilitarian advantages of the orange flavor, is particularly significant in assessing functionality in this case"); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001), TMEP § 1202.02(a)(v)(B).

Applicant argues that most of its advertisements don't tout the utilitarian aspects.

According to the applicant:

In certain instance, an applicant's advertisement which touts the utilitarian advantages of product's design can be used to support a finding of functionality. *In re Morton-Norwich Products, Inc.* 671 F.2d 1332, 1340-41. However in some cases, statements in advertising that suggest a utilitarian advantage can be explained as mere "puffing" or such advertising can be outweighed by other factors militating against functionality.

Applicant's brief at 3.

The evidence submitted by the clearly demonstrate that the applicant has touted the utilitarian advantage of its wavy ridges. The applicant does not simply puff or allege that its product is the best. The applicant instead touts a specific function of its wavy ridge design. It appears that the applicant's design does in fact provide applicant's hoops with the very benefits described in applicant's advertising.

With regards to the third and fourth *Morton-Norwich factors*, applicant has made of record a declaration signed by the applicant to support its contention that alternative designs of equal or lesser cost exist.

In *TrafFix*, the court stated:

Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. . . . There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used.

532 U.S. at 33-34, 58 USPQ2d at 1006-1007.

As such, it is of no consequence that competitors can use alternative designs if the design at issue is functional under the *Inwood* rule – i.e., if the design is necessary to the

product's use or purpose, or if the design affects the product's cost or quality. The fact that alternative designs may exist does not lead to the conclusion that applicant's wavy ridge design is not functional. In *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002), the court stated that the "Morton-Norwich factors aid in the determination of whether a particular feature is functional" and noted that "alternative designs are considered as "part of the overall mix." However, the court concluded "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." *Valu Engr., id.* at 1276, 61 USPQ2d at 1427.

A few arbitrary or otherwise nonfunctional features included within a product or packaging configuration mark do not affect a functionality determination where the evidence shows the overall design to be functional. See *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1024-27, 224 USPQ 625, 628-30 (Fed. Cir. 1985); *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 368 (TTAB 1985); TMEP §1202.02(a)(v).

A mark that consists of a three-dimensional configuration of a product or its packaging is functional, and thus unregistrable, when the evidence shows that the design provides identifiable utilitarian advantages to the user; i.e., the product or container "has a particular shape because it works better in [that] shape." *Valu Engr.*, 278 F.3d at 1274, 61 USPQ2d at 1425 (internal punctuation and citation omitted); see TMEP §1202.02(a)(iii)(A).

The evidence 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).

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 at 1484, 222 USPQ at 3; TMEP §1202.02(a)(iv). However, to establish a prima facie case under §2(e)(5), it is not necessary that an examining attorney consider each of the *Morton-Norwich* factors, nor is it necessary for all four of the *Morton-Norwich* factors to weigh in favor of functionality. TMEP §1202.02(a)(v). Therefore, to establish a prima facie case that applicant's closure design is functional, it is sufficient that applicant's promotional materials clearly tout the design's utilitarian advantages.

A determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Engr.*, 278 F.3d at 1273, 61 USPQ2d at 1424; *In re Caterpillar*, 43 USPQ2d at 1339; TMEP §1202.02(a)(iv).

A determination that an applied-for configuration mark is functional 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*, 532 U.S. at 29, 58 USPQ2d at 1006; *In re Controls Corp. of Am.*, 46 USPQ2d 1308, 1311 (TTAB 1998); TMEP §1202.02(a)(iii)(A). This is certainly the case here as the proposed mark is indeed functional.

CONCLUSION

For the reasons set forth above, the examining attorney respectfully submits that applicant's proposed configuration mark comprises matter that, as a whole, is functional and provides utilitarian advantages which are outside the realm of trademark protection. Given those advantages, which applicant routinely touts, the examining attorney respectfully requests that the Board affirm the refusal to register under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5).

Respectfully submitted,

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