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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kun Yuan Lin

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Serial No. 85065887

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Alfred H. Chan of Shen & Chan, APLC for Kun Yuan Lin

Rudy R. Singleton, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

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Before Kuhlke, Shaw, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Kun Yuan Lin, an individual, applied to register on the Principal Register the mark set forth below for “Exercise and toy hoop,” in International Class 28:



The mark is described as follows: “The mark consists of 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.”¹ Color is not a feature of the mark.

The trademark examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that applicant’s proposed mark comprises matter that, as a whole, is functional.² The refusal was made final, and applicant appealed. Applicant and the examining attorney have filed briefs.

The Supreme Court has stated: “In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). The Supreme Court has called this “*Inwood* formulation” the “traditional rule” of functionality. *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The functionality doctrine is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the

¹ In response to a final requirement of the examining attorney, applicant submitted this description of the mark in his appeal brief. Applicant’s brief at 8-9. The examining attorney acknowledged and accepted the amendment in his appeal brief. Examining attorney’s brief at 2. Although applicant’s method of filing its amendment is not the preferred procedure for doing so, under these circumstances the Board treats the amendment as having been entered into the record. TBMP § 1205.01 (3rd ed., rev.1, 2012)

² The examining attorney also initially refused registration on the ground that the mark was a nondistinctive product configuration, under Trademark Act §§ 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127. However, the examining attorney later withdrew this refusal upon review of the applicant’s showing of acquired distinctiveness under § 2(f), 15 U.S.C. § 1052(f). *See* Office action of June 23, 2011. The application file has been updated to reflect the § 2(f) showing.

Supreme Court observed in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995):

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 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).

The determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009). The Federal Circuit, our primary reviewing court, looks at the following 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). These well-known "*Morton-Norwich* factors" are "legitimate source[s] of evidence to determine whether a feature is functional." *Valu Engineering*, 61 USPQ2d at 1427. However, the Supreme Court has made it clear

that the standard for functionality is set forth in *Inwood*, i.e., whether a feature is “essential to the use or purpose of the device or... affects the cost or quality of the device,” and that if functionality is properly established under *Inwood*, further inquiry into facts that might be revealed by a *Morton-Norwich* analysis will not change the result. *TrafFix*, 58 USPQ2d at 1006 (“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.”).

The relevant evidence of record in this case consists of examples of advertising and packaging for applicant’s goods; advertising for similar goods of others; and a copy of U.S. design patent No. 399,969, issued to applicant for a design that is essentially the same as the mark that applicant seeks to register.³

The evidence shows that applicant’s product is a weighted sports hoop, which is offered in several weights and sizes. A small hoop, intended for a child, is 35.5” in diameter and weighs 1.5 lb.; a larger hoop, for an adult, is 41.5” in diameter and weighs 5 lb. The hoop is circular in shape and is intended to be placed around the hips or other part of the body such as an arm, a leg, or the chest, and swung around repeatedly by means of the user’s bodily movements, providing exercise to the user. The outer circumference of the hoop is smooth and circular; the inner surface of the hoop (which is intended to have contact with the user’s body) is not perfectly circular in that it has an undulating surface.

³ All of applicant’s evidence was submitted with his response accompanying his petition to revive filed on May 30, 2011, and will be identified herein by the exhibit numbers assigned in that filing. The examining attorney submitted evidence consisting of additional samples of applicant’s advertising with his final Office action of June 23, 2011.

The examining attorney has the burden of making a *prima facie* showing that the applicant's mark is functional. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012). The examining attorney contends that the "wavy ridges" of applicant's goods function to massage the user and to help the user to maintain the position of the hoop on the user's body.⁴ The examining attorney notes that applicant's design patent is entitled "MASSAGE HOOP." The claim in that patent reads, "The ornamental design for a massage hoop, as shown and described." The examining attorney also contends that applicant's advertising for the goods touts the utilitarian features of the "wavy ridges," of applicant's hoops, and points out the following claims from applicant's advertising:⁵

* Unique wavy design inside the hoop makes [sic] the hoop easier to stay on your body and better workouts to your muscles.

...

* For fitness workout, massage and have fun.

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.

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

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

⁴ Examining attorney's brief at 5-7.

⁵ Submitted with the final Office action of June 23, 2011.

The examining attorney also urges the Board to view several online videos posted on advertising web sites of applicant. However, as these have not been made of record, we have not considered them.⁶

Applicant, in order to rebut the evidence presented by the examining attorney, addresses the four *Morton-Norwich* factors. First, applicant states that “there [has] never been a utility patent issued in connection with Applicant’s design....”⁷ This statement is not controverted by the examining attorney. Applicant is silent as to whether he has ever applied for a utility patent for the configuration at issue; however, we note that during prosecution the examining attorney required disclosure of all such applications.⁸ While the existence of a utility patent is highly significant to a functionality analysis, we consider the lack of a utility patent to be a neutral factor, as there are many reasons, other than a lack of functionality, that can explain why a utility patent has not been obtained or applied for. *See TrafFix*, 58 USPQ2d at 1007 (“Whether a utility patent has expired or there has been no utility patent at all, a product design which has a particular appearance may be functional because it is ‘essential to the use or purpose of the article’ or ‘affects the cost or quality of the article.’”).

⁶ Submitting a printout of a web page that contains a link does not effectively put in the record the material that one might find by clicking on that link. *In re HSB Solomon Associates, LLC*, 102 USPQ2d 1269 (TTAB 2012); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1219 (TTAB 2011). *See also* TMEP § 710.01(b) (2012).

⁷ Applicant’s brief at 2-3.

⁸ Office action of September 25, 2010.

To rebut the examining attorney's claim that applicant's advertising "touts" the utilitarian advantages of applicant's goods, applicant contends that what has been shown "can be explained as mere 'puffing,'" and points out that "most of Applicant's advertising materials ... do not have specific mention of Applicant's 'wavy ridge' design being inherently functionally superior to other similar designs for 'exercise hoops.'"⁹ Going further, applicant contends that the suggestion that the wavy ridges function to make the hoop stay on the body more easily is not true: "In actuality, the ridges do not serve such function. As many users recognize, to which Applicant agrees, the weight of the hoop or a larger diameter hoop makes the hoop easier to swing, keeps the momentum going, and therefore helps the hoop stay on the body."¹⁰ While the evidence does suggest that hoops of larger diameter are easier to use, we do not see any evidence to support the contention that the ridges do not serve to help the hoop stay on the body more easily. Applicant also points out that "Applicant's packaging... makes no mention of any alleged utilitarian advantages of Applicant's product design."¹¹ The evidence is consistent with this contention.¹²

Addressing the third *Morton-Norwich* factor, applicant has submitted evidence showing that at least seven competing products that do not make use of the "wavy ridges" design exist in the market, "each of which would achieve the same

⁹ Applicant's brief at 3.

¹⁰ Applicant's brief at 5.

¹¹ *Id.*

¹² Applicant's Exhibit 3.

‘function’ as Applicant’s design.”¹³ The examples of competing products include large, weighted exercise hoops that feature a variety of nodules of varying sizes and shapes, arrayed along the length of the hoop, which interrupt the smooth circularity of the hoop.¹⁴ The evidence indicates that these products are offered primarily for the same purpose and function as applicant’s goods (*i.e.*, exercise) and that they are perceived by customers as competitive alternatives to applicant’s goods. Accordingly, this factor does not support a finding of functionality.

Addressing the fourth *Morton-Norwich* factor, applicant has submitted his verified declaration regarding the costs of manufacture of his goods.¹⁵ He states that the processes for manufacturing his hoop with wavy ridges and his hoop without wavy ridges “are the same, except the injections mold being used for the wavy-ridges exercise hoops is different.”¹⁶ The cost of materials for a typical hoop with wavy ridges is \$9.25, while the cost for a hoop without wavy ridges is \$8.93. The retail price of a hoop with wavy ridges is \$31.00 on applicant’s company web site, while the retail cost of a hoop without wavy ridges is \$30.00.¹⁷ He asserts that “I do not know the exact amount of the manufacture costs for my competitors’ similar products with alternative design, but the manufacture costs and process are very similar to the manufacture costs and process of my wavy ridges exercise hoops

¹³ Applicant’s brief at 6.

¹⁴ Applicant’s Exhibit 4.

¹⁵ Submitted with applicant’s response/petition to revive filed May 30, 2011.

¹⁶ Lin affidavit ¶ 6.

¹⁷ Lin affidavit ¶¶ 3-4.

that is the subject of this trademark.”¹⁸ Applicant’s brief states that similar hoops with alternative designs sell for between \$17.93 and \$53.95.¹⁹ The evidence of record is consistent with this statement. This showing demonstrates that applicant’s configuration does not meaningfully “affect[] the cost” of the goods, effectively addressing the cost element of the *Inwood* test.

Finally, going beyond the *Morton-Norwich* factors, the applicant has made of record his U.S. design patent No. 399,969, which protects “The ornamental design for a massage hoop....”²⁰ The design set forth in this patent is essentially the same as the mark that applicant seeks to register.²¹ Applicant argues that “the existence of a design patent suggests, at least presumptively, that the design is not de jure functional,” citing *Morton-Norwich*, 671 F.2d at 1342, fn. 3.

Upon review of all the evidence, the only *Morton-Norwich* factor that potentially supports a finding of functionality is the purported touting to be seen in applicant’s advertising. However, the few instances in which applicant’s advertising makes vague references to the massaging effect of the hoop and the function of the wavy ridges to “maintain the hoop on the body consistently” are insufficient to show that the configuration of applicant’s product “is essential to the

¹⁸ Lin affidavit ¶ 7.

¹⁹ Applicant’s brief at 8.

²⁰ Applicant’s Exhibit 1.

²¹ We note that the design patent, having been granted on October 20, 1998, expired on October 20, 2012. Consequently, this case exemplifies the potential conflict of policies, noted in *Qualitex*, as between the trademark and patent laws: whether the potentially perpetual protections of trademark registration should be afforded to applicant’s design after the expiration of applicant’s time-limited patent protection.

use or purpose of the article” or “affects the... quality of the article.” *Inwood Laboratories*, 214 USPQ at 4 n.10. It is not at all clear from the evidence that massage (as opposed to exercise) is an actual “purpose” of applicant’s goods. In any event, an exercise hoop of any shape (including a smooth hoop with no nodules) would have impact on the body and exert some “massaging” effect. It is also not clear that a feature for helping to maintain the hoop on the body is “essential to the use” of applicant’s goods. Moreover, any irregularity of the inside surface of the hoop (such as a textured surface) would likely increase the friction between the hoop and the body, thereby helping to maintain the hoop on the body.

The evidence of functionally equivalent designs²² does provide some support for perceiving massage or the “maintenance function” as the purpose of the configuration of the inner surface of the hoop. The evidence shows that applicant’s competitors have designed hoops with nodules or projections on their inner surfaces. Advertisements for these third-party goods contain references to the pressure effect caused by such nodules and the maintenance function:

- Exercise with the hoop stimulates acupressure points of the waist and abdomen sufficiently....
- Elastic projections prevents the hoop from going downward during exercise....

.....

Acu-Hoop Pro is composed of a Hula-hoop with the addition of acu-pressure balls on the inner ring of the Hoop. The acu-pressure balls of the hoop have a therapeutic effect when you use it, helping you get in shape, strengthen your abdomen and lower back while

²² Applicant’s Exhibit 4.

improving your blood circulation. ... Get a great workout and massage in the comfort of your own home with the Acu-Hoop Pro!

.....

The J Fit Adjustable Weighted Hula Hoop 3 lbs has padded massaging nodules to help tone hip and stomach muscles....

.....

- You could have the pressure effect without having any pain from Passion Health Hoop.

Customer commentary regarding these third-party goods focuses on the exercise function of the hoops:

I only used this hula hoop twice... and my whole body is so sore! ... I am definitely sticking to this exercise routine!

.....

This Hula Hoop works great! ... Inches are disappearing....

.....

I have this hoop for more than 2 years, and it works for me.... Trust this hoop after two weeks of use you will see the results =)...

.....

Read the instructions before you start and yes, no pain, no gain! ...

This evidence of third-party products indicates that exercise -- not massage -- is the primary purpose of these goods and that the “maintenance effect” is little more than an incidental feature. The evidence provides scant support for the proposition that the specific configuration of applicant’s goods is essential to the use

or purpose of the article. Moreover, the fact that several different methods of configuring the inner surface of the exercise hoop are present in the market and that little is said regarding the specific benefits of any one configuration suggests that applicant's specific configuration is not essential to the use or purpose of the goods.

We have also considered the fact that applicant's design patent suggests that applicant's product has the purpose of providing massage (inasmuch as it refers to the product as a "massage hoop"). However, the design patent does not support a finding that the applicant's configuration is functional; rather, it does the opposite, as we discuss below.

We find that all of the evidence that may tend to indicate the functionality of applicant's configuration is not sufficient to make out a *prima facie* showing that applicant's mark is functional under the *Inwood* standard. However, even if we assume that the examining attorney has made out a *prima facie* showing of functionality, it is sufficiently rebutted by the applicant's design patent.

A design patent, alone, does not dispose of the question of functionality, as it can be outweighed by other evidence. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984). Design patent applications, as opposed to trademark applications, are examined under different standards of functionality and are issued in furtherance of different public policies. However, applicant's design patent shows that the U.S. Patent and Trademark Office, on a record that may well have included more evidence than we have before us now, viewed the applicant's design as "not

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dictated by function alone.” *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 148, 9 USPQ2d 1847, 1851 (1989). We have before us no evidence on the basis of which we could find otherwise.

Decision: The refusal to register is reversed. The application will be forwarded to publication for opposition.