

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: June 21, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Book to Bed, Inc.*  
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Serial No. 85262093  
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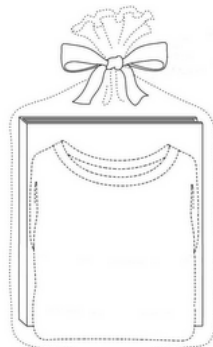
Roger N. Behle, Jr., Foley Bezek Behle & Curtis LLP for Book to Bed, Inc.

Mark Rademacher, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

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Before Kuhlke, Kuczma and Adlin, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Applicant, Book to Bed, Inc., seeks to register the following as a trademark on the Principal Register for “Children’s and infant’s apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Nightgowns; Pajamas; Sleepwear” in Class 25:



The applied-for mark is described in the application as follows:<sup>1</sup>

The mark consists of packaging for sleepwear that consists of a transparent bag enclosing a book positioned behind matching sleepwear so that the cover of the book remains partially visible from the front of the packaging, together with a ribbon positioned directly above the book and sleepwear tying the neck of the bag. The matter in dotted lines is not part of the mark and serves only to show the position of the mark.

All features except for the bow and the book are shown in dotted lines which are used only to show the position of the mark.

The examining attorney issued a final refusal to register the applied-for mark pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the “applied-for-mark consists of a nondistinctive product design or product packaging.” After the refusal was made final applicant appealed. Applicant and the examining attorney have filed briefs. For the reasons set forth below, the refusal to register is affirmed.

#### Distinctiveness

It is well-established that registrable trade dress includes product packaging and product design and that distinctiveness is a prerequisite for registration of a trade dress under § 2 of the Trademark Act, 15 U.S.C. § 1052. *Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1067 (2000). Classification of trade dress as either product packaging or product design is typically an important consideration. A product configuration or design can never

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<sup>1</sup> Application Serial No. 85262093 was filed on March 9, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming dates of first use anywhere and first use in commerce at least as early as October 1, 2005.

be inherently distinctive and proof of secondary meaning is necessary in order to obtain a registration. On the other hand, trade dress that is deemed to be product packaging may be inherently distinctive and therefore, registrable, without proof of secondary meaning. *Wal-Mart*, 54 USPQ2d at 1069-1070.

Applicant's applied-for trade dress is a book and bow, being part of a sleepwear set, with the book being positioned behind the sleepwear such that part of the book is visible, all of which is packaged in a transparent bag tied off with the bow at the top. Applicant contends that its trade dress is directed to the packaging of its product and constitutes the overall composite of the packaging.<sup>2</sup> Specifically, applicant contends that the key to its trade dress "lies in the positioning of the goods *within* and *relative* to their packaging (i.e., the books are positioned directly behind matching sleepwear so that the cover of the book remains partially visible through the front of the transparent bag, and a distinctive ribbon tying the neck of the bag is placed directly above the book and sleepwear)." (emphases original).<sup>3</sup>

The examining attorney counters that the book included as part of the applied-for mark is more than just packaging as it is an object of the consumer's purchase. As such, this renders the trade dress more akin to a product design or to nondistinctive features of a product design.<sup>4</sup> In support of his position, the examining attorney points to pages from applicant's website which show that applicant markets its product as "Pajama and Book Sets Designed from your

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<sup>2</sup> Applicant's Appeal Brief p. 1.

<sup>3</sup> Applicant's Appeal Brief p. 8.

<sup>4</sup> Examiner's Appeal Brief p. 4.

Favorite Bedtime Books.”<sup>5</sup> Notably, the website advises customers that the apparel is also sold without the book and only comes with a matching book if a gift set is ordered. Given this condition of sale, customers who purchase the gift set desire to include the book as part of their purchase. While applicant characterizes the book as part of its packaging, the examining attorney correctly argues that the book is more than just packaging; it is an object of what is offered to and purchased by customers. This is a strong indication that applicant’s trade dress is more akin to a feature of product design than product packaging. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006) (product design can consist of design features incorporated into a product).

The Supreme Court has recognized that it may be necessary to draw difficult lines between product-design and product-packaging trade dress observing that the classic *Coca-Cola* bottle may constitute packaging for those consumers who drink the beverage then discard the bottle, but may constitute the product itself for those consumers who are bottle collectors, or part of the product itself for those consumers who purchase *Coke* in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former. To the extent that there is any question as to whether a trade dress is a product design or product packaging, the Supreme Court advises courts to err on the side of caution classifying ambiguous trade dress as product design, thereby requiring proof of secondary meaning. *Wal-Mart*, 54 USPQ2d at 1070. If we classify applicant’s applied-for trade dress as a product

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<sup>5</sup> See attachment Nos. 79-81 to April 6, 2012 final Office Action.

design, the absence of any secondary meaning evidence in this case requires affirmance of the refusal to register.<sup>6</sup> However, even if we construe applicant's trade dress to constitute product packaging, the registrability of the trade dress is doomed unless it is inherently distinctive.

Unlike product configurations which are never inherently distinctive, product packaging may be inherently distinctive and registrable without proof of secondary meaning. Alternatively, product packaging that is not inherently distinctive may be registrable upon proof of secondary meaning. Applicant maintains that its trade dress constitutes inherently distinctive product packaging. As it has not submitted any secondary meaning evidence, if its trade dress is not inherently distinctive packaging, the refusal to register must be affirmed. We therefore come to the determinative issue presented in this case: whether the applied-for trade dress constitutes inherently distinctive product packaging.

For purposes of evaluating the distinctiveness of marks under § 2, inherently distinctive marks are marks whose intrinsic nature serves to identify their particular source. *Wal-Mart*, 54 USPQ2d at 1067-68, *citing Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992). Our primary reviewing court and the Board look to *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977), to determine whether a design (exclusive of product design, which can never be inherently distinctive) used in connection with

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<sup>6</sup> In the Office Action of June 16, 2011, the examining attorney advised applicant that applicant may submit evidence that the applied-for mark has acquired distinctiveness under Trademark Act § 2(f). No such evidence has been submitted.

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goods or services, is inherently distinctive. *See In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1689 (Fed. Cir. 2010); *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1122 (TTAB 2012) and *In re Right-On Co. Ltd.*, 87 USPQ2d 1152, 1155 (TTAB 2008).

*Seabrook* articulates the following factors for determining whether a design is inherently distinctive: (1) whether the design is a common basic shape or design; (2) whether the design is unique or unusual in the field in which it is used; (3) whether the design is a mere refinement of a commonly-adopted and well-known form of ornamentation for the particular class of goods viewed by the public as a dress or ornamentation for the goods; or (4) whether the design is capable of creating a commercial impression distinct from any accompanying matter, if presented together with text or other matter. *Seabrook*, 196 USPQ at 291. Any one of these factors, by itself, may be determinative as to whether the trade dress is inherently distinctive. *Chippendales*, 96 USPQ2d at 1687.

Looking to the first three factors, the evidence shows that transparent plastic wrap that is fastened at the top with a bow, including bows having a similar appearance to the bow featured in applicant's trade dress, are commonly used for packaging gift sets:

- Creative Gift Packaging Florist & Gift Basket Suppliers features clear cellophane bags for gifts and gift baskets<sup>7</sup>
- Google search results for "gift baskets bag" shows images (with accompanying descriptive text) for clear cellophane

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<sup>7</sup> See Attachment Nos. 16-17 to April 6, 2012 final Office Action from [http://www.creativegiftpackaging.com/Cellophane\\_bags\\_s/1.htm](http://www.creativegiftpackaging.com/Cellophane_bags_s/1.htm).

gift bags for gift wrapping baskets, and featuring bows cinching bags at top<sup>8</sup>

- Clear Cellophane Basket Bag “great to use for gift wrapping” with image of gift wrapped basket with bow cinching top<sup>9</sup>
- Gift Basket Wrap Bags with image of gift basket in clear cellophane bag with bow cinched at top:<sup>10</sup>



- Nashville Wraps: offering gift bags and gift wrap; shows images of gift transparent bags tied at top with bow having a similar appearance to applicant’s bow:<sup>11</sup>

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<sup>8</sup> See Attachment Nos. 19-20 to April 6, 2012 final Office Action.

<sup>9</sup> See Attachment Nos. 28-29 to April 6, 2012 final Office Action from <http://www.meijer.com/s/clear-cellophane-basket-bag/ /R-135619>.

<sup>10</sup> See Attachment Nos. 22-27 to April 6, 2012 final Office Action from <http://www.amazon.com/Gift-Basket-Wrap-Bag-Clear/dp/B003JY4NR0>.

<sup>11</sup> See Attachment Nos. 43-44 to April 6, 2012 final Office Action from <http://www.nashvillewraps.com/cello-bags/mc-019.html>.



**Cello Bags Bases**

Colorful, sturdy Bases and Cardboard inserts to fit our best-selling cello bag sizes.



**Cello Bags Designer Window**

Designer Print Cello bags will bring a designer look to your products. Bags are made in the USA.

Likewise, children’s gift sets that include books and other child-friendly items such as plush toys, personal care products and apparel including hats, booties and bath towels, are common:<sup>12</sup>

- Storybook PJs from Little Toader: Storybook PJ’s - book and pajama package:<sup>13</sup>

<http://www.littletoader.com/Storybook-PJs-book-pajama-package/dp/B003RBTYFG> 04/04/2012 01:14:28 PM



- Gift Basket 4 Kids: Elmo Gift Basket: includes books, card game, rain poncho, plate, cup and bowl, stickers:<sup>14</sup>

<sup>12</sup> See for example, Attachment Nos. 45-47, 56-57 to April 6, 2012 final Office Action.

<sup>13</sup> See Attachment No. 8 to April 6, 2012 final Office Action from <http://littletoader.com/Storybook-PJs-book-pajama-package/dp/B003RBTYFG>.

<sup>14</sup> See Attachment Nos. 30-31 to April 6, 2012 final Office Action from <http://www.giftbasket4kids.com/elmo-gift-basket.html>.





- Awesome Creations, Inc.: Personalized Baby Gifts ~ Puppy Love and Purr-fect Baby gift baskets for new baby boys and girls including bodysuit, hooded towel, bib, plush toy and small books placed in front of other items:<sup>15</sup>

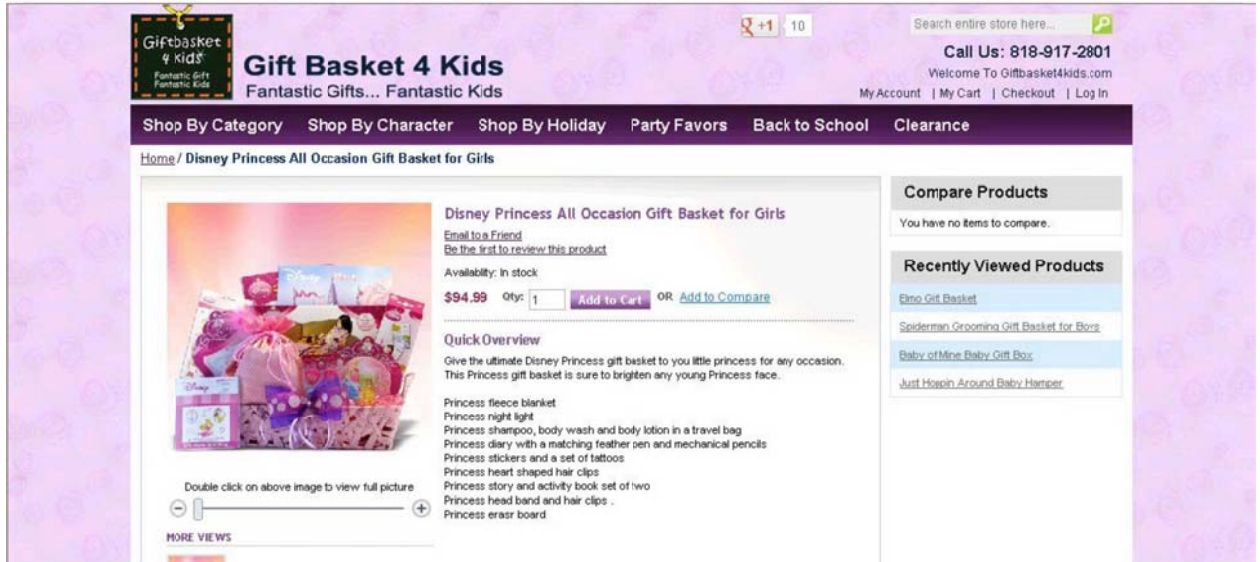


Children's gift sets containing books have also been marketed featuring arrangements where the books that are part of the set are positioned behind the other contents of the gift set:

<sup>15</sup> See Attachment Nos. 37-39 and 40-42 to April 6, 2012 final Office Action from [http://www.awesomecreations.com/personalized\\_baby\\_gift\\_puppy\\_love.htm](http://www.awesomecreations.com/personalized_baby_gift_puppy_love.htm) and <http://www.awesomecreations.com/personalized-baby-girl-kitty.htm>.

- Gift Basket 4 Kid: Disney Princess All Occasion Gift Basket for Girls including fleece blanket, nightlight, books etc.<sup>16</sup>

<http://www.giftbasket4kids.com/disney-princess-all-occasion-gift-basket-for-girls.html>  
04/06/2012 11:12:59 AM



- Shop the Gift Basket Store: Unique Baby Shower Gift Basket 12 Gifts of Birth Book:<sup>17</sup>

<http://www.shopthegiftbasketstore.com/unbashgiba12.html>  
04/05/2012 11:32:34 AM



<sup>16</sup> See Attachment Nos. 32-33 to April 6, 2012 final Office Action from <http://www.giftbasket4kids.com/disney-princess-all-occasion-gift-basket-for-girls.html>.

<sup>17</sup> See Attachment Nos. 49-50 to April 6, 2012 final Office Action from <http://www.shopthegiftbasketstores.com/unbashgiba12.html>.

Because applicant's product contains only two items, pajamas and a book, it is logical that the book would be placed behind the sleepwear item, particularly where the book is larger in size than the sleepwear item. Such positioning also provides a firm support for the non-rigid sleepwear. Indeed, viewing applicant's product and those shown in the evidence, it appears that placement of a book in gift sets is determined by the size of the book relative to the size of the accompanying items; if the books are smaller in size they will be placed near the front of the arranged items while larger-sized books are placed behind the other items. Accordingly, the evidence shows that the relative locations of the book and the bow featured in applicant's applied-for mark are the ordinary locations that are used for gift sets which are frequently wrapped in transparent plastic wrap or bags which are cinched with a bow at the top. Thus consumers are familiar with such arrangements and the placement of a book in a gift set with other items would not serve a source distinguishing purpose.

In view of the foregoing evidence, packaging gift sets, including gift sets containing children's apparel and books, in transparent wrap with a bow at the top as shown in the applied-for mark is not new. Although the third-party evidence does not reveal the exact arrangement shown in applicant's trade dress, this is not conclusive. Even if no other party uses trade dress identical to the applied-for mark, such circumstances do not render applicant's trade dress inherently distinctive. Where, as here, an applied-for mark is a mere refinement of commonly adopted and well-known product and packaging arrangements, the applied-for

mark is not inherently distinctive despite being unique in the marketplace. *See In re File*, 48 USPQ2d 1363, 1367 (TTAB 1998) (novel tubular lights used in connection with bowling alley services would be perceived by customers as “simply a refinement of the commonplace decorative or ornamental lighting to which they have become accustomed and would not be inherently regarded as a source indicator.”); *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253, 1255 (TTAB 1998) (“while the designs [of packaging for electric lights for Christmas trees that] applicant seeks to register may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive”). Thus, under the analysis of the first three *Seabrook* factors, applicant’s trade dress is nondistinctive.

The fourth *Seabrook* factor, whether applicant’s trade dress is capable of creating a commercial impression distinct from any accompanying matter, also points to the nondistinctiveness of the trade dress. In addition to incorporating a common and ordinary arrangement in its trade dress, applicant’s trade dress is always accompanied by applicant’s registered BOOKS TO BED and Design mark.<sup>18</sup> Applicant readily acknowledges the source-identifying role of its registered word and design mark which appears on its packaging and sleepwear arguing that use of its BOOKS TO BED and Design mark “. . . on both the packaging and the products identify the source of the product as Applicant’s and distinguish the product from

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<sup>18</sup> See Applicant’s Appeal Brief p. 8. Although applicant’s registration for its BOOKS TO BED and Design mark is not of record, whether or not the mark is actually registered does not impact the registrability of applicant’s trade dress.

other products . . . .”<sup>19</sup> We agree with applicant that its BOOKS TO BED and Design mark is what serves to indicate source to consumers. We find it unlikely that applicant’s applied-for mark, which features ordinary packaging and product arrangement, is capable of creating a commercial impression that is distinct from applicant’s admitted use of its BOOKS TO BED and Design mark on both the packaging, namely, on the ribbon (bow) and the “bellyband” placed around the book and sleepwear, and the product.<sup>20</sup> Based upon the record presented, applicant’s trade dress is not inherently distinctive.

In this case, we need not make an absolute determination whether applicant’s trade dress comprises a product configuration, packaging, or some “*tertium quid*” that is akin to packaging,<sup>21</sup> because the particular classification does not affect the outcome. If applicant’s trade dress is classified as a product configuration or design, by operation of law, it cannot be considered inherently distinctive and proof of secondary meaning is required. Likewise, if applicant’s trade dress is classified as product packaging, the record establishes that it is not inherently distinctive and proof of secondary meaning is required. Because applicant has not submitted any evidence of secondary meaning, its trade dress is

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<sup>19</sup> See Applicant’s Appeal Brief p. 9.

<sup>20</sup> See Applicant’s Appeal Brief p. 9.

<sup>21</sup> In addressing the *Two Pesos* case in *Wal-Mart*, the Supreme Court explained that *Two Pesos* is “inapposite to our holding here because the trade dress at issue, the décor of a restaurant, seems to us not to constitute product *design*. It was either product packaging—which, as we have discussed, normally *is* taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.” (emphases original). *Wal-Mart*, 54 USPQ2d at1069.

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unregistrable as either a product configuration or as product packaging, and the refusal of registration must be affirmed.

**Decision:** The refusal of registration pursuant to §§ 1, 2 and 45 of the Trademark Act is affirmed.