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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85281291

MARK:



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Heatcon, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Heatcon, Inc., has appealed the Trademark Examining Attorney's refusal to register the proposed configuration mark on the Supplemental Register, on the ground that the mark is functional, pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5), and the requirement for a drawing that conforms to TMEP §§807.08, 1202.02(c)(i).

FACTS

On March 30, 2011, Applicant filed this application under Section 1(a) of the Trademark Act to register the three dimensional configuration of the whole user interface of a process controller for bonded composite fabrication and repair. In the first Office Action dated July 7, 2011, registration was refused under Trademark Act § 2(e)(5) on the ground that the mark appeared to be a functional design for such goods. Alternatively, the examining attorney refused the mark as it consisted of a nondistinctive product design or nondistinctive features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness the under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127. The examining attorney also required an amendment to the identification of goods, an ownership claim of prior registrations, and an amendment to the drawing and description of the mark.

On January 5, 2012, having satisfied the identification of goods requirement, Applicant responded arguing that the *arrangement* of the applicant's user interface components provided no real utilitarian advantages to the user, and is one of many equally feasible, efficient and competitive designs for a hot bonder's interface. The applicant claimed Section 2(f) acquired distinctiveness based on substantially exclusive and continuous use in commerce for at least five years. Also, the applicant submitted a substitute drawing that displayed the case, handle and latches of the hot bonder unit in dotted lines, yet showed the rest of the mark in solid lines.

On February 10, 2012, the examining attorney issued a second non-final regarding the insufficiency of the Section 2(f) acquired distinctiveness claim and continuing the Section 2(e)(5) refusal. In the August 10, 2012 response to the Office Action, the applicant reiterated that the configuration of the whole user interface was not functional and that the drawing as submitted was acceptable. The applicant also included advertising expenditures and annual sales in support of the Section 2(f) claim.

The examining attorney then issued a final refusal on September 20, 2012 pursuant to Section 2(e)(5), Section 1, 2, and 45, insufficiency of the Section 2(f) claim and the drawing requirement. Applicant filed a notice of appeal on March 20, 2013.

On June 11, 2013, applicant submitted a Request for Remand to amend the application to the Supplemental Register, which made the Section 1, 2, and 45 refusal and Section 2(f) claim insufficiency moot. Subsequently, the examining attorney requested a remand on August 1, 2013, to address the amendment to the Supplemental Register. The request for remand was granted and a non-final refusal was issued on September 22, 2013, refusing registration on the Supplemental Register due to functionality under Trademark Act Section 23(c). The drawing requirement was also continued. The applicant responded on June 3, 2014, stating that the mark was non-functional and the drawing was accurate. On July 26, 2014, the examining attorney issued a final refusal based on Sections 2(e)(5), 23(c) and the drawing requirement. Applicant subsequently filed an appeal brief to which the examining attorney now responds.

ARGUMENT

I. THE PROPOSED MARK IS FUNCTIONAL FOR THE GOODS

In general terms, trade dress is functional, and cannot serve as a trademark, if a feature of that trade dress is "essential to the use or purpose of the article or if it affects the cost or quality of the article." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4, n.10 (1982)). TMEP §1202.02(a).

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining a proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-165, 34 USPQ2d 1161, 1163 (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, 35 U.S.C. Sections 154, 173, 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.)

In other words, the functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture. In *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness. TMEP §1202.02 (a)(ii).

In this case, the applicant seeks registration for the three-dimensional configuration of the arrangement as a whole of the user-interface components for the HCS92000B Composite Repair Set as described below:

The mark consists of a three dimensional configuration of the arrangement of the HCS9200B Composite Repair Set's (Hot Bonder's) user interface components featuring a display panel located in the middle of the top half of the interface, an output power LED indicator left of the display panel, another output power LED indicator right of the display panel, an input power receptacle left of the display panel, another input power receptacle right of the display panel, an output power receptacle left of the display panel, another output power receptacle right of the display panel, an air input port left of the display panel, an electric vacuum pump power receptacle right of the display panel, a vacuum out port left of the display panel, another vacuum out port right of the display panel, a vacuum monitor port left of the display panel, another vacuum monitor

port right of the display panel, a set of ten thermocouple jacks left of the display panel and below the vacuum ports, another set of ten thermocouple jacks right of the display panel and below the vacuum ports, a power switch below the display panel, an alarm also below the display panel and right of the power switch, a vacuum control regulator below the thermocouple jacks left of the display panel, another vacuum control regulator below the thermocouple jacks right of the display panel, a circuit breaker switch below the vacuum control regulator left of the display panel, another circuit breaker switch below the vacuum control regulator right of the display panel, a keypad below the power switch and alarm, a printer exit left of the keypad, another printer exit right of the keypad, and the face plate that these components are located on. The broken lines depicting the case, handle and latches indicate placement of the mark on the goods and are not part of the mark.

Functional matter may not be registered on either the Principal or Supplemental Registers, regardless of 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.*, 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). Further, a determination of functionality is a question of fact. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1372, 102 USPQ2d 1372, 1375 (Fed. Cir. 2012); *In re Bose Corp.*, 476 F.3d 1331, 1334, 81 USPQ2d 1748, 1751 (Fed. Cir. 2007); TMEP §1202.02(a)(iv). Such a determination 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).

Determining 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 product or packaging 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.
- (4) Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Becton, Dickinson & Co., 675 F.3d 1368, 1374-75, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *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).

A. APPLICANT’S PRODUCT DESIGN PROVIDES UTILITARIAN ADVANTAGES THAT ARE REFERENCED IN UTILITY PATENTS

Generally, a utility patent claiming the design features at issue is strong evidence that those features are functional. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); see TMEP §1202.02(a)(iv), (a)(v)(A). In this case, the applicant does not have a utility patent for the hot bonder interface device. However, a third-party utility patent is relevant evidence of functionality when

the patent discloses the utilitarian advantages of the applied-for product or product packaging configuration sought to be registered. *See, e.g., Kistner Concrete Prods. Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1921 n.7 (TTAB 2011); *In re Dietrich*, 91 USPQ2d 1622, 1627 (TTAB 2009); TMEP §1202.02(a)(v)(A).

U.S. Patent No. 6,976,519, hereafter referred to as the Bivens Patent, was issued for a portable curing system for use with vacuum bag repairs and the like. See September 20, 2012 Outgoing Office Action, pages 99 - 100. The Bivens portable curing system claims a carrying case, a controller with a microprocessor, a vacuum pump, at least one heater connector for receiving a lead of a thermocouple, and a touch screen display to view information and input information to the controller. The Bivens patented device arranges the components differently from the applicant's proposed interface, but contains the same major components essential for the operation of the device. There are also power ports along the top with a printer beside a centralized display screen.

Applicant argues that the Bivens patent has no probative value as only the system is claimed with no reference to how the components are arranged. See Applicant's June 1, 2015 appeal brief, page 12. However, please note the included diagrams and drawings displaying the intended layout of the patented device. The panel contains a centralized display screen, with connecting ports around its perimeter. A utility patent need not be in the exact configuration for which trademark protection is sought to be considered probative. *See In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (citing *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33, 34-35, 58 USPQ2d 1001, 1005 (2001)).

According to www.abarisononline.com, hot bonders generally contain a keypad and display, chart recorder, alarms, vacuum pump and connection ports. The connection ports include input power (power supply), output power (to heat source), air intake (compressed air or plant air), vacuum line and monitor (to repair), and thermocouple control board. See February 10, 2012 Outgoing Office Action, page 15. The Bivens device and the applicant's hot bonder interface both tilt the display screen toward the user and place the printer away from the power input port and vacuum connector ports. The operator can connect cords, cables and wires away from his position and avoid entangling the connections or blocking access to the other features of the panel. See July 26, 2014 Outgoing Office Action, page 56. See also U.S. Patent No. 7,789,643 for an in situ pipe repair controller and system. The controller arranges the ports around the upper periphery of the instrument panel for an easy and unencumbered connection for cables and hoses. See July 26, 2014 Outgoing Office Action, pages 77-86. Both patents reference hot bonder configurations that provide practical advantages for safety and ease of use.

B. ADVERTISING TOUTS THE ADVANTAGE OF THE DESIGN

Applicant's own advertising that extols specific utilitarian advantages of the applied-for product design or product packaging is strong evidence that the matter sought to be registered is functional. TMEP §1202.02(a)(v)(B); see, e.g., *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375-76, 102 USPQ2d 1372, 1377-78 (Fed. Cir. 2012); *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1924 (TTAB 2011). In this case, the applicant includes the following wording in its list of standard features for the goods:

All aluminum, scratch resistant, anodized faceplate

Ergonomic design, convenient hookup of all accessories

Circuit breakers are on front panel, no fuses to replace

See Applicant's response of January 5, 2012, pages 10-12. Applicant's interface contains four 10 foot vacuum lines with an on screen display for monitoring the vacuum lines. Additionally, the inclusion of the display makes the unit programmable without a personal computer. The applicant's product is reliable, easy to use, and upgradeable with superior capabilities. See Applicant's response of January 5, 2012, pages 11-12. According to www.compositesworld.com, the applicant's product has a display "that lets mechanics monitor the cure cycle of composites used in repairs, which is important for assuring that the resulting component meets airworthiness requirements. Speed, rapid response and visually assuring that cure cycles parameters are being followed are absolutely essential in this whole process." See the September 20, 2012 Outgoing Office Action, page 119. The applicant's products "retain functions similar to larger, more traditional equipment", yet its "smaller size and lighter weight" makes the bonders "easier to use in remote areas and improve response times for technicians in the field." See the September 20, 2012 Outgoing Office Action, page 118-119. Although the applicant is not touting the benefits of its own product configuration, the CompositesWorld article points out the product advantages over other hot bonders.

The applicant argues that the evidence does not tout the utilitarian advantages of the arrangement as a whole of the user interface components, nor does the "ergonomic design" and components list reference the arrangement as a whole. See applicant's June 1, 2015 brief, page 13-14. On page 12 of Applicant's response of January 5, 2012, the standard features list an "All aluminum, scratch resistant,

anodized faceplate” immediately above the reference to ergonomic design. The “ergonomic design” reference is immediately followed by “convenient hookup of all accessories”. The connections for the accessories are arranged on the face of the interface panel in a manner that makes hooking up the accessories *convenient*. Also, the term “ergonomic” is defined as “designed to minimize physical effort and discomfort, and hence maximize efficiency.” See the definition from www.collinsdictionary.com in the July 26, 2014 Outgoing Office Action, pages 87-88. As the interface is referenced before and after “ergonomic design”, the phrase may reference the comfortable and efficient design or arrangement of the faceplate/interface. See Applicant’s response of January 5, 2012, pages 11-12.

Additionally, competitors’ advertising and promotional materials that extol specific utilitarian advantages of the applied-for product design or product packaging are also strong evidence that the matter sought to be registered is functional. TMEP §1202.02(a)(v)(B); *see, e.g., In re Van Valkenburgh*, 97 USPQ2d 1757, 1763 (TTAB 2011); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001). For instance, the applicant’s competitor WichiTech Industries promotes the ease of operation and safety of its product. Like the applicant’s device, WichiTech Industries’ HB-2 Composite Repair system features a centralized input pad enabling the user to control the device and reach the components from the center of the unit with minimal movement. Meanwhile, the overall unit retains its compact size. See July 26, 2014 Outgoing Office Action, page 60.

Also note the similar arrangement of the Witech Industries operator interface and the applicant’s panel. See the applicant’s response of January 5, 2012, page 21-22. The interface products of both parties have dual zones with many of the components mirrored on the left and right. The power and vacuum connector ports are along the top of the unit, with thermocouple

jacks grouped together on the sides. The keypad is located in the center, with printer output feeds to the left and right. See the applicant's response of January 5, 2012, page 11. The competitor Wichitech Industries touts

These twin features permit you to perform two independently-programmed cures simultaneously. Fail-safe protection is provided by the monitoring of multiple thermocouples, and audible alarms guard against temperature and vacuum conditions that could ruin the repair.

See the applicant's response of January 5, 2012, pages 21-22.

Similarly, the dual zone multi-feedback hot bonder from Zimac Laboratories, Inc, allows the user to "Increase your productivity." Like the applicant's device, the Zimac Laboratories product has the power ports along the top with thermocouple ports grouped on opposite sides. The center of the panel is left open to contain the laptop which acts as the display, allowing centralized monitoring of the repair process. See July 7, 2011 Outgoing Office Action, page 25. The Aeroform France hot bonder also installs the power and vacuum ports at top of the unit, with the display and input in the center. See February 10, 2012 Outgoing Office Action, pages 11-12. Another competitor, Briskheat touts a *fast* dual vacuum system. Like the applicant, the Briskheat product has a centered display with power ports at the top. See February 10, 2012 Outgoing Office Action, pages 5-6.

Like its competitors' products, the applicant's dual zone arrangement may allow the operator to increase productivity by running simultaneous cures, centralizing the input and monitoring aspects, enabling easy operation and increasing safety.

C. AVAILABILITY TO COMPETITORS OF FUNCTIONALLY EQUIVALENT DESIGNS

When functionality is found based on other considerations, there is "no need to consider the [third *Morton-Norwich* factor regarding] availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available." *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1376, 102 USPQ2d 1372, 1378 (Fed. Cir. 2012) (quoting *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002)); TMEP §1202.02(a)(v)(C).

In this case, the applicant argues that its particular arrangement of the individual components of the composite repair set would not disadvantage its competitors as it is "merely one of a virtually infinite number of ways to configure an arrangement of user-interface components for a hot bonder." See applicant's June 1, 2015 appeal brief, page 9. However, the infinite number of component configurations may be severely hampered when considering industry standards and safety concerns. Hot bonders are often designed to be compliant with the repair specifications of the industries in which they operate. For example, SFA UK provides hot bonders designed to be compliant with Airbus Industrie, Boeing, Eurofighter, GKN Westland and MoD composite repair specifications. See February 10, 2012 Outgoing Office Action, page 16.

Note that on its similar HCS9000B-EV product, the applicant provides ten thermocouple inputs per zone *per aerospace manufacturers' recommendations*. [Emphasis added.] See September 20, 2012, Outgoing Office Action, page 42. With the applicant's HCS900FL line, the products "are further designed to meet the requirements of Class I, Division II, hazardous environment operation for the U.S. National Electric Code (NEC), as promulgated by the National Fire Protection Association (NFPA). See Applicant's response of January 5, 2012, page 12. Adherence to third party standards for quantity of components may limit how and where these components may be placed on the instrument, yet still maintain ease of use.

The applicant further asserts that the hot bonder user interfaces of Wichitech, BriskHeat, Applied Heat, Aeroform France, ATACS and Zimac use different arrangements of user-interface components, providing strong evidence that the applicant's arrangement does not give it an advantage over its competitors. See Applicant's June 1, 2015 appeal brief, page 14-15.

However, the dual zones of the applicant's arrangement enable the user to be able to handle two separate composite repairs simultaneously. The attachment of the power receptacle and vacuum hoses at the top edge of the unit allows the user to freely connect to heat blankets or other accessories. See Applicant's response of January 5, 2012, page 48. The position of the display away from the connecting ports also allows the user to actively monitor the part being repaired while viewing the display screen and printouts. Further, the applicant includes the following warning in its operating manual:

IF OPERATING TWO (2) ZONES, ENSURE THAT THE TCs FROM ONE ZONE ARE NOT
CONNECTED TO THE OTHER ZONE. DAMAGE TO THE EQUIPMENT OR PART MAY RESULT
IF TCs ARE CROSSED BETWEEN ZONES.

See Applicant's response of January 5, 2012, page 36. Please note that TC stands for thermocouple. See Applicant's response of January 5, 2012, page 31. The arrangement of applicant's user interface into two zones that mirror each other, places the thermocouple connection ports at extreme opposite positions on the panel. Please note that the thermocouple jacks on the Aeroform France hot bonder are placed in a continuous line across the top of the panel. The applicant's arrangement of the widely separated thermocouple jacks appears safer as it lessens the likelihood of connecting the thermocouples to the wrong zone.

Some competitors, such as Applied Heat, provide single zone bonders. Two Applied Heat brand hot bonders must be linked via a communications cable to create a fully functional dual zone hot bonder. See applicant's January 5, 2012 response, pages 15-18. Applicant's user-interface arrangement provides the dual zone capability in one compact package without the expense of additional equipment and accessories.

Where the evidence indicates that the applicant's configuration is the best or one of a few superior designs available, this evidence will strongly support a finding of functionality. *See, e.g., In re Dietrich*, 91 USPQ2d 1622, 1636 (TTAB 2009) ("[T]he question is not whether there are alternative designs that perform the same basic function, but whether the available designs work 'equally well.'") (citation omitted); *In re N.V. Organon*, 79 USPQ2d 1639, 1645-46 (TTAB 2006) (concluding that, since the record showed that orange flavor is one of the most popular flavors for medicine, it cannot be said that there are true or significant number of alternatives); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) (finding that applicant had not shown there were alternative guitar shapes that could produce the same sound as applicant's

configuration, and noting that the record contained an advertisement obtained from the website of a competitor, whose guitar appeared to be identical in shape to applicant's configuration, which stated that the shape of the guitar produces a better sound). TMEP § 1202.05(a)(v)(C).

D. MANUFACTURING CONSIDERATIONS

A product feature is functional if it is essential to the use or purpose of the product *or if it affects the cost or quality of the product. Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982) (emphasis added). Therefore, a showing that a product design or product packaging results from a comparatively simple or inexpensive method of manufacture will support a finding that the claimed trade dress is functional TMEP §1202.02(a)(v)(D). The applicant contends that its user interface components do not appear to be simpler or less expensive to manufacture. In this case, there is no evidence to support or dispute this assertion.

II. THE PROPOSED MARK IS COMPOSED OF INDIVIDUAL FUNCTIONAL ELEMENTS AND THEIR ARRANGEMENT DOES NOT CREATE A NON-FUNCTIONAL TRADEMARK

The applicant's three-dimensional arrangement of a composite repair set user-interface components is unregistrable under Trademark Act § 2(e)(5) on the grounds that the mark

appears to be a functional design for the goods. The mark consists of the following, listed from top to bottom:

- a display panel in the upper middle of the interface
- an input and a output power receptacle on both the upper left and right of display panel
- an output power LED indicator left of the display panel between the power receptacles
- another output power LED indicator right of the display panel between the power receptacles
- a blanket overheat supervisory circuit below the power receptacles on the left and right sides of the panel
- Circuit breaker with a breaker guard on each side of the display screen
- a GFI fault LED indicator light with a reset button on each side of the display screen
- Input air fitting on the left of the panel
- one vacuum out fitting on both the middle left and right sides of the panel
- a vacuum monitor fitting on both the middle left and right sides of the panel
- a vacuum adjust needle valve
- a master power switch centered below the display panel
- LED indicator lights
- Audio alarm
- a set of ten thermocouple jacks left of the display panel
- a set of ten thermocouple jacks right of the display panel
- a vacuum control regulator above each set of ten thermocouple jacks
- a keypad centered at the bottom of the panel
- a dot matrix printer to the left and right of the keypad
- a printer paper feed pushbutton switch below the keypad

- the face plate upon which these components are located

See Applicant's response of January 5, 2012, pages 9-10. The components listed above are all functional elements of the goods. The display allows the user to operate the device by "easy to follow menus on High-Resolution, High Contrast, Sunlight readable LCD screen." The vacuum out ports connect the device to hoses enabling the unit run off of plant air. The vacuum monitor ports allow the user to monitor the repair from separate line. The GFI and GFI reset switches maximize equipment safety. The temperature is controlled by the thermocouples. The alarm system of lights and audible signals, scans the thermocouples and vacuums for deviations. The keypad allows the user to input data. The dot matrix printer exit and paper feed provide temperature summaries, graphs of actual cures, alarm conditions, and program changes. The faceplate incorporates all of the individual functional components. See Applicant's response of January 5, 2012, pages 9-11.

The applicant asserts that the proposed mark is for the arrangement of the components. In support of its argument, the applicant emphasizes that

Section 2(e)(5) of 15 U.S.C. §1052 states that, "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 consists of a mark which comprises any matter that, as a *whole* [emphasis added], is functional." And Section (c) of 15 U.S.C. §1091 states that, "For the purposes of registration on the supplemental

register, a mark may consist of any trademark, symbol, label, package, *configuration of goods* [emphasis added], name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a *whole* [emphasis added] is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

See Applicant's June 1, 2015 appeal brief, page 5. Citing TMEP §1202.02(a) and *Qualitex, Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), the applicant questions the application of functionality with regard to trade dress. The applicant argues

Because the TMEP replaces the second occurrence of "product" with "trade dress", one can reasonably interpret "a feature of that trade dress" to mean an element, component or portion of the trade dress, and thus conclude that a product feature is functional if an element, component or portion of the product feature is essential to the use or purpose of the product or if it affects the cost or quality of the product. Such a conclusion, however, contradicts 15 U.S.C. §§1052(3)(5) and 1091(c), which require that the mark (product feature), as a whole, be considered, not the mark's (product feature's) elements, components or portions, individually.

Again, Section 2(e)(5) of 15 U.S.C. §1052 states that, "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 consists of a mark which comprises *any*

matter that, as a whole is functional.” [Emphasis added.] The reference to “any matter” means any matter, or features, within the trademark. This matter would include “product features”, reconciling the applicant’s proposed contradiction.

Further, the applicant cites *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d 217 (S.D.N.Y. 2004). The applicant argues that its design is nonfunctional as the court in that case found “that the combination of features composing Cartier’s trade dress as a whole would not seriously limit [the] options [of] a watch designer.” See Applicant’s June 1, 2015 appeal brief, page 8. However, Cartier’s trade dress incorporated elements not essential to the function of the watch such as the “Roman numerals, a cabochon, an octagonal winding stem, a minute track, a particular face shape, a particular shape of a watch case and its extensions connecting the face to the strap and a particular bracelet link formation or shape.” The Court stated that “the watch designs at issue are purely ornamental and do not play a functional, essential, or cost-saving role in the manufacture of watches.” Conversely, the applicant’s configuration is comprised entirely of functional components such that their arrangement would not be “non-functional” or “purely ornamental.” It appears that the various parts are placed in such a way to make operation of the device easier, safer or more efficient.

Applicant also argues that “where all individual aspects are functional, the “overall composite design can be nonfunctional.” The applicant cites *In re Chesebrough-Pond’s, Inc.*, in which the TTAB stated that there was nothing to indicate that the design has such superiority over other possible designs that competitors need the freedom to copy it in order to compete effectively with applicant. 224 USPQ 967 (TTAB 194). See Applicant’s June 1, 2015 appeal brief, page 8. In

the present case, the number of possible designs may be limited by industry requirements, ease of use and space constraints. The hot bonders of the applicant and its competitors have a common quadrilateral shape and the units must include certain functional components to successfully complete a repair. With weight and portability being contributing factors in the configuration of the devices, the number of interface designs available may be limited. Unlike the Chesebrough-Pond's case, competitors may need to place their displays, ports, jacks and hose connectors in the same place to manufacture competitive products.

Applicant further asserts that in *Honeywell*, "the TTAB held that a product configuration was not functional despite the fact that it included some functional elements, because competitors would not need to use the particular combination of elements claimed by the applicant." See Applicant's June 1, 2015 appeal brief, page 8. In that case, the Honeywell cover had been the subject of a design patent lending credence to the non-functionality of the cover. The applicant in the *Honeywell* case also touted the decorative qualities of its cover with the Board finding that the circular shape of the cover was not functional. See *In re Honeywell Inc.* 8 USPQ2d 1600 (TTAB 1988). In the present case, the applicant does not have a design patent and the overall shape and basic configuration appears to be fairly common among hot bonders. While the *Honeywell* case referenced *some* functional elements, the applicant's goods incorporate essentially all functional elements. The applicant's arrangement of predominately functional elements is not "decorative", hence, the configuration of those elements appears functional. Thus, the proposed mark is simply composed of multiple functional elements, and the arrangement of those elements does not create a non-functional trademark in this case.

III. THE DRAWING OF THE MARK IS UNACCEPTABLE

Functional elements of a trade dress mark are never capable of acquiring trademark significance and are unregistrable, much like informational matter. 15 U.S.C. §1052(e)(5); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995). Therefore, to show that they are not part of the mark, functional elements must be depicted in broken or dotted lines on the drawing to show the position or placement of the claimed portion of the mark. See 37 C.F.R. §2.52(b)(4); *In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983). TMEP §1202.02(c)(i)(A).

Applicant was required to depict functional elements of the mark in the drawing with broken or dotted lines. The functional elements included the power receptacles, video display, numeric keypad, dot matrix printer, circuit breakers, vacuum connecting port, thermocouple jacks, LED lights, indicators, and switches. The applicant asserts that the proposed mark is for the *arrangement* of the components. Therefore, the functional components themselves must be shown in dotted lines to show their position in the arrangement. See 37 C.F.R. §2.52(b)(4); TMEP §§807.08, 1202.02(c)(i). However, the applicant argues that the components of the user interface currently shown in solid lines should remain in solid lines as they are elements of the three-dimensional configuration of the whole user interface of its composite repair set. The applicant maintains that showing the elements in dotted lines would result in an unclear depiction of the mark. See June 1, 2015 appeal brief, page 17.

Drawings of three-dimensional product design and product packaging trade dress marks may not contain elements that are not part of the mark (i.e., matter that is functional or incapable of trademark

significance). If the mark comprises only a portion of product design or product packaging, solid lines must be used on the drawing to show the elements of the product design or product packaging that are claimed as part of the mark, and broken or dotted lines must be used to indicate the portions that are not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); see *In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980) (affirming the functionality of a circular-shaped container for the goods and the requirement for an amended drawing to either delete the representation of the container from the drawing or show it in dotted lines); TMEP §1202.02(c)(i). In this case, the use of solid lines is analogous to a claim of the functional components of the user interface.

Only, in rare instances where it is impractical to render certain elements of a mark in dotted or broken lines - for example, if those elements are proportionally so small as to render dotted lines illegible - or if dotted lines would result in an unclear depiction of the mark, the applicant may use solid lines. However, the applicant must insert a statement in the description of the mark identifying these elements and declaring that these elements are not part of the mark and that they serve only to show the position of the mark on the goods, as appropriate TMEP §1202.02(c)(i). In this case, the applicant claimed the elements as a part of the overall configuration and failed to insert a statement to the contrary.

CONCLUSION

Based upon the evidence submitted for the record, the Examining Attorney has demonstrated that the proposed mark is essential to the use or purpose of the device, and thus is functional for the identified

goods. Additionally, the applicant's drawing with the functional elements displayed in solid lines is found unacceptable.

Accordingly, the examining attorney respectfully requests that the Board affirms the refusal of applicant's mark on the Supplemental Register under Section 23(c) of the Trademark Act as the mark is functional according to Trademark Section 2(e)(5), and affirm the requirement for an acceptable drawing of the mark.

Respectfully submitted,

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