

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: November 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*In re Coobs Canada Ltd.*  
—

Serial No. 85345427  
—

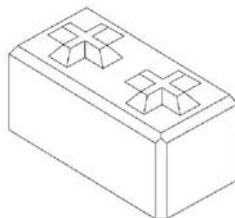
Joseph W. Berenato, III of Berenato & White, LLC,  
for Coobs Canada Ltd.

Cory Boone, Trademark Examining Attorney, Law Office 104,  
Chris Doninger, Managing Attorney.

—  
Before Quinn, Mermelstein and Gorowitz,  
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Coobs Canada Ltd. (“Applicant”) seeks registration on the Principal Register of  
the following:



for “concrete blocks” in International Class 19.<sup>1</sup> The application includes an amended description of the mark, which reads: “The mark consists of a design showing a three-dimensional concrete block.”<sup>2</sup>

The Trademark Examining Attorney has refused registration under Section 2(e)(5) of the Trademark Act on the ground that Applicant’s asserted mark consists of a functional design, and under Sections 1, 2, and 45 on the ground that the asserted mark is a non-distinctive product design for which Applicant has not provided sufficient evidence of acquired distinctiveness. In response to the Office Action dated June 3 2013, in which the Examining Attorney maintained both grounds for refusal, Applicant appealed. We affirm the refusals to register.

#### I. Evidentiary Issue.

Before proceeding to the merits of the refusals, we address an evidentiary matter. Applicant submitted new evidence with and in its Brief and Reply Brief. Evidence submitted after an appeal is untimely and ordinarily will not be considered<sup>3</sup> unless the Examining Attorney, in his or her brief, discusses the exhibits attached to the Applicant’s brief without objecting to them. Trademark Rule 2.142(d); *see In re Development Dimensions International, Inc.*, 219 USPQ 161,

---

<sup>1</sup> Application Serial No. 85345427 was filed on June 14, 2011 based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act and upon Section 44(e) of the Trademark Act based upon Applicant’s ownership of Canada Reg. No. TMA449524 dated November 3, 1995, renewed November 3, 2010.

<sup>2</sup> It is clear from Applicant’s filings and arguments during examination of the application and during this appeal that Applicant claims as its mark the *shape* of its goods (“concrete blocks”). The Examining Attorney has treated the application consistent with that understanding, and we will do the same.

<sup>3</sup> Trademark Rule 2.142(d), 37 CFR § 2.142(d).

162 n.2 (TTAB 1983); and Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1207.03 (2014).

The Examining Attorney did not discuss said exhibits. Accordingly, any exhibits first submitted with Applicant's Brief and Reply Brief have not been considered.

## II. Functionality Refusal under Section 2(e)(5) of the Trademark Act.

Registration was refused under Section 2(e)(5) of the Trademark Act,<sup>4</sup> which prohibits registration of a mark which comprises any matter that, as a whole, is functional. The mark, as depicted in the drawing, consists of a three-dimensional block with two protruding crosses on top. Applicant claims the entire depiction as its mark.

The case law of our primary reviewing court, the Court of Appeals for the Federal Circuit, and of its predecessor, the Court of Customs and Patents Appeals,

establishes that before an overall product configuration can be recognized as a trademark, the *entire* design must be ... non de jure functional. *Petersen Mfg. Co. v. Central Purchasing, Inc.*, 740 F.2d 1541, 222 USPQ 562, 569 (Fed. Cir. 1984); *In re Minnesota Mining and Mfg. Co.*, 335 F.2d 836, 142 USPQ 366 (CCPA 1964). The reason for this rule is self-evident — the right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were accorded trademark protection because they included a few ... nonfunctional features. *See Petersen Mfg. Co.*, 222 USPQ at 569; *In re R.M. Smith*, 734 F.2d 1482, 222 USPQ 1, 2-3 (Fed. Cir. 1984). In cases where the holders of such designs seek trademark protection, it can be obtained only for those features that are nonfunctional. *Petersen Mfg. Co.*, 222 USPQ at 569; *Vuitton et Fils S.A. v. J. Young Enterprises, Inc.*, 644 F.2d 769, 774, 210 USPQ 351, 357 (9th Cir. 1981). Moreover,

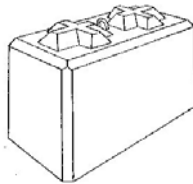
---

<sup>4</sup> Section 2(e)(5), which became effective on October 30, 1998, codified prior case law. Trademark Manual of Examining Procedures (TMEP) § 1202.02(a)(1) (2014).

an applicant for trademark protection has the burden to prove that a design is nonfunctional, once a prima facie case of functionality is made by an opponent. *In re Teledyne, Inc.*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982); *see also R.M. Smith*, 221 USPQ at 3; *In re Morton-Norwich*, 671 F.2d 1332, 1343, 213 USPQ 9, 17 (CCPA 1982).

*Textron, Inc. v. U.S. International Trade Commission et al.*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985) (citations revised).

Applicant does not argue that the underlying three-dimensional rectangular shape of the block (without the protruding cross-shaped feature) is not functional. Instead, Applicant argues that its ownership of prior incontestable Registration No. 1912535 for the following block design:



for “concrete blocks for use in constructing retaining walls,” mandates a finding that the three-dimensional block designated in the application at issue is not functional.<sup>5</sup>

This argument is not persuasive. It has long been held that

[t]rademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (citations omitted).

---

<sup>5</sup> Applicant argues that the registered mark is merely a depiction of the same concrete block from a different angle. However, there are differences in the appearance of the registered mark and the designation now before us.

Each case must be decided on its own facts. Neither the USPTO — specifically, the examining attorney who examined the application here at issue — nor the Board, is bound by the decision of the examining attorney who examined the application for the applicant’s previously registered mark. *See In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (upholding examining attorney’s requirement for a more definite identification, notwithstanding applicant’s ownership of several registrations in which the term “chronographs” appeared without further qualification in the identification); and *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars).

*In re Cordua Rests. LP*, 110 USPQ2d 1227, 1233 (TTAB 2014).<sup>6</sup>

In any event, although the differences are not great, both the mark and the goods in Applicant’s prior registration differ from those set out in the application now before us — indeed, it seems likely that is the reason why Applicant is seeking a new registration. Regardless of the treatment of Applicant’s prior registration, an application for registration of a different mark for different goods is a “new ball game,” which must be predicated on current thought.” *See In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979). Thus, Applicant’s ownership of prior Registration No. 1912535 does not affect our finding that the three-dimensional rectangular shape of the block at issue, without the cross-shaped protrusions, is functional. Moreover, the evidence supports our finding that the three-dimensional block is a

---

<sup>6</sup> The incontestable status of the prior registration is not relevant to our decision. Any registration, even an incontestable one, may be cancelled at any time if the registered mark is functional. Section 14 of the Trademark Act, 15 U.S.C. § 1064.

common shape of concrete blocks sold by Applicant and its competitors<sup>7</sup>, which provides certain advantages when used to build certain structures, such as retaining walls.

We look next at the cruciate protrusions on the top of Applicant's concrete blocks. To determine whether the cross-shaped protrusions are functional, we consider the factors set forth in the *Morton-Norwich* case:

1. The existence of a utility patent that discloses the utilitarian advantages of the design;
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.* 213 USPQ at 15-16.

Upon consideration of these factors, our determination of functionality is ultimately a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d at 1424 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997). Furthermore, it is not required that all four factors be proven in every case, nor do all four factors have to weigh in favor of functionality to support a refusal.... See *Valu Eng'g, Inc.*, 61 USPQ2d at 1427; *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009).

---

<sup>7</sup> The record establishes that a number of Applicant's competitors sell rectangular shaped blocks, including Independent Concrete Ltd., Rempel Bros. Concrete and Bashaw Concrete Products Limited. Office Action dated June 3, 2013.

*AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833-34 (TTAB 2013)  
(citations revised).

1. The existence of a utility patent that discloses the utilitarian advantages of the design.

Applicant owns Patent No. 6931797, entitled “Arched structures and method for the construction of the same.”<sup>8</sup> Applicant’s ’797 Patent discloses an arch and the method of building it using blocks which “include[ ] a protrusion extending from the surface, said protrusion being mateable with a corresponding recess in” a similar adjacent block. Claim 1 and Claims 3, 4, 6, and 7 further disclose the use of similar blocks having “cross-shaped” protrusions. The drawings (## 50 & 60) also show blocks with cross-shaped protrusions, which “impede slippage in any direction,” demonstrating that an advantage of using a block with a protrusion, especially one with “both longitudinal and transverse components,” is better stability.

As discussed, *supra*, the protruding cross-shaped feature<sup>9</sup> of applicant’s concrete block is disclosed in Applicant’s patent. “A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until

---

<sup>8</sup> Applicant claimed ownership of this patent in response to the Examining Attorney’s request that Applicant provide information regarding the asserted mark. Response dated March 26, 2012.

<sup>9</sup> In the concrete block industry, the protruding portion of such a block is known as a “key.” See Appeal Brief, pp. 15-16, 7 TTABVUE at 15-16 and Examining Attorney’s Brief, p. 4, 11 TTABVUE at 5.

proved otherwise by the party seeking trade dress protection.” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001).

To overcome the presumption of functionality, Applicant argues that the “patent relates to voussoirs<sup>10</sup> and arches constructed therewith,” and not to blocks. Appeal Brief, p. 8, 7 TTABVUE at 9. “One of the objects of the ’797 patent ‘is to provide a [wedge-shaped piece] with features enabling an improved interlock with like [wedge-shaped pieces] but also to enhance the ease of assembling an arched structure.” *Id.* Although the block configuration at issue is not wedge-shaped, as discussed *infra*, the protruding cross shape depicted in the application is the same as the protruding cross-shaped key disclosed in the patent. In both cases, the cross — which interlocks with a recess in an adjacent and similar block — enhances the stability of a structure. Applicant’s patent thus strongly supports a finding that the cross-shaped key which is a feature of Applicant’s proposed mark is functional.

Further, contrary to Applicant’s assertion, we do not find that the absence in the trademark application of the recess disclosed in the patent, which connects with the protrusion, renders the cross feature non-functional. The ’797 Patent discloses a block which is manufactured with cross-shaped protrusions on the top surface and cross-shaped recesses on the bottom surface. Applicant’s failure to include the

---

<sup>10</sup> “Voussoir” is defined in Merriam-Webster’s Online Dictionary as “one of the wedge-shaped pieces forming an arch or vault.” As requested by Applicant, we take judicial notice of the definitions submitted by Applicant from Merriam-Webster’s Online Dictionary.

The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).



recessed portion in the drawing of the applied-for mark<sup>11</sup> does not render the cross-shaped protrusions claimed in the application non-functional.

2. Advertising by the applicant that touts the utilitarian advantages of the design.

Both the Examining Attorney and Applicant submitted advertising material from Applicant's website that touts the utilitarian advantages of the cross-shaped feature. For example, the page entitled HOME OF THE LOCK-BLOCK, ARCH-LOCK & LOCK-BLOCK TRAFFIC BARRIER states:

Our founder Jay Drew, a professional engineer licensed in British Columbia invented the United Lock-Block Ltd. building system ...

To make it easy to stack the units up straight, and for other engineering considerations Jay looked at many interlocking shear key designs and copyrighted the best one.

Exhibit to Office Action dated April 16, 2012, and Exhibit 5 to Response dated March 26, 2012;

The page entitled WALLS, SHELTERS, INDUSTRIAL & RESIDENTIAL APPLICATIONS states:

Features and benefits that are common to many of our applications ...

Self aligning interlocking key that speeds assembly and allows easy straight stacking.

Exhibit to Office Action dated April 16, 2012; and

---

<sup>11</sup> The drawing in the application depicts only the top and two sides of a concrete block. Although they are not depicted, it is obvious from the drawing that applicant's actual concrete blocks have a bottom and two additional sides which could easily include recesses corresponding to the cross-shaped key depicted in the proposed mark

The page entitled ARCH-LOCK – THE NEW ROMAN ARCH states:

The copyright protected interlocking key design holds the units together in alignment during and after assembly.

Exhibit to Office Action dated April 16, 2012.

Accordingly, we find that the advertising material touts the utilitarian advantages of the interlocking key in the shape of two crosses, e.g., the shape speeds assembly and allows easy straight stacking with improved lateral stability.

3. Facts pertaining to the availability of alternative designs.

Applicant has established that there are various alternative interlocking key designs available. However, because we find that the design affects the quality of the goods and as such is functional, “there is no need to proceed further to consider if there is a competitive necessity for the feature.” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 58 USPQ2d at 1006.

4. Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

There is no evidence regarding the method of manufacturing the protruding cross feature. To that end, we find this element to be neutral.

As discussed, *supra*, it is not necessary that all four *Morton-Norwich* factors be proven in every case, or that all four factors weigh in favor of functionality to support a refusal. In this case, the first two *Morton-Norwich* factors support a finding of functionality of the protruding cross feature.

Conclusion.

As discussed, *supra*, the shape of the block is essential to the building of structures, including retaining walls, and the protruding cross-design (a portion of the self-aligning interlocking key), speeds assembly, allows easy straight stacking and holds the units together in alignment during and after assembly. As such, the designation as a whole is functional and the refusal under Section 2(e)(5) is affirmed. Having determined that the design is functional, it is not necessary for us to decide the alternate ground for refusal, namely, whether Applicant has established acquired distinctiveness of its non-distinctive design. However, we do so for the sake of completeness.

### III. Non-Distinctive Design Refusal under Sections 1, 2, and 45 of the Trademark Act.

As asserted by the U.S. Supreme Court, a product's design is not inherently distinctive since with "product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing." *Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000). As such, since Applicant's asserted mark consists of the product design consisting of a concrete block, it is *per se* not inherently distinctive. The burden of proving acquired distinctiveness is on Applicant. *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Applicant has not met this burden.

Applicant argues that by virtue of its ownership of an incontestable registration for a similar, albeit, not identical, mark used in connection with “identical goods,”<sup>12</sup> its asserted mark has acquired distinctiveness.<sup>13</sup> In support of this position, Applicant relies on *In re Best Software, Inc.*, 63 USPQ2d 1109 (TTAB 2002), and *In re American Sail Training Association*, 230 USPQ 879 (TTAB 1986). This case can be distinguished from the *American Sail Training* case, where a disclaimer was not required of the previously registered term “TALL SHIPS,” because the Applicant owned a registration for the entire registered mark, whereas in the present case, the marks are not identical.

The Board reached a contrary conclusion in *Best Software*, where the issue was whether the term BEST must be disclaimed in the mark BEST! IMPERATIV HRMS for “computer software for human resource, payroll, W-2 and tax processing and employment management,” where the applicant owned an incontestable registration for the mark BEST! for “computer programs for accounting, tax preparation, generating office reports and manuals, electronic filing and facsimile transmission, human resource management, financial management, computer network management, and for office administration and file management.” The Board, in affirming the disclaimer requirement, acknowledged the differences in

---

<sup>12</sup> The goods, as identified in the application at bar, “concrete blocks” are broader than the goods identified in the prior registration, “concrete blocks for use in constructing restraining walls.” Thus, to the extent that the goods include concrete blocks that are not for use in constructing for retaining walls, they are not identical.

<sup>13</sup> Applicant acknowledges that Reg. No. 1912535 issued prior to the Supreme Court’s decision in *Wal-Mart v. Samara* and, therefore, Applicant was not required to establish acquired distinctiveness of the design in order to register it.

both the goods and marks in the application and the prior incontestable registration, stating:

ownership of an incontestable registration does not give the applicant a right to register the same or similar mark for different goods or services, even if they are closely related to the goods or services set forth in the incontestable registration. Here, this application seeks registration of a different mark—BEST! IMPERATIV HRMS—with a different commercial impression from the mark in the prior registration—BEST! per se—for goods which, although similar, are nevertheless somewhat different.

*Best Software*, 63 USPQ2d at 1113. The present case is similar to the *Best Software case* in that the goods in the current application, while in part identical, are broader than the goods in Applicant's prior registration. More importantly, the alleged mark in this case, if not functional, is so highly descriptive that it is not capable of acquiring distinctiveness. As such, the alleged mark at issue is similar to the descriptive nature of the laudatory term "BEST," which was held by the Court of Appeals for the Federal Circuit to be "so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark.... [I]t is so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin." *Best Software*, 63 USPQ2d at 1111 (quoting *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (affirming refusal to register the mark BEST BEER IN AMERICA)) A term or slogan that is so highly laudatory and descriptive that it cannot function as a trademark is analogous to a generic term or slogan, which can be cancelled at any time. §14(3) of the Trademark

Act, 15 U.S.C. § 1064(3). Similarly, in this case where the asserted mark is a product design consisting of a three-dimensional rectangular shape of a block commonly used by third parties, with a functional cross-shaped protrusion, ownership of a prior registration — even one over five years old — for a similar, albeit not identical, mark for related goods is not sufficient to establish distinctiveness.

“While there is no fixed rule for the amount of proof necessary to demonstrate [acquired] distinctiveness, the burden is heavier in this case because it involves product configurations.” *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) (use of design for “eyeglass lens holders, eyeglass/spectacle frame display holders and brackets” in commerce for between seven and seventeen years, and evidence of sales and advertising, are not sufficient to establish distinctiveness). In this case, Applicant asserts that it “has continuously utilized, *for over twenty (20) years*, a design substantially similar to the design of the ’427 application as a source identifier.” Appeal Brief, p. 16, 7 TTABVue at 17 (emphasis in original). Applicant has provided no sales or advertising figures, nor has Applicant provided evidence of the extent of its use of the configuration in the United States.<sup>14</sup>

Long use of a mark is a relevant factor to consider in determining whether a mark has acquired distinctiveness, however, it is not necessarily conclusive or persuasive. *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984)

---

<sup>14</sup> Applicant is a Canadian corporation. The current application is based on its Canadian registration and on an intent to use the mark in commerce.

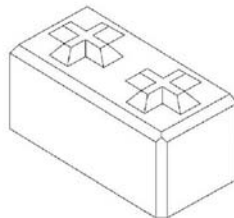
(Sixteen years of use not sufficient to establish acquired distinctiveness). *See also, In re Andes Candies, Inc.*, 478 F.2d 1264, 178 USPQ 156 (CCPA 1973) (evidence held insufficient to show registrability under Section 2(f) for “CREME DE MENTHE” on chocolate mint candy squares notwithstanding 20 years use, \$2.5 million in annual sales, \$25,000 per year in advertising and promotion, national distribution through 1400 distributors in 49 states and Canada, nearly 100 unsolicited letters purportedly showing mark recognition, and affidavits of president of applicant and of a chocolate distributing firm); *In re Interstate Folding Box Co.*, 167 USPQ 241 (TTAB 1970) (applicant held, alternatively, to have failed to meet burden of proof that “INNER-LINED” for pasteboard cartons had become distinctive under Section 2(f) notwithstanding 30 years of use, \$50,000 in advertising per year, seven “representative” unsolicited letters showing mark recognition, and 70 million cartons sold throughout the U.S. plus advertising samples supplied to verify nature of use); and *In re Riviana Foods, Inc.*, 160 USPQ 757 (TTAB 1970) (registration refused under Section 2(f) to “PRESCRIPTION DIET” for dietary animals foods sold to veterinarians and animal hospitals notwithstanding 18 years of use, existence of two Supplemental Register registrations for designation, and an “independent survey” among practicing veterinarians which the Board found deficient). Accordingly, we find that the asserted use of the concrete block configuration for over twenty years is not sufficient in this case to establish distinctiveness, particularly since there is no other evidence of acquired distinctiveness.

Finally, Applicant argues that consumers would view its three-dimensional block design as a logo since Applicant has used it next to Applicant's trade name. Applicant's argument is unpersuasive since the trade name is not part of the mark sought to be registered and we must consider the registrability of the mark shown in the drawing, which is the configuration of a concrete block, not a graphic design. *See* Trademark Rule 2.52; 37 C.F.R. § 2.52. The case relied on by Applicant, *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780 (TTAB 2006), is distinguishable from this case, particularly since it relates to a product design used as a service mark, and thus is not applicable.

Based on the evidence of record, we find that Applicant has not established that the shape of its concrete blocks has become distinctive as an identifier of their source.

In conclusion, we find that Applicant's depiction of a three dimensional block is functional. However, if on appeal the depiction is found to be not functional, we find that Applicant has not established that the design has become distinctive.

**Decision:** The refusals to register Applicant's asserted mark



under Section 2(e)(5) and Sections 1, 2, and 45 are affirmed.