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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85690391

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GENERAL TRADEMARK INFORMATION:

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TTAB INFORMATION:

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

APPLICANT: Foamation Inc.

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EXAMINING ATTORNEY'S APPEAL BRIEF

The Applicant has appealed the trademark examining attorney's refusal to register the trademark depicted as a swatch drawing of cheese-shaped foam on the ground that the applied-for mark consists of a nondistinctive product design or nondistinctive features of a product design within the meaning of Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127. Applicant also appeals the

requirements for an amended drawing and mark description and also for an acceptable specimen of use.

ISSUE

This appeal presents the question of registrability of a swatch drawing of cheese-shaped foam for a range of disparate goods, where the specimen shows that the goods are constructed of the foam. The Trademark Trial and Appeal Board is asked to decide whether the mark should be refused registration because (1) it is nondistinctive product design; (2) Applicant has failed to provide an acceptable drawing; (3) Applicant has failed to provide an acceptable mark description; and (4) Applicant has failed to provide an acceptable specimen of use.

FACTS

On July 30, 2012, Applicant applied for the mark described as “the color yellow/gold and a pattern of pock marks which are circular or oval-shaped depressions applied to the entire surface of the goods in a manner evoking the appearance of cheese” and identified different products all made of cheese-shaped foam, specifically, for foam coasters, sleeve holders for beverage cans and bottles, storage baskets, headwear, hats, ties, ear muffs, belts, Christmas tree ornaments, flying discs, toy bricks, sports balls and footballs. Registration was refused on the basis that the mark was a phantom mark and the identification of goods was rejected as indefinite. Based on Applicant’s response of May 16, 2013, the phantom mark refusal was withdrawn and the identification requirement was satisfied.

On July 9, 2013, after further review of the drawing and the specimens, the mark was refused as a multiple mark and for failure to function as ornamental under Sections 1, 2 and 45 of the Trademark Act. Additionally, the specimens were rejected as non-matching, a new drawing was required and a request for information was issued in order to ascertain the nature of the repeating pattern claimed in the mark. On August 2, 2013, Applicant responded with arguments against the Sections 1, 2 and 45 refusals and answered the inquiries regarding the repeating pattern. Applicant also argued against the specimen refusals and the requirement to provide a new drawing.

On October 3, 2013, a final refusal was issued for failure to function as a mark based on ornamentation and the requirements were made final for a matching specimen, an amended drawing and for additional information. The application was appealed on January 7, 2014 with an appeal brief filed on February 18, 2014.

The application was reassigned to the current examining attorney on April 11, 2014. A Request for Jurisdiction was filed by the new examining attorney on the basis that there were issues affecting registrability not raised in the previous prosecution. Pursuant to Trademark Rule 2.142(f)(6), jurisdiction was granted on April 17, 2014.

On May 21, 2014, a new nonfinal Office action issued, refusing the mark as nondistinctive product design on the basis that the actual mark comprises the shape of the identified goods where the foam design shown in the drawing creates the commercial impression that Applicant's goods are made of cheese. The Office action further required a new drawing and mark description accurately capturing the

nature of the mark and advised the Applicant that upon amendment of the drawing and mark description, due to the disparate goods, the mark may be refused as failing to function to identify and distinguish all of Applicant's goods from those of others. Evidence showing competitors' products formed from cheese-shaped foam was provided to Applicant. Applicant was advised that contingent on fulfillment of other requirements, amendment to seek allowance on the Supplemental Register would be considered.

In addition, the specimen refusal was continued, with additional grounds given. Applicant was advised that amendments to the drawing may resolve the matching issues for certain goods.

However, Applicant was further advised that due to the differences in the goods, the differing configurations would raise the issue of multiple marks.

Applicant replied on October 20, 2014 with arguments against the refusals and requirements. Applicant declined the opportunity to amend the drawing, mark description or request amendment to the Supplemental Register and did not make a claim of acquired distinctiveness of record.

Finding Applicant's arguments and evidence unpersuasive, on February 11, 2015 the examining attorney issued a subsequent final refusal reconfirming the withdrawal of the Phantom Mark refusal. The Final also confirmed withdrawal of the following: Multiple Mark Refusal, Ornamental Refusal, and the Information Request. The refusal under Trademark Act Sections 1, 2 and 45 for Failure to Function as Nondistinctive Product Design was made final along with requirements to amend the drawing and mark description to accurately describe the mark. Also made final was the requirement to provide an

acceptable specimen of use. Following the subsequent final refusal, this file was returned to the Board for resumption of the appeal.

ARGUMENT

I. THE APPLIED-FOR MARK CONSISTS OF NONDISTINCTIVE PRODUCT DESIGN OR NONDISTINCTIVE FEATURES OF PRODUCT DESIGN THAT IS NOT REGISTRABLE ON THE PRINCIPAL REGISTER WITHOUT SUFFICIENT PROOF OF ACQUIRED DISTINCTIVENESS.

A. Applicant's Mark Is A Configuration Mark Constituting Product Design.

Registration has been refused because the applied-for mark consists 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. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i).

Applicant seeks to trademark the foam material it uses to make assorted novelty items, thus the material composing the *whole* of the goods. However, the foam is incorporated into the goods in such a manner that it is not capable of standing out on its own as a perceptible mark. Rather, only when the foam is shaped into the individual products does a perceptible mark emerge, thus creating distinct configuration marks. Applicant's mark is more analogous to the penguin-shaped cocktail shaker referenced in *Wal-Mart*, where product design can consist of design features incorporated into a product. *In re Slokevage*, 441 F.3d at 962, 78 USPQ2d at 1399 citing *Wal-Mart Stores, Inc. v. Samara*

Bros., 529 U.S. at 207, 213. The juxtaposition of utilitarian items with the cheese-shaped foam material alters the impression of the entire product, transforming an ordinary item into a novelty item that is desirable to a specific consumer. In short, the “mark” (i.e., the foam) is inseparable from the goods themselves. *Id.* It follows that the use of the cheese-shaped foam in the drawing to make the disparate goods identified in the application creates distinct and different marks. See *Specimens* at pp. 2-4. Thus, Applicant’s foam is no more separable from the items it is formed into than a penguin design is separable from the cocktail shaker that is shaped like a penguin.

Applicant’s mark is a configuration mark constituting product design for two reasons. First, the design feature is not separable from the goods, but rather an integral component. This feature of the design is meant to appeal to a certain target audience. In other words, it is the fanciful design that makes the goods desirable. *Walmart*, 529 U.S. 205 at 214 (“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”). Thus, it is the fact that the cup holder, tie or hat is shaped like cheese that renders the items desirable, as these novelties are marketed to Green Bay Packer sports fans known as “Cheeseheads.” See *Specimens* at p. 3 that states the goods are “for extreme Cheesehead fans” and provides “Green Bay Packer Links.” Applicant’s specimen touts desirability of the novelty configuration in the display for the goods, in particular, the fact that sports fans can order various goods made from the foam. *Specimen* at p. 3.

The second reason the mark is a configuration mark is that it has obvious characteristics that are three-dimensional. When viewing use on the specimens, one can easily see the three-dimensional contours,

holes and pock marks that are part of the foam material in the drawing. These are not flat patterns or textures attached to existing products like the handbags in Applicant's evidence. Rather, the drawing shows the material composition of the goods, i.e., cheese-shaped foam, which features necessary three-dimensional characteristics that make the goods look like cheese. These features are created during the process of molding foam into different shapes of common objects, with the result being the appearance that the goods are made *entirely* from cheese. *See specimens of use.* For instance, the specimen for the class 21 sleeve holders (*Specimens*, at p.1) clearly shows a three-dimensional foam product with open holes and concave indentations and contours throughout the entire product. As a result, the holes, indentations and contours shown in the drawing define the overall configuration/shape of the products. In fact, the three-dimensional shapes created by the foam is plainly evident in all of Applicant's specimens, with holes, indentations and contours clearly visible in Applicant's novelty hats (*Specimens* at p. 5), ties (*Specimens* at pp. 6-7), Christmas tree ornaments (*Specimens* at p. 11).

Applicant urges the Board that the mark is applied to the surface of the goods and not the material composition of the goods. However, the Applicant's own description of the mark indicates the foam is the material molded into shapes in its Supplemental Brief at p. 7:

The three dimensional shape is created by different molds used for the various products made by the applicant, and those shaped or product configurations result in the utilitarian product sold by applicant – a hat, a football, a tie – all with a common pattern and color trade dress.

As discussed above, Applicant may not separate the color and pattern from the three-dimensional cheese configuration as these elements are fused together in the mind of the consumer.

Applicant has characterized its mark as a “unique combination of color and textured pattern on the surface of its variously configured products.” *Applicant’s Response* of 10/20/2014 at p.10. Clearly, Applicant’s mark is not merely a colored pattern that is applied to the surface of goods and would not be perceived so by consumers, who only purchase these items because they look as if they are made of cheese. What is patently obvious is that the foam shown in the drawing is formed into the resulting cheese-shaped product, not unlike Applicant’s Cheesehead hats worn at Green Bay Packer games. See *Specimen*, p. 3.

B. Applicant’s Product Design Is Nondistinctive.

Even if material composition was registrable trademark matter, Applicant’s foam on its own without a distinct shape is incapable of indicating source. Many competitors use cheese shaped foam to create novelty and promotional items. Please note the examples of cheese foam goods attached to the Office Action of May 21, 2014 (pp. 2, 3-4, 6, 9, 14, 17, 18, 20, 22), which indicate cheese-shaped foam products are not novel or inherently distinctive. It also shows that such goods are encountered under many different trademarks. That some of this use might be by licensees or infringers is invisible to the consuming public. Additionally, Applicant has not provided proof that it has pursued infringers with copies of cease and desist letters or copies of licenses.

Further, in addition to cheese-shaped foam products, products otherwise shaped like cheese are common and neither novel nor source-identifying. To illustrate, the examples of competing products

attached to the Subsequent Final of February 11, 2015 show the cheese-like products are utilized by numerous industries. (See *Subsequent Final of February 11, 2015* at pp. 2-16 showing myriad types of products such as novelty cheese knives, silicone cell phone holders and a cutting board, all configured to resemble cheese.) In addition, please note examples of cheese configurations in goods such as knife blades (p. 14) and an animal hideaway (p.12). Accordingly, based on the record, an overall cheese pattern cannot be considered capable of indicating source.

Even if Applicant's configuration mark was found to be capable, product design can never be inherently distinctive as a matter of law; consumers are aware that such designs are intended to render the goods more useful or appealing rather than identify their source. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. at 212-13, 54 USPQ2d at 1068-69; *In re Slokevage*, 441 F.3d at 962, 78 USPQ2d at 1399. Thus, consumer predisposition to equate a product design with its source does not exist. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. at 213, 54 USPQ2d at 1069. Applicant has not made a claim of acquired distinctiveness of record. Therefore, registration must be refused.

C. Applicant's Arguments And Evidence Are Unpersuasive.

Applicant's examples of third party registrations do not support the contention that its mark is not a configuration mark. Many of the cited marks are ornamental or nondistinctive background matter marks registered with Section 2(f) claims, for instance U.S. Reg. Nos. 1323310, 4104123 and 3009490. Others, such as U.S. Reg. Nos. 2946953 and 1924891, are nondistinctive ornamental features registered on the Supplemental Register. Still others are actually configuration marks appropriately registered with Section 2(f) claims, including U.S. Reg. Nos. 1413427 and 2236976 according to the mark descriptions.

And, the “Epi” leather examples from the Louis Vuitton marks are clearly distinguishable, as the pattern does not alter the nature of the product in the same manner as Applicant’s foam, which turns its goods into cheese-formed novelty items for Green Bay Packer fans. Furthermore, in none of the examples are there myriad disparate goods identified by the cited marks. Finally, none of the examples Applicant cites present the material composition of the goods as a trademark, where the whole of the goods are constructed from the material indicated in the drawing.

By contrast, Applicant’s cheese form foam is not merely texture applied to goods and is not in any way analogous to the registrations relied upon. The images of Applicant’s products clearly show that they have a three-dimensional shape created from the contours created by the random holes in the foam. The unique shape of the resulting products from the incorporation of the foam into the specific shape of the goods forms the mark, not material in the swatch drawing.

Accordingly, Applicant’s arguments that the mark is not a configuration mark are wholly unpersuasive and without merit.

II. APPLICANT’S DRAWING MUST BE A SUBSTANTIALLY EXACT REPRESENTATION OF THE MARK.

For applications based on §1, the mark drawing must be a substantially exact representation of the mark as used, or intended to be used, on or in connection with the goods or services specified in the application. 37 C.F.R. §2.51. Consumer perception of the image depicted by the specimens includes

both the shape of the goods and the material used to make the goods. As discussed above, the foam material is incorporated into the shape of the goods, thus forming the perceptible mark when shaped into the individual items. In order to accurately capture the nature of the configuration of the mark, the drawing must capture the precise shape of the goods.

A. Applicant Has Not Complied With Requirements for Configuration Marks.

For marks consisting of a configuration of the goods or a specific design feature of the goods or packaging, the drawing must depict a single three-dimensional view of the goods, showing in solid lines those features that Applicant claims as its mark. See 37 C.F.R. §2.52(b)(2); TMEP §§807.10, 1202.02(c)(iv); *In re Minn. Mining & Mfg. Co.*, 335 F.2d 836, 839, 142 USPQ 366, 368-69 (C.C.P.A. 1964). If the mark cannot be adequately depicted in a single rendition, Applicant must file a petition to the Director requesting that the requirement to provide a single rendition of the mark be waived. TMEP §807.10.

If the drawing of the mark includes additional matter not claimed as part of the mark (e.g., matter that shows the position or placement of the mark), Applicant must depict such matter using broken or dotted lines. 37 C.F.R. §2.52(b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §§807.08, 1202.02(c)(i); see *In re Water Gremlin Co.*, 208 USPQ 89, 91 (C.C.P.A. 1980). Applicant's mark is a configuration mark and thus, requires more than the swatch drawing.

B. Applicant's Swatch Drawing is Insufficient.

Even if Applicant's mark was a repeating pattern and not a configuration mark, the swatch drawing is not acceptable because it is not a substantially exact representation of the mark. The impression changes significantly when the repeating patterns are used to create different items, such as use on a hat versus a beverage insulation sleeve. Thus, the swatch drawing encompasses multiple marks. Additionally, because the practice of utilization of cheese-shaped foam as a material composition of goods in and of itself is not capable of indicating source, there is no evidence to rely on the swatch as indicating the nature of the mark.

Applicant would require the Office to allow it to present the swatch merely because other Applicants have done so without considering the differences in the nature of Applicant's mark. However, it is well-settled that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). Here, when considering the look of the mark as used on the specimens of use, it is clear that Applicant's three-dimensional mark is not analogous to any of the marks it has cited. Thus, because the swatch shown in the drawing depicts only the material composition of the goods, it is therefore not a substantially exact representation of the mark as used on the specimens.

C. Applicant's Goods Are Disparate Goods.

In amending the drawing, Applicant may not submit individual drawings for all of the items listed in the identification of goods because doing so would render the mark as failing to function due to the disparate goods. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see TMEP §1202.02(f)(i). Slight variations in the appearance of a mark comprising a three-dimensional product design may be acceptable if all products in a product line or series have a “consistent overall look” such that (1) the product design conveys a single and continuing commercial impression, and (2) any changes to the product design do not alter its distinctive characteristics. TMEP §1202.02(f)(i); *cf. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 173, 57 USPQ2d 1125, 1131 (3d Cir. 2000) (quoting *Rose Art Indus., Inc. v. Raymond Geddes & Co.*, 31 F. Supp. 2d 367, 373, 49 USPQ2d 1180, 1184 (D.N.J. 1998), *rev’d on other grounds sub nom. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 57 USPQ2d 1125 (3d Cir. 2000)) (requiring a party seeking protection under Trademark Act Section 43(a) for unregistered trade dress of a series or line of products to establish a “consistent overall look” for the trade dress of those products).

Here, the nature of the goods is so different that there is no consistent overall look, as a tie looks completely different from a football, for instance. Thus, changes in the appearance of the mark on different goods are consequential and alter the overall impression of the goods. Due to the disparate goods, the mark as depicted by the swatch would fail to function as a trademark to identify and distinguish all of Applicant’s goods from those of others, and to indicate the source of Applicant’s goods. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see TMEP §1202.02(f)(i).

An Applicant may apply for only one mark in a single application. 37 C.F.R. §2.52; TMEP §807.01; see, e.g., *In re Int’l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999); *In*

re Hayes, 62 USPQ2d 1443, 1445-46 (TTAB 2002). Thus, amending the drawing to show the configuration of all of the identified goods would create multiple marks.

Accordingly, while Applicant must provide a drawing showing the shape of the mark for a particular good, because the disparate goods create an inconsistent overall look of the products and because of the prohibition against registering multiple marks in a single application, Applicant may not provide drawings of all of the goods recited in the application. Because Applicant has failed to provide an acceptable drawing, registration should be refused. *See Examination Guide 1-15 Repeating Pattern Marks*, June 2015.

III. APPLICANT MUST PROVIDE AN ACCEPTABLE MARK DESCRIPTION.

A mark description must accurately state what the mark comprises. TMEP 808.02. It may not be used to create a misleading impression or limit the perception of the nature of the mark. TMEP 808.03(g) (“the description may not be used to state any limitations as to how a mark does not and will not appear.”). Therefore, because Applicant’s mark is not merely a texture and color applied to the goods but encompasses the shape and material composition of the goods, Applicant must provide an accurate description of the mark. Here, Applicant must provide a description that:

(1) Indicates that the mark is a three-dimensional configuration of the goods or of a specific design feature of the goods;

(2) Specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark; and

(3) Specifies any elements which are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.

See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 178 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii). As Applicant has failed to comply in any manner with the mark description, registration must be refused.

IV. APPLICANT HAS FAILED TO PROVIDE AN ACCEPTABLE SPECIMEN.

Registration was refused because the specimens differ significantly from the mark shown in the swatch drawing. The mark is so merged with the identified goods, which are formed from the physical material shown in the mark, resulting in different marks for the individual goods. The mark as shown on the goods varies considerably from the mark in the drawing. Thus, the specimens do not match the drawing and registration must be refused under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Accordingly, registration should be refused.

Conclusion

For the forgoing reasons, it is respectfully requested that the Board affirm the refusal to register Applicant's proposed mark.

Respectfully submitted,

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