

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
September 11, 2015

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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*In re Foamation Inc.*

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Serial No. 85690391

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Lori S. Meddings and Laura M. Konkel of Michael Best & Friedrich LLP, for  
Foamation Inc.

Renee Servance, Senior Attorney, Law Office 116 (Christine Cooper,  
Managing Attorney).

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Before Quinn, Ritchie, and Masiello, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Foamation Inc., applicant herein (“Applicant”), seeks registration on the  
Principal Register of the proposed mark shown below for “foam coasters;  
insulating sleeve holders for beverage cans and bottles; foam storage  
baskets,” in International Class 21; “headwear; hats; ties; ear muffs; belts,” in

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International Class 25; and “Christmas tree ornaments; flying discs; toy bricks; balls for sports; footballs,” in International Class 28:<sup>1</sup>



The mark contains the following description:

The mark consists of 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.

The Trademark Examining Attorney who was originally assigned to examine the application issued several refusals and requirements, which

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<sup>1</sup> Serial No. 85690391, filed on July 30, 2012 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1152(a), claiming May 1990 as the dates of first use and first use in commerce for the goods in International Classes 21 and 28, and May 1987 as the dates of first use and first use in commerce for the goods in International Class 25.

were made final, and an appeal was filed on January 7, 2014. The case was reassigned to the current Examining Attorney, who requested remand for further examination on April 17, 2014, which was granted the same day. After remand, the Examining Attorney issued a refusal on the ground that the mark constitutes non-distinctive product design and constitutes the configuration of the goods without a showing of acquired distinctiveness pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, 1127.<sup>2</sup> The Examining Attorney also issued requirements for:

- 1) a product configuration drawing that depicts Applicant's mark in the drawing to include broken or dotted lines to show the position of the mark on goods or container, 37 CFR 2.52(b)(4);
- 2) an amended mark description that accurately describes the mark, 37 CFR 2.37; 2.52(b)(2) and (b)(4); and
- 3) an acceptable specimen of use, 37 CFR 2.63(b).

When the refusal and requirements were made final, the appeal was resumed and Applicant filed its supplemental appeal brief. Both Applicant and the Examining Attorney filed briefs, and Applicant filed a reply brief.

### **Product Design**

Product design may not be registered without sufficient proof of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 US 205, 209-210, 54 USPQ2d 1065, 1066 (2000). The Examining Attorney asserts that the mark Applicant is attempting to register falls under this category, arguing that what Applicant seeks to register is nondistinctive product design or

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<sup>2</sup> The Examining Attorney withdrew all prior refusals, including phantom mark refusal under Sections 1 and 45, 15 U.S.C. §§ 1051, 1127; multiple marks refusal under Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127; ornamentation refusal under Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052, 1127; and a request for information.

nondistinctive features of product design “where the foam design shown in the drawing creates the commercial impression that Applicant’s goods are made of cheese.” 12 TTABVUE 4. In particular, the Examining Attorney notes two rationales for finding the mark to constitute product design, first that Applicant’s goods are “shaped like cheese,” and second that the mark has the texture of cheese which “define[s] the overall configuration/shape of the products.” 12 TTABVUE 8.

Applicant argues that the Examining Attorney misses the point on its mark, arguing that

It is not the three-dimensional configuration of Applicant’s products that creates the mark. It is strictly the surface color and texture combination that creates the cheese appearance consumer [sic] recognize and that Applicant seeks to register. 10 TTABVUE 5.

We agree with Applicant that its mark must be viewed as a mark composed of a combination of color (yellow/gold) and texture (circular or oval shaped depressions applied to the entire surface of the goods), as set forth in the description thereof. The description states that this combination of color and texture “evokes the appearance of cheese.” This refers not to the shape of the goods, though, but to the color and texture of the surface of the goods, regardless of the goods’ overall shape. Indeed Applicant’s specimens show that some of its goods are shaped like cheese wedges (*e.g.*, some of the hats and beverage holders), while others have different overall shapes (*e.g.*, a bow tie, a basket, a star, a football):

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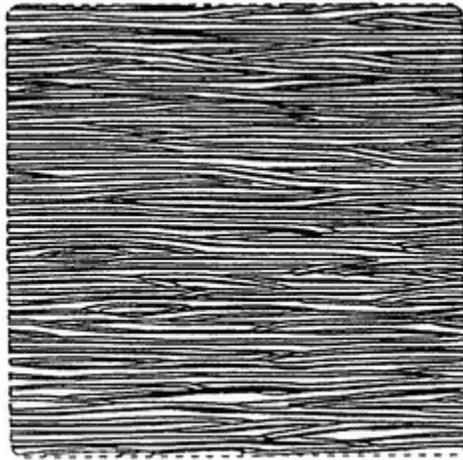




Nevertheless, it is equally clear that the color and texture form part of the design and configuration of the product, as the texture necessarily affects, in part, the shape of the goods and the manner in which consumers perceive the goods. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 54 USPQ2d at 1068 (finding that “design, like color, is not inherently distinctive.”) and *In re Slokevage*, 441 F3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006) (finding product design consisted of specific features). In accordance with this guidance and our analysis above, we find that Applicant’s mark is not registrable without a showing of acquired distinctiveness.

Applicant, in its attempt to justify the registration of its proposed mark, cites to a number of registrations for third-party marks, including various

texture marks, such as Louis Vuitton's Registration No. 2263903 for the mark shown below for various leather goods:



The registration describes the mark as follows:

The mark consists of a distinctive man-made textured pattern utilized as a surface feature of applicant's variously configured products. The pattern is displayed in contrasting shades of the same color, the darker shade presented on the elevated portion of the surface and the lighter shade serving as the background or lower surface. The lining shown is a feature of the mark and does not indicate specific color. No claim is made to the broken lines which reflect the positioning of the mark. The drawing shown in the application depicts a change purse.

As the Examining Attorney points out, this registration, as most of the others, is registered with a Section 2(f) claim of acquired distinctiveness.<sup>3</sup> Accordingly, this simply serves to support the Examining Attorney's argument that Applicant's texture mark may be registered on the Principal Register only with a claim of acquired distinctiveness. We agree.

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<sup>3</sup> Others are registered with either a Section 2(f) claim of acquired distinctiveness on the Principal Register, or are registered on the Supplemental Register.

Applicant was given several opportunities to either claim acquired distinctiveness or to amend to the Supplemental Register. It is untimely for Applicant, on appeal, to state that “Only when the Board resolves this issue and confirms that the applied-for design can function as a trademark can Applicant demonstrate its distinctiveness.” 10 TTABVUE 13. It was incumbent on Applicant to do this during the prosecution of its application.<sup>4</sup>

### The Requirements

Based on our affirmance of the trade dress refusal, we find the requirements to be apt. Trademark Rule 2.52(b)(4) provides, in relevant part:

*(4) Broken lines to show placement. If necessary to adequately depict the commercial impression of the mark*, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. ... For any drawing using broken lines to indicate placement of the mark, ... the applicant must describe the mark and explain the purpose of the broken lines.

37 C.F.R. § 2.52(b)(4) (emphasis added).

Applicant’s mark is sufficiently unconventional in nature that it was reasonable of the Examining Attorney to require a drawing that shows the placement of the mark on the goods (or at least on one of the goods), for the purpose of clarifying for the USPTO and the public the nature of the mark to be registered. The amendment of the drawing in this manner would have also

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<sup>4</sup> In this regard, Applicant also could have claimed acquired distinctiveness in the alternative. TMEP § 1212.02(c) (2015); TBMP § 1215 (2015) (“[I]t is the applicant’s responsibility to make clear that it is taking alternative positions.”). See, e.g., *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1419 (TTAB 2010); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009).

required a corresponding amendment to the description of the mark, as well as a specimen that matches the drawing.

In particular, since we have found that Applicant's mark constitutes product trade dress, we affirm the requirements for 1) a drawing that shows the placement of Applicant's mark on the goods, with broken or dotted lines to show the position of the mark on goods or container as required by 37 CFR 2.52(b)(4); 2) an amended mark description that accurately describes the mark as applied to the goods, in accordance with 37 CFR 2.37 and 2.52(b)(2); (b)(4); and 3) an accurate specimen of use that matches the drawing.

Hence, the requirements are all affirmed.

Decision: The refusal to register on the ground that Applicant's mark constitutes a nondistinctive product design that has not been shown to have acquired distinctiveness is affirmed. The three requirements are also affirmed, requiring: 1) a drawing that shows the placement of Applicant's mark on the goods, with broken or dotted lines to show the position of mark on goods or container; 2) a corresponding amended mark description that fully describes the mark and its position or placement on the goods; and 3) an accurate specimen of use that matches the drawing.