

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
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ARM

Mailed: November 20, 2014

In re Dyson Limited

Serial No. 85708119

Filed: 8/20/2012

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By the Trademark Trial and Appeal Board:

Applicant Dyson Limited has appealed from the Examining Attorney's refusal of registration of Applicant's mark on the ground that the mark is functional, under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5). It appears to the Board that an issue not raised during examination may render Applicant's mark unregistrable. In particular, Applicant's mark may be unregistrable because it consists of a nondistinctive product design and, thus, does not function as a mark, under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127. A mark that consists of product design trade dress is never inherently distinctive and is not registrable on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205,

213-216, 54 USPQ2d 1065, 1069-70 (2000). We note that Applicant filed with its application a claim that its mark had acquired distinctiveness, supported by a declaration of Applicant's Group IP Director Gillian Ruth Smith, and at various times filed evidence that could support a claim of acquired distinctiveness. However, the Examining Attorney never issued a refusal other than the refusal under Section 2(e)(5) and never considered Applicant's claim of acquired distinctiveness, taking the position that "the applicant's claim of acquired distinctiveness cannot be considered" because "[a] determination that an applied-for configuration mark is functional constitutes an absolute bar to registration..., regardless of any evidence of acquired distinctiveness."¹

Because a finding that Applicant's mark is a nondistinctive product design that has not acquired distinctiveness would render Applicant's mark unregistrable regardless of any finding regarding the mark's alleged functionality, we hereby suspend this appeal and remand the application to the Examining Attorney for further examination, under 37 C.F.R. § 2.142(f)(1) ("If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examiner for further examination to be completed within thirty days.")

¹ Final Office Action of July 15, 2013 at 3 (emphasis omitted); *see also* Office Action of December 20, 2012 at 3.

Within thirty (30) days from the mailing date of this order, the Examining Attorney must take the following actions:

(1) Examine the application to determine whether a refusal of registration is warranted on the ground that Applicant's mark consists of a nondistinctive product design and, thus, does not function as a mark, under Sections 1, 2, and 45 of the Trademark Act. In connection with such examination, the Examining Attorney should examine all of the evidence of record having a bearing upon Applicant's claim of acquired distinctiveness.

(2) If the Examining Attorney finds that Applicant has demonstrated that its mark has acquired distinctiveness under Trademark Act § 2(f), 15 U.S.C. § 1052(f), or if the Examining Attorney finds for any other reason that no additional refusal is warranted, the Examining Attorney should promptly return the application to the Board with a written statement that further examination did not result in an additional ground for refusal of registration. *See* 37 C.F.R. § 2.142(f)(2). The six-month response clause should be omitted from such Office action. The Board will then resume the appeal relating to the refusal under Section 2(e)(5).

(3) If further examination does result in an additional ground for refusal of registration, the Examining Attorney should issue a non-final Office action stating all applicable refusals and requirements, allowing Applicant an opportunity to respond before issuing a new final refusal (with the six-month response clause omitted) and returning the application to the Board for resumption of the appeal. If the new final refusal of registration states an

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additional ground of refusal, upon resumption of the appeal the Board will allow Applicant and the Examining Attorney an opportunity to supplement their appeal briefs to address the additional ground of refusal, all in accordance with 37 C.F.R. § 2.142(f). *See* TBMP § 1209.01 (2014).

Proceedings in the appeal are suspended and the application is remanded to the Examining Attorney for action as detailed above.