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Sent: 8/4/2014 7:56:34 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 85708119 - 42466-240970 - EXAMINER BRIEF

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Count: 1

Files: 85708119.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85708119

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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: Dyson Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

42466-240970

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EXAMINING ATTORNEY'S APPEAL BRIEF

Statement of the Case

The applicant has appealed the examining attorney's refusal to register a mark consisting of a three-dimensional configuration of a bladeless fan. The mark was refused as a functional design for the goods under Trademark Act Section 2(e)(5), 15 U.S.C. §1052 (e)(5); *see* TMEP § 1202.02(a)(ii).

Statement of Facts

The original application was filed on August 20, 2012, on a use basis. The applicant included a claim of acquired distinctiveness.

The examining attorney refused registration on December 20, 2012, on the ground that the three-dimensional configuration claimed was functional. The examining attorney noted that functionality is an absolute bar to registration, despite any claim of acquired distinctiveness.

On June 20, 2013, the applicant responded, arguing that the trade dress as a whole was not functional.

The examining attorney made final her refusal on July 15, 2013.

On January 15, 2014, the applicant filed a request for reconsideration.

The examining attorney denied reconsideration on March 18, 2014. This appeal followed.

Issue

Is the proposed trade dress consisting of the configuration of a circular ring on top of a column-shaped base a functional design of a bladeless fan under the terms of Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5)?

Argument

“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.’” TMEP §1202.02(a) (quoting *Qualitex Co. v Jacobson Prods. Co.*, 514 U.S. 159 (1995)(quoting *Inwood Labs, Inc.*, 456 U.S. 844, 850 n. 10 (1982)). The prohibition against registration of functional features “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.” TMEP § 1202.02(a)(ii).

The *Morton-Norwich* case sets forth the factors that must be considered in assessing functionality. They are:

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 (Fed. Cir. 2012); *in re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (CCPA 1982); TMEP § 1202.02(a)(v)

I. The Proposed Trade Dress is Functional Because it is Covered by the Applicant’s Utility Patents

In order to assess whether the proposed trade dress is covered by the applicant’s utility patents, it is important first to consider what the applicant has claimed. The applicant states that its mark consists of “[a] circular ring on top of a column-shaped base with inlets and buttons.” The drawing shows a ring on top of a cylindrical base that features three buttons close to the bottom of the base. An

area of air-inlet mesh encircles the base. The drawing also discloses three single-line circles girdling the base, one below the fan ring, one below the buttons, and a slightly hyperbolic circle below the air inlet.

The examining attorney discusses each aspect of the claimed design below. The applicant protests that this is not an acceptable way to proceed, and that the features of the claimed design cannot be considered separately. The case law, however, supports this as the only practical approach to take in most cases. As the Board stated in *In re Smith, Inc.*, 219 USPQ 629, 632 (TTAB 1983), “in most cases the best that can be done is to analyze a configuration from the standpoint of its various features,” and further that “consideration should be given to the functional aspects of the *separate* elements which applicant claims serve as its mark (emphasis added), *aff’d* 734 F.2d 1482 (Fed. Cir. 1984); *see also In re Controls Corp. of America*, 46 USPQ2d 1308, 1312 (TTAB 1998) (“it has been recognized that it is sometimes helpful to analyze a configuration from the standpoint of its various features”).

A. The Nozzle

The applicant is the owner of a multitude of utility patents. Although not all of them focus primarily on the ring and base, a very large number of patents include identical claims regarding a circular ring and a cylindrical base. Each of the following patents claims a nozzle that is “substantially annular” (meaning ring-shaped), “at least partially circular,” and in the form of a “loop”: U.S. Pat. 7,931,449 (claims 7-9), U.S. Pat. 8,308,445 (claims 3-5), U.S. Pat. 8,403,650 (claims 3-5), U.S. Pat. 8,348,629 (claims 8-10), U.S. Pat. 7,972,111 (claims 12-14). The fact that the main focus of the patent may be on other aspects of the invention, as the applicant states, is not dispositive. It is enough that the elements sought to be registered appear in the patent claims, and that their utilitarian functions are described.

The applicant's patents quite clearly describe the utilitarian advantages of the claimed trade dress. With regard to the circle or loop feature, U.S. Pat. 7,931,449 states:

Preferably the nozzle comprises a loop In a preferred embodiment the nozzle is annular. By providing an annular nozzle the fan can potentially reach a broad area. In a further preferred embodiment the nozzle is at least partially circular.

All of the patents referenced above contain similar language. U.S. Pat. 7,931,449 further states that the circular design means that the nozzle "can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs." U.S. Pat. 8,403,650 contains almost identical language. This language discloses a second utilitarian advantage of the claimed trade dress, namely, ease of manufacture. Thus, the circle or loop is functional both because it allows the fan to reach a broad area and because it permits the circular portion of the fan to be manufactured as a single piece.

B. The Cylindrical Base

The applicant's patents also describe the cylindrical base of the claimed trade dress. The following patents describe a cylindrical base: U.S. Pat. 7,972,111 (claim 7), U.S. Pat. Pub. 2011/0058935 (claim 5), U.S. Pat. Pub. 2010/0226787 A1 (claim 5), U.S. Pat. Pub. 2012/0082561 claim 17), and U.S. Pat. 7,972,111 (claim 4). In the judge's order referenced by the applicant and made of evidence in the record of this case (*Cornucopia Prods., LLC v. Dyson, Inc.*, Case No. CV 12-00924 PHX-NVW, 2012 U.S. Dist. LEXIS 104750 (D. Ariz. July 27, 2012)), the judge noted that, since the internal blades housed in the base of the applicant's fan rotate in a circle, a cylindrical housing, or base, is the most efficient form to contain them. (Order at 15). Thus, this feature too is functional. The Order states:

The function of the base is as a platform for the concealed fan that draws air from around the base and forces it into the nozzle for discharge. Since exposed fan blades

are an obvious safety hazard, some sort of housing is necessary. And since the fan blades rotate in circular fashion, any sort of housing will, at a minimum, be cylindrical.

The cylindrical shape of such housing is not just one among many equally useful shapes. Rather, function requires cylindrical housing of the fan, or air and pressure would be lost between the blades and the housing. Thus, [the witness] was right that numerous designs could accommodate the impeller and ducting inside the base without changing the fan's performance or stability – but only in the sense that the operating internal cylindrical shape could be hidden with an additional external covering of any shape. The question here is whether Dyson can monopolize the look of a cylindrical form that is functional. The answer in general is no. The look of a cylinder is not arbitrary or decorative; it is the look of operation.

Order at 15-16.

As any housing for the impeller assembly must be cylindrical, it is readily apparent that there are manufacturing advantages for a cylindrical base: Such a base uses the least amount of material to perform the necessary functions of enclosing the impeller and supporting the nozzle. In addition, as U.S. Pat. Pub. 12/716,749 discloses, such a cylindrical base is composed of a single flush surface, having “the benefit of allowing the outer surfaces of the base and the body to be quickly and easily wiped clean.” (U.S. Pat. Pub. 2010/0226787, para. [0013], found at Applicant's Request for Reconsideration dated 1/15/2014, at 257).

C. The Inlets

The base of the applicant's fan is encircled by mesh-like air inlets. There can be no question that any enclosed housing for a fan must include both an inlet and an outlet. In this case, the size of such an inlet is dictated by the optimum amount of air to be displaced by the fan: too small, and the impeller will work too hard; too large, and the inlet will result in unnecessary manufacturing costs as

well as possible decreased structural integrity. U.S. Pat. 7,931,449 (Request for Reconsideration dated 1/15/2014 at 178) (air inlets positioned so that primary air flow creates a low pressure area).

The area of the inlet surface being dictated by the volume of air moved by the impeller, we must now look to the placement. Again, such placement is dictated by the impeller assembly. The inlet must be at the opposite end from the outlet. Therefore, the placement of the inlets on the base must be below the impeller unit. In order to minimize material costs, such inlets would ideally be placed directly below the impeller assembly. "This can provide a short, compact air flow path that minimises [*sic*] noise and frictional losses." (Request for Reconsideration dated 1/15/2014 at 258). To minimize the vertical footprint of the inlet (again reducing material costs of manufacture), the surface of the inlet should be oriented horizontally around the base, as is shown in the drawing and disclosed in Pat. App. 12/716,749 (Request for Reconsideration dated 1/15/2014 at 253).

There are only a limited number of options for the placement of such an inlet, given the functional requirements dictated by the unseen impeller assembly and the demonstrated utilitarian shape of the base. See U.S. Pat. 8,308,445 (Request for Reconsideration dated 1/15/2014 at 192) (describing the relationship between the inlet and outlet aspects of the invention). As the size and placement of the inlet is optimized to the functioning of the impeller assembly, the inlet also is functional.

D. The Three Lines

The drawing also shows that the base unit is encircled by three lines. These lines, however, are not decorative. Instead they are artifacts of additional utilitarian features of the fan. The upper line indicates an oscillating portion of the base, one that enables the nozzle to be turned from side to side. See Pat. App. 12/716,749 (Request for Reconsideration dated 1/15/2014 at 248 and 259).

The middle line, slightly hyperbolic in shape, is an artifact of the tilting feature of the fan. *Id.* at 252 and 257-258.

The bottom line is merely indicative of a connection between the lower base member and the upper base member. *Id.* at 252 and 260.

All three of the lines are merely byproducts of the method of construction, and are indicative of the simplest and most basic connections. As such, they too are purely functional in nature.

E. The Control Buttons

Finally, the applicant's proposed trade dress includes buttons. Every electrical device must have an on/off switch of some type. The applicant has not put into the record any evidence that these buttons are unique in appearance or placement. Rather, they perform the simple utilitarian function of allowing the device to be activated. *See* Pat. App. 12/716,749 (Request for Reconsideration dated 1/15/2014 at 248 and 259); U.S. Pat. 7,931,449 Request for Reconsideration dated 1/15/2014 at 178) (buttons allow device to be operated).

The applicant argues that even though each of the individual features of its device may be functional, the design as a whole is not functional. The applicant, however, has not pointed to any aspect of the design that is not functional. In previous cases, the Board has stated that an applicant that believes its design contains non-functional features should file an application specifically for those features. *See, e.g. In re R.M. Smith, Inc.*, 219 USPQ 629, 633 (TTAB 1983) ("We are not called upon to decide whether *any* of the separate features listed by the applicant does in fact function as a trademark for applicant's water nozzle. If applicant so believes, it may file an application seeking registration only of such arbitrary and non-functional features, with unclaimed features being shown in the dotted lines"), *aff'd In re R.M. Smith, Inc.*, 734 F.2d, 1482) (Fed. Cir. 1984). Here, the applicant has not pointed

to any specific feature of its device that is not covered by its utility patents and could function independently as a trademark.

The applicant further references *In re Weber-Stephen Prods., Co.*, 3 USPQ2d 1659 (TTAB 1987). The applicant cites that case for the proposition that, where the patent in question lists many possible embodiments, the particular embodiment at issue in a trademark application will not be held to be functional. In this case, however, as noted above, the applicant itself has noted that the design sought to be trademarked both optimizes the performance of the fan and is less expensive and easier to manufacture. The applicant's utility patents make clear that each of the features shown is superior to alternative designs. Thus, the *Weber* case is not persuasive.

I. **The Applicant's Advertising Touts the Utilitarian Advantage of the Trade Dress**

The applicant's own advertising touting the utilitarian aspects of its product design or product packaging is often strong evidence supporting a functionality refusal. *See, e.g., In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375-76, 102 USPQ2d 1372, 1377-78 (Fed. Cir. 2012); TMEP §1202.02(a)(v)(B). In the present case, the applicant's advertising makes repeated reference to various functional features of the proposed trade dress.

An advertisement attached to the examining attorney's final refusal includes the following statement, "Airflow is accelerated through an annular aperture" (Final Refusal at 6) The examining attorney previously attached a definition that explains that "annular" means "ring-shaped." Thus, this advertisement states that the ring shape is one of the reasons that the airflow accelerates to create the breeze blown by the applicant's fan. Another Dyson advertisement states, "Air Multiplier technology generates smooth, uninterrupted air flow using an annular jet" (Final Refusal at 24). Again the ring shape is described as essential to the smooth, continuous air flow.

The TMEP also states that the examining attorney may consult third-party sources for evidence of functionality. The TMEP states, “In addition, [the] examining attorney may check the websites of applicant’s competitors for evidence of functionality. See *In re Van Valkenburgh*, 97 USPQ2d 1757, 1762-63, (TTAB 2011); *Gibson Guitar*, 61 USPQ2d at 1951. Industry and trade publications and computer databases may also be consulted to determine whether others offer similar designs and features or have written about the applicant’s design and its functional features or characteristics.” TMEP §1202.02(a)(v)(B).

In the present case, third-party sources confirm the functional nature of the applicant’s trade dress. For example, the Wikipedia entry for a bladeless fan states, “A ‘bladeless fan’ blows air from a *ring* with no blades” (Final Refusal at 20) (emphasis added). The entry further states, “The air goes into the base. It is then sent up into a *ring*.” *Id.* (emphasis added). Thus, the ring shape is described as an essential part of a bladeless fan.

An electronics review site also mentions the importance of the Dyson ring shape stating, “the pedestal of the fan contains a brushless electric motor that takes in air and feeds it into the *circular* tube” (Final Refusal at 9) (emphasis added).

An article in Time magazine contains the clearest statement of the importance of the ring shape to the Dyson fan:

The motor in the base of the fan sucks in air and pushes it up into the *ring*. The air rushes out of tiny, millimeter-long slots that run along the circular frame and flows down a gently sloping ramp. As the air emerges from the ramp, it creates a *circular* low pressure region that pulls in the air from behind, creating a fairly uniform flow of air through the *ring*.

(Final Refusal at 16) (emphasis added). This language dovetails with advertisements created by Dyson.

While these advertisements do not mention the word “ring,” they discuss the functional advantages of

the ring. *See, e.g.*, Application at 14 (“surrounding air drawn into air flow” with a pointer showing air drawn into the ring shape).

Thus, the second Morton-Norwich factor, the applicant’s own advertisements as well as articles by third parties both point to the conclusion that the shape of the trade dress is functional.

II. Although Other Designs Exist, This Design is the Simplest and Most Efficient

The applicant has submitted evidence that other designs for bladeless fans exist. The applicant’s own utility patents, however, describe the advantages of a simple ring design. As noted above, U.S. Pats. 7,931,449 and 8,403,650 state that the circular design means that the nozzle “can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs.” The Supreme Court has stated that, even when other designs are available, if a design effects the “cost or quality” of a product, it is functional, and competitive need does not have to be considered. TMEP §1202.02(a)(v)(C) (citing *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001)). Since the applicant itself has stated in its utility patent that the current design is functional, the evidence regarding alternative designs is not relevant. This answer disposes of the fourth Morton-Norwich factor as well; the applicant’s own utility patents proclaim that the design is the most simple and inexpensive alternative.

The applicant has offered additional arguments that must be addressed. First, the applicant argues that the proposed mark shown here is greater than the sum of any features covered by its utility patents. As shown above, however, each feature shown in the drawing is covered by the applicant’s utility patents and therefore functional. The applicant cannot point to any aspect of it that is not covered by a utility patent, nor has the applicant explained in what way the whole is greater than the sum of its functional parts.

The applicant further argues that the court order it has submitted into the record holds that the design as a whole is not functional. The order, however, granted a preliminary injunction. As such, the order simply states that the balance of equities favored the applicant's position, and that barring the importation of the allegedly infringing fan should be granted to preserve the status quo until the matter can be adjudicated. The applicant has not submitted a final opinion, based on a fully briefed case, in which a court held that the applicant's trade dress was not functional. Moreover, the granting of a preliminary injunction is not binding on the Board. Rather, the Board should be guided by the strong evidence that the trade dress is in fact functional.

III. **Applicant's Design Patents**

The applicant contends that the existence of design patents proves that the claimed trade dress is not functional. For the purposes of this analysis, only U.S. design patents are considered, since the standards for examination in other countries are not known. The applicant has made of record two U.S. design patents – D602,143 and D605,748. Only one of these patents claims the entire configuration at issue here; the other patent portrays the base in dotted lines. Even the second patent is not persuasive, because:

[O]wnership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination. *See In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377; *In re Witco Corp.*, 14 USPQ2d 1557, 1559 (TTAB 1989).

TMEP § 1202.02(a)(V)(A); *see also In re R.M. Smith, Inc.*, 734 F.2d 1482, 1486 (Fed. Cir. 1984) (the existence of a design patent does not by itself show that a design is distinctive or capable of functioning as a trademark) (quoting *In re Honeywell Inc.*, 532 F.2d 180 (TTAB 1976)); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997) (“The existence of a design patent, while some evidence of non-

functionality, is not alone sufficient”). It is unclear in the present case why the design patent was granted, given the evidence of functionality presented in the utility patents. Here, the evidence of functionality is compelling and outweighs the fact that design patents have been granted.

Claim of Acquired Distinctiveness

Finally, the applicant has included evidence that its mark has acquired distinctiveness. When trade dress is found to be functional, however, that is an absolute bar to registration. Thus, evidence of acquired distinctiveness need not be considered. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001).

Summary

The examining attorney has demonstrated that each of the salient features of the applied-for mark is purely functional. In particular, the examining attorney has shown that each element shown in the drawing has a particular utility, as disclosed in the applicant’s utility patents and promotional literature. Specifically, the ring shape of the nozzle maximizes air flow and optimizes ease of manufacture. The cylindrical base is the ideal shape to contain the concealed fan element. The inlets optimize air flow, the lines allow the fan to tilt and stand stably on its base, and the buttons allow the fan to be turned on and off. The elements as a whole combine to create a functional design.

Furthermore, the examining attorney has set forth reasons for why alternate designs, while available, are not as effective, efficient, or cost-effective to manufacture as the form shown in the drawing. Finally, the examining attorney has explained why, when the individual utilitarian features are combined, the form at hand is the most cost-effective and efficient way to do so. As the examining attorney has demonstrated that the proposed mark, as a whole, is merely functional pursuant to Section 2(e)(5) of the Trademark Act, she respectfully requests that the refusal to register be *affirmed*.

Respectfully submitted,

/Doritt Carroll/

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