

This Opinion is Not a  
Precedent of the TTAB

Hearing: December 16, 2014

Mailed: September 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re E.R. Shaw, Inc.*  
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Serial No. 85797528  
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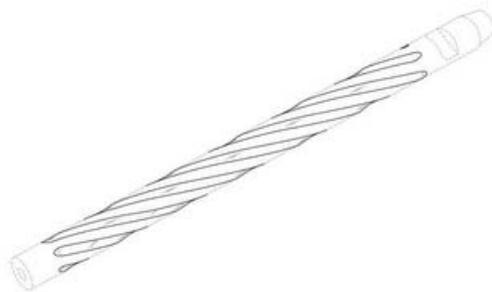
Paul M. Reznick, Cecilia R. Dickson and Steven M. Johnston  
of The Webb Law Firm, for E.R. Shaw, Inc.

Frank J. Lattuca, Trademark Examining Attorney, Law Office 109,  
Dan Vavonese, Managing Attorney.

—  
Before Zervas, Wellington, and Kuczma,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

E.R. Shaw, Inc. (“Applicant”) has applied to register the following configuration  
mark on the Principal Register for “rifle barrels; rifles” in International Class 13:<sup>1</sup>



<sup>1</sup> Application Serial No. 85797528 filed on December 7, 2012.

The mark (hereinafter referred to as the “rifle barrel configuration mark”) is described in the application as follows:

The mark consists of a three-dimensional configuration of external helical fluting around a gun barrel. The dotted lines featuring the rest of the gun are to show position of the configuration and are not claimed as part of the mark.

The application is based on an allegation of first use anywhere and in commerce on December 31, 1999, and contains a claim that the mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

The Examining Attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that the rifle barrel configuration mark is a functional design of the identified goods, namely, rifle barrels.

In addition, the Examining Attorney has refused registration on the basis that Applicant failed to respond fully to a request for information pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b).

Applicant filed a request for reconsideration and then appealed. The Examining Attorney denied the request for reconsideration. Both Applicant and the Examining Attorney filed briefs, including a reply brief from Applicant. In addition, Applicant and the Examining Attorney presented arguments at an oral hearing held before this panel on December 16, 2014.

*Background – The Goods and the Proposed Mark*

Applicant seeks to register its proposed rifle barrel configuration mark in connection with rifles and rifle barrels. A “rifle” is described as:<sup>2</sup>

... a small firearm discharged from a shoulder position and having a helically grooved, or rifled, bore, which imparts an axial spin to a bullet as it travels through the barrel. This gyroscopic action keeps the bullet’s axis in the line of flight, reducing air resistance and allowing the use of longer projectiles with round or ogive (arch) points. The number of turns in the rifling throughout the barrel depends on the type of rifle and bullet it will fire.

The described “helically grooved” feature in this definition is on the inside of the rifle barrel or the “bore.” This may be distinguished from “fluting” where material is removed from the outside of the gun barrel, “usually [by] creating grooves,” and “[t]he main purpose [of which] ... is to reduce weight, and to a lesser extent increase rigidity for a given total weight or increase surface area to make the barrels less susceptible for overheating for a given total weight.”<sup>3</sup> The advantages of a fluted rifle barrel are corroborated by Applicant’s own website describing its use of helical fluting:<sup>4</sup>

[T]he unique appearance of our Helical Fluting provides the discriminating shooter with a barrel that not only looks great but is up to thirty percent more rigid than a similar barrel with Straight Fluting. Helical fluting provides additional surface area for improved cooling, improved barrel harmonics, and helps counteract rotational torque, giving the shooter greater shot consistency.

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<sup>2</sup> “Rifle.” *Encyclopedia Americana*. Grolier Online <http://ea.grolier.com/article?id=0333140-00> (accessed September 18, 2015). The *Encyclopedia Americana* is published by Scholastic Library Publishing.

<sup>3</sup> From [www.wikipedia.org](http://www.wikipedia.org), printouts attached to Office Action dated March 28, 2013.

<sup>4</sup> From [www.ershawbarrels.com](http://www.ershawbarrels.com), printouts attached to Office Action dated March 28, 2013. The advantages are further acknowledged by Applicant’s principal, Carl H. Behling, in his declaration submitted (“Exhibit A”) with Applicant’s response filed July 29, 2013.

As the drawing of the mark in the application depicts, the proposed rifle barrel configuration mark involves solely the external features of a helically fluted rifle barrel and does not include, or depict, any internal characteristics such as helical grooves which, as described above, are used for rifling bullets through the bore of the barrel when fired. Thus, for purposes of our functionality refusal analysis, we focus on the features claimed and shown in the drawing.

### *Functionality*

Functional matter cannot receive trademark protection. *E.g.*, *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001 (2001). A product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). At its core, the functionality doctrine serves as a balance between trademark and patent law. As the Supreme Court explained in *Qualitex*:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

514 U.S. at 164-165, 34 USPQ2d at 1163.

In making our determination as to whether a proposed configuration mark is functional, the following four factors are considered:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the 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; and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

*In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). See also, *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372 (Fed. Cir. 2012); and *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002). 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*, 61 USPQ2d at 1424; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); see also, Trademark Manual of Examining Procedure ("TMEP") §1202.02(a)(v)(July 2015).

#### 1. The Existence of Patents

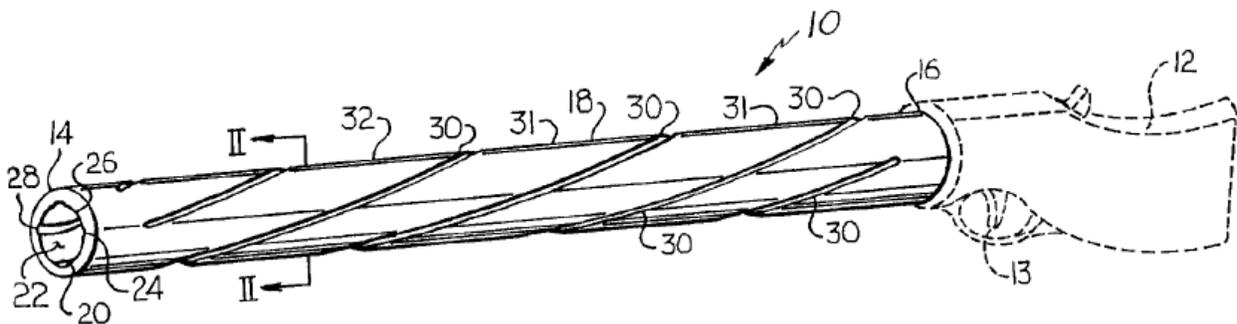
With respect to the first factor, Applicant owns two relevant patents, a utility patent and a design patent.

A. Applicant's Utility Patent

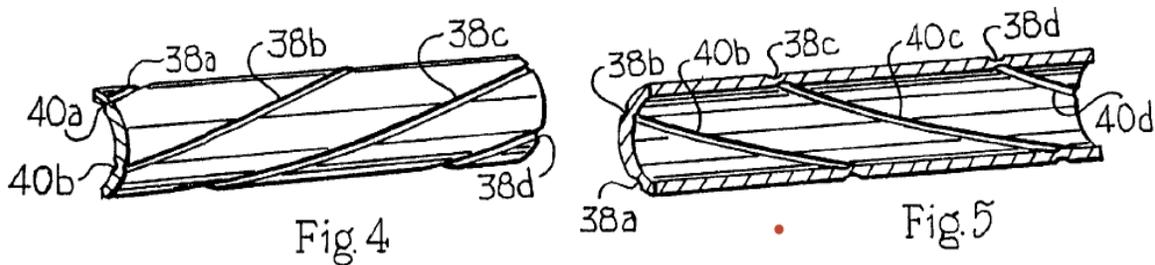
As to the utility patent, U.S. Pat. No. 6,324,780 ("the '780 patent), it is for a "Fluted Gun Barrel" and described as:<sup>5</sup>

[a] gun barrel having a generally cylindrically-shaped barrel with a first end, a second end, an inner surface and an outer surface. The inner surface defines a plurality of internal spiral grooves and the outer surface defines a plurality of external spiral grooves.

The '780 patent depicts at Fig. 1 the outside of the barrel in the following manner:



While the above illustration is similar to the applied-for rifle barrel configuration mark, this illustration and the patent itself clearly involve the internal part, or bore, of the gun barrel, in combination with the helical external fluting. Indeed, other drawings from the '780 patent (Figs. 4 and 5) show cross-sections of the exterior and interior of the barrel:



<sup>5</sup> U.S. Patent No. 6,324,780 issued on December 4, 2001, from an application filed on July 9, 1999, listing Carl Behling as the inventor. Copies of this patent were attached to Applicant's response filed on July 29, 2013, and the Examining Attorney's second Office Action issued on September 9, 2013.

The “Summary of the Invention” section of the ’780 patent describes the relationship between the barrel’s exterior and interior spiral grooves, equal in number but with different depths, and states that this relationship helps define the invention. Some of the stated objectives of the internal and external grooves are as follows:

In an effort to have a more accurate shooting rifle, yet a lighter rifle, straight flutes or grooves have been formed on the outer surface of the gun barrel, while rifling is present on the surface of the bore. Although the straight flutes or grooves provide some improvement, the straight flutes or grooves do not remove a substantial amount of the excess weight from the gun barrel.

Therefore, it is an object of the present invention to provide a strong, lightweight, and accurate gun barrel.

[Column 1, lines 21-30]; and, referencing the Fig. 1 drawing (see above):

It is believed that the spiral or helical grooves **28** and the spiral flutes or grooves **30** as described previously herein, will result in a gun barrel **10** that is lighter than a gun barrel not having flutes **30**, while emulating the stiffness and the harmonic response of a heavier gun barrel. Further, the spiral flutes **30** permit the gun barrel **10** to cool quicker than gun barrels with straight flutes or no flutes. For example, if the gun barrel **10** has spiral flutes that are twenty percent longer than straight flutes for the same length of a gun barrel then it is believed that the spiral fluted gun barrel will cool twenty percent faster than the straight fluted gun barrel. Further, it is believed that the stiffness characteristics will improve with the spiral fluted gun barrel over a straight fluted gun barrel. Also, although the present invention is preferably used with shotguns and rifles, it may also be used with other guns such as handguns.

[Column 3, lines 36-51].

These features, both the internal and external grooves (or fluting), are claimed in each claim of the ’780 patent. For example, Claim 1 involves a gun barrel comprising:

...an inner surface defining a gun barrel bore and a plurality of internal spiral grooves *and said outer surface defining a plurality of external spiral grooves*, wherein the internal spiral grooves are not in fluid communication with the external spiral grooves, and wherein a cross section taken through the intermediate portion, which is transverse to the longitudinal axis, *includes an external spiral groove* and an internal spiral groove radially spaced from the longitudinal axis, and wherein the plurality of internal grooves and the plurality of external grooves when viewed from said first end progress in the same direction of rotation.

[Column 4, lines 16-27] (italics added). Dependent Claims 2 and 3 refer to the barrel “claimed in Claim 1.” Dependent Claims 4-6 claim a gun with a barrel having the same features described in Claim 1.

Independent Claim 7 describes a gun barrel comprising:

an open-ended hollow body having a first end, a second end, an inner surface and an outer surface, said inner surface defining a gun barrel bore and a number of internal spiral grooves *and said outer surface defining a number of external spiral grooves, wherein the number of the internal spiral grooves equals the number of the external spiral grooves.*

[Column 4, lines 61-67] (italics added). Claims 8-13 are dependent claims which directly or indirectly reference and rely upon the “gun barrel claimed in claim 7.” Claims 14-20 also reference a gun with the same type of barrel as that described in Claim 7.

It is readily apparent from the '780 patent that the external spiral grooves on Applicant's rifle barrels, as depicted in the patent's drawings and the applied-for rifle barrel configuration, are an integral part of the invention. The patent's self-described objectives of creating a lighter, stiffer and heat-diffusing gun barrel (versus a similar gun barrel without the benefit of the patented technology) are accomplished by virtue of these spiral grooves. More specifically, the external spiral

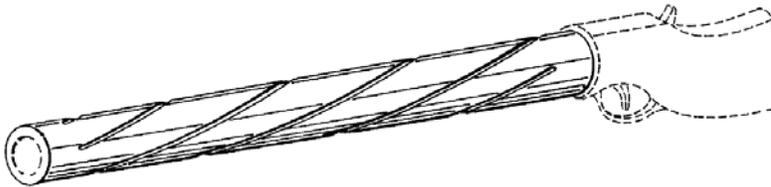
grooves allow for a lighter gun barrel “while emulating the stiffness and the harmonic response of a heavier gun barrel”; the external “spiral flutes permit the gun barrel to cool quicker than gun barrels with straight flutes or no flutes”; and, “the stiffness characteristics will improve with the spiral fluted gun barrel over a straight fluted gun barrel.” In other words, the stated benefits of the technology contained in the invention rely on the existence of the spiral external grooves, or helical fluting, of the gun barrel shown in the applied-for rifle barrel configuration mark.

Applicant argues that the '780 patent's description of the external grooves, or fluting, cannot be “carved” from the internal grooves and that the patent “does not disclose any functional benefits of external fluting on its own.” Brief, p. 2. While Applicant is correct in that the patent's description of the external fluting is nearly always described in conjunction with the barrel's internal grooves, and often described as a “set” of grooves, this does not mean that the applied-for mark is not functional. As noted above, and as Applicant does not dispute, the external grooves are clearly crucial to the patented invention, and are an essential element of each claim. Although external helical fluting may be but one element of the patented invention, the grant of a trademark registration – which would be *prima facie* evidence of the exclusive right to use the feature on rifle barrels or rifles – would prevent others from practicing the invention disclosed in Applicant's patent, even after its expiration. Therefore, Applicant's attempt to acquire trademark protection for such an integral part of the invention is tantamount to seeking an indefinite and

exclusive right in the patented technology. As indicated, *Qualitex* clearly prohibits this.

B. Applicant's Design Patent

Applicant also relies on the second patent, Design Patent D426,611,<sup>6</sup> (“the ’611 patent”) and argues that the existence of this design patent “presumptively indicates that the [applied-for mark] is not *de jure* functional,” citing *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372. The ’611 patent covers a claim of an “ornamental design for a gun barrel” as shown:



It is described in the ’611 patent as “the embodiment of a gun barrel showing my new design, with a gun barrel borehole and gun stock in broken lines and which do not form a part of the new design.”

According to Applicant, the “subject of the design patent and the instant [applied-for mark] are identical.” Brief, p. 9. Applicant, quoting the Court in *Becton, Dickinson*, contends that “[the] law recognizes that the existence of a design patent for the very design for which trademark protection is sought ‘presumptively ... indicates that the design is not *de jure* functional.’” *In re Becton, Dickinson and Co.*, 102 USPQ2d at 1377 (citing *In re Morton-Norwich*, 213 USPQ 17 at n. 3).

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<sup>6</sup> Issued on June 13, 2000, for a term of 14 years, from an application filed on June 4, 1999, listing Carl Behling, the listed inventor of the ’780 patent, as inventor. A copy of this patent was attached to Applicant’s response filed on July 29, 2013.

Applicant is correct to the extent that a design patent covering the identical design for which an applicant seeks trademark protection has probative value in a functionality refusal analysis; however, the mere existence of a design patent is not dispositive and may be outweighed by other evidence. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984) (existence of expired design patent covering part of a proposed pistol-grip water nozzle configuration mark was insufficient in light of the evidence showing functionality).

Indeed, when both a utility and a design patent are present and addressing the same product component, the Board must thoroughly review the patents, especially the claims and any discussion of the utilitarian advantages of the invention set forth in the utility patent, in conjunction with the applied-for configuration mark. In the case of *In re Caterpillar, Inc.*, the Board was presented with this very situation, and stated that:<sup>7</sup>

[t]he fact that a configuration design is the subject of a design patent, as in this case, does not, without more, establish that the design is non-utilitarian and serves as a trademark. Here, this evidence is clearly outweighed by the other evidence of record [including a utility patent] showing the great degree of utility reflected in applicant's configuration design.

43 USPQ2d at 1339. The Board went on in *Caterpillar* to note that the utility patent was “helpful in shedding light on the utilitarian aspects of applicant's design,” and

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<sup>7</sup> The goods involved in that appeal were “tractors for earth moving, earth conditioning and material handling; and undercarriage for such tractors” and the mark was described as “the configuration of a continuous crawler track with an elevated drive sprocket and idler wheels therefor.”

“strong evidence of the de jure functionality of the configuration in which applicant alleges trademark significance.” *Id.* at 1337.

We have considered the design patent here, but ultimately find, as we did in *Caterpillar*, that its probative value is outweighed by other evidence, including a utility patent describing the same design’s utilitarian features. In other words, and specific to this decision, although the spiral lines on the gun barrel are described as “ornamental” in the design patent and may be aesthetically pleasing, the question remains whether, on balance, this design is merely incidental to the overall purpose of the article or whether it “adopts a significant portion of the invention disclosed in the [utility] patent.” *In re Van Valkenburgh*, 97 USPQ2d 1757, 1760-61 (TTAB 2011). In this case, Applicant’s proposed configuration mark is a “significant portion” of the invention described in the utility patent. Accordingly, this factor supports a finding of functionality.

## 2. Advertisements Touting the Utilitarian Advantages of the Design

With respect to the second *Morton-Norwich* factor, as noted earlier, Applicant’s website clearly touts the utilitarian advantages of its rifle barrel configuration design (“Helical fluting provides additional surface area for improved cooling, improved barrel harmonics, and helps counter act rotational torque, giving the shooter greater shot consistency.”). Applicant prefaces these comments by acknowledging its ownership of and reliance on the patents discussed above (“Shaw’s Patented Helical Fluting (U.S. Patents DES. 426,611 and USG.

324,780B1)").<sup>8</sup> Applicant's claims are more than mere puffery; as highlighted in the *Background* section of this decision, Applicant specifically claims on its website that its "patented helical fluting" provides an improvement of "up to thirty percent rigidity versus straight fluting." Thus, while Applicant mentions a "unique appearance" to the fluting in the same passage on its website, it also clearly claims the same specific utilitarian advantages identified in the patent, i.e., more rigid, lighter, improved cooling, etc.

In addition to Applicant's website, the appeal record includes printouts from various other websites consisting of advertisements, descriptions or articles involving fluted gun barrels. These materials, some of which discuss the effectiveness of fluting, largely support the proposition that helical or spiral fluting is a superior attribute to non-fluting or straight fluting. For example:

Spiral fluting removes more surface area than traditional fluting which allows [the barrel] to not only dissipate the heat more efficiently but also lightens the weight of the upper assembly. Spiral fluting is the length of the barrel... [from "Marks Armory" website];<sup>9</sup>

and

Deeper flutes are far more effective, and the deep, spiral flutes offered by [Applicant] provide more flute-length per inch of barrel...and the barrel cools down pretty quickly, thanks both to the fluting and DBC inside the bore.<sup>10</sup>

Although the views expressed in these articles and advertisements are not from Applicant itself, the statements are made by and for those in the gun industry about

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<sup>8</sup> On Applicant's web site printout submitted with Office Action dated March 28, 2013.

<sup>9</sup> Printout from [www.marksarmory.com](http://www.marksarmory.com) attached to Office Action issued on September 9, 2013.

<sup>10</sup> Printout from article labeled [www.gunsmagazine.com](http://www.gunsmagazine.com) attached to Office Action issued on September 9, 2013.

Applicant's guns. In this regard, they buttress the assertions of Applicant, in both its utility patent and website, that there are utilitarian advantages to a helical or spiral fluting design on the outside of the rifle barrel. Accordingly, we find that this factor, too, supports a finding of functionality. Existence of Alternative Designs

As already discussed, a rifle barrel need not be fluted at all and the record includes examples of non-helical fluting designs. Applicant also relies on the declaration of its principal, Mr. Carl Behling, who avers to the existence of various fluting styles used by competitors.

The existence of alternative designs available to competitors is certainly relevant to our functionality analysis. Nevertheless, the availability of alternative designs does not detract from the functional character of the product design where the subject matter sought to be registered is "the preferred or a superior design." *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 5 (Fed. Cir. 1985). The question, thus, is not whether the alternative designs perform the same basic function, but whether these designs work "equally well." *Valu Eng'g*, 61 USPQ2d at 1427 (quoting, J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:75, 7-180-1 (4<sup>th</sup> ed. 2001)).

Here, there is sufficient evidence for us to conclude that, should competitors desire to manufacture a fluted barrel, Applicant's design would be the more desirable option because a helical or spiral design has utilitarian advantages over non-helical fluting. The ability to create longer grooves on the same length of gun barrel provides more surface area and thus more efficient heat dissipation, and

reduces more weight while retaining rigidity. Straight flutes, pocked indentations or other grooves do not reduce as much weight from a similar size gun barrel and straight fluting is not as strong, according to the '780 patent. Thus, helical fluting is clearly superior to the other fluting designs in the record, and this factor also supports a finding of functionality.

### 3. Rifle Barrel Configuration Mark and the Method of Manufacture

There is no evidence showing that Applicant's configuration mark allows for a simplified method of manufacture. Applicant claims that, to the contrary, its rifle barrel configuration mark "requires the use of sophisticated computer numeric controlled (CNC) milling machines" and thus is "neither simple nor inexpensive relative to methods used to manufacture other external fluting designs." Brief, p. 12. In support, Applicant submitted the declaration of its principal, Mr. Behling, who averred that "because of the differences in the equipment needed... externally helically fluted gun barrels may cost 100% more to produce than gun barrels having straight fluting."<sup>11</sup> But when viewed together with applicant's advertising claims of the significant utilitarian advantages of the helically-fluted design, the fact that other designs are simpler and cheaper to make does not weigh very much in applicant's favor. *See, e.g., In re Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) ("[E]ven at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially ... a superior quality wheel."); *In re Pingel Enter. Inc.*, 46 USPQ2d 1811, 1821 (TTAB 1998) ("That applicant, despite the inherent

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<sup>11</sup> "Second Declaration" of Carl H. Behling, attached as "Exhibit A" to Applicant's response filed on July 29, 2013.

advantages of a design which is simple and less expensive to manufacture than other petcocks, has, however, deliberately chosen a more complex and expensive manner in which to manufacture its product does not mean that the configuration thereof is not de jure functional.”); *see also In re Am. Nat’l Can Co.*, 41 USPQ2d 1841, 1844-45 (TTAB 1997).

#### 4. Functionality Conclusion

For the aforementioned reasons and based on all of the record evidence, we find Applicant’s proposed rifle barrel configuration mark is principally dictated by utilitarian concerns. With respect to the *Morton-Norwich* factors in particular, Applicant owns a utility patent demonstrating and claiming the utilitarian purposes of its fluted design; Applicant extols these same virtues in its advertisements; and Applicant’s design is considered superior to other barrel fluting designs. With these findings and viewing the record in its entirety, we conclude the proposed rifle barrel configuration mark comprises matter that, as a whole, “is essential to the use or purpose of the article or ... affects the cost or quality of the article,” as contemplated by *Inwood*, and thus is functional and not registrable on that basis.

#### *Refusal on Ground of Failure to Comply with Requirement for Information*

The Office may require an applicant to furnish information that “may be reasonably necessary” for proper examination of the application. Trademark Rule 2.61(b). Failure to comply with such a request is a ground for refusal of registration. *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013). *See also, In re*

*Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1701(TTAB 2003); and TMEP § 814.

In the first Office action, the Examining Attorney requested information regarding:

- The existence of a utility patent that discloses the utilitarian advantages of the product or packaging design sought to be registered;
- Advertising by the applicant that touts the utilitarian advantages of the design;
- Facts pertaining to the availability of alternative designs; and
- Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In response to this request, Applicant submitted copies of its two patents<sup>12</sup> and the declaration of Applicant's principal, Mr. Behling, who averred to the existence of "at least four other external fluting patterns" and that Applicant's costs of manufacturing its helical fluted barrels are "significantly more expensive and complex than a gun barrel having no fluting or straight fluting."<sup>13</sup>

In the second Office action, making the requirement "final," the Examining Attorney stated that Applicant addressed "some of, but not all" of the informational issues.<sup>14</sup> Specifically, the Examining Attorney contended that Applicant did not provide:

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<sup>12</sup> Attached as "Exhibit D" to its response filed on July 29, 2013.

<sup>13</sup> Behling declaration attached as "Exhibit A" to its response filed on July 29, 2013. It is noted that Mr. Behling explained in further detail the fluting design as well as the reasons for its fluting design being more expensive.

<sup>14</sup> Office action issued on September 9, 2013.

...any information regarding additional advertising for the product, particularly any materials specifically related to the design features embodied in the applied for mark. The applicant did not include any such materials, nor did applicant explicitly state that there were no materials to be offered.

He went on to note that Applicant mentioned in its response that it has a large advertising budget devoted to these goods and “so there is a presumption, unless applicant states so otherwise, that advertisements regarding the spiral fluting design exist to be made available.”

In its Request for Reconsideration, Applicant noted the Examining Attorney’s repeated request for additional advertising and responded that “[e]lsewhere in this electronic reply, Applicant has provided the Examining Attorney with a selection of additional images of advertising. Accordingly, this request has been adequately addressed.” With the request for reconsideration, Applicant attached copies of articles or printouts from gun-oriented magazines that reference Applicant’s goods. Applicant did not state that no advertising materials exist and, of the materials supplied with the reconsideration request, the closest to an advertisement is what appears in a publication (“Predator Xtreme” August 2005) listing “Shooting Accessories.” Applicant’s name is listed amongst other companies along with a general description of the companies’ products or services.

The Examining Attorney denied the request for reconsideration, stating that Applicant “has supplied additional advertising,” but asserted that Applicant still had not complied with the information request. He contended that Applicant had “provided no assurances that this is the extent of the advertising, or that it would [be] representative of ... advertising extolling the virtues of the spiral fluting.”

In its appeal brief, Applicant states that materials already submitted comprise “a representative sampling of readily-available advertising sufficient to demonstrate its use of the trade dress in commerce.”<sup>15</sup> Brief, p. 13. Nevertheless, the Examining Attorney rejected this explanation once again, noting that “there is a large advertising budget devoted to these goods, and so there is a presumption, unless applicant states so otherwise, that advertisements regarding the spiral fluting design exist to be made available.” Brief, p. 15.<sup>16</sup>

Finally, in its reply brief, Applicant states that “[a]fter a good faith effort to locate additional written advertising in response to the Examining Attorney’s requests, Applicant has confirmed that there are no additional, non-cumulative advertising materials in its possession that would further assist the examination of the pending application.” Reply brief, p. 9. Applicant also reiterates that “a large advertising budget does not give rise to any sort of presumption that Applicant’s advertising dollars are spent on print advertisements.” *Id.*

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<sup>15</sup> Applicant’s response appears to be more relevant to a requirement for an acceptable specimen than a request for information; the request for advertising materials is directly relevant to the second *Morton-Norwich* factor with respect to a functionality refusal.

<sup>16</sup> The Examining Attorney is referencing Applicant’s assertions (made in its response dated July 29, 2013) that:

[Applicant] has spent substantial sums in advertising its applied-for mark ... Specifically, Applicant has annual turnover **in excess** of two million dollars per year. ... This position is further substantiated by Applicant’s efforts to advertise, among other products, the applied-for mark, including operation of an interactive website, direct mailings, trade show appearances, and occasional advertisements in print periodicals. The annual costs to Applicant for these efforts are approximately \$95,000.” (emphasis in original).

Based on Applicant's aforementioned statements in its main and reply briefs, we find that it has adequately complied with the Examining Attorney's requirement. We would be remiss, however, if we did not point out that the better practice would have been for Applicant to have offered these statements earlier in its responses to the Office actions. Applicant's delay resulted in this issue having to be resolved on appeal.

**Decision:** We reverse the refusal premised on Applicant's failure to comply with the requirement for information under 37 C.F.R. § 2.61(b); however, we affirm the refusal to register Applicant's proposed mark on the ground that it is functional.