

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 Paul Adam's Trademarks and Patents LLC

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Serial No. 85851688
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David H. Chervitz,
for Paul Adam's Trademarks and Patents LLC.

Hai-Ly Lam, Trademark Examining Attorney, Law Office 112,
Angela Bishop Wilson, Managing Attorney.

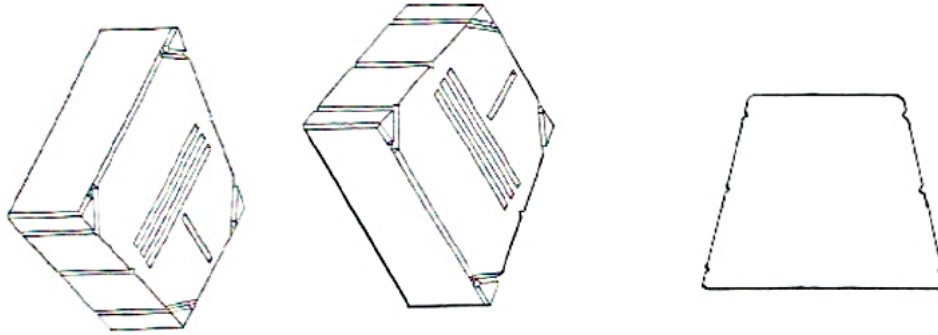
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Before Bucher, Ritchie and Shaw,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Paul Adam's Trademarks and Patents LLC ("Applicant") seeks registration on the Principal Register of the configuration shown in three different views below¹ for

¹ Applicant petitioned the Commissioner for Trademarks for permission to show the mark in more than a single rendition as required by Trademark Rule 2.52(b)(2). The petition was granted on November 18, 2014.

goods identified as “multi-use stone retaining wall blocks,” in International Class 19:²



The design is described in the application as follows:

The mark consists of a three-dimensional configuration of a stone retaining wall block having a top side that features three horizontal grooves, one vertical groove, and angled grooves at each corner and each side having a center vertical groove, a vertical groove adjacent to one of the angled grooves at one of the corners, and a vertical groove adjacent to the other one of the angled grooves at the other one of the corners.

The Trademark Examining Attorney initially refused registration of Applicant’s mark under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the grounds that the mark is functional. Applicant amended the application to seek registration on the Supplemental Register, and the Trademark Examining Attorney again refused registration on the grounds that the mark is functional, this time under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c).³ After the

² Application Serial No. 85851688 was filed on February 15, 2013, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as 1992.

³ The Examining Attorney’s Brief references both Sections 2(e)(5) and 23(c), however, once Applicant amended to seek registration on the Supplemental Register the statutory

Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Applicable Law

Matter is functional under Section 2(e)(5) if “it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citation omitted). “To support a functionality rejection in proceedings before the Board, the PTO examining attorney must make a *prima facie* case of functionality, which if established must be rebutted by ‘competent evidence.’” *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) quoting *In re Teledyne Indus.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982). In making our determination of functionality we apply the test first set forth in *In re Morton-Norwich Prods., Inc.*, 740 F.2d 1550, 213 USPQ 9 (CCPA 1982). See *Becton, Dickinson and Co.*, 102 USPQ2d at 1377 (citing *Morton-Norwich*, 213 USPQ at 15-16). These factors are not exclusive, however, for functionality “depends upon the totality of the evidence.” *Valu Eng’g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002).

Although the application before us now seeks registration on the Supplemental Register and the statutory authority for refusal is Section 23, the case law applying

authority for the refusal is only Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c), which governs the Supplemental Register. *Cf.* Trademark Manual of Examining Procedure § 1209.02(a)(i) (2015) (if an applicant responds to a mere descriptiveness or genericness refusal by amending to the Supplemental Register the statutory basis for such a refusal is Section 23 of the Trademark Act).

Section 2(e)(5) and addressing functionality refusals prior to the 1998 amendments to the Trademark Act, adding Section 2(e)(5) and amending Section 23(c), is directly relevant because the issue, functionality, is the same. See *In re Minnesota Mining and Mfg. Co.*, 335 F.2d 836, 142 USPQ 366, 368 (CCPA 1964), citing, *In re Deister Concentrator Co.*, 289 F.2d 496, 129 USPQ 314 (CCPA 1961).

Morton-Norwich identifies the following factors to be considered in determining whether a particular design is functional:

1. the existence of a utility patent disclosing the utilitarian advantages of the design;
2. advertising materials in which the applicant touts the design's utilitarian advantages;
3. the availability to competitors of functionally equivalent designs; and
4. facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

Morton-Norwich, 213 USPQ at 15-16. It is not required that all four factors be proven in every case; nor do all four factors have to weigh in favor of functionality to support a refusal. Nevertheless, in reaching our decision, we will review all four factors. See *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833 (TTAB 2013). The examining attorney has the burden of making a *prima facie* showing that the applicant's mark is functional. *In re Becton, Dickinson & Co.*, 102 USPQ2d at 1376.

II. Analysis

Applicant manufactures retaining wall blocks, usually of concrete and sold under the brand name "Pyzique," which are used to make retaining walls and other

landscape structures such as free-standing walls, steps, borders, and raised planter beds.⁴ As can be seen from the drawing above, Applicant's blocks are trapezoidal in shape and have various grooves or lines molded in to them. Applicant, in its response to the Examining Attorney's request for information, described the purpose of the features comprising the applied-for mark as follows:

(1) The three horizontal grooves on the top of the block may be, but do not have to be used, for alignment of the block. The number of grooves, the placement of the grooves, and the length of the grooves are solely a design choice.

(2) The first groove and the third groove of the three horizontal grooves on the top of the block may be, but do not have to be used, to arbitrarily set back a block placed over the block by 5/8". The middle groove cannot be used to set back a block placed over the block by 5/8". The number of grooves, the placement of the grooves, the length of the grooves, and the 5/8" dimension are solely a design choice.

(3) The vertical groove located on the top of the block may be, but does not have to be used, to split the block in half. The placement and length of the vertical groove is solely a design choice.

(4) The tri-face grooves of the block may be, but do not have to be used to split off corners of the block. The number of tri-face grooves, the position of the tri-face grooves, and length of the tri-face grooves are solely a design choice.

(5) The side alignment grooves may be, but do not have to be used, to align the block. The number of grooves, the placement of the grooves, and the length of the grooves are solely a design choice.

⁴ Applicant's Response, December 5, 2013; Dec. of Paul Adam; <http://www.pyzique.com/HTML/home.html>.

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(7) The trapezoidal shape of the block may be, but does not have to be, used to form a curved wall from the blocks. The trapezoidal shape is solely a design choice.⁵

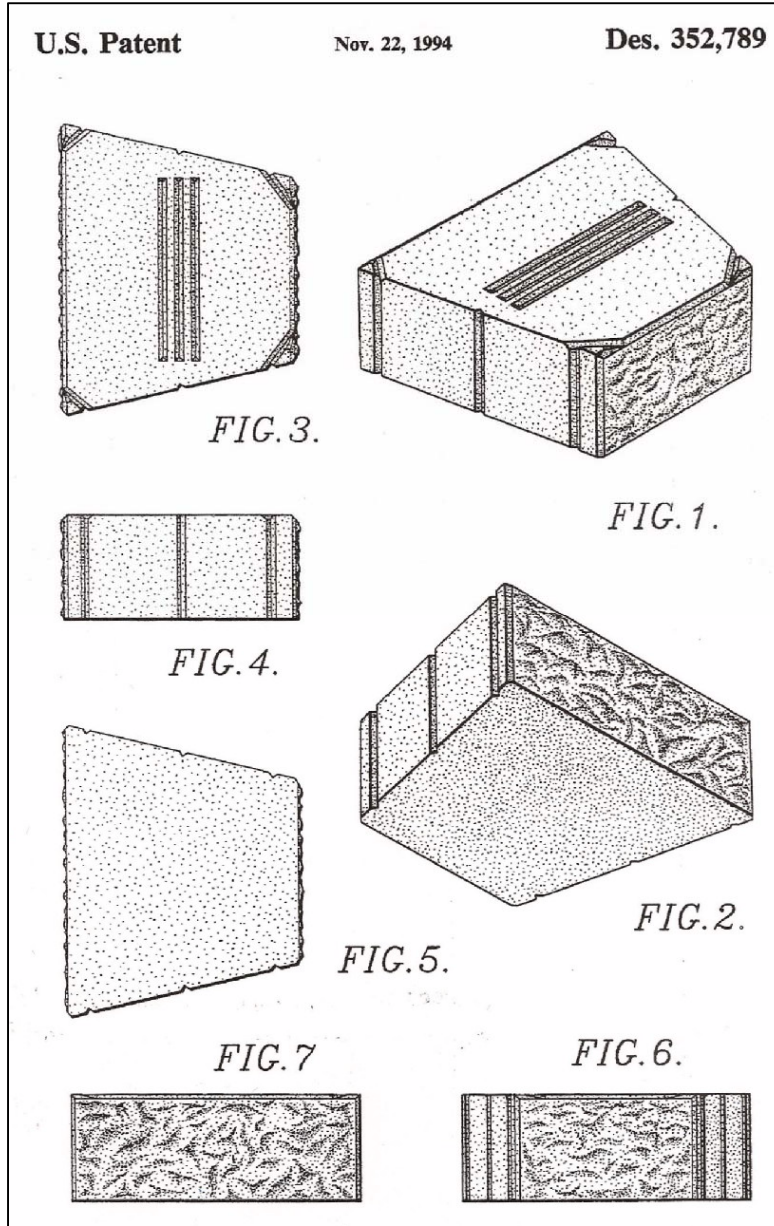
From the foregoing explanation provided by Applicant, we conclude that each of the features shown in the drawing, e.g., the trapezoidal shape, the horizontal alignment grooves, the vertical splitting groove, and the corner grooves for beveling the faces, all may be used by the builder to facilitate the construction of the retaining wall or other landscape project. The question before us is whether the mark as a whole is functional.

A. The Existence of a Patent

We begin with the first *Morton-Norwich* factor pertaining to the existence of a utility patent disclosing utilitarian advantages of the applied-for design. Applicant does not have a utility patent but instead claims ownership of an expired design patent, U.S. Design Patent No. 352789. Applicant argues that “a design patent cannot properly be obtained on a configuration or design feature that is primarily functional” thus “Applicant’s design patent demonstrates that the U.S. Patent and Trademark Office viewed Applicant’s design ‘as not dictated by function alone.’”⁶ The patent claims “[t]he ornamental design for a retaining wall block, as shown and described.” Various figures showing different views of the claimed design are reproduced below.

⁵ Applicant’s Response, June 23, 2014.

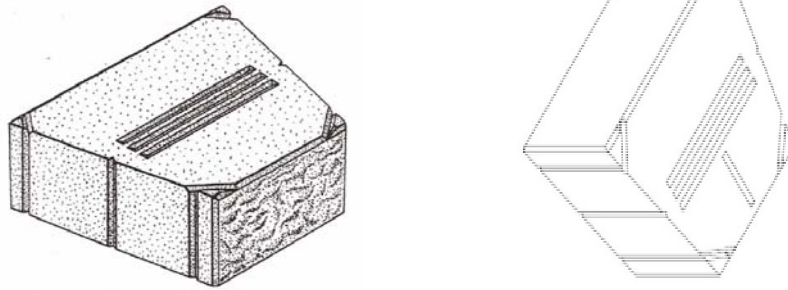
⁶ Applicant’s Br. at 12.



The court in *Morton-Norwich* stated that when a party owns a design patent, this “at least presumptively, indicates that the design is not *de jure* functional.” *Morton-Norwich*, 213 USPQ at 11, n.3 (citations omitted). However, the “existence of a design patent, while some evidence of non-functionality, is not alone sufficient evidence.” *In re American Nat’l Can Co.*, 41 USPQ2d 1841, 1843 (TTAB 1997). See

also, *In re Caterpillar, Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997) (“The 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.”).

We do not find Applicant’s registration of U.S. Design Patent No. 352789 to establish the applied-for mark as not functional inasmuch as the design patent block and the applied-for mark have significant differences. Representative views of the design patent block and the applied-for mark appear below.



When we compare the two blocks we find that the design patent block features heavily textured front and back faces whereas the applied-for mark has smooth front and back faces.⁷ Additionally, the applied-for mark has a “vertical groove” on the top side whereas the design patent block shows no such groove. These differences, especially the differences in the texture of the block faces, suggest that the applied-for mark is far less ornamental than Applicant’s design patent block. That is, the applied-for mark is missing the most ornamental and decorative feature

⁷ None of Applicant’s renditions of its mark shows the back face of the block. Nevertheless, Applicant does not claim that the back face of the block is textured, nor does the bottom view rendition show any texture in relief on the back face.

of the design patent block, namely the highly textured block faces. Given these significant differences between the design patent block and the applied-for mark, Applicant's ownership of the design patent does not establish the applied-for block configuration as non-utilitarian. "Absent identity between the design patent and the proposed mark, the presumption [that a mark is not functional under Section 2(e)(5)] loses force. . . ." *In re Becton, Dickinson and Co.*, 102 USPQ2d at 1377.

B. Advertising Touting the Mark's Utilitarian Features

We next turn to the second *Morton-Norwich* factor: advertising by the applicant that touts the design's utilitarian advantages. *Morton-Norwich*, 213 USPQ at 15. An applicant's own advertising promoting the utilitarian aspects of its product design is strong evidence supporting a functionality refusal. *In re Van Valkenburgh*, 97 USPQ2d 1757, 1761 (TTAB 2011). The Examining Attorney argues that the following excerpts from Applicant's own advertising materials and website extol specific utilitarian advantages of the applied-for configuration:

- "[The] trapezoidal shape provides its own interlock by imposing forces on adjacent stones that deter shifting and is an excellent choice for stone steps."⁸
- "You may wish to take advantage of Pyzique's tri-face option. Place a stone chisel in the corner tri-face groove of the face that will be exposed. One hit with a hammer on the chisel at each corner will give the tri-face option."⁹

⁸ Office Action, January 2, 2014, <http://www.pyzique.com/HTML/pictures/pictures.html>.

⁹ *Id.*

- “One hit with a hammer on a chisel placed on the corner triface groove creates yet another look. . . .”¹⁰
- “Retaining walls are not built straight up unless expensive geogrid materials are used. Walls must have a horizontal force equal to or greater than the horizontal force of the soil being retained, otherwise the wall will fail. Pyzique is designed with a 5/8” set back for each row (5/8” horizontal tilt per 4” of wall height) to impose a horizontal force against the retained soil.”¹¹
- “Set the center side alignment groove directly above the backmost 5/8” set back groove of the stones in the next lower layer . . . Use this visual alignment for each successive layer of stones.”¹²

In addition, Applicant submitted an excerpt from its own web page touting the benefits of its retaining wall blocks:

PYZIQUE, the one stone does it all system. . . . Each stone has two faces that allow many types of projects such as Free-standing walls, steps, borders, raised planter beds and PYZIQUE’s exclusive BBQ. . . . PYZIQUE is a single stone system that can build many types of projects. . . . Each trapezoidal shaped PYZIQUE Stone has two faces allowing many projects beyond retaining walls to be built. . . . The PYZIQUE Stone builds straight and curved retaining walls, shadow box walls, bump-out walls, steps, patio barrier walls, BBQ grills, outdoor kitchens, stone fence, lawn and paver edge, and much more.¹³

We find that the foregoing references directly address the utilitarian advantages of Applicant’s applied-for mark. Applicant touts the “trapezoidal shape” as “an excellent choice for stone steps.” Similarly, Applicant touts the ease with which the face of a block can be beveled using the corner grooves: “One hit with a hammer on

¹⁰ *Id.*, <http://www.pyzique.com/HTML/pictures/pictures.html>.

¹¹ *Id.*, <http://www.pyzique.com/HTML/installation/installation.html>.

¹² *Id.*

¹³ Applicant’s Response, December 5, 2013, <http://www.pyzique.com/HTML/home.html>.

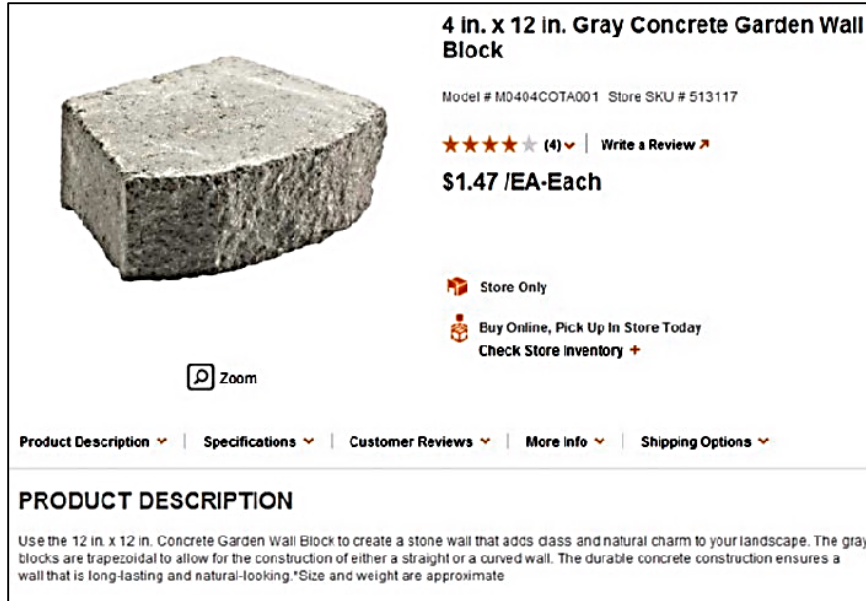
the chisel at each corner will give the tri-face option.” Applicant also touts the alignment lines as a way of arranging the blocks “to impose a horizontal force against the retained soil” to counter-act forces that might shift the position of the blocks. Applicant’s own web pages touts the benefit of these features as a whole when it declares the blocks to be a “one stone does it all system” and a “single stone system that can build many types of projects.”

We conclude that the advertising evidence submitted by the examining Attorney supports a finding that Applicant’s mark is functional.

C. Availability of Alternative Designs

We now turn to the third *Morton-Norwich* factor: Whether functionally equivalent designs are available to competitors. *Morton-Norwich*, 213 USPQ at 16. We note, however, that the mere fact that other designs may be available does not necessarily mean that applicant’s design is not functional. *See TrafFix Devices*, 58 USPQ2d at 1007; *In re Bose*, 772 F.2d 866, 227 USPQ 1, 5-6 (Fed. Cir. 1985); *In re Van Valkenburgh*, 97 USPQ2d at 1763.

Regarding the trapezoidal shape of the applied-for mark, the Examining Attorney introduced a number of generally trapezoidal-shaped retaining wall blocks available to consumers from the Home Depot and Lowe’s hardware stores. The following two examples are representative:



4 in. x 12 in. Gray Concrete Garden Wall Block

Model # M0404COTA001 Store SKU # 513117

★★★★☆ (4) | [Write a Review](#)

\$1.47 /EA-Each

Store Only

Buy Online, Pick Up In Store Today

[Check Store Inventory](#)

Zoom

[Product Description](#) | [Specifications](#) | [Customer Reviews](#) | [More info](#) | [Shipping Options](#)

PRODUCT DESCRIPTION

Use the 12 in. x 12 in. Concrete Garden Wall Block to create a stone wall that adds class and natural charm to your landscape. The gray blocks are trapezoidal to allow for the construction of either a straight or a curved wall. The durable concrete construction ensures a wall that is long-lasting and natural-looking.*Size and weight are approximate

14



Pavestone 12 in. Palomino Concrete Wall Block

Model # 81181 Store SKU # 296535

★★★★★ (1) | [Write a Review](#)

\$1.47 /EA-Each

This item cannot be shipped to the following state(s): AK,HI

15

The record shows that these blocks are trapezoidal in shape in order to enable the construction of straight or curved walls without gaps between the blocks. The product description for Home Depot’s “Gray Concrete Garden Wall Block” states the “blocks are trapezoidal to allow for the construction of either a straight or a curved wall.” The Examining Attorney also introduced articles explaining how to build walls and other projects with retaining wall blocks. These articles tout the benefits

¹⁴ Office Action, June 5, 2013.

¹⁵ *Id.*

of the trapezoidal shape. For example, an article from the Today's Homeowner website states: "[t]he stones are often slightly wedge-shaped to allow you to create gentle curves."¹⁶

We find that the trapezoidal shape is preferred because no other shape provides the ability to build straight or curved walls without requiring customers to cut the blocks with a saw or hammer and chisel. Accordingly, the trapezoidal shape is superior to other shapes because it allows the blocks to be formed into straight or curved walls without modification. This saves on both construction time and materials.

Regarding the three horizontal grooves and the center vertical groove on the sides of the block, which are used to align the blocks, we find that none of the alternatives submitted by the Examining Attorney or the Applicant directly correlate to these features. Some of the blocks described in the record use a pin and channel system to lock the blocks together but we do not find that this feature serves the same purpose as Applicant's alignment grooves. Similarly, some of the blocks such as the "Versa-Lok Retaining Wall System"¹⁷ use a 3/4" setback rather than Applicant's 5/8" setback but we do not find such a small difference in setback to be significant.

Regarding the grooves at each corner, neither Applicant nor the Examining Attorney has submitted any examples of design alternatives with precisely these

¹⁶ Office Action, July 25, 2014, www.todayshomeowner.com/how-to-build-a-stackable-block-retaining-wall.

¹⁷ Applicant response, December 5, 2013.

same features. However, the “Keystone Garden Wall” block is sold in both a straight front as well as a “triplane” front.¹⁸ This suggests that Applicant’s block is superior in design since it is a single block that can be modified to either a flat or “triplane” front. This saves on construction time and simplifies the ordering of materials.

Regarding the vertical groove on the top of Applicant’s block, used to split the block, again, none of the blocks described in the record can be considered alternative designs. One block, the “Allan Block”¹⁹ described in user instructions submitted by the Examining Attorney has “pre-marked splitting notches” but these serve the same purpose as Applicant’s groove and thus cannot be considered an alternative. Rather, most of the blocks described in the record require cutting with a saw or scoring the block before using a hammer and chisel to split the blocks. The relative ease with which Applicant’s block can be split using the vertical groove suggests that Applicant’s block is superior in design compared to competitor’s designs.

In sum, we find that the record does not show that functionally equivalent designs comprising the features in Applicant’s applied-for mark are available to competitors, either individually or as a whole, and thus this third *Morton-Norwich* factor weighs in favor of finding the mark to be functional.

D. Comparative Methods of Manufacture

We next consider the fourth *Morton-Norwich* factor, whether the design of Applicant’s product results from a comparatively simple or inexpensive method of

¹⁸ *Id.*

¹⁹ Office Action, July 25, 2014.

manufacture. Applicant submitted the declaration of Paul Adam, the inventor of the blocks, stating that the price of Applicant's blocks is similar to those of other manufacturers, and that Applicant's blocks do not result from a comparatively simple or cheap method of manufacture.²⁰ While evidence that a product feature makes the product cheaper to manufacture may be probative in showing functionality, evidence that it does not affect its cost is not necessarily proof of non-functionality. Thus, the fourth *Morton-Norwich* factor is neutral.

E. Balancing the Factors

The *Morton-Norwich* factors pertaining to advertising touting the utilitarian advantages of the design and to the lack of functionally equivalent alternative designs favor a finding of functionality.

When we view the applied-for mark as a whole, we find that the described features aid in the installation of the block and give Applicant's product a significant advantage in versatility over blocks without these features. It is the aggregation of these features that make Applicant's blocks a "one stone does it all system."²¹ That is, the trapezoidal shape, the horizontal and vertical alignment grooves, the splitting groove, and the corner grooves for beveling the faces, taken together, are all "essential to the use or purpose of the article" as described by Applicant, namely, "a single stone system that can build many types of projects."²²

²⁰ Dec. of Paul Adam, Applicant's Response, December 5, 2013.

²¹ Applicant's Response, December 5, 2013, <http://www.pyzique.com/HTML/home.html>.

²² *Id.*

See TrafFix Devices, 58 USPQ2d at 1006. Accordingly, we find that the Examining Attorney has made a *prima facie* showing that Applicant's product design is functional within the meaning of Section 23(c). Applicant's declaration and other evidence do not rebut the Examining Attorney's showing.

Decision: The refusal to register Applicant's mark, the configuration of a multi-use stone retaining wall block, is affirmed.