

This Opinion is not a
Precedent of the TTAB

Mailed: February 21, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arlington Specialties, Inc.

Serial Nos. 85851794 and 85851833

Jami A. Gekas of Foley & Lardner LLP,
for Arlington Specialties, Inc.

Thomas M. Manor, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

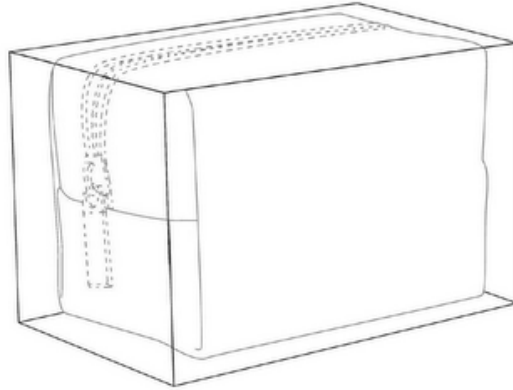
Before Zervas, Wellington and Greenbaum,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Arlington Specialties, Inc. (“Applicant”) has filed the following two applications seeking registration on the Principal Register for trade dress marks for goods

(specified below) that can be generally characterized as kits containing personal care items:¹

1. Application Serial No. 85851794 ('794) for the following mark:



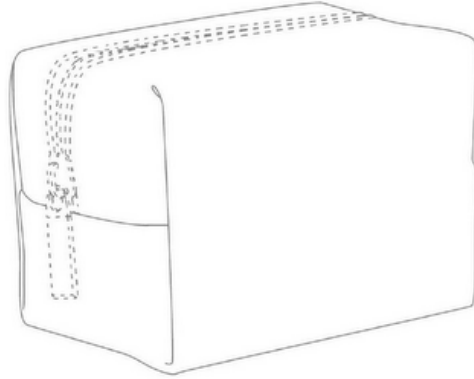
The mark is described in the application as follows:

The mark consists of a three-dimensional configuration for packaging featuring a transparent, cuboid outer box through which a soft, structured inner pouch is visible, the inner pouch having a rounded cuboid shape with distinctive folded and tucked corners, a zipper running from the midpoint of one side of the pouch horizontally along the length of the top of the pouch to the midpoint of the second side of the pouch, and a pull tab on the zipper. The zipper and the pull tab on the zipper are presented in broken lines and is/are not claimed as a feature of the mark. Color is not claimed as a feature of the mark.

Applicant entered a disclaimer of “the transparent, cuboid outer box portion of the packaging.”

2. Application Serial No. 85851833 ('833) for the following mark:

¹ Applicant is also owner of a related third application (Serial No. 85851792) that was also subject of an appeal and consolidated with the involved appeals. However, the appeal involving this application was dismissed as moot by the Board because the Examining Attorney withdrew the refusal and approved that application for publication. See 23 TTABVUE in the appeal docket for that application.



The mark is described in the application as follows:

The mark consists of a three-dimensional configuration for packaging featuring a soft, structured pouch having a rounded cuboid shape with distinctive folded and tucked corners, a zipper running from the midpoint of one side of the pouch horizontally along the length of the top of the pouch to the midpoint of the second side of the pouch, and a pull tab on the zipper. The zipper and the pull tab on the zipper are presented in broken lines and is/are not claimed as a feature of the mark. Color is not claimed as a feature of the mark.

Both applications were filed on February 13, 2013, and are based on an allegation of first use anywhere and in commerce on July 31, 2008, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

The identified goods in Application '794 are:

Kits containing an assortment of products of benefit to women, namely, nail polish, nail polish remover wipe being pre-moistened cosmetic wipes, emery board, lip balm, replacement backings for earrings, hair elastics, sewing kit comprised of needle, thread and extra buttons, double-sided tape, namely, adhesive tape for clothing and household use, stain removing preparations for use on clothing, disposable wipes impregnated with deodorant, pain relief medication, tampon, breath freshener, safety pins, adhesive bandages and dental floss in International Class 3.

Application '833 covers the same goods as well as the following additional kits (also in International Class 3):

Kits containing an assortment of products of benefit to girls, namely, hairspray, glitter nail polish, emery board, lip balm, hair elastics, barrettes, facial tissues, breath freshener, replacement backings for earrings, adhesive bandages and emergency information card.

The assigned Examining Attorney has finally refused registration of each mark on the alternative grounds that the mark is a non-inherently distinctive configuration of product packaging or of the goods themselves, and that the mark has not acquired distinctiveness.² However, in his brief, the Examining Attorney expressly withdrew the non-distinctive product design refusal with respect to the proposed mark in Application ‘833.³

Applicant concurrently filed appeals and requests for reconsideration of the refusals which the Examining Attorney denied.

The appeals have been consolidated pursuant to the Board’s June 2, 2016 order⁴ and have been fully briefed.

Although the applied-for marks involve several common issues, we address them individually. Indeed, we keep in mind that in spite of the appeals being consolidated, Applicant is ultimately seeking protection on an individual basis

² See Office Actions issued on November 28, 2014 in each application file. The Examining Attorney also made final a requirement to withdraw a disclaimer in each application; however, this requirement was later withdrawn (see Office Actions issued on June 22, 2015), and the disclaimers remain of record.

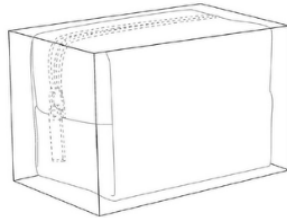
³ See 17 TTABVUE 4 (“Serial number 85/851833 the Non-Distinctive Configuration of Goods Refusal is withdrawn”) and *Id.* at 8 (in identifying the issues on appeal, “For application serial number 85/851833 whether Applicant’s intended mark has acquired distinctiveness pursuant to Trademark Act Section 2(f), sufficient to overcome the Non-distinctive Configuration of Product Packaging as Design Final Refusal.”) Unless otherwise specified, all TTABVUE citations in this decision correlate to the docket of Application ‘794.

⁴ 16 TTABVUE.

for the two different marks and we must consider their registrability apart from one another.

Application ‘794: Packaging Trade Dress

As noted, the Examining Attorney ultimately refused registration of the proposed trade dress mark in Application ‘794, depicted below again, on the two grounds: that it comprises non-distinctive packaging design and that it is non-distinctive product design, under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051-1052, 1127, to support both refusals.



Specifically, the Examining Attorney asserted in the final Office Action that the outer clear box portion of the mark “consists of a non-distinctive configuration of packaging for the goods” and “the small pouch portion appearing in the applied-for mark consists of a nondistinctive product design or nondistinctive features of a product design.”⁵ The Examining Attorney contends that, because the proposed mark lacks distinctiveness, it “would not be perceived as indicia of source of the goods.”⁶

⁵ Office action issued on November 28, 2014.

⁶ Id.

In essence, the Examining Attorney sets forth two different refusals, each applying to a different portion of the mark. As he explained in the final Office Action:

In this instance the Applicant's combination of two non-distinctive elements, namely, a soft pouch and clear box does not serve to transform Applicant's goods into an inherently distinctive mark. Merely because Applicant may be the first to combine these two elements in their product does not render the combination a distinctive indicia of source, because the consumer would merely see the outer box as a container to protect and display for sale the soft pouch containing the remainder of the "kit" goods. As previously stated, the inner pouch serves the utilitarian purpose of being part and parcel of the goods being offered. In this instance the consumer would perceive one or more of the literal elements and concurrent designs, as are present in the specimens of record and evidence present in Applicant's response to Office action, as indicia of the source of Applicant's goods, not the product and/or product packaging.

Applicant, on the other hand, asserts that *both* the pouch and the outer box are "unquestionably product packaging."⁷ Relying on the declaration of its founder, Applicant describes the proposed mark as follows:⁸

[T]he inner Minimergency Pouch is a container to hold the *actual* product, namely, the various personal care items that combine to make up a 'personal care kit,' while the outer clear box is merely a container that makes packaging and display easier on retail shelves. Together, the trade dress is similar to other types of containers which may be protected as packaging trade dress, such as a lip balm container, a lipstick case, or a perfume bottle, many of which may also be enclosed in a clear, protective outer display box on store shelves.

Applicant further argues that the mark is inherently distinctive; but in the event that it is found not to be inherently distinctive, Applicant claims it has submitted

⁷ 13 TTABVUE 6; Applicant's appeal brief.

⁸ Id. at 7-8, referencing declaration of Georgette Kaplan attached to Applicant's April 11, 2014 response. As Ms. Kaplan explains, and evidenced throughout the prosecution, Applicant uses "Minimergency" as one of its word marks for the identified goods. Kaplan decl. ¶ 6.

sufficient evidence demonstrating the mark has acquired distinctiveness and is thus registrable under Section 2(f). The Examining Attorney has rejected this argument and contends the evidence does not support a finding that the mark has acquired distinctiveness.

Section 45 of the Trademark Act, in relevant part, defines a “trademark,” as “any word, name, symbol, or device, or any combination thereof used by a person. . . to identify and distinguish his or her goods. . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. A trade dress mark, including product packaging and product design, has long been recognized as being eligible for registration so long as it is distinctive. Section 2 of the Trademark Act, 15 U.S.C. § 1052; *Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1067 (2000). “The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.” *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010).

In light of the Examining Attorney’s refusal to registration being based on both product design and product packaging, and Applicant’s argument that its proposed mark consists solely of product packaging, we must first make a determination regarding the type of trade dress present. Making this decision is not without ramifications for product design trade dress can never be inherently distinctive and may only be registered upon a showing of acquired distinctiveness. *Wal-Mart*, 54 USPQ2d at 1068-1070. As the Supreme Court explained, “[c]onsumers are aware ...

that, almost invariably, even the most unusual of product designs -- such as a cocktail shaker shaped like a penguin -- is intended not to identify the source, but to render the product itself more useful or appealing." *Id.* at 1069. On the other hand, a mark comprising product packaging trade dress may be inherently distinctive. ("The attribution of inherent distinctiveness to certain . . . product packaging derives from the fact that the very purpose of . . . encasing [a product] in a distinctive packaging, is most often to identify the source of the product"). *Id.* at 1068. In identifying the type of trade dress present here, we keep in mind the Court's instruction that "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." *Id.* at 1070; *see also, In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006).

We find that the mark in Application '794 consists of packaging design, and not product design. More specifically, we agree with Applicant's characterization of its mark as:⁹

the inner [pouch] is a **container** to hold the *actual* product, namely, the various personal care items that combine to make up a "personal care kit," while the outer clear box is merely a container that makes packaging and display easier on retail shelves.

[Bold and italics in original].

We do not simply rely on Applicant's argument. Rather, our determination that the mark qualifies as packaging, and not product design, is consistent with how the mark is specifically described in the application, namely, as a "configuration for

⁹ 13 TTABVUE 6.

packaging featuring a transparent, cuboid outer box through which a soft, structured inner pouch is visible,” and remains consistent with the disclaimer pertaining to the “outer box portion of the *packaging*.” (Emphasis added). At no point during the prosecution did the Examining Attorney attempt to correct this description of the mark nor did he suggest that the description be amended to describe the pouch as a configuration of the identified goods or product design. To the contrary, on at least one occasion, the Examining Attorney conceded that “Applicant’s entire mark is non-distinctive product packaging.”¹⁰ To be sure, the goods identified in the Application are not depicted in the mark. That is, the identified goods are “kits containing an assortment of products of benefit to women, namely, nail polish, nail polish remover wipe ... [and various other toiletry or personal items]” and none of these goods are depicted in the mark.

Bearing in mind that Applicant has disclaimed the outer clear box portion, the focus in Applicant’s applied-for mark is on the design of the pouch that serves as a “container for the goods.” Nevertheless, our analysis regarding Applicant’s mark in this decision must be based on how it will be perceived in its entirety and the fact that it comprises packaging within packaging or, as Applicant labels it, “a double packaging design.”¹¹

1. Whether Applicant’s Proposed Trade Dress Is Inherently Distinctive

¹⁰ See Office Action issued on October 11, 2013 (in “Withdraw of Prior Disclaimer Statement Requirement” section).

¹¹ 26 TTABVUE 10.

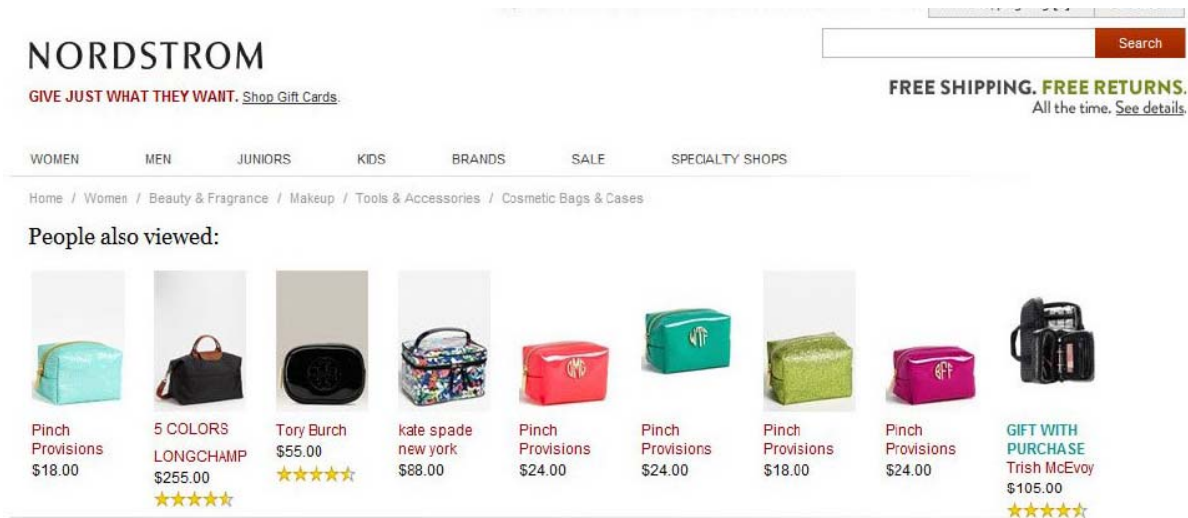
We accordingly treat the mark as packaging or, more precisely, as ‘packaging within packaging’; accordingly, we first consider Applicant’s contention that the proposed mark is inherently distinctive. In order for it to be so, it must possess an “intrinsic nature [that] serves to identify a particular source.” *Wal-Mart*, 54 USPQ2d at 1068 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081, 1083 (1992)). Applicant and the Examining Attorney both acknowledged in their briefs, as do we, that the relevant factors for determining any inherent distinctiveness in a proposed design mark were set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (CCPA 1977). These factors (known as “the *Seabrook* factors”) involve the questions of whether the design is:

1. a "common" basic shape or design?
2. unique or unusual in a particular field?
3. a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods?
4. capable of creating a commercial impression distinct from the accompanying words?

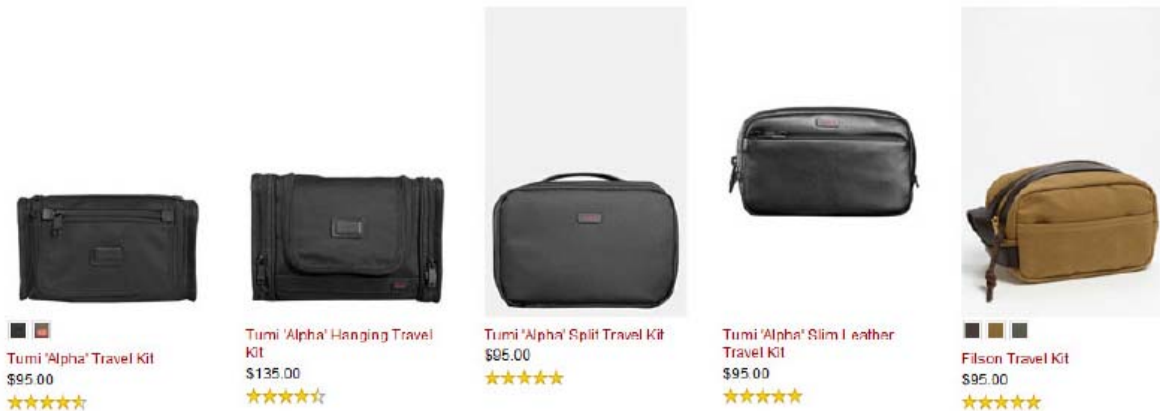
Id. at 291.

In applying the *Seabrook* factors to the mark at hand and based on the record before us, we conclude that it is not inherently distinctive. The Examining Attorney attached printouts from numerous websites showing very similarly-designed pouches (or bags) that can be used for housing toiletry or cosmetic goods like those

described in Applicant's kits, as well as evidence of clear boxes used in packaging.¹² This evidence includes the following excerpts from various websites offering very similar, if not identical, containers used for personal care items, such as cosmetics or toiletry goods:



[from the www.nordstrom.com website; the “Pinch Provisions” goods are Applicant’s goods, whereas the Longchamp, Tory Burch, Kate Spade and Trish McEvoy branded goods are not],¹³









[from the www.norstrom.com website];¹⁴

¹² Attached to Office actions issued on October 11, 2013, and May 6, 2015, and November 28, 2014.


¹³ Attached to Office action issued on October 11, 2013.

¹⁴ Id.

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STEPHANIE JOHNSON | my shopping bag | checkout | press | celebrity sightings | sj's style compass | retailer | editor log-in




























What's New



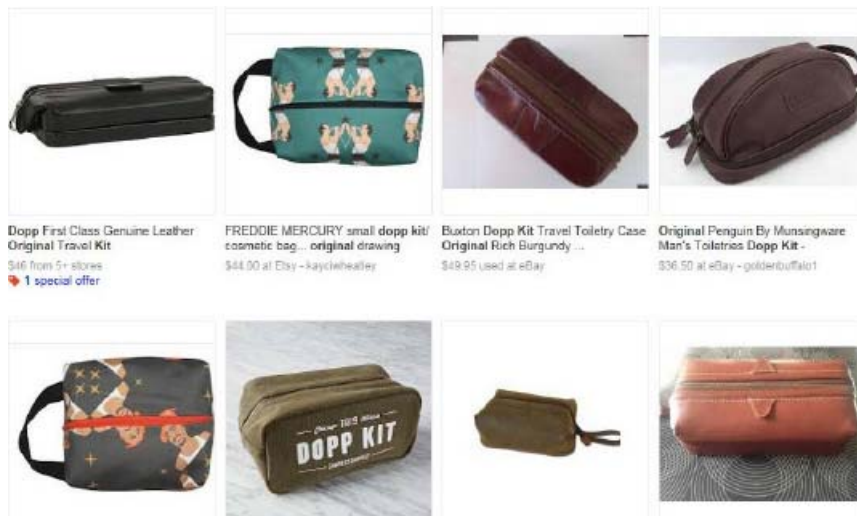
Style Guide: Nile!

Fierce feline meets African Queen as sparkling sequins dance like diamonds upon the surface of exotic leopard. Meet our Nile Collection, new for Fall 2013.

Select by Shape

 ML Traveler	 JENNY Train Case	 LARGE Flat Pouch	 CASSANDRA Large Zip Top	 LAURA Large Trapezoid	 iPAD Case	 MEDIUM Flat Pouch	 KATIE Folding Cosmetic	 SIDE Handle Tube
 JUMBO Zip Cosmetic	 MARLIEN Round Jewel Case	 MINI Pouch	 Passport Cover	 Luggage Tag	 Wristlet	 JULIE Jewelry Case	 SMALL Zip Cosmetic	 GRACE Brush Case
 MARY ALICE	 MARY Brush	 ALEX Sparkle	 MEDIUM Zip	 SNAP Mirror	 FIONA Dome	 IRIS Small Box	 EYE MASK	 MOLLY Straw

[from the www.stephaniejohnson.com website];¹⁵



Dopp First Class Genuine Leather Original Travel Kit
\$46 from 5+ stores
1 special offer

FREDDIE MERCURY small dopp kit/ cosmetic bag... original drawing
\$44.00 at Etsy - kayciehealer

Buxton Dopp Kit Travel Toiletry Case Original Rich Burgundy ...
\$49.95 used at eBay

Original Penguin By Munsingware Man's Toiletries Dopp Kit -
\$36.50 at eBay - goldenbuffalo1

¹⁵ Id.



PEE WEE HERMAN small dopp kit/ cosmetic bag... original drawing
\$44.00 at Etsy - kayciwheatley



Dopp Kit
\$50.00 at Scoutmob



Bellemonde Brown Men's Dopp Kit
Vintage Style Travel Luggage ...
\$56.41 at Fishpond.com



Vintage Ralph Lauren Blackwatch
Toiletry Travel Dopp Kit Bag
\$89.99 used at Bonanza - Bella Bean



Vintage Ralph Lauren Tweed
Cosmetic Bag Dopp Kit
\$89.99 used at Bonanza - Bella Bean



Dopp Delegate - Top grain cowhide
leather travel kit with center
\$455.88 at www.imprintitems.com



Senator Pen B06947-B - Dopp
Leather Delegate Travel Kit Bag
\$29.78 at Worldwide-USA.com



Dopp Delegate - Top grain cowhide
leather travel kit with center
\$455.88 at www.imprintitems.com

[from Google website “shopping” search results for “original dopp kit”];¹⁶



QUICKLOCK
PHILIPA IKAT ULTIMATE COSMETIC BAG
\$79
special \$45
free shipping
new
online only



QUICKLOCK
KENNEDY PALAMPORE JEWELRY ROLL
\$94
special \$19
free shipping
new
monogramming available
online only



QUICKLOCK
KENNEDY PALAMPORE ULTIMATE
COSMETIC BAG
\$99
special \$45
free shipping
new
online only



QUICKLOCK
LEOPARD COSMETIC BAGS, SET OF 2
\$79



QUICKLOCK
KENNEDY PALAMPORE BRUSH CASE
\$79

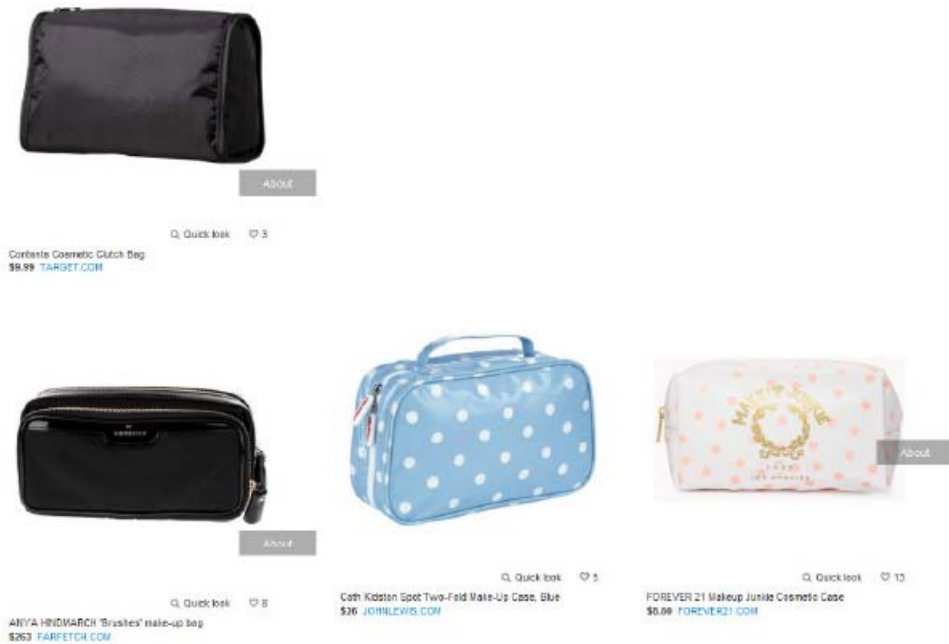


QUICKLOCK
LEOPARD JEWELRY ROLL
\$79

[from the www.potterybarn.com website];¹⁷ and

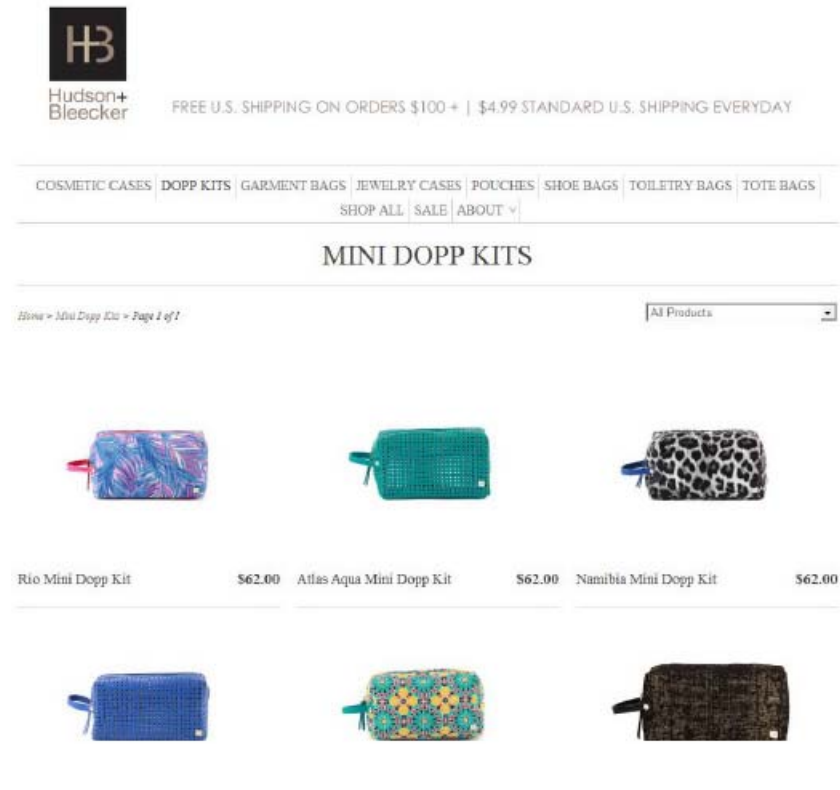
¹⁶ Id.

¹⁷ Id.



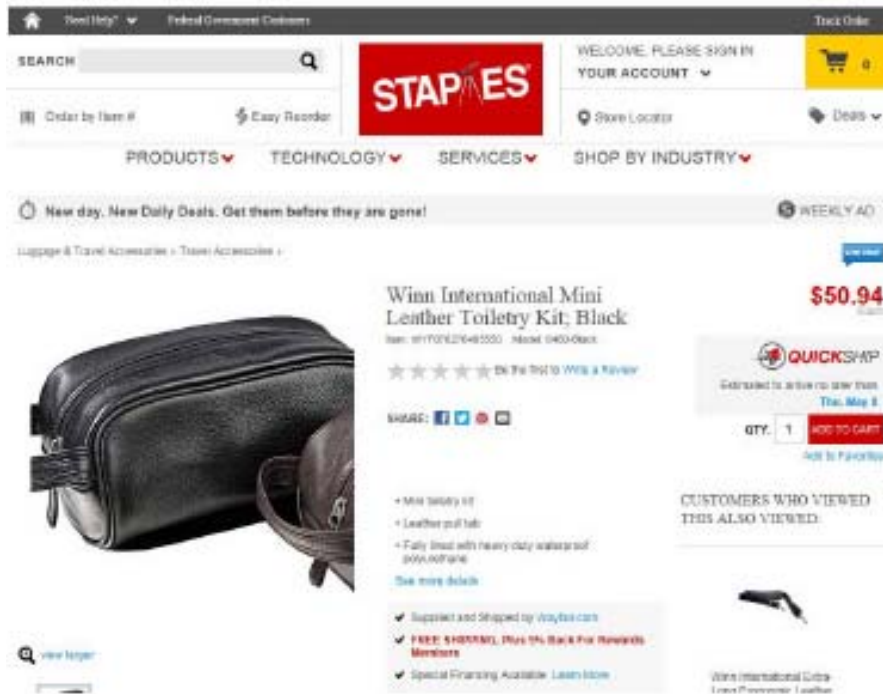
[from the www.polyvore.com website].¹⁸

The evidence includes bags or pouches available in smaller or “mini” sizes:



¹⁸ Id.

[from the www.hudsonbleeker.com website];¹⁹



[from the www.staples.com website].²⁰

Although Applicant disclaimed exclusive use of the clear box packaging portion of the mark, the Examining Attorney attached evidence to show that using this type of packaging to display products is not uncommon. For example:



[from the www.dhgate.com website, offering similar boxes to “display cosmetic, snack, car models, etc.”];²¹

¹⁹ Attached to Office action issued on May 6, 2014.

²⁰ Id.

²¹ Attached to Office action issued on October 11, 2013.



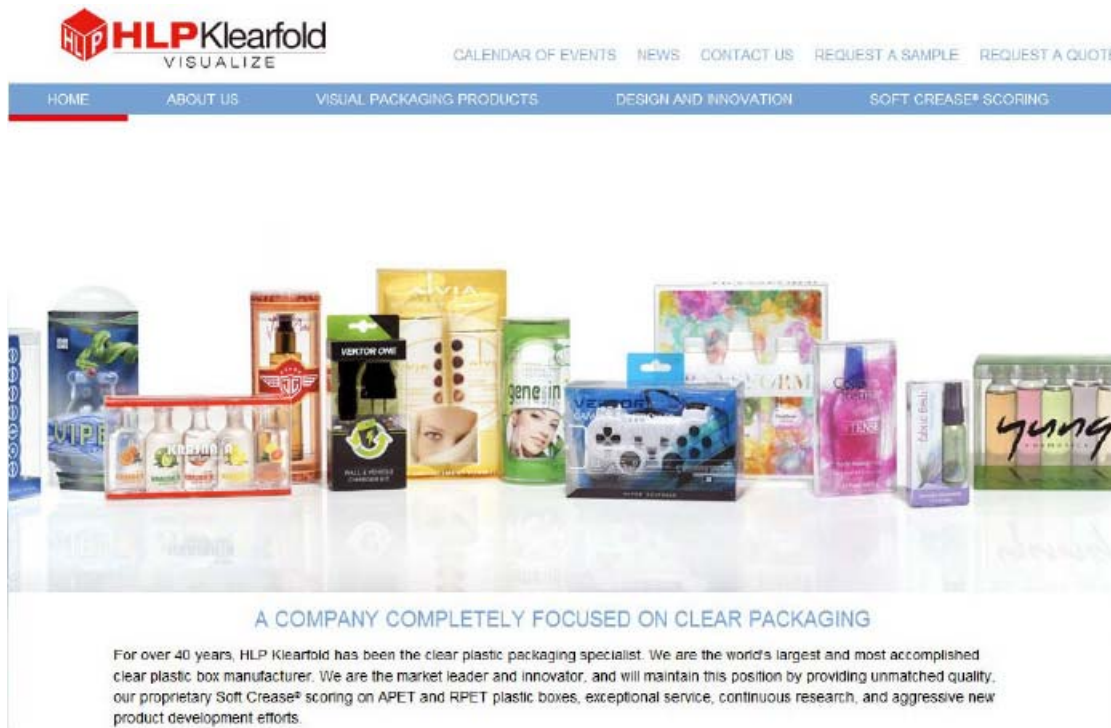
[from Google website “images” results for search of term “clear box packaging”];²²



[from the packaging manufacture “Transparent Packaging” website (www.tpackaging.com) that touts its “expertise in designing and manufacturing clear plastic folding cartons and boxes ... suited for any product in virtually unlimited configurations”];²³

²² Attached to Office action issued on May 6, 2014.

²³ Id.



[from another packaging manufacturer's website, www.hlpklearfold.com].

With respect to the first two *Seabrook* factors, the evidence establishes that Applicant's pouch design is a common shape and is hardly unique or unusual in the field of cosmetic and toiletry bags. Indeed several of those depicted above are nearly indistinguishable from Applicant's pouch. One website in particular, the Stephanie Johnson website (www.stephaniejohnson.com) allows customers to "shop by shape" for bags and cases, including a "MINI pouch" shape that is nearly identical to Applicant's pouch design. This helps show that this is a recognized and common design.

Applicant attempts to explain the features that it believes makes its trade dress inherently distinctive:

The [pouch], which is the dominant portion of the trade dress, is both rounded and cube-like, soft yet structured, and it has distinctive and unique folded and tucked corners. The smooth, rounded edges, tucked and folded corners, lack of piping and placement of the zipper give the [pouch] a clean, modern look.

We disagree with Applicant's position that the attributes it describes are unique. The evidence submitted by the Examining Attorney shows that there are numerous third-party bags, or pouches, that are used for the same purpose as Applicant's packaging, namely to hold cosmetic and toiletry items, that have the same exact features that Applicant asserts are distinctive. Many of the "mini Dopp kits," shown above, have a zipper running down the middle-top of the pouch, as well as having smooth, rounded edges, tucked and folded corners, and lack of piping.

Applicant attempts to distinguish its packaging from the third-party use of the same-shaped pouch by arguing:²⁴

It is not the size *per se* that is distinctive, but rather the overall appearance of a diminutive or shrunken product that catches the attention. In the same way that a perfume bottle may catch attention by resembling an actual flower, the Minimergency Pouch packaging—which is a temporary container for an assortment of tiny women's products that are meant to be used up and discarded—intentionally resembles something it is not, namely, a dopp kit, which is a sturdy, long-lasting piece of travel luggage intended for men.

Applicant thus freely admits that its packaging design is intended to resemble a "Dopp kit."²⁵ Although Applicant further argues that the size of the pouch or

²⁴ 13 TTABVUE 9.

²⁵ A dopp kit is described as a "small toilet bag, made of leather, vinyl, or cloth, that is used for storing men's grooming tools for travel." The name derives from a German immigrant who invented a toiletry case. From Wikipedia (www.wikipedia.com), printout attached to

packaging is not necessarily a distinctive attribute of its proposed trade dress, Applicant makes the seemingly contradictory argument that consumers will perceive its pouch design as a “diminutive or shrunken” version of a dopp kit. We find this argument flawed for the very simple reason that there is no size restriction with respect to Applicant’s proposed mark. That is, Applicant has applied for and is seeking exclusive rights in a packaging trade dress mark, namely a pouch within a clear plastic box, *without any limitation as to the size of the packaging*. As a result, any registration of the proposed mark would not reflect that the packaging is intended to intimate a “diminutive or shrunken” version of a dopp kit; rather, Applicant would be conferred rights in a packaging design that could include a full-size, dopp kit-styled bag within a clear outer box. In any event, as the above evidence shows, dopp kits and other very-similarly designed types of toiletry or cosmetic bags may be found in smaller sizes, including “mini Dopp kits.” For purposes of considering whether Applicant’s proposed trade dress is distinctive, or has acquired distinctiveness, we must assume that the packaging can include the same size as other similarly-designed pouches, cosmetic bags, dopp kits, etc.

October 11, 2013 Office action. A photograph from this website depicts the dopp kit as follows:



A traditional leather dopp kit

Applicant argues strongly that the Examining Attorney’s evidence, although it shows extensive third-party use of similarly-designed cosmetic and toiletry bags or dopp kits, is irrelevant because the goods being depicted are sold empty and should not be compared to Applicant’s kits, which contain a variety of cosmetic and toiletry items. Instead, Applicant contends that the only probative examples of third-party packaging should be for goods where cosmetic and toiletry goods are being sold together as a kit or package. Applicant asserts that packaging for what it considers are the same goods is visually distinguishable from its proposed trade dress. Some examples include the following internet printouts, submitted by the Examining Attorney, showing third-party goods advertised as kits containing “essential” or “emergency” items in a single kit:²⁶



²⁶ Attached to Office Action dated October 11, 2013. The Examining Attorney did attach a printout depicting a “Minor Incident Kit” with a Home Depot logo on the front that appears to be identical in design to Applicant’s trade dress. However, these goods were available through a “microsite” directed to Home Depot employees and “the manufacturer of this product has changed its packaging following receipt of a ‘cease-and-desist’ letter sent by [Applicant’s] attorneys.” Kaplan Declaration (paragraph 74), attached to Applicant’s response filed April 11, 2014.

Applicant, too, submitted examples of what it calls “women’s essential kits,” including:²⁷



With respect to the examples of cosmetic and toiletry bags or dopp kits that do bear a strong resemblance to Applicant’s pouches, Applicant cites a Board decision involving trade dress in explaining why it should not be considered probative in this proceeding:

[Applicant’s pouch design] is a unique form of packaging for use *in the field of personal care kits*, and ... the Examining Attorney’s evidence of cosmetic bags and “dopp” style bags sold empty is irrelevant, pursuant to the Board’s precedential *In re The Proctor & Gamble Company* (“P&G”) opinion. 105 USPQ2d 1119, 2012 WL 6064533, n.12 (TTAB 2012) (the relevant market for determining uniqueness of a bottle and cap for mouthwash was limited to containers for mouthwash products; designs of bottles for containing and dispensing liquids in *other* fields (e.g., perfume, ketchup, salad dressings), as well as the configuration of goods sold empty, which could then be filled with the type of product sold by the applicant, were completely ‘irrelevant’ to the inquiry).

[Bold in original].²⁸

In the case cited by Applicant, the *Proctor & Gamble* decision, the Board was determining the distinctiveness of an applicant’s trade dress consisting of a

²⁷ Attached to Kaplan Declaration (paragraphs 56-68).

²⁸ 26 TTABVUE 10-11.

mouthwash bottle and, in a footnote, discussed the value of evidence showing similarly-shaped, crystal decanters that were empty but could be filled with liquids, including mouthwash. *In re The Proctor & Gamble Co.*, 105 USPQ2d 1119, 1126 n. 12 (TTAB 2012). The Board ultimately did not find this evidence probative reasoning that there should be “some showing of a substantiality of the link” between the market for empty decanters and that for mouthwash, and “we do not view the mere availability of empty crystal decanters ... as a sufficient factual predicate for considering such decanters here.” *Id.*

The evidentiary circumstances in this case are different and, in accordance with the type of showing contemplated in the *Proctor & Gamble* decision, we find a strong link between the market for Applicant’s kits containing cosmetic and toiletry items with the market for cosmetic bags, toiletry bags or dopp kits, in spite of the fact that the latter goods are being sold empty. As the record reveals, all of these goods are often marketed to a female audience, particularly a younger consumer who has an eye on fashion. The Examining Attorney’s evidence shows cosmetic and toiletry bags, as well as certain dopp kits, are sometimes presented with a designer motif or displayed for fashion conscious consumers. Applicant’s kits are also regarded as fashion accessories and may be found in national retail outlets, such as Sephora, BHLDN, Apricot Lane Boutique, Francesca’s, etc., who carry a range of women’s fashion accessories, including cosmetic and toiletry bags sold empty.²⁹ Bloggers who specialize in beauty and fashion products, like those mentioned by

²⁹ See, respectively, Kaplan Declaration (paragraph 27), Exhibits 2, 3, and 7, all attached to Applicant’s response filed on April 11, 2014.

Applicant's founder,³⁰ are likely to discuss Applicant's goods as well as any other fashionable cosmetic or toiletry bag that is sold without additional cosmetic or personal items. The more obvious and, perhaps significant link is that the cosmetic and toiletry bags, as well as dopp kits, are specifically designed to hold most, if not all, of the same types of goods found in Applicant's kits. That is, Applicant's goods are kits containing certain cosmetic and toiletry items that are normally placed in either cosmetic bags (e.g., "nail polish, nail polish remover wipe being pre-moistened cosmetic wipes") or toiletry bags and dopp kits (e.g., "emery board, lip balm ... pain relief medication, tampon, breath freshener, ... adhesive bandages and dental floss"). Put simply, the pouch portion of Applicant's proposed mark is performing the same purpose as a cosmetic bag or toiletry bag or dopp kit. Accordingly, the evidence of various third-party cosmetic bags, toiletry bags, and dopp kits is considered and relevant in our determination of whether Applicant's proposed trade dress is unique or distinctive.

As to the latter two *Seabrook* factors, involving whether the packaging design is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods or if it is capable of creating a commercial impression distinct from the accompanying words, there is very little to indicate that it is inherently distinctive. Although the record does not demonstrate that Applicant's mark is merely a refined version of competitor trade dress, we find no demonstrated reason why consumers would perceive Applicant's packaging design as anything

³⁰ Kaplan Declaration (paragraph 42-44).

other than merely a dopp kit-shaped container for cosmetic and toiletry items within a clear plastic box packaging. The circumstances here are unlike those where we found an Applicant's trade dress "stands alone in the quality and quantity of its distinctive traits which set it apart from [competitors' trade dress]." Cf. *In re Frankish Enterprises Ltd.*, 113 USPQ2d 1964, 1971 (TTAB 2015) (applicant's monster truck trade dress was "cut and molded to convey the body of a dinosaur and adorned with other dinosaur elements, including horns, a protective shield and eyes bordered by scales" and this made it very different from competitors). Likewise, we find that Applicant's packaging design is not capable of creating a distinct commercial impression apart from the word mark placed on the packaging. Again, in contrast to *Frankish Enterprises*, we do not have a situation where the design "predominates" over the word mark. *Id.* Applicant's goods are presented in the following manner:³¹



We see no reason why a consumer viewing this product packaging would perceive it as having a distinct commercial impression or would otherwise initially

³¹ Specimen, submitted by Applicant with the application, as filed on February 15, 2013.

view the packaging as indicating the source of the goods. Rather, it is the word mark(s) with designs and logos that “predominate” and will be, at least initially, relied upon for identifying the source of the goods.

Ultimately, as discussed above with respect to the Seabrook factors and the record before us, we find that Applicant’s packaging, as shown in Application ‘794, is not inherently distinctive. Applicant’s product packaging does not possess the necessary *intrinsic nature that serves to identify a particular source*. *Wal-Mart*, 54 USPQ2d at 1068.

2. Whether Applicant’s Proposed Trade Dress Has Acquired Distinctiveness

We now turn to Applicant’s alternative claim that its product packaging design has acquired distinctiveness and is thus registrable under Section 2(f). The burden of proof is on Applicant. *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988) (applicant “seeking to register its configurations/designs under Section 2(f), [bears] the burden of establishing acquired distinctiveness in ex parte proceedings before the PTO”); *see also Van Valkenburgh*, 97 USPQ2d at 1765 (product design features registrable only with a showing of acquired distinctiveness). As explained in *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000):

To establish acquired distinctiveness, applicant must show that the primary significance of the product configurations in the minds of consumers is not the product but the producer. Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as

years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. 1999).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. See *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (CCPA 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729, 730 (TTAB 1985). Typically, more evidence is required when a proposed mark is shown to be in use by others. Cf., *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (more evidence required to establish acquired distinctiveness for a word mark because it is so highly descriptive and purchasers are less likely to believe that it indicates source in any one party); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657, 1659 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984).

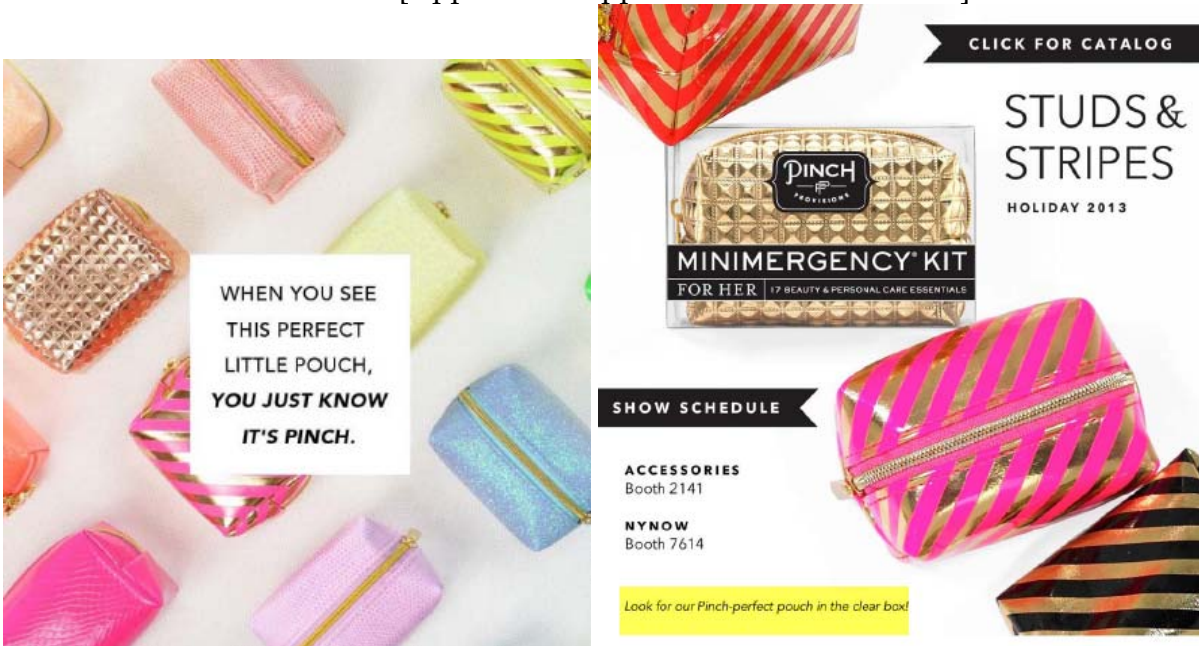
In support of its alternative claim of acquired distinctiveness of the pouch packaging within the clear box packaging, Applicant relies extensively on the declaration of Georgette Kaplan, one of its founders, and the exhibits thereto.³² Some of the salient factual averments made by Ms. Kaplan include:

- Applicant has been using applied-for trade dress since 2008;

³² Attached to Applicant's response filed on April 11, 2014 (as "Exhibit 1").

- At that time, “only two other companies were selling kits of items for women ... on a national scale” and Applicant was the first “to use fabric pouches as packaging for portable care kits for women.”
- To date [of declaration, on April 10, 2014], “over one million kits have been sold in the [applied for trade dress]” and that figure is expected to double “in the next 12-18 months”;
- Applicant’s kits “for women and girls range in MSRP from \$14 to \$16.”
- Since 2008, Applicant’s revenue has increased “approximately 600%” and has “at least double-digit growth for five years straight,” with a “significant portion of this due to sales of [Applicant’s goods with the applied-for trade dress”];
- Applicant’s “Pinch Provisions” website, www.pinchprovisions.com, “garners millions of page views per year”;
- The kits are sold “in a variety of fashion colors and finishes,” but the applied-for trade dress remains “consistent”;
- Applicant’s proposed trade dress has “remained consistent before, during, and after [Applicant’s] rebranding process,” namely, changing its labels in 2010 and 2012, and the trade dress “enabled customers to identify our products through the re-branding process”;
- Applicant’s kits are “an established and market-leading product,” available for purchase “in over 3,000 retail locations including Sephora, J.Crew, Nordstrom, The Container Store, Francesca’s Collections ...” and are “also carried in a wide range of retail channels, such as hotels, airports, museums, hospital gift shops, salons, spas, and independent boutiques across the country”;
- In Sephora, Applicant’s goods bearing its applied-for trade dress have been “located in the store’s ‘Beauty-to-Go’ section near the checkout for going on four years” (a photograph is attached as an exhibit) and this resulted in “every single paying Sephora customer [waited] in front of or walked past” Applicant’s kits prior to checkout;
- In J.Crew, Applicant’s goods are displayed for sale in a manner similar to Sephora;
- Since 2013, Applicant has “received over 1,400 formal vendor applications” and has been “approached by an additional 40 leading retail outlets” seeking to carry Applicant’s trade dress goods;

- Applicant’s website, www.pinchprovisions.com, “garners millions of page views per year”;
- Applicant “has spent more than half a million dollars in advertising, marketing, and promotion over the past three years alone,” including attendance at trade shows as well as “promotion and distribution via retail stores, online, in-store and through social media”;
- Applicant works with “public relations firms to promote the [goods] through national, regional, and local media outlets, be they in print, online, or on television”;
- Applicant’s advertising includes “ads like the following, which direct consumers to look for [Applicant’s applied-for dress features]:



- Applicant won an industry award from Graphic Design USA magazine for its applied-for trade dress and the trade dress has mentioned in articles on “The Dieline” and in “Beauty Packaging” magazine;
- Applicant’s proposed trade dress has been “featured in coverage of [Applicant’s goods] in dozens of magazines and has appeared on popular, national television shows such as The View, The Today Show, Good Morning America, CBS Morning, Regis and Kelly, and the Rachel Ray Show. It has “appeared” in magazines, such as Better Home & Gardens, Good

Housekeeping, Cosmopolitan, Marie Claire, etc., and in the New York Times;³³

- Applicant's goods, bearing the proposed trade dress, have been featured in social media circles, which Ms. Kaplan stated she is familiar with, whereby presenters highlight various fashion products. This includes the presentation of Applicant's trade dress goods in outlets like YouTube, Twitter, and Instagram. This includes comments indicating that "customers recognized the product and correctly noted that the [Applicant's goods are] available for purchase at Francesca's Collections, Henri Bendel, Sephora, and Nordstrom";³⁴
- Applicant's trade dress receives unsolicited attention, including customer reviews, and has "appeared in an estimated 400 blog mentions since July 2012";
- In 2013, Applicant, through its attorneys, has sent "a half dozen [cease-and-desist] letters to various manufacturers and distributors of competitive products using copycat pouch packaging, and in each instance, the recipient of the letter stopped using the confusingly similar packaging"; and
- Applicant has initiated civil action against "infringers" of its trade dress and "has obtained favorable settlements" resulting in discontinued use of the packaging.

In addition to the Kaplan declaration and accompanying exhibits, Applicant submitted the declarations, also with accompanying exhibits, of the following individuals who have knowledge of Applicant's goods:

- Rachel Weisse, Merchandise Assistant at BHLDN (described as an "online retailer" with "brick-and-mortar stores" in various cities, but also as "a wedding brand from ... lifestyle retailer Anthropologie" that sells a "curated, edited selection of gifts");³⁵

³³ Printouts of from the magazines (Exhibit F) and a partial printout from the New York Times (Exhibit G) were attached to the Kaplan Declaration.

³⁴ Specifically, Ms. Kaplan references screenshot printouts (Exhibit I).

³⁵ Attached to Applicant's response filed on April 11, 2014 (as "Exhibit 2").

- Amanda Wulff, Corporate Buyer at Apricot Lane Boutique, a “women’s boutique that specializes in apparel, shoes, accessories, and gifts,” with “123 current and planned ... stores in 33 states”;³⁶
- Alexzndra Louras, Associate Manager of the Merchandising Team at Birchbox, an “online discovery platform that helps consumers explore new and exciting beauty, fashion and lifestyle products from top brands”;³⁷
- Doria Murphy, a freelance makeup artist, copywriter and founder/editor of BeautyPopStop, a “makeup artistry and beauty review blog”;³⁸
- Lisa Smith, a buyer for The Container Store, a national retail chain that “provides storage and organization solutions”;³⁹ and
- Liz Tharp, a Gift Buyer in 2010-2013 for Francesca’s Collections, a national boutique retail chain featuring accessories, gifts and clothing for women.⁴⁰

Each of these declarants avers to the popularity of Applicant’s goods with consumers and the uniqueness of Applicant’s packaging. In addition, each states to differing degrees her ability to recognize Applicant’s goods based on the packaging design and/or the attraction of consumers to the packaging. For example, Ms. Weisse states:

I definitely identify the shape and details of the [Applicant’s] packaging with Pinch. The size, weight, construction, the placement of the gold zipper. Even how it darts at the edges, too. That's what I would recognize first, at a distance: the shape and the construction of the pouch. That's how I would immediately know that the product is from Pinch. ... [Applicant’s] packaging stands out. Compared to other beauty emergency kits, [Applicant’s] pouch is more current. It's much cleaner. It's pretty, it's cute, it's very feminine. Competitor products can be kind of tacky.

Ms. Wulff avers:

³⁶ *Id.*, Exhibit 3.

³⁷ *Id.*, Exhibit 4.

³⁸ *Id.*, Exhibit 5.

³⁹ *Id.*, Exhibit 6.

⁴⁰ *Id.*, Exhibit 7.

I would recognize [Applicant's] pouch as originating from Applicant if it did not have any labels or wording on it. The style, size, width and design of the pouch would help me recognize it. The outside clear box is also very distinctive. ... The Pinch Provisions pouch and the outside clear box are unique in the industry.

Ms. Louras states that Birchbox has presented Applicant's kits without any labeling, but Birchbox "knew many consumers would recognize the product even without the outer branding, because they would recognize the pouch packaging used by Applicant." She also avers that "consumers frequently call out the packaging specifically in their reviews" and "have specifically approved of the 'cute, girlie packaging,' 'cute design,' and 'adorable pouch.'" Ms. Murphy, a blogger, finds the packaging "is so attractive, cute and different." Ms. Smith states that she "cannot recall any of the other personal essential kits being presented in a pouch and clear outer box similar to [Applicant's packaging]." Finally, Ms. Tharp avers that she thinks Applicant's packaging is "unique" because of "the combination of the pouch and acetate box. The acetate box signals Pinch Provisions as the source of the kit and signals that the product is, in fact, a kit. I am not aware of any other kits that come in a clear box with a visible pouch."

The record created by Applicant, including materials that are not specifically mentioned above, is not insubstantial; nevertheless, we find that it does not demonstrate that the applied-for trade dress has acquired distinctiveness. At best, the evidence shows that consumers might recognize Applicant's goods because the pouches are compact or 'cute.' Applicant's advertising ("When You See This Perfect

Little Pouch”) indicates an attempt to make this association,⁴¹ and statements from the declarants, as well as unsolicited comments from consumers, help corroborate the significance of the size of the pouch. The problem, however, and as mentioned previously, is that even to the extent that the size of the pouch has become a distinctive feature, this is not an attribute of Applicant’s trade dress as it is described in the Application (nor is size evident from the mark shown in the drawing). And there is no evidence that the trade dress elements identified in Applicant’s applied-for mark perform any source-identifying function.

With respect to the proposed trade dress feature involving the placement of the pouch packaging within a clear outer box packaging, the totality of evidence does not support a finding that this feature (which is reflected in the Application) has acquired distinctiveness. Although a few of the declarants comment on the ‘packaging within packaging’ feature, there appears to be little if any mention of this feature from consumers discussing Applicant’s goods or its packaging. We acknowledge that Applicant promoted the feature in at least one advertisement (“look for the Pinch Perfect pouch in the clear box”); however, there is insufficient evidence to find that consumers have become accustomed to viewing Applicant’s proposed ‘packaging within packaging’ trade dress as anything more than merely packaging.

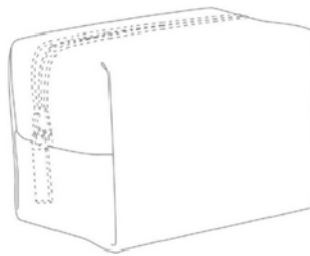
⁴¹ Applicant did not submit additional evidence to show the extent of this “look for” advertising or what portion of Applicant’s advertising budget (“half a million dollars in advertising, marketing, and promotion over the past three years”) was allocated to advertising that highlights what Applicant believes are unique attributes of its proposed trade dress mark. Moreover, without any basis for comparison, it is difficult to gauge the significance, if any, that Applicant’s advertising expenditures for the last three years should play in our determination as to the distinctiveness of the proposed trade dress.

Application ‘794 – Conclusion

In sum, we find that Applicant’s proposed packaging trade dress, as described and shown in Application ‘794, is neither inherently distinctive nor has it acquired distinctiveness. The evidence as a whole does not demonstrate that Applicant’s packaging, as applied for, has unique features that consumers would perceive as source-identifying. In making these conclusions, we keep in mind the near identity of Applicant’s pouch design with that of a dopp kit and the ubiquity of third-party cosmetic and toiletry bags with that same design. As a result, the evidentiary burden for showing that the pouch is unique in the field of containers for cosmetics or toiletry goods is certainly elevated.

Application ‘833: Product Packaging Trade Dress

The Examining Attorney refused registration of the proposed mark in Application ‘833, depicted below again, on the sole ground that it comprises non-distinctive packaging design:



As is evident, the configuration of Applicant’s packaging is merely the pouch and is identical to the pouch within the outer clear box in Application ‘794. Thus, many of the considerations and factors, already discussed, hold true with respect to this

proposed trade dress. Moreover, the evidentiary record created with respect to this application is nearly identical with no substantial difference.

Indeed, for reasons already outlined, we find that Applicant's pouch design is neither inherently distinctive nor has it acquired distinctiveness. Consumers viewing this packaging configuration in the context of personal care kits containing toiletry and cosmetic items, will perceive it as merely another dopp kit-styled bag or container used for holding these items. There is no real distinguishing characteristic between Applicant's proposed trade dress and many of the third-party goods shown in the Examining Attorney's evidence. Applicant's attempt to prove that its packaging has acquired distinctiveness based on it being a "cute" or miniaturized version of a dopp kit fails because, again, the applied-for trade dress in Application '833 has no size attribute. Although there is evidence to support Applicant's argument that individuals are able to recognize its goods based on the size of the packaging, the stated distinguishing attributes are not reflected in the Application. We reiterate that, if Applicant's proposed mark were to register, Applicant would then be accorded exclusive rights in that packaging design, regardless of size, and thus entitled to enforce the mark against competitors who seek to sell any full-size, dopp kit-styled bag containing toiletry or cosmetic items.

Decision: The refusals to register Applicant's marks, as applied for in both Applications '794 and '833, are affirmed because the proposed marks are non-distinctive product packaging.