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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Selig Sealing Products, Inc.

Serial No. 86078062

Joseph T. Nabor of Fitch, Even, Tabin & Flannery for Selig Sealing Products, Inc.

Curtis French, Trademark Examining Attorney, Law Office 115 (Daniel Brody, Managing Attorney).

Before Zervas, Masiello, and Coggins, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Selig Sealing Products, Inc. ("Applicant") applied to register on the Principal Register the mark set forth below for "Primarily non-metal seals for use in container closures and caps; Laminates of plastic and paper used as container closure liners; Non-metal inner seals for caps of bottles and jars; Non-metal closures, namely, inner seals for containers," in International Class 17:¹

¹ Application Serial No. 86078062, filed on September 30, 2013 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), with a claim of first use and first use in commerce of March 31, 1997. Applicant claims that its mark has become distinctive of its goods in commerce, as contemplated by Trademark Act Section 2(f), 15 U.S.C. § 1052(f).



The application describes the mark as follows: "The mark consists of a three dimensional configuration of a half-moon shaped pull-tab of an inner container seal; the dotted lines in the mark are intended only to illustrate the placement of the mark on the surface of the goods and are not part of the mark; the shape of the seal to which the pull-tab attaches is not a feature of the mark." Color is not claimed as a feature of the mark.

The Trademark Examining Attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that Applicant's proposed mark comprises matter that, as a whole, is functional; and on the ground that it is a nondistinctive product configuration that has not been shown to have acquired distinctiveness, under Trademark Act §§ 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127. When the refusal was made final, Applicant appealed. The case is fully briefed.²

I. <u>Refusal on grounds of functionality</u>.

The Supreme Court has stated: "In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *Inwood Labs, Inc. v. Ives Labs, Inc.*, 456 U.S. 844, 214 USPQ 1, 4

² In this opinion, citations to the examination record refer to the downloaded .pdf documents as they appear in the USPTO's Trademark Status & Document Retrieval (TSDR) system. Citations to the appeal record refer to the Board's TTABVUE online docketing system.

n.10 (1982). A functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." *Qualitex Co. v. Jacobson Prods Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995). The Supreme Court confirmed the "*Inwood* formulation" as the "traditional rule" of functionality in *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The functionality doctrine is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court observed 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, 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).

34 USPQ2d at 1164.

The Examining Attorney has the burden of making a *prima facie* showing that Applicant's mark is functional. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012). The determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *E.g., Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB

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2009). The Court of Appeals for the Federal Circuit, our primary reviewing Court, looks at the following four factors when it considers the issue of functionality: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design 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. In re Becton, Dickinson and Co., 102 USPQ2d at 1377, citing Valu Eng'g, 61 USPQ2d at 1426 and In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). These well-known "Morton-Norwich factors" are "legitimate source[s] of evidence to determine whether a feature is functional." Valu Eng'g, 61 USPQ2d at 1427. However, the Supreme Court has made it clear that the standard for functionality is set forth in *Inwood*, *i.e.*, whether a feature is "essential to the use or purpose of the device or... affects the cost or quality of the device," and that if functionality is properly established under Inwood, further inquiry into facts that might be revealed by a Morton-Norwich analysis will not change the result. TrafFix, 58 USPQ2d at 1006 ("Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.").

A. <u>Applicant's goods</u>.

Applicant's goods are "inner seals for containers." Applicant explained that "Our method of creating an inner seal for a container is induction sealing."³ The record

³ Response of April 24, 2014 at 17.

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shows that "induction sealing" is a method of hermetically sealing the top of a plastic or glass container with a metallic foil.⁴ An example of the product as applied to a plastic bottle is pictured below:⁵



Applicant supplied the following explanation of how induction sealing works:

The closure is supplied to the bottler with foil liner already inserted. Although there are various liners to choose from, a typical induction liner is multi-layered. The top layer is a paper pulp that is generally spot-glued to the cap. The next layer is wax that is used to bond a layer of aluminum foil to the pulp. The bottom layer is a polymer film laminated to the foil. After the cap or closure is applied, the container passes under an induction coil, which emits an oscillating electromagnetic field. As the container passes under the induction coil (sealing head) the conductive aluminum foil liner begins to heat. The heat melts the wax, which is absorbed into the pulp

⁴ Entry for "Induction sealing" at <wikipedia.org>, Response of April 24, 2014 at 119-123.

⁵ Applicant's specimen of use filed September 30, 2013.

backing and releases the foil from the cap. The polymer film also heats and flows onto the lip of the container. When cooled, the polymer creates a bond with the container resulting in a hermetically sealed product. Neither the container nor its contents are affected, and this all happens in a matter of seconds.⁶

The sealing portion of the seal, which is affixed to the opening of the container when the seal is used, is not an aspect of Applicant's mark. The only aspect of the seal that Applicant claims as its mark is the "half-moon shaped pull-tab." As the drawing of the mark shows, the pull-tab is attached to the center of the sealing portion and extends to the edges of the sealing portion. The question before us is whether the semicircular shape of the pull-tab and its position at the center of the seal and extending to the edges of the seal are, as a whole, functional.

B. <u>The Morton-Norwich factors</u>.

Applicant and the Examining Attorney have presented a substantial amount of evidence relevant to the *Morton-Norwich* factors. A brief summary follows.

Patents

Applicant states that no utility patent that it owns or has owned claims the features of the mark at issue.⁷ In response to information requirements of the Examining Attorney, Applicant has made of record copies of numerous patents relating to induction seal technology, belonging to Applicant and third parties, which are instructive as to the desirability and purpose of various features of

⁶ Response of April 24, 2014 at 119.

⁷ See Reply brief at 3-4, 7 TTABVUE 5-6 ("none of them claim a semi-circle pull tab at the center of the seal. ... Applicant ... is not aware of any utility patent claims which are directed to this shape of a pull tab or its placement on the innerseal.").

induction seals. Even though there is no patent that claims the exact configuration for which trademark protection is sought, "statements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality." *In re Becton, Dickinson*, 102 USPQ2d at 1377, *citing TrafFix*, 58 USPQ2d at 1006.

Touting

Applicant and third parties that have been involved in marketing Applicant's seals (which are offered under the word mark LIFT 'N' PEEL) have touted the ease with which Applicant's pull-tab can be gripped. This evidence indicates that a function of the design of Applicant's pull-tab is to improve the grippability of the tab for the purpose of removing the seal:

The Lift 'n' PeelTM range of induction seals incorporate an easy open polyester tab that has been designed to be ergonomically easy to grip, flexible and extremely strong.⁸

The foil laminate is easily gripped by its unique semicircular tab allowing for an easy open feature and creating differentiation.⁹

These benefits can now be offered with an improvement to the consumer experience with an easy to open, intuitive, Lift 'n' Peel or Top Tab brand liner from Selig Group.¹⁰

LPM is a one piece top-tabbed induction innerseal that incorporates an easily gripped semi-circular tab as an easy-open feature.¹¹

⁸ Web page at <seligsealing.com>, Office Action of December 8, 2014 at 9.

⁹ Id. at 11.

¹⁰ Transcript of video from <seligsealing.com>, Response of June 8, 2015 at 35.

¹¹ Web page of Weatherchem, referring to Applicant's product, Office Action of February 29, 2016 at 9.

Lift 'n' PeelTM heat induction seals incorporate a polyester tab that has been designed to be ergonomically easy to grip, flexible and extremely strong.¹²

Looking for an alternative to pull tab liners with those "tiny" tabs? Try Lift-n-Peel or Top Tab materials with their generous tabs for easy removal – consumers will thank you for it.¹³

Ergonomical Tab The large tab allows consumers to easily grip the seal. They can then peel from the edge and remove cleanly, in one piece.¹⁴

If you have ever broken a nail or cut yourself while removing a liner from a bottle, Lift'n'PeelTM may be just what you need. Our unique and patented Lift'n'PeelTM range presents an easily gripped semi-circular tab as an easy open feature.¹⁵

Applicant, on its web page, describes a survey of shoppers who were asked to rate

four different containers:

It was clear that consumers found all induction seals extremely important, with the highest emphasis placed on product safety, freshness, ensuring no leaks or spills, and *being easy to remove*. Convenience and *being easy to open*, *without the use of a tool*, was the factor most liked about the Lift 'n' PeelTM over a traditional seal.¹⁶

 $^{^{12}}$ Web page of Pres On, referring to Applicant's product, id. at 8. See also web page at <seligsealing.com>, Office Action of December 8, 2014 at 9.

¹³ <danburyplastics.com>, Office Action of October 24, 2013 at 7.

¹⁴ Web page at <seligsealing.com>, Office Action of December 8, 2014 at 6.

¹⁵ Web page at <amseal.co.nz>, Office Action of October 24, 2013 at 19.

¹⁶ <seligsealing.com>, Office Action of December 13, 2014 at 13 (emphasis added).

Alternative designs

Applicant has demonstrated that alternative designs for pull-tabs on induction seals are available. *See, e.g.,* Response of April 24, 2014 at 39-48; and Patent Nos. 4960216, 5265745,¹⁷ and 5514442.¹⁸ Some alternatives are shown below:



¹⁷ Response of November 19, 2014 at 24-28 and 49-58.

¹⁸ Response of June 8, 2015 at 37-49.

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The question we must consider is whether the alternative designs would permit a competitor to manufacture a pull-tab that performs the same functions as Applicant's product "equally well." *Valu Eng'g*, 61 USPQ2d at 1427, quoting with approval J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §7:75, 7-180-1 (4th ed. 2001). If variations from the design of Applicant would alter the functional qualities of a competitor's goods, then it would be clear that the design "affects the ... quality of the article." *See Inwood*, 214 USPQ at n.10; *TrafFix*, 58 USPQ2d at 1006. We will address these issues in our full discussion, below.

Ease of manufacture

An officer of Applicant provided a declaration stating that "The Pull Tab design of this application has greater material cost and is more complicated to make than either of [two other] alternatives. ... Providing a Pull Tab that extends upward requires the use of at least one extra layer of material, which is more costly than other induction seals having a tab protruding from the edge of the seal."¹⁹ Another declarant, retired from the packaging industry, stated, "I am aware that it is more costly to produce than any similar seals that provide similar package sealing function. ... [T]his shape requires the use of an extra layer of material which is more costly than other similar functioning induction seals. ... The design of this product is not a comparatively simple or inexpensive method of manufacture. In

 $^{^{19}}$ Brucker declaration $\P\P$ 5, 9, Response of June 8, 2015 at 28-29.

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fact, this product is more difficult and expensive to produce than other seals in the industry. Packagers in this industry have always been highly cost sensitive."²⁰

C. <u>Use or purpose of the article</u>.

The record of this case shows that an important function of the pull-tab is to allow users to conveniently remove Applicant's induction seal from a sealed container. Applicant has submitted several declarations of persons knowledgeable in the trade that state as follows (emphasis added):

In certain product packaging, it is essential that the package be sealed in a manner that allows for a secure seal. It is also essential that there be a manner in which the seal can be broken or removed to access the contents of the package. The $\frac{1}{2}$ Moon Tab design, which is the subject of this trademark application, does not enhance the sealing of the liner membrane to the package. The $\frac{1}{2}$ Moon Tab purpose is to provide a convenient removal feature to allow the consumer to remove the seal to access the product in the package.²¹

In view of this purpose of the pull-tab, an important ancillary feature is that the pull-tab be strong enough not to break before the seal has been successfully removed. The record shows that consumers have complained about breaking pull-tabs on induction seals.²² One of Applicant's patents for an induction seal explains that "[y]et another advantage of the present invention is to provide a closure seal

 $^{^{20}}$ Radek declaration $\P\P$ 4, 7, 10, Response of January 8, 2016 at 24-25.

 $^{^{21}}$ See ¶ 5 of declarations of Paul R Schmidt, Scott Manning, and Jake Wilson, Response of January 28, 2016 at 6-14; declarations of Sterling Anthony, Victor Kassell and William Zito, Response of January 8, 2016 at 13-23.

²² Office Action of February 29, 2016 at 21 ("The liners even have reinforced pull tabs that hold tighter and won't easily tear away from the rest of the seal like lower quality ones."); Office Action of October 24, 2013 at 13 ("Note to manufacturer: extremely strong doesn't matter unless the seal to the container requires slightly less force to peel than the tab takes to tear.").

having a pull-tab which resists breaking.²³ The claim relating to the pull-tab refers to "a unitary pull tab portion secured across the entirety of said upper surface [of the seal].²⁴

In our analysis, we will focus on the pull-tab's function as a method for removing the seal and on the important functional feature that the pull-tab be strong. We also will limit our analysis to the question of whether the proposed mark would be functional as a whole as applied to *circular* seals. It is true that Applicant has specifically stated that "the shape of the seal to which the pull-tab attaches is not a feature of the mark." It is also clear that containers having non-circular openings exist and that Applicant's semi-circular pull-tab could be attached to a non-circular seal for such an opening. However, containers having a circular opening are an important segment of the universe of containers. Nearly all of the evidence of record relates to use of induction seals on circular openings;²⁵ and, as Applicant admits, "Obviously, the shape of the innerseal itself is dictated by the shape of the container."²⁶

D. <u>Discussion</u>.

Applicant's proposed mark has two notable features: the semicircular profile of the pull-tab, and its position across the center of the seal, reaching from edge to edge. First we will address the pull-tab's position. When the pull-tab is placed

²³ Pat. No. 5702015, Response of November 19, 2014 at 61.

 $^{^{24}}$ *Id*. at 63.

²⁵ See, e.g., Response of April 24, 2014 at 39-48.

²⁶ Reply brief at 7, 7 TTABVUE 9.

across the center of a circular seal, from edge to edge, the base of the tab will lie upon the circle's diameter. The diameter is, of course, the longest chord between any two points on the circle. Thus, by positioning the pull-tab along the center of the seal, the base of the pull-tab will be as long as it possibly can be. The attachment of the pull-tab to the seal along a greater length logically allows the bond to be stronger than an attachment along a shorter length.

The fact that the pull-tab reaches the edge (where the adhesive is holding the seal to the container's opening) allows the user who manipulates the pull-tab to exert force directly against the small portion of the adhesive that is directly under the end of the pull tab. This is more effective – more likely to successfully separate the seal from the opening – than pulling on another portion of the seal (*e.g.*, pulling directly upward at the center of the seal), where the force would be distributed over a wider area of the adhesive on the edge.²⁷

The fact that the pull-tab reaches the edge in two places, located diametrically opposite each other on the rim of the container, provides two places on the edge where the seal is most vulnerable to removal. This design is superior to seals that have only a single tab on the edge. The symmetry of this arrangement means that a consumer may attempt to remove the seal from two different directions with equal efficiency. This increases convenience, as the user has less need to reposition the

²⁷ See Reply brief at 8, 7 TTABVUE 10 ("all pull-tabs on the market ... are located on the edge of the innerseal. This is true for pull-tabs located on the top of the innerseal as well as those that protrude from the edge of the innerseal."). See also Georgia Tech Research Institute publication, Office Action of February 29, 2016 at 23 ("On inner seals that are intended to be grasped and peeled from the container, place the grasp point in a location selected for the application of optimum force. The tab should be located along the edge of the seal if the seal is designed to be peeled from the edge.")

container in order to manipulate the tab with his stronger or dominant hand. This symmetry would be lost if the pull-tab reached the edge in only one place, or if the pull-tab were positioned across a shorter chord of the circle (thereby bringing the two vulnerable locations on the edge closer together on one side of the circle). Thus, we see that the position of the pull-tab across the center of the seal, extending from edge to edge, improves both the strength of the pull-tab and the ease with which it will remove the seal.

Next we turn to the semi-circular shape of the pull-tab and consider whether this shape has a functional purpose as used on a circular seal. The record indicates that at least two considerations have a bearing on the shape of the pull-tab: the ease of removing the seal; and the manner in which induction seals are applied to containers.

The record shows that an important feature of pull-tabs is that they be of sufficient size to allow for easy grasping. A Georgia Tech Research Institute publication on industrial design of seals states:

The inner safety seal can be difficult to remove from the squeeze container's orifice if the seal does not provide a *sufficient grasping surface*. The seal may have a pull tab that is too small, or there may be no tab at all. If a tab is not provided, users may attempt to pinch the tiny edge of the seal, likely resulting in pain and frustration for users with arthritis. ... Even if a tab is provided, the tab may be too small for some users to easily grasp.²⁸

A suggested "potential solution" is:

²⁸ Office Action of February 29, 2016 at 22 (emphasis added).

Provide a large tab on the edge of the seal with a sufficient grasping surface that can be removed with less than 5 pounds (22.2 N) of force. ... [The tab] should be at least 0.47 inches (12 mm) wide by 0.79 inches (20 mm) long so that users can grasp it between the thumb and lateral aspect of the index finger. Smaller tabs may be difficult to grasp ...²⁹

A patent for an induction seal similar to Applicant's seal confirms the importance of the "basic problem of grippability" of pull-tabs, which "has not been effectively solved to date."³⁰ The above evidence indicates that a larger pull-tab makes the seal easier to remove, because consumers find larger pull-tabs easier to grip. Of course, a large, easily-grasped pull-tab of virtually any shape could be attached to a seal. We must ask whether there is a functional reason to make the pull-tab on a circular seal semi-circular.

As we have noted above, when a circular seal is to be applied, it is "inserted" into the circular cap and "generally spot-glued to the cap."³¹ In other words, the seal must fit inside a circular cap, and any pull-tab (lying flat against the rest of the seal)³² must also fit in. The fact that the edge of the pull-tab is a circular arc makes it possible for the edge of the pull-tab to match the edge of the circular seal without extending beyond the perimeter of the rest of the seal. Indeed, when the base of a semi-circular pull tab is anchored to the center of the seal and extends across the

 $^{^{29}}$ Id. (bolding in original).

³⁰ Pat. No. 5004111, Response of November 19, 2014 at 39.

³¹ <Wikipedia.org>, Response of April 24, 2014 at 119.

³² See Reply brief at 6, 7 TTABVUE 8 ("[A]ll the pull tabs on innerseals which the Applicant has produced allow for the tab top essentially lay flat so that the container can be capped. That is the essence of an innerseal. ... If the innerseal does not lay flat, then the cap would not likely close.").

entire diameter of the seal, the pull-tab's free edge will exactly match half of the edge of the seal. The patent materials of record indicate that it is desirable to avoid letting the pull-tab exceed the perimeter of the seal. Patent No. 5702015 criticizes an earlier design, saying, "because the tab flaps freely, it can become misaligned during capping of a container and then can get in the way of the cap."³³ Patent No. 8201385 also touts the benefit of not extending beyond the edge of the seal:

The tab **26** ... is substantially contained within the perimeter of the substrate **16**, and ... does not extend beyond the periphery of the rim **14**, nor does it hang down onto the container **12** in any way. ... [B]y maintaining the tab **26** within the perimeter of the rim **14**, the tab **26** will remain intact without tearing or pealing [*sic*] away during the bottling, handling, distribution and storing of the container **12**, to a much better extent than if the tab **26** extended around the rim and onto the container exposing more of the tab to bumping and tearing forces during the processes discussed above.³⁴

The need to prevent the pull-tab from extending beyond the perimeter of the seal is also, to some extent, dictated by the manufacture of the seals. According to the Brucker declaration, Applicant supplies packagers with the multi-layer seal material (one layer of which is the pull-tab material) in the form of sheets or rolls, from which "the packager cuts the disc-shaped seal and applies it to the container neck."³⁵ This process of cutting a disc shape out of the sheet or roll of multi-layer material necessarily truncates the pull-tab material at the perimeter of the seal and actually creates the semi-circular shape of the pull tab. (If the pull-tab were

³³ Response of November 19, 2014 at 61.

³⁴ *Id.* at 74.

 $^{^{35}}$ Brucker declaration \P 14, Response of June 8, 2015 at 29.

intended to fall short of the perimeter of the seal, it would have to be pre-cut or otherwise pre-formed by a separate process.)

When a semi-circular pull-tab on a circular seal is positioned at the center of the seal (*i.e.*, along its diameter), the base of the pull-tab is as long as it possibly can be; and the semi-circle defined by that diameter is as large as a semi-circle can be without extending over the edge of the circular seal.

As we have seen, a large pull-tab is better than a smaller one for purposes of removing the seal, because it is easier to grasp; and a pull-tab that is more strongly bonded to the seal is better than one that is less strongly bonded. One could give the pull-tab a shape other than a semi-circle; but any other shape that does not exceed the perimeter of the seal would be smaller in area than a semi-circle, and therefore harder to grasp; and any shape larger than a semi-circle (for example, a square defined by the diameter of the seal) would exceed the perimeter of the seal, which is undesirable both for manufacturing the seals and for affixing them to containers. One could position the base of the pull-tab along a shorter chord of the circle (farther from the free end of the tab), and thereby make a larger pull-tab with a circular-arc profile (greater than a semi-circle); but by doing so, one would reduce (and weaken) the area of bonding between the tab and seal;³⁶ and one would lose

 $^{^{36}}$ A competitor could, in theory, compensate for the smaller area of bonding by using a stronger adhesive. However, *TrafFix* states that a competitor should not have to seek alternative techniques in order to work around a functional design. 58 USPQ2d at 1007. The need to find a stronger adhesive is a competitive disadvantage that is not reputation-related.

the symmetry that allows the user to open the seal as easily from one direction as from the other.

Applicant argues that the design of its pull-tab "is not 'essential' ... because the seal to which is it [sic] attached can be removed with or without the use of any tab at all let alone one with that particular shape"³⁷ Applicant argues that in Maker's Mark Distillery, Inc. v. Diageo North America, Inc., 703 F.Supp.2d 671, 97 USPQ2d 1780 (W.D. Ky. 2010), aff'd 679 F.3d 410 (6th Cir. 2012), the Court found that red, dripping wax applied as a seal on Bourbon whiskey was not functional, purportedly because "the seal would work with or without the wax, the wax was not essential and therefore was not legally functional."³⁸ That case is distinguishable. In Maker's Mark, testimony persuaded the Court "that the closure mechanisms on distilled spirits bottles make additional protection unnecessary and that the wax serves no true protective or preservative function. ... Their testimony convinced the Court ... that the wax on the Maker's Mark bottle serves no function; and that Maker's Mark did not intend for it to serve any function." 97 USPQ2d at 1787-8. In the case before us, by contrast, the record shows that seals without pull-tabs are often difficult and frustrating to open; so that seals having pull tabs perform better with respect to the important function of ease of opening. Thus, the addition of a useful pull-tab "affects the ... quality" of the seal. Inwood Labs., 214 USPQ at 4 n.10.

³⁷ Applicant's brief at 5, 4 TTABVUE 9.

³⁸ Applicant's brief at 6, 4 TTABVUE 10.

Applicant argues that registration of its mark will not inhibit competition, as contemplated by *Qualitex*, because "there are a large variety of alternative designs available for competitors to use [and] this particular mark is not the most cost effective design, so competitors will not be put at a disadvantage if they use any [of] the various alternative designs."³⁹ We disagree. Every aspect of Applicant's design – the size and shape of the pull-tab and its position on the goods – contributes to the ease of grasping the pull-tab and the strength with which it is bonded to the seal. There are no alternative designs that achieve the balance of desirable features (the size of the pull-tab, the dual purchase upon the edge of the seal, and the length of the bonded edge of the pull-tab) as Applicant's design does. Competitors would be at a disadvantage if they were not free to position pull-tabs across the center (diameter) of a circular seal, where the tab could have its longest point of contact with the seal; or if they could not use a single tab to intersect with the edge of the seal in two, opposite places on the seal; or if, in so positioning their pull-tabs, they were required to eschew the use of a circular arc shape, resulting in smaller tabs. Even though Applicant's design is not the only practical design for a pull tab that is strong, easy to grip and easy to use in opening a seal, the features of the design are useful solutions for achieving these desired attributes in a market in which most containers have circular openings that require circular seals. As the Supreme Court stated in *TrafFix*:

> There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities

³⁹ Applicant's brief at 7, 4 TTABVUE 11.

... Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of [the] product; it is the reason the device works. Other designs need not be attempted.

58 USPQ2d 1007. The same is true even if we assume that Applicant's design is not the *best* possible design. If the design features improve, in any way, the performance of any aspect of the purpose of the goods, they "affect the ... quality of the article" and should remain available to competitors if they are not protected by patent.

Applicant has made of record 11 third-party registrations of three-dimensional configurations of goods or packaging,⁴⁰ and argues that they illustrate "Trademark Office practices"⁴¹ according to which Applicant's mark should be found registrable. Applicant has not persuaded us that these registrations have any relevance to the question of functionality in the present case, as they all relate to completely different technologies and marks that differ in virtually all respects from Applicant's proposed mark. Applicant's contention that this evidence "shows that the specific shape of the half-moon tab is essentially arbitrary"⁴² conflicts with a great deal of the evidence of record, which shows that there are many functional reasons that explain the semi-circular shape of Applicant's pull-tab.

⁴⁰ Response of June 8, 2015 at 58-79.

⁴¹ Applicant's brief at 12, 4 TTABVUE 16.

⁴² Applicant's brief at 13, 4 TTABVUE 17.

E. <u>Conclusion</u>.

For the reasons discussed in this decision, we are persuaded that all of the elements of Applicant's design affect the performance of Applicant's pull-tab as a method for removing Applicant's seals, and that the combination of these design elements results in a design that is, as a whole, functional within the meaning of Section 2(e)(5).⁴³ Viewing the record in its entirety, we find that the design of Applicant's product comprises matter that, as a whole, "is essential to the use or purpose of the article or ... affects the ... quality of the article," as contemplated by *Inwood*. We therefore find that Applicant's product design is functional within the meaning of Section 2(e)(5).

II. <u>Acquired distinctiveness</u>.

Although our finding that Applicant's proposed mark is functional under Section 2(e)(5) requires that registration be refused, for the sake of completeness we will consider the Examining Attorney's alternative refusal on the ground that Applicant's proposed mark is a nondistinctive product configuration that has not been shown to have acquired distinctiveness, under Trademark Act §§ 1, 2, and 45. In *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1069-70 (2000), the Supreme Court held that "a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning." In that case, the Court observed, "In the case of product design, ... we think consumer predisposition to

⁴³ Although we find that all elements of Applicant's design are functional, it bears noting that the Federal Circuit has stated that "a mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional." *In re Becton, Dickinson*, 102 USPQ2d at 1376.

equate the feature with the source does not exist. Consumers are aware of the reality 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 more appealing." 54 USPQ2d at 1069.

Acquired distinctiveness – also known as "secondary meaning" – is generally understood to mean "a mental association in buyers' minds between the alleged mark and a single source of the product." 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed. March 2017 update). "It is only necessary that a 'substantial part' of the buying class make such an association." *Id.* §15:45.

Applicant has submitted a number of verified declarations by its officers and others relating to Applicant's operations and the degree to which its proposed mark is known in the marketplace. They show that Applicant has used its pull-tab design continuously since 1997, and since then has sold "millions" of container seals bearing the design (which Applicant's customers in turn use to seal containers), resulting in total revenues of "over \$300 million" over 19 years. Applicant has spent "hundreds of thousands of dollars on advertising and marketing" for its seals, and has advertised the design at trade shows in the packaging industry around the world. Applicant operates a website that "regularly receives [] 1,000 visitors each month." Applicant also has a presence on Facebook and Twitter.⁴⁴ Applicant's Vice President for Technology stated, "To the best of my knowledge, until very recently, no other entities have ever used the Pull Tab design for inner seals for

⁴⁴ Declaration of John J. Brown (Applicant's Vice President, Marketing), Response of April 24, 2014 at 22-26.

containers."⁴⁵ Knowledgeable third parties have stated that they are aware of Applicant's pull-tab design, consider it "a unique design for induction seals," are not aware of "any similar ½ Moon Tab style design[s] in the USA marketplace,"⁴⁶ and that the design "indicates to me that Selig is the source of the product."⁴⁷ The record contains examples of Applicant's advertising materials, including a few "look for" ads that specifically draw attention to the pull-tab design with the phrase "Look for the ½ moon tab to assure a quality Selig Product."⁴⁸ A great deal of the advertising of record refers to Applicant's conventional word mark for its product, LIFT 'N' PEEL; however, most of the pictorial advertisements depict the pull-tab design as well.

The evidence of record falls far short of persuading the Board that Applicant's pull-tab design has acquired distinctiveness as Applicant's source-identifier. Although revenues of \$300 million over 19 years is a substantial amount of business, the other evidence submitted is lacking in specificity and the types of details that would allow the Board to assess the impact made by Applicant's design on the relevant marketplace. There is no explanation in the record of the nature and size of Applicant's customer base or of the typical trade channels through which

⁴⁵ Declaration of Steven A. Brucker ¶ 16, Response of June 8, 2015 at 30.

⁴⁶ Although most of Applicant's declarants assert that Applicant is alone in using the subject pull-tab design, the Examining Attorney has made of record one example of a third-party offering a similar design, namely, the Tekni-Plex EdgePull induction seal. *See* Office Action of February 29, 2016 at 18-19. Applicant contends that this product "has only been recently introduced into the market." Applicant's brief at 19, 4 TTABVUE 23.

⁴⁷ Declarations of Sterling Anthony; Victor Kassel; William Zito; and Robert Radek, Response of January 8, 2016 at 14-27; Declarations of Paul R Schmidt; Scott Manning; and Jake Wilson, Response of January 28, 2016 at 6-14.

⁴⁸ Response of January 8, 2016 at 29-30.

products are brought to their attention. There is no information regarding the overall market demand for induction seals such as might allow the Board to determine whether sales of "millions" of seals constitutes a large or small market share. There is only scant information regarding the channels through which Applicant's advertising has been distributed or the number of customer impressions generated thereby. Although there is information about a few particular trade shows attended by Applicant, there is no information regarding the number and location of such events attended in a given year, or of the impact they have on potential customers. Although third-party testimonials regarding recognition of Applicant's design are a meaningful type of evidence, in this case there are only seven of them; and we have too little information regarding the nature and size of Applicant's customer base to conclude that these seven declarations meaningfully reflect the perception of Applicant's design in the marketplace at large. On this record, we find that Applicant has failed to demonstrate that its pull-tab design has acquired distinctiveness as a source-indicator for its seals.

Decision: The refusal to register Applicant's proposed mark on the ground that it comprises matter that, as a whole, is functional, under Section 2(e)(5), is AFFIRMED. The refusal to register Applicant's proposed mark on the ground that it is a nondistinctive product configuration that has not been shown to have acquired distinctiveness, under Sections 1, 2, and 45, is AFFIRMED.

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