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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86172232

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Crane USA, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

10271T00090U

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant is appealing the final refusal under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, based on the examining attorney's determination that the applied-for mark

constitutes trade dress of a product design, along with related application requirements for (1) a product configuration drawing that depicts the mark in the drawing to include broken or dotted lines to show the position of the mark on the goods or container, 37 C.F.R. §2.52(b)(4); TMEP §§807.08, 1202.02(c)(i), that also shows the mark itself using solid lines, see 37 C.F.R. §§2.52(c), 2.54(e); TMEP §§807.05(c), 807.06(a); (2) a corresponding clear and concise description of the mark that (a) indicates that the mark is a three-dimensional configuration of the goods or their packaging or of a specific design feature of the goods or packaging; (b) specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark; and (c) specifies any elements which are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark, See 37 C.F.R. §§2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 178 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii); and (3) product information and documentation regarding the applied-for mark, See 37 C.F.R. §2.61(b); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); TMEP §§1202.02(a)(v) *et seq.*

ARGUMENTS

I. THE MARK IS A CONFIGURATION OF A NON-DISTINCTIVE PRODUCT DESIGN OR TRADE DRESS

Trade dress constitutes a “symbol” or “device” within the meaning of §2 of the Trademark Act, 15 U.S.C. §1052. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209-210, 54 USPQ2d 1065, 1065-66 (2000).

Trade dress originally included only the packaging or “dressing” of a product, but in recent years has been expanded to encompass the design of a product. It is usually defined as the “total image and

overall appearance” of a product, or the totality of the elements, and “may include features such as size, shape, color or color combinations, texture, graphics.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1, 23 USPQ2d 1081, 1082 n.1 (1992).

Thus, trade dress includes the design of a product (i.e., the product shape or configuration), the packaging in which a product is sold (i.e., the “dressing” of a product), the color of a product or of the packaging in which a product is sold, and the flavor of a product. *Wal-Mart* ., 529 U.S. at 205, 54 USPQ2d at 1065 (design of children’s outfits constitutes product design); *Two Pesos*, 505 U.S. at 763, 23 USPQ2d at 1081 (interior of a restaurant is akin to product packaging); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (color alone may be protectible); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006) (flavor is analogous to product design and may be protectible unless it is functional).

However, this is not an exhaustive list, because “almost anything at all that is capable of carrying meaning” may be used as a “symbol” or “device” and constitute trade dress that identifies the source or origin of a product. *Qualitex*, 514 U.S. at 162, 34 USPQ2d at 1162. When it is difficult to determine whether the proposed mark is product packaging or product design, such “ambiguous” trade dress is treated as product design. *Wal-Mart* , 529 U.S. at 215, 54 USPQ2d at 1066.

“In some cases, the nature of a potential trade dress mark may not be readily apparent. A determination of whether the mark constitutes trade dress must be informed by the application content, including the drawing, the description of the mark, the identification of goods or services, and the specimen, if any. If it remains unclear whether the proposed mark constitutes trade dress, the examining attorney may call or e-mail the applicant to clarify the nature of the mark, or issue an Office action requiring information

regarding the nature of the mark, as well as any other necessary clarifications, such as a clear drawing and an accurate description of the mark. 37 C.F.R. §2.61(b).” TMEP § 1202.02

Applicant applied to register a mark comprised of the product design of a humidifier. Applicant describes the mark in the following manner: “The mark consists of a two-dimensional depiction of a three-dimensional housing having generally a tear shape, a slightly offset top region terminating at an opening, three vertically spaced circumferential lines, a round dial with a small circle within its perimeter and an enclosed area within which the round dial resides and bounded by an upwardly opening U-shaped line and the lowermost circumferential line.”

In this case, the examining attorney determined that the drawing of the mark, description of the mark, and the identification of goods indicate that the proposed mark is a product configuration, or trade dress for the goods and is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. As such, registration was properly refused under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i), (d). A product design can never be inherently distinctive as a matter of law; consumers are aware that such designs are intended to render the goods more useful or appealing rather than identify their source. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. at 212-13, 54 USPQ2d at 1068-69; *In re Slokevage*, 441 F.3d at 962, 78 USPQ2d at 1399. Thus, consumer predisposition to equate a product design with its source does not exist. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. at 213, 54 USPQ2d at 1069.

In its October 27, 2014 response, as well as in the appeal brief, applicant asserted that the refusal is inappropriate because the mark in the drawing is a two-dimensional line drawing and not a three dimensional configuration mark. See Appeal Brief at 2. Specifically, applicant asserts that the mark description clearly indicates the mark is a two dimensional line drawing. See Appeal Brief at 3-4. The examining attorney respectfully disagrees. The description indicates that the proposed mark is a “depiction of a three-dimensional housing.” The drawing is a realistic depiction of the goods and is properly interpreted as a configuration mark for applicant’s humidifiers for household use in International Class 011.

Applicant argues that the examining attorney misinterprets the nature of applicant’s drawing that shows curvature of an object indicating depth, width and height because “there is no requirement that a two dimensional drawing have straight lines.” See Appeal Brief at 4. However, applicant concedes that the drawing depicts an actual three-dimensional object, the housing for the goods; “If applicant chooses its mark have lines that indicate curvature, then that is applicant’s choice. The fact that a two-dimensional drawing depicts a product that happens to be three-dimensional does not change the character of the drawing. The drawing is two-dimensional and is intended as such.” See Appeal Brief at 4.

Applicant is correct in asserting that any two-dimensional design mark may have curved lines depicting the mark, that straight lines are not required for a mark drawing. See Appeal Brief at 4. However, all three-dimensional objects must be drawn on a two-dimensional plane to submit a drawing page to satisfy the drawing requirement in order to receive a filing date for a trademark application. See 37

C.F.R. §§2.21(a)(3) and 37 C.F.R. 2.52(e). However, applicant's drawing includes curvature to indicate depth and shape of a three dimensional object, and the mark description includes terminology such as a "depiction of a three-dimensional housing." The drawing depicts a configuration of applicant's goods, and the description refers to the three-dimensional characteristic of the goods.

To support its contention that the proposed mark is not a configuration mark, applicant argued in its October 27, 2014 response that there are many live third-party registrations for two-dimensional drawings of three dimensional objects that are not configuration marks. The examining attorney does not dispute that a two-dimensional drawing of an object can function as a trademark or service mark. However, the issue at hand is whether applicant's mark is a configuration mark. Regardless, applicant's evidence of one third-party registration is not relevant to show applicant's mark is not a configuration mark for its goods; "Applicant's mark, like numerous other marks on the Register, is a two-dimensional depiction of a three-dimensional object. The mark is similar in that respect to many registered marks, such as the mark identified in the attached printout – Registration No. 4,333,641." See the October 27, 2014 response. This is not persuasive because the mark in U.S. Registration No. 4333641 is a drawing of 3 stylized transportation buses for an "Automobile dealership service featuring buses" in International Class 035. Unlike applicant's configuration mark for household humidifiers that specifically depicts the shape of applicant's goods, a depiction of three different types of buses does not indicate a specific service, i.e., an "Automobile dealership service featuring buses." Thus, applicant's arguments and evidence are not persuasive because no configuration issue was raised in the referenced registration.

Conversely, the examining attorney attached marketplace evidence to the November 19, 2014 final Office action that further supports the conclusion that the proposed mark is a configuration

of applicant's humidifiers. The marketplace evidence consists of a product page showing applicant's humidifiers on a retail website for Target® online department stores. The configuration of the humidifier on the website agrees with the drawing of the mark in the application. Since the application is filed as intent-to-use under Trademark Act Section 1(b), there is no specimen of use to examine for further consideration of the configuration of the goods versus the drawing of the mark, description of the mark and the identification of goods. It is noted that applicant has refused to submit product information to satisfy the examining attorney's final product information requirement as discussed below. The examining attorney asserts that the marketplace evidence further supports the conclusion that applicant's mark consists of a product configuration. In fact, applicant concedes that the examining attorney's evidence shows a product of the applicant's, a humidifier. See Appeal Brief at 4. Applicant contends that the examiner's supporting evidence is irrelevant because it merely shows that applicant's drawing of the mark corresponds to a product applicant sells. See Appeal Brief at 5. Despite this, applicant has not offered any explanation of its intended use of the mark.

The examining attorney respectfully disagrees that the evidence is irrelevant. Without a specimen of use in the application, the marketplace evidence is probative to support the examining attorney's conclusion that the mark description, identification of goods and the pictorially accurate drawing of the mark constitute trade dress for the goods. Material obtained from the Internet is generally accepted as competent evidence. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re White*, 80 USPQ2d 1654,

1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Accordingly, applicant's mark is a configuration or trade dress mark for the goods. Therefore, the application is properly refused because a mark that consists of a nondistinctive product design or nondistinctive features of a product design is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i), (d).

The drawing presents itself as a configuration of the goods. The evidence of record demonstrates that applicant's goods appear as depicted in the drawing. Further, applicant has not provided an explanation of its intended use of its mark. As such, the refusal under Sections 1, 2 & 45 that the mark represents non-distinctive trade dress should be affirmed.

II. CONFIGURATION DRAWING AND DESCRIPTION REQUIRED

The examining attorney has correctly determined that the “depiction of a three-dimensional housing” in the mark description indicated the proposed mark was, in fact, intended as a configuration drawing of a product design for the goods in class 011. Accordingly, the examining attorney required applicant submit (1) a product configuration drawing that depicts the mark in the drawing to include broken or dotted lines to show the position of the mark on the goods or container, 37 C.F.R. §2.52(b)(4); TMEP §§807.08, 1202.02(c)(i), that also shows the mark itself using solid lines, see 37 C.F.R. §2.52(c), 2.54(e); TMEP §§807.05(c), 807.06(a); and (2) a corresponding clear and concise description of the mark that (a) indicates that the mark is a three-dimensional configuration of the goods or their packaging or of a specific design feature of the goods or packaging; (b) specifies all the elements in the drawing that constitute the mark and are claimed as part of the mark; and (c) specifies any elements which are not part of the mark and indicates that the matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark, See 37 C.F.R. §2.37, 2.52(b)(2), (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 178 (TTAB 1983); TMEP §§807.08, 807.10, 1202.02(c)(ii)

Applicant contends that the requirements are obviated because the mark at issue depicts a two dimensional line drawing and not a three dimensional configuration of a product. See Appeal Brief at 2. The examining attorney is not persuaded because the mark description indicates the drawing depicts a three dimensional housing for applicant’s goods. The mark appears to show a realistic three-dimensional depiction of the goods, and the goods are limited to a specific single product, a household humidifier. In addition, the examining attorney submitted evidence that shows applicant markets a humidifier matching the configuration in the drawing of the mark. Applicant concedes that the product shown in the examining attorney’s evidence is its humidifier. See Appeal Brief at 4. Applicant states that “The fact

that a two-dimensional drawing depicts a product that happens to be three-dimensional does not change the character of the drawing.” *Id.* Thus, the applicant concedes that the mark depicts an actual three-dimensional product.

Finally, applicant argues that a configuration mark description is not required because the examining attorney has not objected to the mark description, but rather, has characterized the proposed mark as three-dimensional configuration. See Appeal Brief at 5. Applicant is incorrect. The examining attorney has specifically objected to the mark description of record because it does not describe that the mark as a three-dimensional configuration of a product design. The examining attorney required that applicant submit a new description of the mark in the first and final Office actions, along with a corresponding drawing showing the position of the mark on the goods in solid lines and the areas that are not part of the mark in dotted lines.

Accordingly, a new drawing and description of the mark is properly required.

III. APPLICANT MUST SUBMIT PRODUCT INFORMATION FOR THE GOODS

Applicant was required to submit the following information and documentation for the proposed mark regarding a possible functionality determination under Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); see TMEP §1202.02(a)-(a)(ii), (d);

(1) A written statement as to whether the applied-for mark, or any feature(s) thereof, is or has been the subject of a design or utility patent or patent application, including expired patents and abandoned patent applications. Applicant must also provide copies of the patent and/or patent application documentation.;

(2) Advertising, promotional and/or explanatory materials concerning the applied-for configuration mark, particularly materials specifically related to the design feature(s) embodied in the applied-for mark.;

(3) A written explanation and any evidence as to whether there are alternative designs available for the feature(s) embodied in the applied-for mark, and whether such alternative designs are equally efficient and/or competitive. Applicant must also provide a written explanation and any documentation concerning similar designs used by competitors.;

(4) A written statement as to whether the product design or packaging design at issue results from a comparatively simple or inexpensive method of manufacture in relation to alternative designs for the product/container. Applicant must also provide information regarding the method and/or cost of manufacture relating to applicant's goods.; and

(5) Any other evidence that applicant considers relevant to the registrability of the applied-for configuration mark.

See 37 C.F.R. §2.61(b); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); TMEP §§1202.02(a)(v) et seq.

With regard to this requirement for information, the Trademark Trial and Appeal Board and its appeals court have recognized that the necessary technical information for *ex parte* determinations regarding functionality is usually more readily available to an applicant, and thus the applicant will normally be the source of much of the evidence in these cases. *In re Teledyne Indus. Inc.*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982); see *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (holding registration was properly refused where applicant failed to comply with trademark examining attorney's request for copies of patent applications and other patent information); TMEP §1202.02(a)(v).

In both the first Office action and the final Office action, applicant was invited to submit information to help the examining attorney better determine the nature of the mark. Specifically, in information requests applicant was asked to provide "advertising, promotional and/or explanatory materials concerning the applied-for configuration mark, particularly materials specifically related to the design feature(s) embodied in the applied-for mark" as well as "any other evidence that applicant considers relevant to the registrability of the applied-for configuration mark.

The applicant has not fulfilled the information or documentation requirements. Rather, applicant merely contends that the requirements are inappropriate because the proposed mark is a two-dimensional design mark, and not a three-dimensional configuration mark. See Appeal Brief at 2.

This is not an acceptable response because (1) as discussed above, applicant's description of the mark, the drawing of the mark, the identification of goods and the examining attorney's marketplace evidence indicates the mark depicts a trade dress configuration for a household humidifier, and (2) functionality and distinctiveness are separate issues. Distinctiveness and functionality are two separate issues in an application for a three-dimensional configuration mark consisting of a product design, product packaging or other types of trade dress. See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); *In re Ennco Display Sys., Inc.*, 56 USPQ2d 1279 (TTAB 2000); TMEP §1202.02. In addition, applicant has offered no explanation as to how the mark will be used.

The examining attorney maintains that the mark sought to be registered is a configuration mark for a product design of a household humidifier, and that the functionality information requirements are appropriate.

CONCLUSION

Applicant's claims that the proposed mark is a two-dimensional design that does not represent a depiction of a three-dimensional configuration of a product are not persuasive when considering

mark description, drawing of the mark, identification of goods, and the marketplace evidence of record. For the foregoing reasons, the refusal of registration of the mark on the Principle Register under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127 as a non-distinctive production configuration, and the related requirements for a configuration mark description, a new configuration drawing, and for product information and documentation about the goods for a possible functionality refusal, should all be affirmed.

Respectfully submitted,

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