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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86768287
Applicant	ICELANDIC PROVISIONS, INC.
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Applicant: Icelandic Provisions, Inc.

Serial No.: 86/768287

Filed: September 25, 2015

Mark: Miscellaneous Design (Container)

Examining Attorney:  
Kristina Morris

Law Office: 116

APPLICANT'S BRIEF ON APPEAL

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I. Introduction

This is an appeal from the Official Action of April 9, 2016, finally refusing registration of Applicant's mark shown immediately below for "dairy products, namely, skyr," in International Class 29.



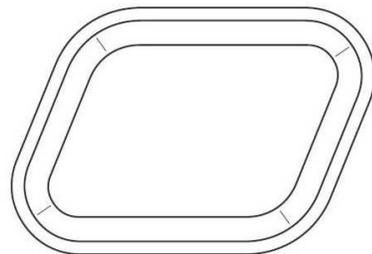
Applicant stated that "The mark consists of the three-dimensional configuration of a container for the goods, the container having substantially the shape of a non-rectangular parallelogram in horizontal cross-section." The drawing in the subject application depicts a container that is tapered from top to bottom, with rounded corners, and a cross-section substantially in the shape of a non-rectangular parallelogram.

II. The Prosecution History.

In an Official Action of February 29, 2016, the Examining Attorney first refused registration of the subject mark on the ground that it was not inherently distinctive. Applicant responded to that Official Action on March 8, 2016, pointing out that the Examining Attorney's evidence did not show that the shape of Applicant's container is a common basic shape: "Unlike applicant's container, none of the cited containers is in the shape of a 'non-rectangular parallelogram.' They either have adjoining sides that are perpendicular to each other, or are not parallelograms at all." Applicant included with the Response two drawings and two photographs to clarify the nature of the applied-for mark.

Applicant encloses herewith two drawings that may assist in the understanding and appreciation of the shape of applicant's container. One is a perspective view of the container, the other is a top plan view. Also enclosed are two photographs of a model of the container shape, one taken looking down from above the open container, the other showing the bottom surface of the container. As can be readily see, the adjacent sides of the container are in planes that do not meet at a right angle. Thus the cross-section of the container taken in a plane parallel to the bottom (or top) is in the shape of a non-rectangular parallelogram with curved corners. This non-rectangular shape is difficult to convey in a single drawing, but Applicant believes that with this additional guidance, the Examining Attorney will recognize that the application drawing shows a non-rectangular shaped container.

The two drawings and the two photographs included with the March 8, 2016 Response include a drawing of the top plan view of the container (shown to the right):



One of the photographs submitted with the response looks down into the container, as shown immediately below:



The Examining Attorney issued a Final Refusal on April 9, 2016, under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, maintaining that “the applied-for mark consists of a nondistinctive configuration of packaging for the goods that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness.” The Examining Attorney suggested, “[a]s an alternative to submitting evidence of acquired distinctiveness, applicant may amend the application to the Supplemental Register.”

On April 12, 2016, after issuance of the Final Refusal, the USPTO accepted Applicant’s Amendment to Allege Use (which had been filed on February 26, 2016). In the Amendment to Allege Use, Applicant amended the identification of goods to read: “dairy products, namely, skyr.” The specimen of use submitted with the Amendment to Allege use is shown immediately below:



On July 25, 2016, Applicant filed a Request for Reconsideration of the Final Refusal, stating:

Applicant continues to maintain that the subject mark is inherently distinctive and therefore registrable on the Principal Register. Applicant intends to file a timely appeal from that refusal. Meanwhile, Applicant requests that the Examining Attorney reconsider that refusal in light of the lack of evidence that anyone in applicant's field is using a container configuration similar to that of the applied-for mark. As an alternative, and without waiver of its right to appeal from the final refusal, applicant accepts the Examining Attorney's invitation to amend this application to seek registration on the Supplemental Register, but only in the event that the appeal from the non-distinctiveness refusal is denied.

The Examining Attorney refused reconsideration on August 20, 2016. However, the Examining Attorney acknowledged that applicant had requested amendment to the Supplemental Register in the alternative, and she stated that "[t]he amendment to the Supplemental Register is acceptable and will not be an issue on appeal."

Applicant timely filed its Notice of Appeal on August 22, 2016.

### III. Argument

#### A. The Applicable Law

Under Trademark Rule 2.52, "A drawing depicts the mark to be registered." The drawing in the subject application depicts a container that is tapered from top to bottom, with rounded corners, and a horizontal cross-section substantially in the shape of a non-rectangular parallelogram. Applicant's specimen of use, accepted by the Examining Attorney, is a photograph of a container embodying the shape of the applied-for mark. (See page 3, above).

It is well established that product packaging trade dress may be inherently distinctive and thus registrable on the Principal Register without proof of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212-213, 54 USPQ2d 1065, 1068 (2000). In *Wal-Mart*, the Supreme Court observed that “retail customers of many different products are ‘predisposed’ through conditioning to regard packaging, containers, and other features of trade dress as signals of the source of a particular product.” *Wal-Mart*, 54 USPQ2d at 1068.

In determining whether a particular packaging trade dress is inherently distinctive, the Board and the CAFC apply the factors set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F. 2d 1342, 196 USPQ 289, 291 (1977), the first three of which are relevant here:

- Whether the subject matter sought to be registered is a “common” basic shape or design;
- Whether the subject matter sought to be registered is unique or unusual in a particular field; and
- Whether the subject matter sought to be registered is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods or services viewed by the public as a dress or ornamentation for the goods.

The USPTO has the burden to establish a *prima facie* case that the applied-for trade dress is not inherently distinctive. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1630 (Fed. Cir. 2003).

B. The Examining Attorney's Position

In the Final Action of April 19, 2016, the Examining Attorney relied on several Internet websites excerpts in asserting that a "parallelogram" is a "common geometric shape," and on other website pages in contending that "overall square- or rectangular-shaped containers are common in the industry." She summarily concluded from the latter evidence, without explanation, that "Applicant's parallelogram-shaped containers are merely a refinement of square- and rectangular-shaped containers in the food industry."

The Examining Attorney then refused registration:

Despite the fact that applicant may be the first user of the parallelogram-shaped container for yogurt, because the shape is a common shape and is a mere refinement of common containers, it is not registrable on the Principal Register without sufficient proof of acquired distinctiveness.

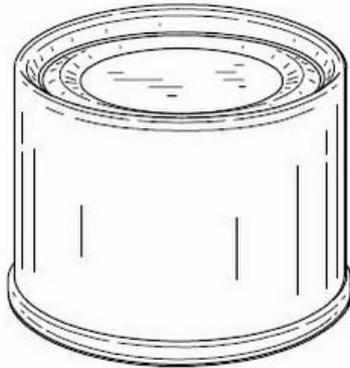
C. Applicant's Argument

Applicant respectfully submits that the Examining Attorney has failed to meet the USPTO's burden of proof to show that the subject mark is not inherently distinctive.

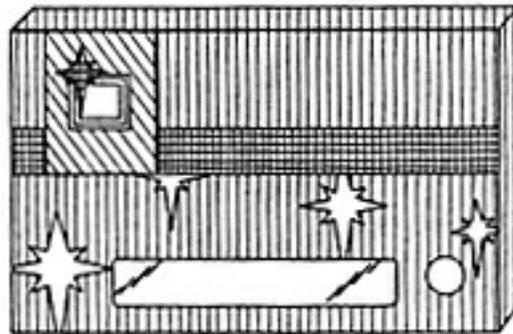
The Examining Attorney cited three cases to support her conclusion of non-registrability, none of which are pertinent here. In the first, *Tone Brothers Inc. v. Susco Corp.*, 31 USPQ2d 1321 (Fed. Cir. 1994), the CAFC reversed and vacated a lower court's summary ruling of non-registrability because the lower court had improperly analyzed the issue of inherent distinctiveness in its determination concerning a particular design for a spice container (not illustrated in the decision). Thus that decision has no applicability whatsoever to the issues in this case.

The other two cases cited by the Examining Attorney are readily distinguishable on their facts. In *In re Mars*, 105 USPQ2d 1859 (TTAB 2013), the Board found that

Applicant Mars's container shape (shown immediately below) for pet food was not inherently distinctive because it comprised merely an upside-down or inverted version of a common container: "In our opinion, the shape or design remains common even if it is inverted, as compared to other pet food containers; the design simply has the appearance of an upside down container." *Id.* at 1870.



*In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253 (TTAB 1998) involved certain packaging trade dress (shown immediately below) for "Christmas decorations, namely electric lights for trees."



The Board found the two versions of the designs at issue (one in green and one in red) not to be inherently distinctive:

It is common knowledge that stars and the color red, green and gold are associated with the Christmas holiday. The evidence submitted by the Examining Attorney shows that stars and the colors, red, green and gold appear either separately, or in various combinations, on packaging for

Christmas merchandise. Also, the evidence shows that it is not uncommon for Christmas merchandise to be packaged in a manner which resembles wrapped Christmas presents. Thus, applicant's designs, which consist of stars and the colors red, green and gold, and indeed resemble wrapped Christmas presents, are a mere refinement of a form of ornamentation for Christmas merchandise. As such, purchasers and prospective customers for applicant's goods would be unlikely to regard these designs as identifying and distinguishing applicant's Christmas tree lights and indicating their source. *Id.* at 1255.

Thus neither *Mars* nor *Kinderman* involved a wholly unique shape for a container in the particular fields there at issue. In *Mars*, the applicant had merely inverted a common container shape for pet food. In *Kinderman*, the applicant took an ordinary rectangular box and added well-known Christmas ornamentation to the surface.

With regard to the website pages cited by the Examining Attorney purportedly to show that a parallelogram is a common basic shape, none of the pages shows a three-dimensional figure having a horizontal cross-section in the shape of a non-rectangular parallelogram, let alone one with tapered sides and rounded corners. All except two of the figures in the webpages cited by the Examining Attorney are two-dimensional. The only three-dimensional illustrations – a cylinder and an octahedron – appear on the first page of the <buzzle.com> website. Of course, Applicant's container is of neither shape.

Moreover, Applicant's applied-for mark is not a "parallelogram" (which is a two-dimensional figure), but rather a three-dimensional container having tapered sides, rounded corners, and a horizontal cross-section substantially in the shape of a non-rectangular parallelogram. Whether a "parallelogram" is a basic geometric figure is basically irrelevant to the issue at hand. Thus as to the first *Seabrook* factor, nothing in the Examining Attorney's evidence shows that the shape of Applicant's container is a "common" basic shape, or design.

Turning to the “food industry” website pages cited by the Examining Attorney (www.dairyfoods.com, www.theeasymarket.com, and www.gianteagle.com), none of those pages depicts or illustrates a container having a cross-section that is substantially a non-rectangular parallelogram, with tapered sides and rounded corners. In fact, the Examining Attorney refers to the containers pictured on those pages as “square- and rectangular shaped containers used in the food industry.” Thus as to the second *Seabrook* factor, nothing in the Examining Attorney’s evidence demonstrates that the applied-for mark is not “unique or unusual” in its field.

As to the third *Seabrook* factor, the Examining Attorney’s assertion that the applied-for packaging trade dress mark is “a mere refinement of common containers” is nothing more than a subjective conclusion unsupported by any evidence. Inverting a cylindrical container commonly found in the pet food industry may be a “mere refinement” of a cylindrical pet food can. Adding common Christmas decorations to the surface of a rectangular box may be a “mere refinement” of known packaging for Christmas tree lights. But those designs are different in kind from Applicant’s trade dress because Applicant’s container is in a unique, not a common, shape.

The Examining Attorney has provided not a scintilla of evidence that the shape of Applicant’s container is common in the field of yogurt, skyr, or dairy products. Nor has she submitted a single trademark application or registration directed to such a shape, or anything like it.

At a minimum, the Examining Attorney is required to present a *prima facie* case of non-distinctiveness if the subject refusal is to be upheld. Here, the Examining Attorney

has submitted nothing that even suggests that Applicant's container is not inherently distinctive trade dress in its field.

IV. Conclusion

Because the USPTO has failed to carry its burden to prove that the subject container design is not inherently distinctive, the Board should reverse the refusal to register.

If the Board affirms the refusal to register, Applicant requests that the Board return the file to the Examining Attorney so that the mark may be registered on the Supplemental Register.

Icelandic Provisions, Inc.

A handwritten signature in black ink that reads "John L. Welch". The signature is written in a cursive style with a large, looping initial "J".

Date: \_\_\_\_\_

\_\_\_\_\_  
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