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Subject: U.S. TRADEMARK APPLICATION NO. 86768287 - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86768287

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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: ICELANDIC PROVISIONS, INC.

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register a mark because the applied-for mark consists of a nondistinctive configuration of packaging for the goods. Because the mark

is not inherently distinctive, it is not registrable on the Principal Register without sufficient proof of acquired distinctiveness under Trademark Act Sections 1, 2, and 45.

FACTS

Applicant filed this application on September 25, 2015, applying to register a mark consisting of the three-dimensional configuration of a container for goods on the Principal Register for “dairy products, namely, skyr.”¹

In the first Office action dated January 13, 2016, applicant was required to clarify the identification of goods and to clarify the elements of the drawing that were being claimed as part of the mark. Applicant was advised that upon consideration of an allegation of use, registration may be refused on the ground that the applied-for mark is a nondistinctive configuration of packaging for the goods that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness.

On February 2, 2016, applicant amended the identification of goods and indicated that all of the elements in the drawing were part of the mark. On February 26, 2016, applicant filed an Amendment to Allege Use, in which the identification of goods was again amended.

On February 29, 2016, the amendment to the identification of goods was accepted and the application was refused because the applied-for mark consists of a nondistinctive configuration of packaging for the

¹ Identification as amended. The original identification read “dairy products; yogurt; strained yogurt; yogurt-based beverages; ice cream; ice milk; frozen yogurt.”

goods that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness under Trademark Act Sections 1, 2, and 45.

On March 8, 2016, applicant traversed the refusal.

On April 9, 2016, the refusal that the mark consists of nondistinctive packaging for the goods was made final.

On July 25, 2016 applicant filed a request for reconsideration amending to the Supplemental Register in the alternative.

On August 20, 2016, the amendment to the Supplemental Register in the alternative was accepted and the refusal was continued in a denial of the request for reconsideration. This appeal ensued.

ISSUE ON APPEAL

The issue on appeal is whether 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 under Trademark Act Sections 1, 2, and 45.

ARGUMENT

THE MARK IS NOT INHERENTLY DISTINCTIVE AND THUS IS NOT REGISTRABLE ON THE PRINCIPAL REGISTER WITHOUT PROOF OF ACQUIRED DISTINCTIVENESS

A mark that consists of a nondistinctive configuration of packaging for the goods 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.

The following factors are among those considered when determining the inherent distinctiveness of configuration marks comprising product packaging:

- (1) Whether the applied-for mark is a “common” basic shape or design
- (2) Whether the applied-for mark is unique or unusual in the field in which it is used
- (3) Whether the applied-for mark is 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

In re Pacer Tech., 338 F.3d 1348, 1350, 67 USPQ2d 1629, 1631 (Fed. Cir. 2003) (citing *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977)); TMEP §1202.02(b)(ii). Any one of these factors, by itself, may be determinative as to whether the mark is inherently distinctive. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1355, 96 USPQ2d 1681, 1687 (Fed. Cir. 2010); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2028 (TTAB 2010).

In this case, the applied-for mark is not inherently distinctive. The evidence of record shows that a parallelogram is a common geometric shape. See evidence from questgarden.com at page 2 of Office action dated April 9, 2016, formulas.mathcaptain.com at page 3 of Office action dated April 9, 2016, and www.buzzle.com at page 5 and 8 of Office action dated April 9, 2016. Applicant's argument that the mark is not a parallelogram shape is not persuasive. (Applicant's brief at page 8.) Applicant's mark description submitted with the application describes the mark as "having substantially the shape of a non-rectangular parallelogram in horizontal cross section." The drawing and applicant's additional renderings of the mark show that applicant's mark has the same shape as the parallelograms depicted in the evidence of record. See attachments at pages 2-5 of applicant's response filed March 8, 2016.

Overall square- or rectangular-shaped containers are common in the yogurt or dairy industry. See evidence from www.dairyfoods.com at pages 10-11 of Office action dated April 9, 2016, www.theeasymarket.com at pages 15-16 of Office action dated April 9, 2016, www.gianteagle.com at pages 17, 19, 21, 23, 25, 27, 29, 31, and 33-39 of Office action dated April 9, 2016, and www.bemis.com at pages 41-42 of Office action dated April 9, 2016. In addition, tapered sides and rounded corners are also a common features of containers in the yogurt or dairy industry. See evidence from www.dairyfoods.com at pages 10-11 of Office action dated April 9, 2016, www.theeasymarket.com at

pages 15-16 of Office action dated April 9, 2016, www.gianteagle.com at pages 19, 25, and 33-39 of Office action dated April 9, 2016, and www.bemis.com at pages 41-42 of Office action dated April 9, 2016.

Applicant's parallelogram-shaped containers are merely a refinement of the square- and rectangular-shaped containers commonly used in the dairy industry. *See In re Mars, Inc.*, 105 USPQ2d 1859, 1869-71 (TTAB 2013). Applicant argues that *In re Mars, Inc.* is not relevant to the present case because the facts differ (Applicant's brief at pages 6-7); however, the current case is similar to the cited case. In *In re Mars, Inc.*, the mark was considered a refinement of a common shape because one change was made to the common shape. The container was inverted. In the current case, the applied for mark changes one feature of the common containers used in the industry. The parallelogram shape of applicant's container merely changes the angles at the corners of the container. This change in angles does not change overall impression created by the container because the overall shape is highly similar to those consumers commonly encounter with four parallel sides, tapered sides, and rounded corners.

Applicant argues that applicant's mark is a unique shape because there is no evidence of other containers featuring the identical shape. (Applicant's brief at page 9.) Even if applicant is the first or sole user of the parallelogram-shaped container for yogurt, the evidence of record shows that the shape is a common shape and is a mere refinement of the containers commonly used in the dairy industry. *See In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253, 1255 (TTAB 1998)(the Board found that "while the designs [of packaging for electric lights for Christmas trees that] applicant seeks to register may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive.")

The mark is not inherently distinctive because it is a common shape that is a mere refinement of common containers in the yogurt and dairy industry and is thus, not registrable on the Principal Register without proof of acquired distinctiveness.

AMENDMENT IN THE ALTERNATIVE TO THE SUPPLEMENTAL REGISTER

It is noted that applicant has requested amendment to the Supplemental Register in the alternative. The amendment to the Supplemental Register is acceptable and is not issue on appeal.

CONCLUSION

Applicant's mark is not inherently distinctive and is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Sections 1, 2, and 45 be affirmed.

Respectfully submitted,

/Kristina Morris/

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