

This Opinion is not a
Precedent of the TTAB

Hearing: January 14, 2020

Mailed: March 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re WCM Industries, Inc.
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Serial No. 87555014
—

Scott W. Johnston of Merchant & Gould PC,
for WCM Industries, Inc.

Heather A. Sales, Trademark Examining Attorney, Law Office 122,
John Lincoski, Managing Attorney.

—
Before Kuhlke, Wellington and Coggins,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On August 3, 2017, WCM Industries, Inc. (“Applicant”) filed an application to register as a mark the configuration shown below for goods identified as “Plumbing products, namely, a bathtub overflow drain cap” in International Class 11, on the Principal Register.¹

¹ Application Serial No. 87555014 was filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as August, 2001.



The application includes the following description of the mark:

The mark consists of [a] three dimensional configuration of the elements of a bathtub overflow drain cap, namely, a cylindrical cap with rounded edges, a smooth, flat face, and a smooth cylindrical sidewall that extends from the face at a nearly perpendicular angle. The cylindrical sidewall has an elongated slot with rounded edges and the slot is fully encompassed by the cylindrical sidewall.

Throughout the decision we generally refer to this configuration as an overflow cover.

I. Refusals

The Examining Attorney has refused registration of Applicant's product configuration mark under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that the product design is functional. Alternatively, registration has been refused under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. § 1051, 1052 and 1127, on the ground that the configuration fails to function

Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) database. References to the briefs on appeal refer to the Board's TTABVue docket system.

as a mark because it consists of a non-distinctive product design, is not registrable on the Principal Register without proof of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and the proffered evidence of acquired distinctiveness is insufficient. When the refusal and alternative refusal were made final, Applicant requested reconsideration which was denied. Thereafter, Applicant appealed and again requested reconsideration. After the Examining Attorney denied the second request for reconsideration, the appeal resumed. We affirm the refusal to register on the ground that the matter sought to be registered is functional, and we do not reach the alternative refusal.

II. Functionality

Section 2(e)(5) of the Trademark Act provides that registration of a product design be denied if it “comprises any matter that, as a whole, is functional.” Generally, a product design or product feature is considered to be functional in a utilitarian sense if it is: (1) “essential to the use or purpose of the article;” or if it (2) “affects the cost or quality of the article.” *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)).

In making our determination of functionality we are also guided by the analysis first applied in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). *See also Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002). *Morton-Norwich* identifies four nonexclusive categories of evidence which may be helpful in determining whether a particular

design is functional: (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. *Morton-Norwich*, 213 USPQ at 15-16.

The Supreme Court has made it clear, however, that if evidence such as statements in a relevant utility patent or the applicant's own promotional materials establishes that the design is functional under the *Inwood* formulation of the test, further inquiry into the existence of available alternative designs or whether there is a competitive necessity for the feature is unnecessary. *TrafFix Devices*, 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."); *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1378 (Fed. Cir. 2012) ("[S]ince the patent and advertising evidence established functionality, the Board did not need to analyze whether alternative designs exist."). Thus, there is no requirement that all of the categories of evidence identified in *Morton-Norwich* appear in every case in order to make a functionality refusal. *In re Change Wind Corp.*, 123 USPQ2d 1453 (TTAB 2017); *In re Heatcon, Inc.*, 116 USPQ2d 1366 (TTAB 2015).

In considering the product configuration mark as a whole, our primary reviewing court has recognized that the initial analysis may be of the separate features of the

involved configuration, followed by consideration of the entire design. *Becton, Dickinson*, 102 USPQ2d at 1376 (“[O]ne object of the *Morton-Norwich* inquiry is to weigh the elements of a mark against one another to develop an understanding of whether the mark as a whole is essentially functional and thus non-registrable.”); *In re R. M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 2 (Fed. Cir. 1984).

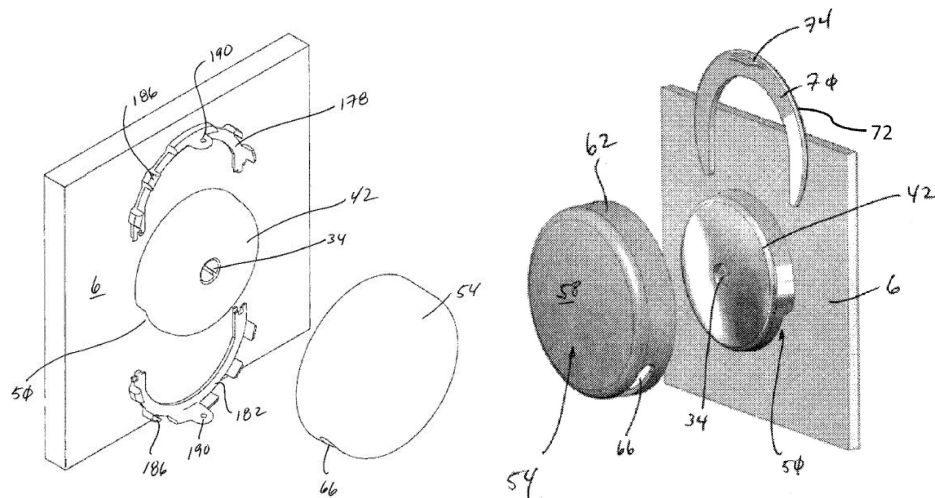
Before reaching the *Morton-Norwich* factors, we observe as the Examining Attorney asserts that “an inlet/slot for water flow is an important segment of bathtub overflow caps; and a cylindrical shape for an overflow cap is a common basic shape in the plumbing industry because of its function to cover . . . a cylindrical shaped drain pipe.” 9 TTABVue 10. Because Applicant did not dot the opening or circular shape in the drawing, the product configuration mark incorporates those general elements. Applicant focuses on the specific shape of the opening, the smooth top, and the curvature into the perpendicular sidewalls.

A. The Existence of Utility Patents

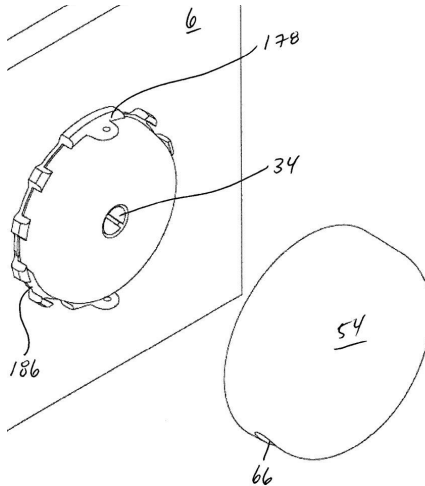
With regard to the first factor, the existence of a utility patent “is strong evidence that the features claimed therein are functional” and “[w]here the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.” *TrafFix*, 58 USPQ2d at 1005. Moreover, even if 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.” *Becton, Dickinson*, 102 USPQ2d at 1377. *See also Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1205 (TTAB 2018) (“We consider the entirety of a patent – both claims and disclosures – and have found functional applied-for marks depicting the preferred embodiment described in a utility patent.”); *Change Wind*, 123 UPSQ2d at 1453.

Applicant has several patents for overflow plumbing devices. The Examining Attorney particularly relies on United States Patent No. 8769736 B2 (July 8, 2014), for “Device for Concealing a Plate Associated with Overflow Plumbing” as shown in the drawings below.²



² November 15, 2017 Office Action at 3-5.



The subject of the trademark application is depicted in numbers 54 (overflow plate cover), 66 (opening), 58 (outer surface) and 62 (wall) in each drawing. The abstract of the patent explains that it is “[a]n overflow plate concealing device for bathtubs that is associated with a plate of an overflow system of the bathtub” and that “aspect of the invention allows the overflow plate to be concealed to allow the user to alter the aesthetic appearance of their bathtub or repair the same.”³ In the detailed description the patent explains “[a]n overflow cover plate 54 ... is employed to conceal the overflow plate 42.” The description notes that the “embodiments of the present invention described below are not limited to incorporation onto the overflow system shown in FIG. 1 and can be used in conjunction with many overflow systems.”⁴ Further, it explains that “one embodiment of overflow plate cover 54 of the present invention is shown that includes an outer surface 58 having a wall 62 depending

³ November 15, 2017 Office Action at 2.

⁴ November 15, 2017 Office Action at 7.

therefrom. Although shown as cylindrical, one skilled in the art will appreciate that the overflow plate cover 54 may be of any shape and be made of any material or finish. The wall 62 includes at least one opening 66 therethrough that is aligned with a fluid opening 50 of the overflow plate 42. One skilled in the art will appreciate that the opening 66 may also be a cut out similar to that of the overflow plate opening 50 shown, thereby increasing the fluid flow capacity of the overflow plate cover.”⁵ Finally, “[w]hile various embodiments of the present invention have been described in detail, it is apparent that modifications and alterations of those embodiments will occur to those skilled in the art. Moreover, references made herein to ‘the present invention’ or aspects thereof should be understood to mean certain embodiments of the present invention and should not necessarily be construed as limiting all embodiments to a particular description. However, it is to be expressly understood that such modifications and alterations are within the scope and spirit of the present invention, as set forth in the following claims.”⁶

The claims include:⁷

1) A device for concealing an overflow plate of an overflow system, the overflow plate having a fluid opening that allows fluid to pass from a basin to which the overflow system is associated comprising: a retention plate adapted to be positioned between the overflow plate and the basin, the retention plate having a lip; and an overflow plate cover for interconnection to said retention plate, said overflow plate cover having an outer surface with a wall extending therefrom with an opening therethrough that is adapted to

⁵ November 15, 2017 Office Action at 7-8.

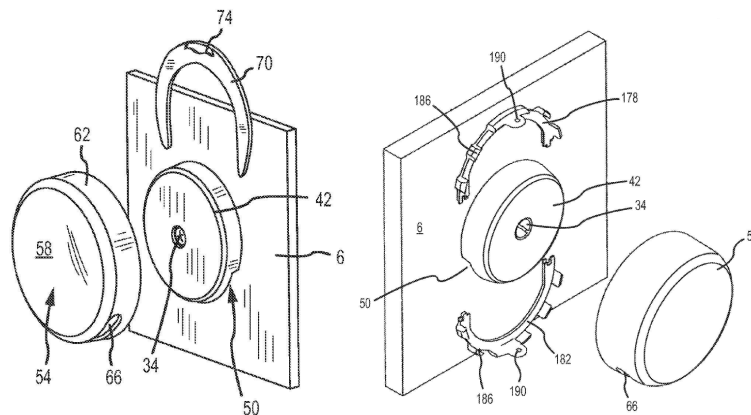
⁶ November 15, 2017 Office Action at 9.

⁷ *Id.* (emphasis added).

be aligned with the opening of the overflow plate to provide a continuous fluid flow path from inside the basin to the overflow system, the overflow plate cover having an inner protrusion, wherein the lip interfaces with the inner protrusion.... an overflow plate cover ... having an outer surface with a wall extending therefrom with an opening therethrough that is adapted to provide a continuous fluid flow path from inside the basin to the overflow system;

2) The device of claim 1, wherein said overflow plate cover engages an outer edge of said retention plate. 3.

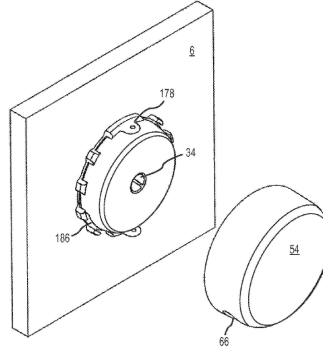
Another of Applicant's patents is for "Device for Concealing a Plate Associated with Overflow Plumbing."⁸ The abstract explains that "the invention allows the overflow plate to be concealed to allow the user to alter the aesthetic appearance of their bathtub or repair the same."⁹ Three drawings are reproduced below:¹⁰



⁸ United States Patent No. 9045886 B2 (2015), November 19, 2018 Office Action at 6-29.

⁹ *Id.* at 6.

¹⁰ *Id.* at 11-13.



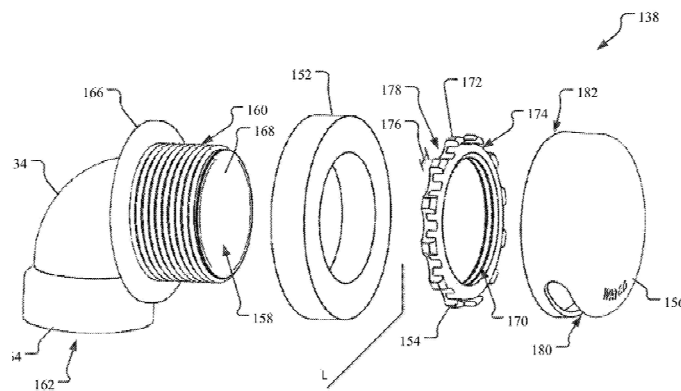
The claims include:¹¹

- 1) A system for concealing a plate of an overflow system, the overflow system comprised of an overflow plate spaced from a flange by way of a sidewall, the flange being engaged on an inner surface of a fluid basin, the overflow plate having a fluid opening that allows fluid to pass from the basin, comprising: an adapter which has an outer edge and an inner edge adapted to be engaged on the flange of the overflow system wherein the sidewall of the overflow system is positioned within said inner edge of said adapter; and an overflow plate cover for selective interconnection to said adapter, said overflow flange cover having an outer surface with a wall extending therefrom wherein said wall selectively engages said outer edge of said adapter, said overflow plate cover also having an opening that provides a continuous fluid flow path from inside the basin to the overflow system.
- 2) The device of claim 1, wherein said outer edge of said adapter is comprised of an outwardly extending ring that extends away from a planar portion of said adapter, said outwardly extending ring capable of selectively receiving said overflow plate sidewall. ...
- 5) The device of claim 1, further comprising a first finger and a second finger each protruding from said adapter, said first finger and said second finger adapted to receive and maintain a retaining member that is also associated with the overflow plate cover to secure said adapter to the overflow system.

¹¹ *Id.* at 28.

- 6) The device of claim 1, wherein said adapter includes a sidewall extending from an outer edge, wherein an end of said sidewall engages the flange of the overflow system.
- 7) The device of claim 6, wherein said end of said sidewall is comprised of an outwardly extending ring for selective receipt of said overflow plate sidewall.
- 8) The device of claim 6, wherein said sidewall includes at least one opening that allows for fluid to pass.

Finally, another patent application depicts the device as shown below:¹²



Applicant's Vice President, Kevin G. Fink explains that the shape and form of the overflow cover, the product configuration mark, required "a mold that was able to be strong, but flexible enough to be able to snap it onto the nut, big enough to allow sufficient water to flow through it, but not too big that it would result in gaps around the edge caused by the curvature of the tub, and the side walls had to be deep enough to allow it to snap onto the nut and allow water to flow through it, but not too deep that it was aesthetically unpleasant."¹³ All of these aspects point to how the product configuration mark results from the utilitarian snap on feature. The size of the cover

¹² Patent Application No. 2018/0044899, November 19, 2018 Office Action at 45.

¹³ Declaration of Kevin G. Fink, Applicant's Vice President, (Fink Dec.) ¶ 5, May 14, 2018 Response at 3.

is dictated by the curvature of the tub, the depth of the side walls is dictated by the requirement to be able to snap on and allow water flow but not too deep as that is aesthetically unpleasant. Presumably, the snap on feature also dictates the need for a complete circle at the bottom to connect with the retainer nut, as noted, for example, in claim 7 “said sidewall is comprised of an outwardly extending ring for selective receipt of said overflow plate sidewall.”¹⁴

Applicant argues that its utility patents protect the functional aspect of its overflow cover which is part of the interior of the cover, not the outward face and sidewall.¹⁵ We note, however, Mr. Fink attests that “most of [Applicant] WCM’s competitors secure the overflow cover from the exterior face. Securement is typically accomplished by screws that are inserted through either the face or the sidewall. The different ways in which WCM and its competitors secure the overflow [cover] naturally distinguishes WCM’s Overflow Cap Mark from its competitors.”¹⁶

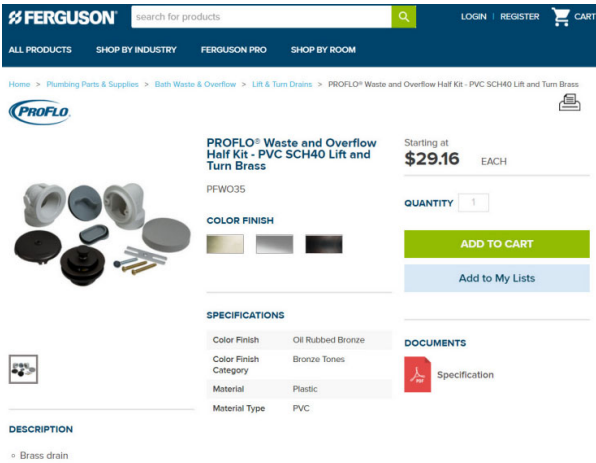
The Examining Attorney asserts that Applicant’s multiple utility patents “embody[] the features of the proposed mark such as the smooth, flat cylindrical face, sidewalls that extend from the face at a nearly perpendicular angle and an elongated slot (also noted as ‘a cut portion’ and/or ‘fluid inlet port of the cap’ in Applicant’s patents).” Ex. Att. Brief, 9 TTABVUE 5. Specifically, the Examining Attorney points to various disclosures and claims in the patents. She explains “the function of

¹⁴ November 19, 2018 Office Action at 28.

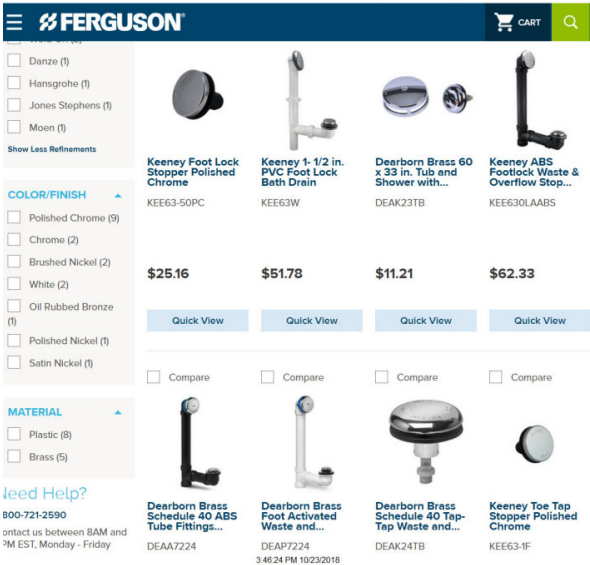
¹⁵ Fink Dec. ¶ 11, May 14, 2018 Response at 5.

¹⁶ Fink ¶ 12, *Id.*

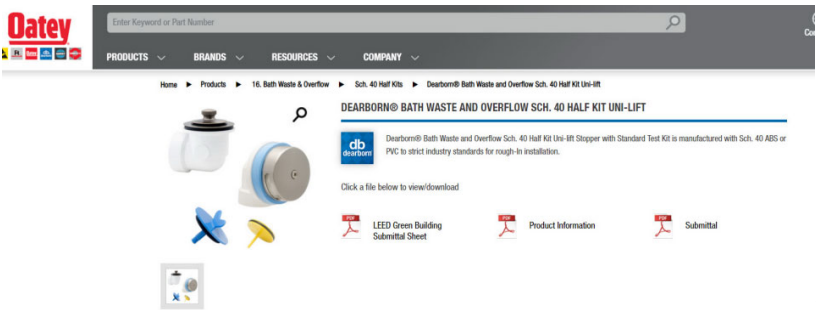
Applicant's applied-for product configuration is to prevent the water level in a bathtub from overflowing in the event the faucet is inadvertently left in an open position, or if the level gets too high when someone gets in and the water is displaced by way of a fluid flow path. The elongated inlet/slot of the overflow cover facilitates the 'increase[...] of the fluid flow capacity of the overflow plate cover' and '...reduce[s] overflowing the bathtub.'" Ex. Att. Brief, 9 TTABVUE 9 (quoting Patent No. 8769736 B1 and Patent Application No. US 2018/0044899). Further she states that "the smooth cylindrical face of the applied-for mark product configuration makes the installation easier, as it can then easily be installed or removed without having to use special tools or fastening means such as screws." 9 TTABVUE 9. As noted above, she states that "an inlet/slot for water flow is an important segment of bathtub overflow caps; and a cylindrical shape for an overflow cap is a common basic shape in the plumbing industry because of its function to cover another cylindrical shape . . . [i.e.,] a cylindrical shaped drain pipe." 9 TTABVUE 10. In addition to the last figure, above, (from Patent Application No. 2018/0044899), below are a few examples supporting this point:



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¹⁷ November 19, 2018 Office Action at 63.

¹⁸ *Id.* at 64.

¹⁹ *Id.* at 65.

Applicant counters that the overflow cover “is an aesthetically pleasing cover that conceals an overflow plate or a retainer nut, while still allowing water to drain from the bathtub, through the overflow system.” App. Brief, 7 TTABVUE 7-8. Applicant argues that the Examining Attorney maintains that the applied-for mark is functional because the shape allows the cap to more readily attach to the overflow system, but there is no evidence that the shape of the cap, including the “smooth, flat face of” the cap, “makes the cap attach better to the rest of the overflow system. Rather the U.S.P.T.O. conflates, among other things, the functional nature of certain potential attachment mechanisms on the back of the cap with the claimed appearance of the front of the cap. ... Applicant is only claiming trademark rights in the outer appearance of the Overflow Cap Mark, not its inner workings or structure.” 7 TTABVUE 8.

Further, in response to the Examining Attorney’s position that the slot increases fluid flow capacity and therefore the shape of the opening is functional, Applicant argues that the drain hole does not need to be in the particular form claimed by Applicant to work. Applicant asserts “the particular shape of Applicant’s elongated slot, being fully encompassed in a sidewall, makes water drain less quickly than other design options. This is clear from Applicant’s patent disclosures, the absence of third parties that have adopted this design, and the laws of physics. Consequently, Applicant’s claimed Overflow Cap Mark cannot be de jure functional because it does not work better in this shape.” 7 TTABVUE 9.

With regard to Applicant's configuration, Applicant explains that the circular retainer nut "allows the mechanisms on the back side of the overflow cap to 'snap on,'" but the exterior could be any shape, in other words, the "structure on the back of the cap does not dictate the shape of the outer surface of the cap" and the "face and the body of the cap do not affect the ease of installations." 7 TTABVUE 12. Applicant states that "the smooth, essentially flat face, the smooth cylindrical sidewall that extends from the face at a nearly perpendicular angle, and the elongated slot with rounded edges that [are] fully encompassed in the sidewall are design choices, not functional ones." 7 TTABVUE 12-13. Applicant states that "none of the patents show any utilitarian advantage for the shape of the slot, which is an elongated slot fully encompassed in the sidewall, that spans less than one hundred and eighty degrees of the sidewall, and which incorporates rounded edges." 7 TTABVUE 14. In sum, Applicant's position is that:

[T]he 'snap on' functionality is a feature of the Applicant's overflow cap, but this feature is not enabled, not does it depend on or relate to, Applicant's Overflow Cap Mark. Moreover, any 'increased fluid flow rate' advertised by Applicant does not result from the shape of Applicant's 'elongated slot;' it results from different features that are not claimed as part of Applicant's Overflow Cap Mark. ... these advantages are facilitated by hidden, unclaimed structures of Applicant's overflow cover. They do not originate from the claimed features of Applicant's Overflow Cap Mark. As noted by the Board in *Grote Indus.*, although Applicant's advertising touts these utilitarian advantages of the product as a whole, the advertising of record does not directly attribute any such advantage to Applicant's claimed configuration.

7 TTABVUE 17-18. See *Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d at 1197 (advertising does not support functionality finding where it does not directly attribute

any advantages to the specific applied-for feature). Essentially, Applicant argues that Applicant's patent for a screw-less overflow cover does not dictate the shape of the cover. Applicant submitted examples of the third-party caps with no external screws. Applicant's examples as displayed in its brief are reproduced below.²⁰

Danco's No External Screw Cap



Westbrass No External Screw Cap



AB&A No External Screw Cap



However, while these may be other ways to achieve a screw-less outer cap they do not do so with the type of circular snap on arrangement that Applicant employs.

²⁰ 7 TTABVUE 13.

Applicant argues that the cylindrical shape is one of many shapes that could be adopted as stated in the patent. In addition, Applicant states that it is not required that the overflow cap be smooth because one of the patents allows for use of screws on the face. 7 TTABVUE 11 (referencing Patent Application No. 2018/0044899).

Regarding the drainage hole, Applicant acknowledges the utilitarian aspect of a drainage hole in general allowing overflow water to drain but argues that the “style of the slot is otherwise a design consideration – not a functional one.” 7 TTABVUE 14. Applicant goes further to say that its slot is less efficient because if it were not fully encompassed by the sidewall it would increase the fluid flow capacity, and as explained in Patent No. US 8769736: “One skilled in the art will appreciate that the opening [] may also be a cut out similar to that of the overflow plate opening [] shown, thereby increasing the fluid flow capacity of the overflow plate cover.”²¹ Applicant points to third-party uses that have the drainage opening cut out at the bottom:²²

²¹ November 15, 2017 Office Action at 7-8.

²² February 4, 2019 Request for Reconsideration at 14.



Applicant also points to a disclosure in its 2018/0044899 patent application that states that the overflow cover may also “include a plurality of discrete openings all completely defined by the exterior wall.” 7 TTABVUE 16 (quoting Patent App. No. 2018/0044899, November 19, 2018 Office Action at 59).

In connection with the overall shape of the overflow cap and the drainage hole Applicant concludes that “when a patent states that a feature can be a different shape, this disclosure has been found by the Board to be evidence of the non-functionality of a configuration.” 7 TTABVUE 16. Applicant relies on *Grote Indus., Inc. v. Truck-Lite Inc.*, 126 USPQ2d at 1206; however, that case involved a pentagonal arrangement of six diodes in which the utility patent disclosed any number of diodes could be used. The Board distinguished those facts from other decisions where functionality was found, stating:

This case is thus distinguishable from *Kistner Concrete*, 97 USPQ2d at 1923, in which the Board found that “each of the elements comprising the trademark is an essential element of the patent.” Further, in contrast to *Heatcon*, the patent does not disclose any utilitarian aspect of the specific placement of the optical elements.

Grote Indus., Inc. v. Truck-Lite Inc., 126 USPQ2d at 1206.

Here, each element is dictated by an essential element of the patent: smooth cylindrical shape from a screw-less design that snaps onto a circular nut and a drainage hole placed and sized to match the drainage hole in the underlying overflow plate. While the rounded ends of the drainage hole may not be “essential” they are too incidental to transform the overall functionality of the applied-for mark into a capable mark.

As explained above, it is not required that “a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant’s assertion that an applied-for mark is not de jure functional.” *Becton, Dickinson*, 102 USPQ2d at 1377. Where all or substantially all of an applicant’s overall design is dictated by the function it performs, it is functional. *In re Vico Prods Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985) (configuration of whirlpool jets for bathtubs held functional because “the appearance of the ... body is adapted to the function it performs”). The patents do not need to precisely identify the specific features; it is enough for statements in Applicant’s patents and patent applications to show that features claimed by Applicant as a trademark constitute an essential or integral part of the invention and offer a utilitarian advantage.

Through, inter alia, the preferred embodiments, the patents disclose the functional role of the cylindrical smooth surface, sidewalls and elongated drainage hole. *See Change Wind*, 123 USPQ2d at 1460 (functional advantages of these features apply equally to the preferred embodiment and the applied-for mark). The cylindrical shape is an obviously functional shape as demonstrated by the multitude of third parties that employ the cylindrical shape to cover a round pipe and round plate to seal to the tub surface; naturally the inner workings of the overflow cover would be configured in a round shape to fit over the round pieces which dictates the cylindrical shape of the outer overflow cover.

Despite the fact that the patent allows for the overflow cover to be in any shape, the preferred embodiment in all of Applicant's patents is cylindrical. The specifications, drawings and preferred embodiments may also constitute strong evidence and we find that they do in this case. *Becton, Dickenson*, 102 USPQ2d at 1377. We note that the circular inner retainer nut to which the overflow cover attaches is a complete circle dictating that the elongated hole be encompassed by the sidewall. *See* Patent Application 2018/044899, November 19, 2018 Office Action at 45 (figure, reproduced above) and 58 ("The retainer nut 154 includes a threaded inner surface 170 that corresponds to and is compatible with the threaded outer surface 160 of the elbow 134. A plurality of circumferentially spaced and radially extending lugs 172 extend from an outer surface 174 of the retainer nut 154. Each lug 172 has a circumferential length 176 and is separated from one another by a gap 178. When the retainer nut 154 engages the overflow elbow 134, the bathtub wall and the seal

152 are compressed between the radial flange 166 and the retainer nut 154 so as to secure the overflow assembly 138 within the overflow port. ... The overflow cover 156 is configured to selectively engage with the retainer nut 154 and conceal the inlet end 158 of the elbow 134 and the retainer nut 154 such that a finish is provided with no visible fastening hardware.); *see also* Patent No. 9045886 B2 figures 6 and 7 upper and lower retainer plates (nos. 178 and 182) (“Referring now to FIGS. 6 and 7 another embodiment of the present invention is shown that employs an upper retention plate 178 and a lower retention plate 182 that work in conjunction to receive and secure the overflow plate cover 54. The upper retention plate 178 is selectively interconnected to the lower retention plate 182 wherein both the upper retention plate 178 and the lower retention plate 182 employ a series of lugs 186 that interface with an inner surface of the overflow plate cover 54.”), November 19, 2018 Office Action at 12-13 (figures²³), 26-27. Moreover, the snap on attachment removes the need for screws which results in a smooth surface. The deeper perpendicular sidewalls are necessary to accommodate the snap on mechanism. *See* Fink Dec. ¶ 5, May 14, 2018 Response at 3 (“Applicant needed to create a mold that was able to be strong, but flexible enough to be able to snap it onto the nut ... and the side walls had to be deep enough to allow it to snap onto the nut and allow water to flow through it....”).

Here, “the functional features far outweigh any nonfunctional aspect of the arrangement which is incidental and hardly discernible as a separate element from

²³ These figures are essentially identical to two of the figures reproduced above for Patent No. 8769736 B2 attached to the November 15, 2017 Office Action at 4-5.

the functional parts.” *Heatcon*, 116 USPQ2d at 1378. The overall configuration is directed by utilitarian concerns of an overflow cover that is used to cover the round overflow pipe and plate while allowing water to flow through the drainage hole. The product configuration makes the overflow cover easier to install (no screws, rounded configuration snaps on to cylindrical retainer nut) and safer (no screws so smooth rounded surface to avoid abrasion on the skin). In addition, the drainage opening encompassed by the sidewall allows for the circular overflow cover to snap onto the circular retainer nut.

While there are many types of overflow drain covers on the market, if the design features improve the performance of any aspect of the purpose of the goods, they “affect the...quality of the article” and should remain available to competitors. *TrafFix*, 58 USPQ2d at 1003. While we find these patents sufficient to make the determination of functionality, we nonetheless address the remaining factors for completeness.

B. Advertisements Touting the Utilitarian Advantages of the Design

The Examining Attorney presented various examples of advertising by Applicant and third parties that reference certain aspects of Applicant’s Overflow Cover Cap. A few examples are set forth below:

“Slash installation time” “water-tight seal” “Requires no tools to install” “Eliminates all screws” “The overflow face plate is then snapped onto the specially designed points of the star nut. No time-consuming screws are needed.” “Overflow plate snaps into place. No need to stock one and two-hole plates. Patent pending. In a short time, the job is finished. You save labor.” Applicant’s Brochures (watcomfg.com, May 13 2019 Office Action at 3-5);

“... the overflow plate just snaps on, no screws to deal with or tools required. It is easy, quick, trouble-free, and simple. Traditional one or two-screw overflow plates can easily be scratched with a screwdriver when installing the screws. This results in the need to replace the overflow plate, which can be very expensive, particularly with special finishes. Screws can be damaged when installing them with powered screwdrivers, which can leave a burr where children can injure themselves. Watco’s new snap-on overflow plate eliminates all these potential and costly problems.” (*Id.* at 11); and

“Easily Converts 1-Hole Or 2-Hole Overflow Plates To Innovator Snap-On Overflow Plate” “Innovator Cover Plate Eliminates Screws And Is Self-Centering, Self-Aligning And Self-Sealing” (third party offering Applicant’s products, hdsupplysolutions.com, *Id.* at 6-7).

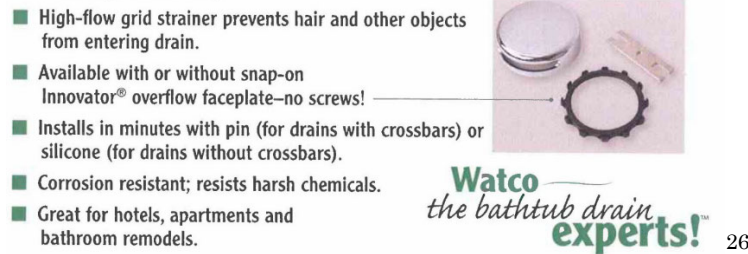
Applicant’s advertising is directed to Applicant’s “use of a ‘screwless’ or ‘no screws’ cap.”²⁴



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²⁴ Fink Decl. ¶ 9, May 14, 2018 Response at 4.

²⁵ May 14, 2018 Response at 324.



The Examining Attorney also points to Applicant’s statements set out below that the overflow cover was created with specific utilitarian advantages in mind:

When WCM originally conceptualized the shape and form of its Overflow Cap Mark, the initial engineering work required to create a mold was significant. In particular, Applicant needed to create a mold that was able to be strong, but flexible enough to be able to snap it onto the nut, big enough to allow sufficient water to flow through it, but not too big that it would result in gaps around the edge caused by the curvature of the tub, and the side walls had to be deep enough to allow it to snap onto the nut and allow water to flow through it, but not too deep that it was aesthetically unpleasant. Presently, the cost that Applicant incurs manufacturing its overflow cap is similar to third parties that manufacture overflow caps composed of similar materials.²⁷

Relying on *Grote Indus., Inc. v. Truck-Lite Inc.*, Applicant argues that the advertising relates to the “snap on functionality” as a feature of the overflow cover but does not tout the applied-for mark: “although the advertising touts these utilitarian advantages of the product as a whole, the advertising of record does not directly attribute any such advantage to Applicant’s claimed configuration.” 7 TTABVUE 18. These facts are different from *Grote* where the heat dissipating advantage allowing greater light output from the diodes was not directly attributable

²⁶ May 14, 2018 Response at 328.

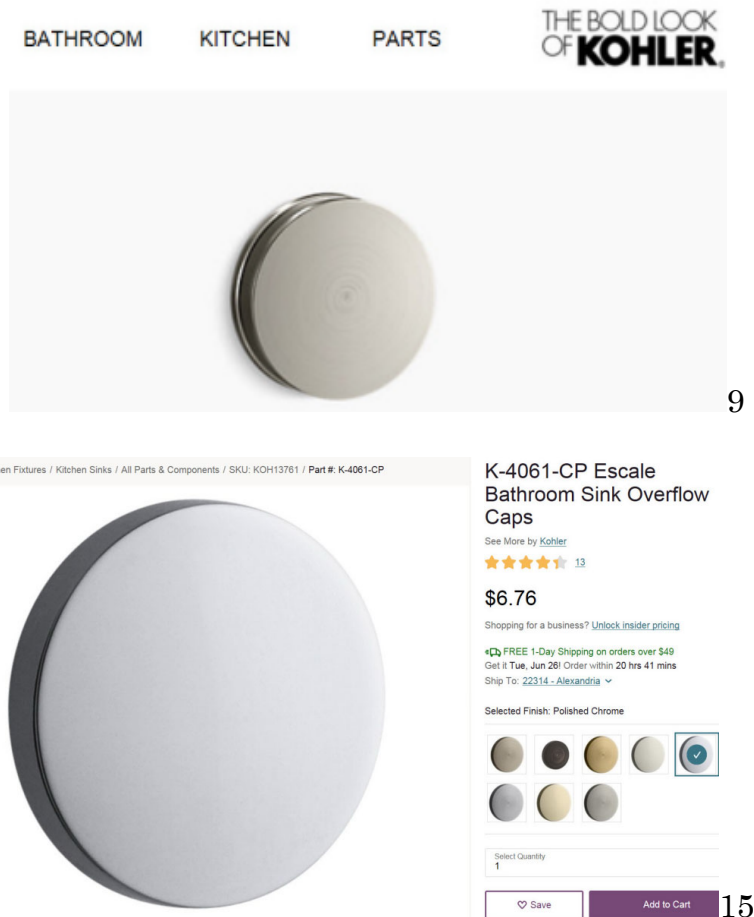
²⁷ Fink Dec. ¶ 5, May 14, 2018 Response at 3.

to the applied-for pentagonal arrangement of the diodes, but the use of a heat-dissipating metal substrate. 126 USPQ2d at 1206-07. In *Grote* the pentagonal pattern did not affect heat dissipation nor was the pattern dictated by a functional feature. Here, at a minimum, the cylindrical shape with sidewalls accommodates the snap on feature attaching to a circular retainer nut.

C. Availability of Alternative Designs

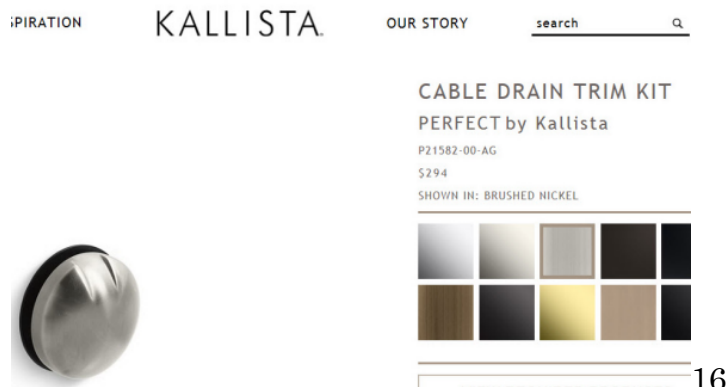
Applicant points to alternative designs that include various shapes and sizes. Applicant argues that there “is no evidence that the exterior shape and design of third party overflow caps make these third party products perform in an inferior fashion. ... There is no evidence that Applicant’s overflow cap is the only, or one of a few, overflow cap designs, that is able to meet applicable federal safety standards. ... Nor, as discussed above, is there evidence that such alternative choices cause competitor products to insufficiently let water flow through the overflow cap.” App. Brief, 7 TTABVUE 19. Applicant concludes that “the lack of any third parties that have adopted an overflow cap featuring all the claimed elements of Applicant’s Overflow Cap Mark is strong evidence that the claimed design of Applicant’s overflow cap is not necessary to compete and is not functional.” *Id.*

The Examining Attorney argues that although there are some caps that deviate slightly in design, Applicant’s “multitude of patents prevent its competitors from using a potentially superior design.” 9 TTABVUE 18. A few third-party examples in the record are set out below:



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It is clear that there are a multitude of overflow cap designs. Fewer appear to be available without screws to provide a smooth cylindrical shape and, as Applicant notes, none include all of Applicant's characteristics. This may well be, as the

Examining Attorney states, a result of Applicant's patents to the extent that the interior workings dictate the outer design. Given our findings regarding the utilitarian aspects that dictate certain design aspects, it is not clear from this record that there are alternative designs that achieve the snap on utility, which requires, for example, a wall of a certain depth that snaps onto a circular nut. We find this factor neutral in our analysis.

D. Cost of Manufacture

The Examining Attorney asserts Applicant's product allows for a comparatively simple or cheap method of manufacturing based on the statement in the patent that it can be made with "those typically utilized for plumbing and trim kits." Ex. Brief, 9 TTABVue 19. Mr. Fink attests that "the cost that Applicant incurs manufacturing its overflow cap is similar to third parties that manufacture overflow caps composed of similar materials."²⁸

This record does not support a finding that the cost of manufacture for Applicant's goods gives Applicant a competitive advantage. However, "[w]hile evidence that a product feature makes the product cheaper to make may be probative in showing functionality, evidence that it does not affect its cost is not necessarily proof of non-functionality." *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1930 (TTAB 2011).

²⁸ Fink Decl. ¶ 5, May 14, 2018 Response at 3.

E. Other Considerations

Finally, apart from the *Morton-Norwich* factors, we note that from the declarations submitted in support of acquired distinctiveness it is clear that aspects of the patent that direct the shape (no screws, walls that have enough depth to engage with the nut and cover the faceplate) and utilitarian advantages of the resulting shape (no screws, rounded edges are easy to clean) are what is noticed by the affiants. A few examples of handwritten notes in response to the prompt “I recognize the bath waste overflow faceplate ... as being a Watco product because the configuration include[s] the following aspects:”²⁹ are set forth below:

The faceplate is attached w/no screws and is sleek in design. Easier to keep clean, for sure;³⁰

The Watco overflow has a solid surface with rounded edges and no screw holes. It features a snap on design unique to Watco products;³¹

No screws;³²

It is not held on to the [] with any screws. It also sticks out about an inch because it snaps onto a retainer ring that holds the overflow elbow in place;³³

Smooth finish. Snap on feature, very clean look, no screw or screw hole;³⁴

²⁹ May 14, 2018 Response at 483.

³⁰ *Id.* at 483.

³¹ *Id.* at 485.

³² *Id.* at 487.

³³ *Id.* at 489.

³⁴ *Id.* at 493.

No screws, snaps on/off;³⁵

Snap-on overflow cover, no screws, smoothed edges;³⁶

No screws, bottom outlet opening for drain, smooth;³⁷

Very clean aesthetic design. Round snap-on, no screws;³⁸

It is not held on to the tub with any screws. It also sticks out about an inch because it snaps on to a retainer ring that holds the overflow elbow in place;³⁹

Overflow hole in faceplate;⁴⁰ and

It clips on instead of screws. It has larger overflow hole.⁴¹

Out of approximately 165 declarations only 21 mention the opening.

F. Aesthetic Functionality

The Examining Attorney argues that “a round overflow cover sans a screw hole is additionally aesthetically functional, and protecting such a design feature is still prohibited from registration because the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage.” Ex. Brief 9 TTABVUE 17. The Examining Attorney points to the third-party websites showing the same or similar overflow covers demonstrating the feature of a smooth round overflow cover enhancing the attractiveness of the product and Applicant

³⁵ *Id.* at 495.

³⁶ *Id.* at 497.

³⁷ *Id.* at 499.

³⁸ *Id.* at 517.

³⁹ *Id.* at 555.

⁴⁰ *Id.* at 559

⁴¹ *Id.* at 795.

states that its caps “snap on and off, making them easily interchangeable to match the décor of the room.” Ex. Brief, 9 TTABVue 16 (quoting September 13, 2018 Response at 1). Applicant asserts that its simple and clean contours and the enclosed nature of the slot with the rounded ends are design choices that do not hinder competition. 7 TTABVue 20. A mark will be deemed aesthetically functional, and therefore prohibited from registration by Section 2(e)(5) of the Trademark Act, if there is a “competitive need” for the feature. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994); *In re Florists’ Transworld Delivery Inc.*, 106 USPQ2d 1784, 1787 (TTAB 2013) (stating that a feature is prohibited from registration “if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage”). We find in this case that the issue of functionality relates more to utility than aesthetics. As discussed above, it is the snap on utility which dictates, in part, the “design” and allows overflow covers to be interchangeable to match décor.

G. Conclusion on Functionality

A round overflow cover with an opening is functional; Applicant does not dispute this. Applicant urges that it is only seeking to protect a specific shape in the cover and the opening. However, as discussed above, much of the shape is dictated by the patented features. To the extent Applicant relies on the specific rounding on the cylindrical cover, the specific height of the sidewalls and the specific rounding on the ends of the opening, these potentially nonfunctional elements are so minor they are dwarfed by the overall functionality of a cylindrical cover with a smooth surface and

drainage hole. *Becton, Dickinson*, 102 USPQ2d at 1376. We find that the evidence of record, assessed in its entirety, establishes that Applicant's design is functional because it is essential to the use or purpose of the product. Accordingly, registration of the design as a trademark is barred under Trademark Act Section 2(e)(5). We affirm the Trademark Examining Attorney's refusal on this ground.

In view of the foregoing, we find that the applied-for product design is functional when used in connection with "Plumbing products, namely, a bathtub overflow drain cap." In making our determination, we keep in mind the guidance from the Supreme Court that "[t]he functionality doctrine ... protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely their inability reasonably to replicate important non-reputation-related product features." *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1165 (1995). To afford registration to functional designs would inhibit legitimate competition by, in effect, granting a monopoly to a non-reputational, or non-source-identifying, feature of a product. *Id.*, 34 USPQ2d at 1163-64. As emphasized in *Morton-Norwich*, "the effect on competition 'is really the crux of the matter,'" and a balance must be struck "between the 'right to copy' and the right to protect one's method of trade identification." *Morton-Norwich*, 213 USPQ at 15-16.

Based on all of the record evidence and arguments, we find that the overall design of Applicant's configuration is "essential to the use or purpose of the article." *TrafFix*,

58 USPQ2d at 1006. Thus, we find that the configuration as a whole is functional and is not registrable on that basis.

In view of our affirmance of the Section 2(e)(5) refusal, we need not and do not reach the additional refusal based Sections 1, 2 and 45 and whether Applicant's configuration has acquired distinctiveness. *See Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1540 n.52 (TTAB 2018) (citing *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013)).

Decision: The refusal to register Applicant's proposed configuration mark is affirmed on the basis of functionality under Section 2(e)(5).