

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Kronebusch Industries, LLC
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Serial No. 87621232
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Danielle I. Mattessich and John P. Olson of Merchant & Gould P.C.,
for Kronebusch Industries, LLC.

Hanno Rittner, Trademark Examining Attorney, Law Office 119,
Brett Golden, Managing Attorney.

—
Before Adlin, Lebow, and Elgin,
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:

Kronebusch Industries, LLC (“Applicant”) appeals the final refusal of registration on the Principal Register of its proposed mark depicted below for “Fire extinguishing preparations” in International Class 1.¹ The mark has been refused on the following

¹ Application Ser. No. 87621232 was filed on September 25, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use and first use in commerce as early as 2008. Applicant claims the mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

Citations in this opinion to the prosecution record refer to the .pdf version of the TSDR system. Citations to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See In re Integra Biosciences Corp.*, Ser. No. 87484450, 2022 LEXIS 17, *6 (TTAB 2022). Case citations are in the form recommended in TRADEMARK TRIAL

grounds: (1) it is functional under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5); (2) it is non-distinctive trade dress under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127; and (3) it fails to show use in connection with the identified goods in Class 1.



The application includes this amended description of the mark: “The mark consists of a three-dimensional configuration of the bottom of product packaging forming a recess and containing a pressure gauge in its center. The dotted and broken lines are not part of the mark and are used to show placement of the mark on the goods.” To show how Applicant uses the claimed mark in connection with the goods identified in the application, we reproduce images from Applicant’s specimen of use below:

AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (June 2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citations to the Lexis legal database and cites only precedential decisions.

Serial No. 87621232



For the reasons set forth below, we affirm the refusal to register on the ground that the matter sought to be registered is functional under Trademark Act Section 2(e)(5). We do not reach the alternative refusals.

I. Prosecution History

We first summarize some of the prosecution history of the involved application because it provides useful background to our analysis of the issues. Applicant initially described the proposed mark as follows:

The mark consists of the unique placement of the charge gauge on the bottom of a fire extinguisher. The broken lines depicting the cylindrical shape of the fire extinguisher canister and the circular shape of the pressure gauge indicate placement of the mark on the goods and are not part of the mark.”²

The Examining Attorney issued an office action requiring clarification of the drawing and description because he found that they failed to specify a particular registrable mark and instead contained multiple marks. He further refused registration of the proposed mark as functional pursuant to Trademark Act Section 2(e)(5) and non-distinctive trade dress pursuant to Trademark Act Sections 1, 2 and 45.³ The Examining Attorney also requested information regarding the existence of any patents directed to Applicant’s fire extinguishers and samples of Applicant’s advertisements for the fire extinguishers.⁴

In response to the Office Action, Applicant amended the description of the mark as follows:

² Sept. 25, 2017 Application at TSDR 4.

³ Jan. 22, 2018 Office Action.

⁴ *Id.* at TSDR 8.

The mark consists of a three-dimensional configuration of charge gauge assembly on the bottom of product packaging, which here is a fire extinguisher. The broken lines depicting the cylindrical shape of the fire extinguisher canister indicate placement of the mark on the goods and are not part of the mark.⁵

Applicant did not respond to the request for information or the drawing refusal.

The Examining Attorney then issued a Final Office Action maintaining and making final the information request and substantive refusals.⁶ In his Final Office Action, the Examining Attorney, having located utility patent applications and a design patent owned by Applicant for fire extinguishers that appeared to be pertinent, pointed out that Applicant's amended description of the mark parrots one of the utility patent application's claims ("a gauge mounted within the recessed bottom portion of the container") with no significant difference.⁷

Applicant requested reconsideration of the final refusal, answered the information request (including copies of its patents and advertisements), and presented a second amended description of the mark:

The mark consists of charge gauge uniquely affixed to the bottom of product packaging (i.e., a fire extinguisher). The broken outline of the canister as packaging for the goods is intended to show the position of the mark on the packaging for the goods and forms no part of the mark serving as positional reference only.⁸

⁵ See July 23, 2018 Response to Office Action.

⁶ August 14, 2018 Final Office Action.

⁷ *Id.* at TSDR 4-5. The Examining Attorney referred to the eighth of sixteen claims in the then-pending patent application; as issued, U.S. Patent Reg. No. 10,159,862 B2 (discussed below) has seven claims.

⁸ Feb. 14, 2019 Request for Reconsideration at TSDR 5.

Applicant also made a claim of acquired distinctiveness of the proposed mark under Section 2(f) based on an allegation of substantially exclusive and continuous use of the design for at least the five years immediately before the date of the statement.⁹

The Examining Attorney nevertheless maintained the refusal on grounds of functionality and non-distinctive trade dress; found that Applicant's Section 2(f) claim was insufficient to overcome these grounds; and found that the drawing and amended description of the mark were inadequate.¹⁰ In response, Applicant argued that its proposed mark is not functional product design because it is placed on packaging (i.e., a fire extinguisher) containing fire extinguishing chemicals in Class 1, not on a fire extinguisher itself. Applicant once again amended the description of the mark, this time to:

The mark consists of the unique location of the pressure gauge on the bottom of a metal canister containing fire extinguishing preparations. The matter shown in dotted lines is not part of the mark. No claim is made to the functional features of the pressure gauge.¹¹

The Examining Attorney issued a second Final Office Action maintaining both substantive refusals and requiring an acceptable description of the claimed mark that both matched the drawing and described a configuration acceptably defining the

⁹ *Id.*

¹⁰ Apr. 9, 2019 Office Action.

¹¹ Oct. 9, 2019 Response to Office Action.

location.¹² Applicant filed a Notice of Appeal¹³ and Request for Reconsideration on February 14, 2019, that reverted to the following description of the mark:

The mark consists of charge gauge uniquely affixed to the bottom of product packaging (i.e., a fire extinguisher). The broken outline of the canister as packaging for the goods is intended to show the position of the mark on the packaging for the goods and forms no part of the mark serving as positional reference only.¹⁴

The Examining Attorney denied reconsideration on the substantive and procedural grounds.¹⁵ The Board resumed the appeal.¹⁶ But, Applicant requested remand to the Examining Attorney to consider a new drawing and the following description of the mark:¹⁷

Color is not claimed as a feature of the mark. The mark consists of a three dimensional configuration of a pressure gauge placed in the center of a recess on the bottom of product packaging. No claim is made to the exclusive right to use the functional features of the pressure gauge, including the indicator arrow. The dotted and broken lines are not part of the mark and are used to show placement of the mark on the goods.

Following the remand, the Examining Attorney found the amended drawing to be acceptable, but found the description of the mark unacceptable as containing extraneous matter and not conforming to the drawing. He maintained the substantive refusals and issued a new refusal based on the specimen of use; namely,

¹² Nov. 5, 2019 Second Final Office Action.

¹³ 1 TTABVUE.

¹⁴ 4 TTABVUE 8.

¹⁵ 5 TTABVUE.

¹⁶ 6 TTABVUE.

¹⁷ 7 TTABVUE 5, 15.

that it does not show use in connection with goods in Class 1, but rather a finished fire extinguisher in Class 9.¹⁸

Applicant's response adopted the description of the mark proposed by the Examining Attorney, namely:

The mark consists of a three-dimensional configuration of the bottom of product packaging forming a recess and containing a pressure gauge in its center. The dotted and broken lines are not part of the mark and are used to show placement of the mark on the goods.¹⁹

Applicant argued its specimens are sufficient to show use in connection with Class 1 goods inasmuch as a fire extinguisher is packaging for "fire extinguishing products." Applicant also presented evidence that the Office has accepted specimens for Class 1 goods showing use of the marks on ordinary containers or apparatuses.²⁰

The Examining Attorney then issued a Subsequent Final Office Action making final the refusals based on (1) Section 2(e)(5) (functionality); (2) Sections 1, 2 and 45 (non-distinctive trade dress) and corresponding insufficiency of the evidence under Section 2(f); and (3) Trademark Act Sections 1, 2, and 45 for failure to show use of the trademark on the goods in commerce (specimen refusal).²¹ Applicant's third request for reconsideration, which largely repeated its former arguments and evidence,²² was

¹⁸ Feb. 11, 2022 Office Action.

¹⁹ Aug. 11, 2022 Response to Office Action at TSDR 8.

²⁰ *Id.* at 8-14.

²¹ Jan. 20, 2023 Subsequent Final Office Action at TSDR 2.

²² July 20, 2023 Request for Reconsideration.

denied.²³ Thereafter, the appeal resumed once again, and Applicant and the Examining Attorney filed briefs.²⁴

II. Functionality

Registration may be denied under Section 2(e)(5) if a mark “comprises any matter that, as a whole, is functional.” Generally, a product or package design is considered to be functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23, 25 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). Prohibiting registration of functional designs allows for legitimate competition by effectively preventing a monopoly to a non-reputational, or non-source-identifying, feature of a product. *Qualitex*, 514 U.S. at 164 (“It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation.”); *In re Bose Corp.*, 772 F.2d 866, 872 (Fed. Cir. 1985) (“If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its de facto purpose, it follows that competition is hindered”).

Our determination of utilitarian functionality is guided generally by the analysis set forth in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (CCPA 1982). *Morton-Norwich* identifies the following non-exclusive inquiries, or categories of

²³ Nov. 20, 2023 Denial of Request for Reconsideration.

²⁴ Applicant’s Brief is at 16 TTABVUE. The Examining Attorney’s Brief is at 18 TTABVUE.

evidence, as helpful in determining whether a particular product or packaging 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.

Id.; see also *Poly-America, L.P. v. Ill. Tool Works Inc.*, Can. No. 92056833, 2017 TTAB LEXIS 392, *17 (TTAB 2017) (setting forth factors to be considered). All four factors need not be proven in every case, nor do all four factors have to weigh in favor of functionality to support a functionality refusal. *Poly-America*, 2017 TTAB LEXIS 392, at *18-19 (citations omitted); see also TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1202.02(a)(v) (Nov. 2024).

Ultimately, the determination of functionality is a question of fact and depends on the totality of the evidence presented. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273 (Fed. Cir. 2002) (citing *Morton-Norwich*, 671 F.2d at 1340; *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 112 (Fed. Cir. 1985)). The Examining Attorney bears the burden of making a prima facie showing that Applicant's configuration mark is functional, which if established must be rebutted by Applicant by a preponderance of the evidence. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374 (Fed. Cir. 2012) ("*Becton, Dickinson*") (citing *Cold War Museum, Inc. v. Cold*

War Air Museum, Inc., 586 F.3d 1352, 1356 (Fed. Cir. 2009); *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1579 (Fed. Cir. 1988)).

A. Advertising Touting the Utilitarian Advantages of the Applied-for Mark

We start with the second *Morton-Norwich* factor, which considers the “advertising materials in which the originator of the design touts the design’s utilitarian advantages,” *id.* (citations omitted), because here it is the strongest evidence of functionality. The Examining Attorney made of record pages from Applicant’s website advertising the utilitarian advantages a fire extinguisher design with a recessed bottom to receive a gauge, including the following statements:

These revamped canisters have also allowed for the inclusion of a deeply recessed pressure gauge in the bottom of each of the NEW Standard and High Capacity STOP-FYRE® fire extinguishers. **This feature . . . makes it much easier for an inspector to quickly determine that the extinguisher is in a pressurized state. Not to mention the recessing of the pressure gauge makes it less likely to be damaged or knocked off while bouncing or rolling around in someone’s vehicle or while being used.**²⁵

This advertising confirms that one of the main utilitarian advantages of a recessed (concave) bottom to Applicant’s fire extinguisher is to protect the gauge in rough conditions. The advertising touts a second utilitarian advantage of the recessed placement of the gauge: the ease for an inspector to quickly determine that the extinguisher is properly pressurized. Applicant fails to address these advertised utilitarian advantages of the design in its brief. The second category of *Morton-*

²⁵ Jan. 22, 2018 Office Action at TSDR 28 (emphasis added).

Norwich evidence strongly supports a determination that the applied-for mark is functional.

B. Applicant’s Utility Patents

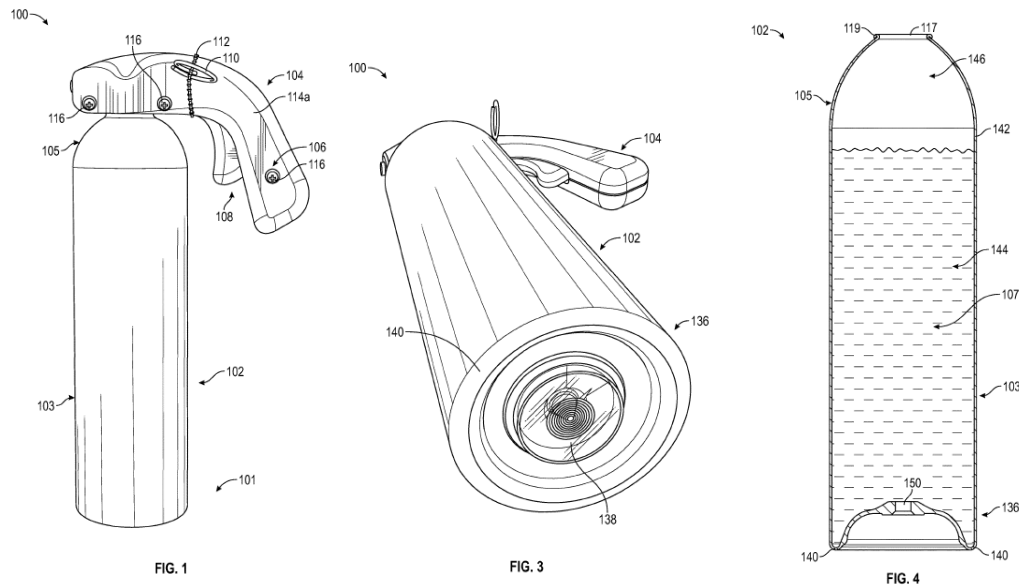
The first *Morton-Norwich* factor – “the existence of a utility patent disclosing the utilitarian advantages of the design” – also supports a finding of functionality. The existence of a utility patent “is strong evidence that the features claimed therein are functional.” *TrafFix Devices*, 532 U.S. at 29. Moreover, “statements in a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Becton, Dickinson*, 675 F.3d at 1375; *see also Poly-America*, 2017 TTAB LEXIS 392, at *38 (“The issue is whether anything in the patent, its specification, or statements made in prosecution disclose the functionality of the marks”) (quoting *In re Bose Corp.*, 772 F.2d at 872).

The Examining Attorney argues that Applicant’s U.S. Patent Reg. No. 10,159,862 B2 (issued December 25, 2018) (the ’862 Utility Patent) for a “Fire extinguisher with recessed gauge” claims utilitarian features directed to the proposed mark, rendering the design functional pursuant to Trademark Act Section 2(e)(5).²⁶ In particular, he argues that the patent demonstrates that the configuration of a recessed cavity in a fire extinguisher claimed in the patent “works better” to deliver fire extinguishing preparations by protecting the pressure gauge.²⁷

²⁶ 18 TTABVUE 5-8. The issued patent was submitted with Applicant’s Feb. 14, 2019 Request for Reconsideration, at TSDR 9-28.

²⁷ 18 TTABVUE 5.

Notably, the patent drawings depicting the invention are similar to the proposed mark:²⁸



The '862 Utility Patent abstract explains that the purpose of the recessed bottom is to house the gauge above the edge of the bottom portion of the fire extinguisher.²⁹ The patent summary confirms that one purpose of the claimed invention is to enable “the fire extinguisher 100 [to] be stored in a variety of different orientations, easing storage and allowing the fire extinguisher 100 to be used in a variety of vehicles, cabinets, or other storage areas where storing traditional fire extinguishers is difficult.”³⁰ The summary also describes the depicted embodiment as “ruggedized”

²⁸ *Id.* at TSDR 11, 13, 14. Figure 1 “illustrates a perspective view of a fire extinguisher, according to one embodiment of the present disclosure.” Figure 3 “illustrates a perspective bottom view of the fire extinguisher of FIG[URE] 1.” Figure 4 “illustrates a cross-sectional side view of a container of the fire extinguisher of FIG[URE] 1.” *Id.* at TSDR 16.

²⁹ Feb. 14, 2019 Request for Reconsideration at TSDR 9 (emphasis added).

³⁰ *Id.* at TSDR 16.

and “configured to be used in a variety of environments.”³¹ The detailed description of the invention confirms that the recessed portion allows the “fire extinguisher 100 [to] sit on a flat surface (as shown in FIG. 1)”;³² “the recessed bottom portion 136 has an edge 140 for supporting the fire extinguisher 100 in an upright manner.”³² The ’862 Utility Patent supports the advertised advantages discussed above of the recessed bottom gauge in a variety of environments, such as rough or rugged conditions.

Applicant also made of record its U.S Patent No. 10,105,561 B2, “Nozzle Cap for Fire Extinguisher” (issued Oct. 23, 2018) (the “’561 Utility Patent”).³³ The background to this patent explains that “Fire extinguishers can be stored in a variety of different environments. Some environments are harsher than others and can expose the fire extinguisher to a variety of abuse and debris. Such abuse and debris can lead to the failure of the fire extinguisher during the event of a fire, which can have catastrophic consequences.”³⁴ Figure 3 of the ’561 Utility Patent shows the recessed bottom of the fire extinguisher that proposes a solution to these problems:³⁵

³¹ *Id.* The underlying patent application explains that “ruggedized” means constructed “to withstand a drop, accidental impact, or other abuse.” *Id.* at TSDR 55.

³² *Id.* at TSDR 16-19. *See also id.* at TSDR 19 (“[W]hen mounted, the gauge 138 does not contact a generally flat surface when the edge 140 is in contact with the flat surface.”).

³³ *Id.* at TSDR 29-43.

³⁴ *Id.* at TSDR 39.

³⁵ *Id.* at TSDR 32.

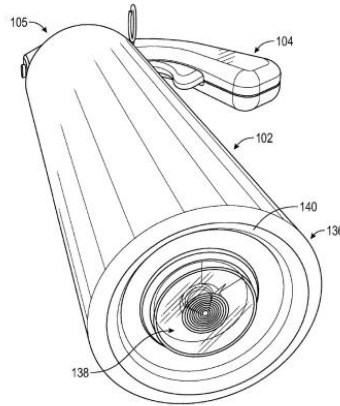


FIG. 3

Figure 3 is explained as the “depicted embodiment, [where] the gauge 138 is shown seated within the recessed bottom portion 136 so that the fire extinguisher 100 may sit on a flat surface.”³⁶ The patent claims “[a] fire extinguisher comprising: a container having a chamber for holding a fire-extinguishing agent, the container including a domed top portion that includes a valve port and a recessed bottom portion, the recessed bottom portion having an edge for standing the container generally upright”³⁷

Applicant fails to address the plain evidence of functionality shown by its utility patents in its brief: namely, that the design allows the fire extinguisher to sit on a flat surface such that it protects the gauge from abuse and debris and promotes ease of inspection. The patents also show that placing a recessed gauge on the bottom of the fire extinguisher better enables storage of the apparatus on a flat surface, in a

³⁶ *Id.* at TSDR 41.

³⁷ *Id.* at 43.

variety of vehicles, cabinets, or other storage areas where storing traditional fire extinguishers is difficult.

Given the strong weight to be accorded patent evidence under *TrafFix Devices*, we find that '862 and '561 Utility Patents also constitutes strong evidence that Applicant's proposed mark is functional. *See, e.g., In re Creative Edge Design Grp.*, Ser. No. 87287662, 2019 TTAB LEXIS 127, *13 (TTAB 2019) (utility patent is prima facie proof that packaging design for milk is functional).

C. Third and Fourth *Morton-Norwich* Factors

The third *Morton-Norwich* factor concerns the availability to competitors of functionally equivalent designs. Applicant introduced examples of competitors' fire extinguishers showing the "industry standard" charge gauge mounted on the top handle, such as the following:³⁸



³⁸ 16 TTABVUE 12 (citing evidence).

Applicant's argument, however, does not address the functional equivalence of those other designs. Moreover, once functionality is found based on other considerations, there is no need to consider this factor because the feature that is found functional cannot be given trade dress protection merely because there are alternative designs available. *In re Creative Edge Design Grp.*, 2019 TTAB LEXIS 127, at *19 (quoting *Becton, Dickinson*, 675 F.3d at 1376; and citing *TrafFix Devices*, 532 U.S. at 25 ("Where the design is functional ... there is no need to proceed further to consider if there is a competitive necessity for the feature.")). The third *Morton-Norwich* factor, therefore, is neutral.

The fourth *Morton-Norwich* factor considers whether the design results in a comparatively simple or cheap method of manufacturing the product. Because there is no relevant evidence of record on this factor, we find it neutral. *See Becton, Dickinson*, 675 F.3d at 1376 (finding fourth factor neutral for insufficient evidence); *In re Creative Edge Design Grp.*, 2019 TTAB LEXIS 127, at *20 (same).

D. Applicant's Argument and Evidence

With all of these functional features of Applicant's fire extinguishing device explained on Applicant's website and claimed in the '862 and '561 Utility Patents, Applicant "carr[ies] 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." *McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, Can. No. 92067618, 2021 TTAB LEXIS 167, *53 (TTAB 2021) (quoting *TrafFix Devices*, 532 U.S. at 30).

Applicant does not argue in its brief that the features of its proposed mark are ornamental, incidental, or arbitrary. In fact, as our discussion of the prosecution history demonstrates, Applicant struggled mightily to draw and describe its mark without reference to the functional aspects described in its advertising and patents.

Rather, Applicant falls back on a distinction it draws between what it did not apply for – a fire extinguisher in Class 9 – and what it claims is merely “packaging” for fire extinguishing preparations in Class 1:

As stated in the various Office Action refusals over the course of the applied-for mark’s prosecution history, the basic contention of the Examining Attorney is that pressure gauges on fire extinguishers – which are always near or on the handle of the apparatuses – are functional and provide utilitarian advantages to the user. Applicant concedes that a gauge is functional on a fire extinguishing apparatus in International Class 9. Here, the “gauge” on the canister is designed to alert users when the pressure in a fire extinguishing canister may be too low to expel the liquefied fire suppression chemicals. Fire extinguishers are designed purposely to expel “fire extinguishing preparations” (Applicant’s identified goods in International Class 1).

However, the critical point is that the gauge – which is uniquely placed at the bottom of the product – serves no function as applied to “fire extinguishing preparations” in International Class 1. This gauge does not even measure the amount of the “fire extinguishing preparations” within the apparatus, but instead the pressure contained within the cannister. **Measuring pressure in the container is the gauge’s only purpose.** As such, the gauge is not functional of the Applicant’s applied-for chemical preparations in International Class 1.³⁹

³⁹ 16 TTABVUE 9-10 (terms shown in bold were underlined in the original).

Applicant's argument was effectively and squarely rejected in *In re Creative Edge Design Grp.*, 2019 TTAB LEXIS 127. There, the applicant also argued it had applied for a packing design in connection with "milk," and not for the jug itself, to avoid a functional refusal under Section 2(e)(5), but as the Board explained:

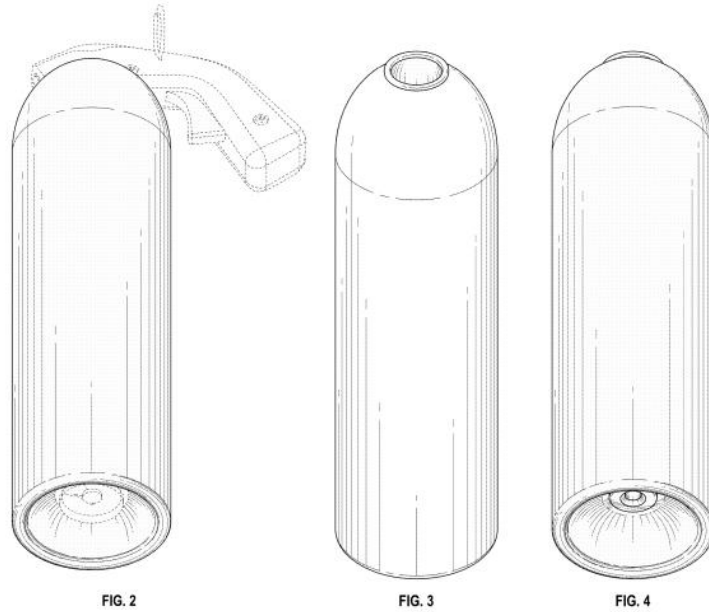
The fact that the configuration is for packaging for milk does not remove its utilitarian aspect from the applied-for goods. The stackability feature is a utilitarian advantage whether the applied-for goods are containers for milk or milk. This advantage begins when the containers are filled with milk, and continues as the milk is distributed to and then sold at the store. In *In re Mars, Inc.*, [Ser. No. 77545810, 2013 TTAB LEXIS 4, at *22] (TTAB 2013), the applicant applied for registration of the three-dimensional configuration of packaging for "pet food." The Board found it to be generic, in part, because the attributes "permit[ed] stacking of containers."

Id. at *18. Thus, assuming for the sake of argument that a fire extinguisher is "packaging," this is immaterial to the inquiry of functionality.⁴⁰ Refusal on the basis of functionality under Section 2(e)(5) of the Trademark Act may apply if the applied-for configuration is either product (as the Examining Attorney argues) or packaging (as Applicant contends).

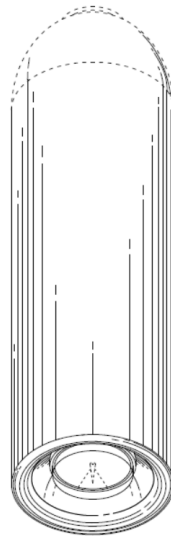
For completeness, we also address Applicant's design patent, U.S. Patent No. D813673 S (issued March 27, 2018) (the '673 Design Patent) that is of record, but

⁴⁰ Although we do not reach this question, the 2016 notes to the Trademark Next Gen (TMNG) ID Master List (No. 009-2935) confirms that "Fire extinguishers' are metal containers filled with fire extinguishing chemicals." See <https://idm-tmng.uspto.gov/id-master-list-public.html>.

which Applicant did not rely upon in its brief.⁴¹ The patent covers an ornamental design of a “spray container,” featuring the following drawings:



The applied for mark (reproduced below) corresponds closely to Figure 4 of the '673 Design Patent:



⁴¹ See 4 TTABVUE 21-29. The '673 Design Patent includes the following description: “The broken line showing of an example fire extinguisher or repellent sprayer in FIGS. 1 and 2, and of the example gauge in FIG. 2, is included to illustrate an operating environment of the spray container and forms no part of the claimed design.”

Because the '673 Design Patent appears to cover the applied-for mark, it is evidence of non-functionality. “Our law recognizes that the existence of a design patent for the very design for which trademark protection is sought ‘presumptively . . . indicates that the design is not *de jure* functional.” *In re OEP Enters.*, Ser. No. 87345596, 2019 TTAB LEXIS 278, *20-21 (TTAB 2019) (quoting *Becton, Dickinson*, 675 F.3d at 1375).⁴²

At the same time, however, the '673 Design Patent is not dispositive of non-functionality. The “fact that a device is or was the subject of a design patent does not, without more, bestow upon said device the aura of distinctiveness or recognition as a trademark.” *Id.* (quoting *Becton, Dickinson*, 675 F.3d at 1375). We must examine the totality of the evidence, including the '862 Utility Patent and Applicant’s advertising. We find that the strong and explicit evidence that the applied-for mark has utilitarian benefits rebuts any presumption of non-functionality resulting from the existence of '673 Design Patent.

E. Summary and Conclusion

Based on all of the record evidence and arguments in relation to the *Morton-Norwich* factors, we find that Applicant’s advertising and patents establish the

⁴² As explained in TMEP § 1202.02(a)(iii)(B), the USPTO no longer distinguishes between what the U.S. Court of Appeals for the Federal Circuit used to refer to as “*de facto* functional,” which means that the design of a product has a function (and “may” qualify for trademark protection), and “*de jure* functional,” which means that the product is in its particular shape because it works better in this shape (and cannot so qualify). *See Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531 (Fed. Cir. 1994) (quoting *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484 (Fed. Cir.1984)). Only what was formerly called *de jure* functionality is grounds for refusal under Section 2(e)(5).

functional benefits of Applicant's proposed mark, namely, that a recessed concave bottom of a fire extinguisher for receiving a pressure or temperature gauge is designed to protect the gauge in demanding conditions, allows the user to store the device in a variety of spaces, including placement on a flat surface, and ease of inspection. The first two *Morton-Norwich* categories of evidence show by a preponderance of evidence that Applicant's proposed mark "is in its particular shape because it works better in this shape," *Becton, Dickinson*, 675 F.3d at 1374. The third and fourth factors are neutral.

We conclude that Applicant's proposed mark is functional within the meaning of Trademark Act Section 2(e)(5), and is thus ineligible for registration on the Principal Register.

Decision

The refusal to register under Trademark Act Section 2(e)(5) is **affirmed**.⁴³

⁴³ In view of our affirmance of the Section 2(e)(5) refusal, we need not and do not reach the additional refusals based on non-distinctive trade dress and Applicant's specimen. *CBC Mtg. Agency v. TMRR, LLC*, Can. No. 92076723, 2022 TTAB LEXIS 295, *1 n.22 (TTAB 2022).