

This Opinion is Not a
Precedent of the TTAB

Hearing: May 25, 2021

Mailed: August 25, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Herman Miller, Inc.

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Serial No. 88027008

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Louise Arnott and Luke W. DeMarte of Michael Best & Friedrich LLP,
for Herman Miller, Inc.

Alison Keeley, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Heasley, Lynch, and Coggins,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

This case involves a well-known chair design dating from the 1940's, when designers Ray and Charles Eames developed a technique for molding plywood and

constructing furniture with it.¹ According to Applicant Herman Miller, Inc.'s website, "Designers Charles and Ray Eames established their long and legendary relationship with Herman Miller in 1946 with their boldly original molded plywood chairs."² The chair ultimately was recognized by *Time* magazine as the Best Design of the 20th Century, and now is in the design collections of numerous museums.³

Applicant Herman Miller, Inc. seeks registration on the Principal Register of most of the chair's configuration as a mark, shown below depicted in more than one view,⁴ for "furniture, namely, chairs" in International Class 20.⁵

¹ TSDR November 20, 2019 Office Action at 12-14 (hermanmiller.com). TSDR cites are to the pdf download format of the particular entry.

² TSDR November 20, 2019 Office Action at 9 (hermanmiller.com).

³ TSDR March 25, 2019 Response to Office Action at 84-85, 94-96; TSDR November 20, 2019 Office Action at 9 (hermanmiller.com); *e.g.*, TSDR March 25, 2019 Response to Office Action at 145 (Kirkland Museum), and 153-54, 167-77 (Museum of Modern Art).

⁴ Applicant was granted a limited waiver of Trademark Rule 2.52(b)(2), which otherwise requires marks with three-dimensional features to be depicted in a single rendition. TSDR November 7, 2018 Petition to Director Granted.

⁵ Application Serial No. 88027008 was filed July 5, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).



The mark is described as:

The mark consists of a three-dimensional configuration of a chair comprised of a curved trapezoidal seat and back, each with rounded corners but different curvatures and proportions, two arched legs, each of continuous material and offset heights which narrow toward the ground. The

broken lines depicting the spine of the chair indicate placement of the mark on the goods and are not part of the mark.

The Examining Attorney refused registration under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), on the ground that the subject matter sought to be registered is functional. Although the Examining Attorney initially also made a nondistinctiveness refusal, Applicant overcame that with a claim of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).

After the Examining Attorney made the functionality refusal final, Applicant filed a request for reconsideration and appealed. The Examining Attorney denied the request for reconsideration, maintaining the refusal. The appeal then proceeded, with briefing and an oral hearing. We affirm the refusal to register.

II. Functionality

Section 2(e)(5) of the Trademark Act provides that registration of a product design may be denied if it “comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). “The functionality doctrine guards against the ‘misuse’ or ‘over-extension’ of trademark protection for product designs.” *Kistner Concrete Prods. Inc. v. Contech Arch Techs. Inc.*, 97 USPQ2d 1912, 1919 (TTAB 2011) (citation omitted). Generally, a product design or product feature is considered functional if it is essential to the use or purpose of the product or affects the cost or quality of the product. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). “[A] functional feature is one the ‘exclusive use of [which] would put

competitors at a significant non-reputation-related disadvantage.” *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1003 (2001) (quoting *Qualitex*, 34 USPQ2d at 1164).

The functionality doctrine maintains the balance between trademark and patent law, as the Supreme Court explained in *Qualitex*:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. 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, after which competitors are free to use the innovation.

34 USPQ2d at 1163 (internal citations omitted).

In determining whether a proposed mark is functional and therefore not registrable as a trademark, we consider the following four factors identified in the seminal case *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), known as the “*Morton-Norwich*” factors:

1. the existence of a utility patent disclosing the utilitarian advantages of the design;
2. advertising materials in which the applicant 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.

In re Becton, Dickinson & Co., 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (citing *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426

(Fed. Cir. 2002) and *Morton-Norwich*, 213 USPQ at 15-16). Not all of the four factors need to be proven or weigh in favor of functionality to support a refusal. See *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833 (TTAB 2013). If functionality is established under the *Inwood* formulation (i.e., whether the matter is essential to the use or purpose of the product or affects the cost or quality of the product, see *Inwood Labs.*, 214 USPQ at 4 n.10), further inquiry into facts that might be revealed by a full analysis of all types of *Morton-Norwich* evidence will not change the result. *TrafFix*, 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.”).

A. Expired Patent Discloses Utilitarian Advantages of the Proposed Mark

The first *Morton-Norwich* factor addresses whether a utility patent discloses utilitarian advantages of the matter Applicant seeks to register. Such a patent constitutes strong evidence of functionality. *TrafFix*, 58 USPQ2d at 1005; see also *Kistner Concrete*, 97 USPQ2d at 1924 (finding utility patents sufficient to establish prima facie that design is functional). Accordingly, absent a contrary showing, this factor can be dispositive. See *In re Howard Leight Indus. LLC*, 80 USPQ2d 1507, 1515 (TTAB 2006) (finding utility patent sufficient basis in itself for holding configuration functional).

Conceding that some expired patents display the subject matter sought to be registered, Applicant contends that the claims of those patents are not directed to the subject matter it now seeks to register. In response to the Examining Attorney’s

information requirement, Applicant submitted two expired utility patents, Patent No. 2,554,490 (the '490 Patent)⁶ for "Furniture Construction" and Patent No. 2,649,136 (the '136 Patent)⁷ for "Furniture Shock Mount Construction." According to Applicant, although the patents disclose "[c]ertain aspects of Applicant's Eames Molded Plywood Chair," its "distinctive shape and appearance ... serve[] no utilitarian advantage but is merely an arbitrary aesthetic design."⁸

Applicant and the Examining Attorney concentrate their arguments under this *Morton-Norwich* factor on the '490 Patent. According to its specification, the '490 Patent "relates to furniture constructions. More particularly it pertains to a novel assembly of supporting parts for contour-conforming, individually mounted back and seat panels."⁹ The patent drawings depict the preferred embodiment, and show a chair that looks identical to that in the proposed mark drawing. We recognize that the patent claims include, and even focus on, the spine that attaches to the seat, back, and legs, and Applicant has excluded the spine from the proposed mark by depicting it in dotted lines in the mark drawing. However, the patent claims also cover other significant features of the proposed mark that serve a functional purpose for the furniture construction and are placed in the appropriate positions for use with the resilient spine (what the patent calls "the relationships among the spine and the relatively inert associated members which make up the chair"). In particular, the

⁶ TSDR March 25, 2019 Response to Office Action at 39-43.

⁷ TSDR March 25, 2019 Response to Office Action at 44-50.

⁸ TSDR March 25, 2019 Response to Office Action at 21.

⁹ TSDR March 25, 2019 Response to Office Action at 41, Col. 1, lines 1-5.

Serial No. 88027008

thin, body-contoured seat and back are claimed, as are the front and rear leg frames, which are situated so that the rear leg frame is shorter than the front leg frame.

Relevant portions of the '490 Patent,¹⁰ starting with the drawings and specification, then moving to the claims, include:

¹⁰ TSDR March 25, 2019 Response to Office Action at 39-43.

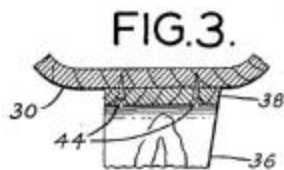
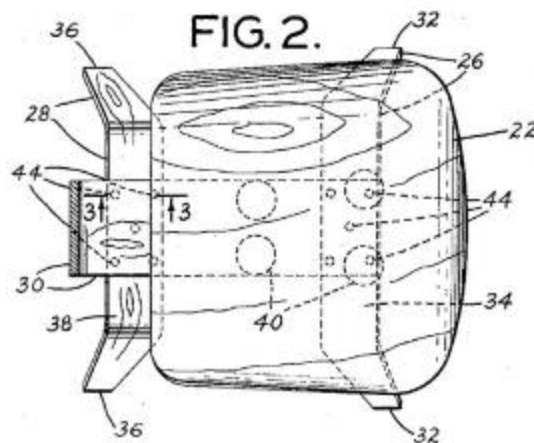
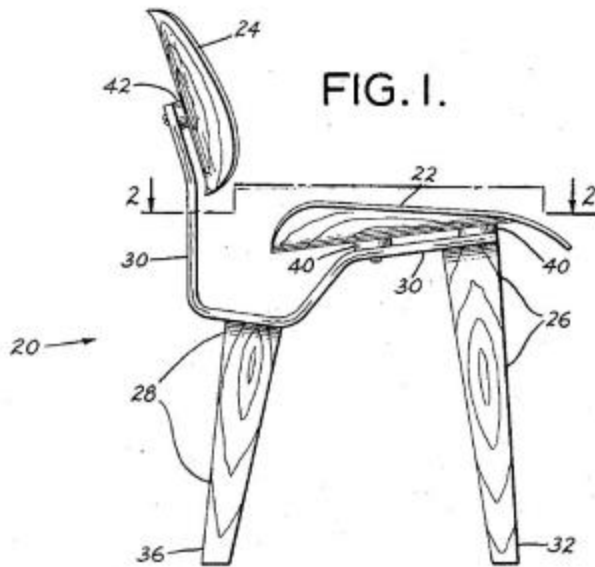
May 29, 1951

C. EAMES
FURNITURE CONSTRUCTION

2,554,490

Filed March 1, 1947

2 Sheets-Sheet 1



INVENTOR.

CHARLES EAMES

BY
Blair, Curtis & Hayward
ATTORNEYS.

May 29, 1951

C. EAMES
FURNITURE CONSTRUCTION

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2 Sheets-Sheet 2

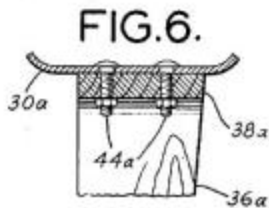
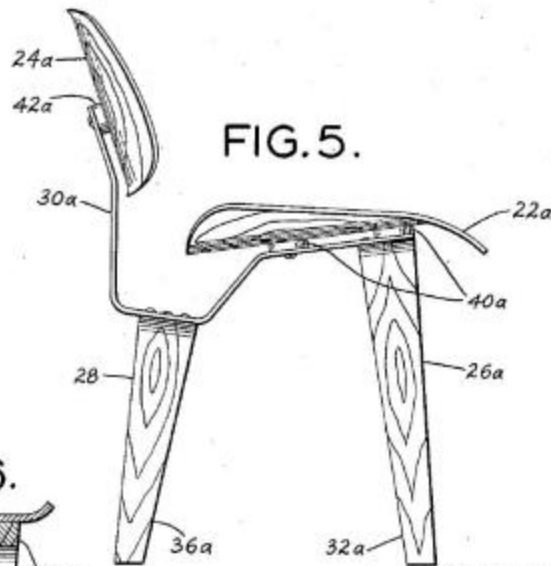
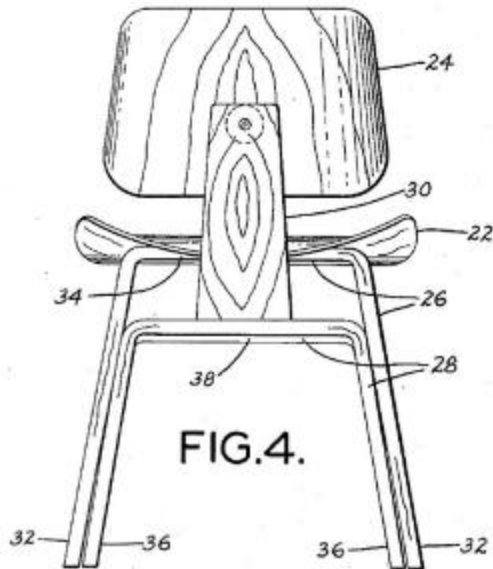


FIG. 5.

FIG. 6.

INVENTOR,
CHARLES EAMES

BY
Blair, Curtis & Hayward
ATTORNEYS.

- “More particularly [this invention] pertains to a novel assembly of supporting parts for contour-conforming, individually mounted back and seat panels. With this construction, the panels are disposed in a slightly yieldable way so that a

chair, for example, embodying the invention remains restful and comfortable over long periods of use and yet may be inexpensively manufactured by mass production methods.” Col. 1, lines 2-5.

- “In Figure 1 a chair is generally indicated at 20 comprising a contour-conforming seat 22 and back 24. A front leg frame 26 and rear leg frame 28 together support a spine. Seat 22 and back 24 are mounted upon and carried by spine 30.” Col. 2, lines 15-19.
- “It is to be observed that the point where the spine is secured to rear cross piece 38 is substantially below the level of the seat so that the rear column portion of the spine is relatively long.” Col. 3, lines 42-26.
- “A furniture construction of the character described having a body-contour-conforming, independently mounted back and seat, said construction including a spine extending rearwardly from a point under the central forward portion of the seat thence downwardly and rearwardly and finally upwardly substantially vertically to a point behind the central portion of the back” Col. 4, lines 53-60 (Claims 3 & 4).
- “[T]he point of attachment between rear leg frame and spine being intermediate and substantially spaced from the points of attachment of the seat and back to the spine and being substantially lower than the point of attachment between the spine and front leg frame.” Col. 5, lines 15-20 (Claim 4).

Applicant maintains that although the features of its mark are illustrated in the drawings of the '490 Patent, the claims (which describe the metes and bounds of the invention) are not directed to these features. According to Applicant, "the spine is the invention," and the seat, back and legs in its proposed mark "are not essential to the invention."¹¹ In *Becton, Dickinson*, the Federal Circuit rejected a similar argument regarding features addressed in a patent specification but not the claims, holding that "statements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality," and "*TrafFix* does not require that a patent claim the exact configuration for which trademark protection is sought." *Becton, Dickinson*, 102 USPQ2d at 1377.

In essence, Applicant's proposed mark is identical to the preferred embodiment in the '490 Patent, except that the spine of the chair has been dotted out, remaining in the mark drawing only to show the placement of the other features of the proposed mark in conjunction with the chair.¹² The proposed mark's contour-conforming separate seat and back panels, and its front and rear single-piece leg frames, which attach to the chair's spine, with the rear leg frame shorter than the front leg frame, form part of the patented furniture construction, which calls for the placement of these elements on the spine just as they are placed in the proposed mark, and explains their useful purposes. *See, e.g., In re Heatcon, Inc.*, 116 USPQ2d 1366, 1372-

¹¹ 15 TTABVUE 5 (Applicant's Reply Brief).

¹² Applicant erroneously refers to the spine being the subject of a disclaimer in the subject application. *E.g.* 6 TTABVUE. A disclaimer would be inappropriate because, as indicated by Applicant's description of the mark, the spine shown in dotted lines is "not part of the mark."

73, 1378 (TTAB 2015) (finding arrangement of features functional, observing that the disclosures and preferred embodiments include aspects directed to the placement and arrangement of the functional elements).

“When the patent claims are compared to the trademark [application], it is readily apparent how important the elements of the trademark, as described in the trademark [application], are to the patentability of the invention.” *Kistner Concrete*, 97 USPQ2d at 1923. In this case, the contours of the seat and back, the single-piece designs and differing heights of the leg frames, as well as their placement along the spine, contribute to the “restful and comfortable” nature of the chair, and the ability to “inexpensively manufacture [it] by mass production methods,” as explicitly stated in the patent.¹³ *Becton, Dickinson*, 102 USPQ2d at 1377; *contrast Grote Ind., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1206 (TTAB 2018) (“nowhere in the patent are any advantages of the six-diode design specifically disclosed.”). Also according to the ‘490 Patent, “[f]or ease of transportation and storage,” the seat is designed to be independently mounted and removable from the spine.¹⁴ While Applicant has omitted

¹³ We note that the ‘136 Patent teaches a combination of elements “formed from thin sheet material,” and states that “[t]he invention accordingly resides in the features of construction, combinations of elements, and arrangements of parts as will be exemplified in the structures hereinafter indicated” TSDR March 25, 2019 Response to Office Action at 46, Col. 1, lines 7-8; Col. 2, lines 13-15. The combination of elements includes “seat and back panels ... preferably made of relatively thin molded plywood or of thin metal, and are molded or shaped to have curved sectional contours to conform comfortably to the contours of a seated person.” TSDR March 25, 2019 Response to Office Action at 47, Col. 3, lines 10-14. In particular, Claim 9 of the ‘136 Patent refers to “a furniture construction wherein seat and back elements include a flexible plywood panel of curved sectional contour approximately conforming to body contours of a person in seated position” TSDR March 25, 2019 Response to Office Action at 50, Col. 10, lines 1-5. We find that the ‘136 Patent corroborates the functionality of the contoured seat and back panels of the proposed mark.

¹⁴ TSDR March 25, 2019 Response to Office Action at 41, Col. 2, lines 45-47.

the spine from its proposed mark, the combination of the other elements and their placement on the spine, which **are** in the trademark drawing, are disclosed and claimed in the patent, reflecting their effect on the quality and cost of the chair.

Applicant cannot avoid the functionality refusal merely by dotting out the spine, but retaining all the other elements in the '490 Patent's preferred embodiment, which are constructed in a particular manner around and joined to the spine in exactly the configuration shown in the proposed mark. While Applicant maintains that the chair design in its proposed mark "is not claimed in a utility patent and was informed by aesthetic design choices,"¹⁵ we are not persuaded. According to *TrafFix*, 58 USPQ2d at 1007:

In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent.

Applicant's arguments and evidence in this regard fail to establish that the proposed mark consists only of arbitrary, incidental, or ornamental aspects of the chair design. Here, the '490 Patent refers to the functional aspects of significant features of the proposed mark. Applicant contends that in the '490 Patent, "the spine is the invention," and "the *specific* seat, back, and legs claimed in the Eames Molded Plywood Chair Design are not essential to the invention."¹⁶ However, the patent

¹⁵ 15 TTABVUE 4 (Applicant's Reply Brief).

¹⁶ 15 TTABVUE 5 (Applicant's Reply Brief) (emphasis in original).

claims features of the seat, back, and legs found in the proposed mark, and claims the manner of placement of these features on the spine, as found in the preferred embodiment chair, just as they appear in the proposed mark. *See In re Change Wind Corp.*, 123 USPQ2d 1453, 1457 (TTAB 2017) (where proposed mark appeared identical to preferred embodiment drawing in patent for wind turbine, except for certain matter dotted out in the mark drawing, the Board rejected the applicant's argument that "no utilitarian advantages are described by the patent with respect to the applied-for mark"; the Board found that the patent disclosed "the functional role of the three components disclosed and claimed in Applicant's drawing of the mark").

We consider the entirety of patents -- both claims and disclosures -- and have found functional proposed marks depicting the preferred embodiment described in a utility patent. *Kistner Concrete*, 97 USPQ2d at 1923, 1931; *Howard Leight*, 80 USPQ2d at 1515; *In re Edward Ski Prods.*, 49 USPQ2d 2001, 2003 (TTAB 1999); *In re Lincoln Diagnostics Inc.*, 30 USPQ2d 1817, 1823 (TTAB 1994) (finding applicant's design not identical to the design of the preferred embodiment depicted in the patent, but substantially similar in appearance and function), *aff'd mem.*, 41 F.3d 1519 (Fed. Cir. 1994). Here, in order to practice the now-expired '490 Patent in its preferred embodiment, the features of Applicant's proposed mark must be constructed as they are shown in the '490 Patent and placed around the spine in the manner that they appear in the proposed mark. *See Valu Eng'g*, 61 USPQ2d at 1425 (once patent expires, "competitors are free to use the innovation," so trademark protection is inappropriate for patented features).

We find the claims and description of the invention in the '490 Patent, taken together with the drawings therein, on point with the description and drawing of the proposed mark. The '490 Patent indicates that the features of the proposed mark are essential to the use and purpose of the chair, and affect its cost and quality. The patent thus is strong evidence that the matter is functional. *See TrafFix*, 58 USPQ2d at 1005; *Becton, Dickinson*, 102 USPQ2d at 1377. To issue a trademark registration covering Applicant's proposed mark would frustrate the policies of patent law whereby, upon the expiration of the '490 Patent, competitors should be free to practice the invention. *See TrafFix*, 58 USPQ2d at 1007; *Valu Eng'g*, 61 USPQ2d at 1425.

B. Advertising Touts Utilitarian Advantages of Some Features of the Proposed Mark

Under the second *Morton-Norwich* factor, we consider evidence regarding "advertising materials in which the originator [or seller] of the design touts the design's utilitarian advantages." *Valu Eng'g*, 61 USPQ2d at 1426 (citing *Morton Norwich*); *see also Heatcon*, 116 USPQ2d at 1373. "If a seller advertises the utilitarian advantages of a particular feature of its product, this constitutes strong evidence of functionality." *Kistner*, 97 USPQ2d at 1924.

Applicant's advertising includes the following statements:

- "Sculpting a seat and back to fit the contours of the human body, they designed a truly comfortable chair that's suitable for businesses and homes."¹⁷

¹⁷ TSDR April 17, 2019 Office Action at 24 (hermanmiller.com).

- “The technique Charles and Ray Eames invented to mold plywood veneer into gentle curves resulted in an inviting chair of contoured comfort”¹⁸
- “The contours the molding process creates out of plywood fit the body’s shape.”¹⁹
- “When the war was over, Charles and Ray applied the technology they had created to making affordable, high-quality chairs that could be mass-produced using dimensionally shaped surfaces instead of cushioned upholstery. When they found that plywood did not withstand the stresses that occurred where the chair and seat back met, they abandoned their original single-shell idea in favor of a chair that had separate molded-plywood panels for the back and seat.”²⁰

The promotional material of SmartFurniture, which sells Herman Miller Eames Molded Plywood Lounge Chairs, states:

- “The curve of the seat matches the curve of a human at rest, and you’ll fit right into it when you sit down. The same goes for the back of the chair, which is both low and expansive; that keeps your lower back supported (your lumbar region) while at the same time keeping your neck and shoulders free to move. That helps your circulation.”²¹

¹⁸ TSDR April 17, 2019 Office Action at 25 (hermanmiller.com).

¹⁹ TSDR November 20, 2019 Office Action at 10 (hermanmiller.com).

²⁰ TSDR November 20, 2019 Office Action at 13 (hermanmiller.com).

²¹ TSDR November 20, 2019 Office Action at 21 (smartfurniture.com).

- “Another element of the design that is sometimes overlooked is how carefully calibrated it is to the human form. The chair is comfortable, not just beautiful, and it’s [sic] natural curves draw the user in and keep them sitting in comfort for hours. The back and seat of the chair are both finely drawn to accommodate the human form in several shapes and sizes.”²²

The Examining Attorney points to other third-party sources as well.²³

Applicant counters that this evidence “does not mention, let alone tout, the specific design elements of the chair claimed herein as providing utility,” and emphasizes that “[t]here is no evidence in the record that the claimed chair design comprised of a trapezoidal seat and back and arched tapered legs is dictated by comfort or support.”²⁴

While we agree with Applicant that the trapezoidal outline of the seat and back and the arched tapering legs are not explicitly touted, other significant features of its proposed mark are. For example, both Applicant’s and SmartFurniture’s materials greatly emphasize the curve of the seat and back and their contouring to fit the human body. SmartFurniture refers to the shape of the back, noting that it’s “low and expansive” to support ergonomics and “help[] your circulation.”²⁵ *See In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) (“[T]he clear import of the advertisement is that the shape of the guitar is what produces a better musical

²² TSDR November 20, 2019 Office Action at 21 (smartfurniture.com).

²³ 14 TTABVUE 9 (Examining Attorney’s Brief) (citing Titteringmachines.com and Wikipedia.org).

²⁴ 15 TTABVUE 8 (Applicant’s Reply Brief).

²⁵ TSDR November 20, 2019 Office Action at 21 (smartfurniture.com).

sound.”); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260 (TTAB 1993) (applicant touts the utilitarian advantages of its product configuration, which demonstrates its superior design). Some of Applicant’s own submissions on the design significance of the Eames molded plywood chair emphasize utilitarian advantages, such as the essay noting, “[a]fter an exhaustive program of prototyping and testing, the first product was a simple plywood chair with both the seat and back supports gently curved so as to ergonomically and comfortably accommodate the human body.”²⁶

Another example comes from an entry on the chair design from the Kirkland Museum of Fine & Decorative Art. The entry refers to the LCW [lounge chair wood], another term for the Eames molded plywood chair, stating:

Husband-and-wife design team Charles and Ray Eames researched inexpensive techniques of wood molding and laminating during World War II, adapting Charles’s work with the Navy to develop molded plywood leg splints. They made a series of plywood chairs as a result, with the LCW’s seat and back molding to the human body to provide optimal comfort. Because of the chair’s comfort, the manufacturer did not need to upholster it.... They intended for the LCW to be an economical, industrially-produced option.... By abandoning upholstery and using plywood, the Eameses made this design less expensive.²⁷

In “Charles Eames: Furniture from the Design Collection,” The Museum of Modern Art describes the Eames approach to the molded plywood lounge chair as

²⁶ TSDR March 25, 2019 Response to Office Action at 141 (Heilbrunn Timeline of Art History, Metropolitan Museum of Art).

²⁷ TSDR March 25, 2019 Response to Office Action at 145 (Kirkland Museum).

“separating functions and defining them in the narrowest possible way, so that each will require a specific shape and material”²⁸

Applicant claims that its advertising promotes “appearance and global renown,” but not functionality. Ultimately, however, we find that this evidence indicates that the proposed mark “looks the way it does in order to be a better chair, not in order to be a better way of identifying who made it (the function of a trademark).” *Specialized Seating, Inc. v. Greenwich Indus., L.P.*, 616 F.3d 722, 96 USPQ2d 1580, 1583 (7th Cir. 2010).

C. Alternative Designs

The third *Morton-Norwich* factor concerns the availability of functionally equivalent designs. Applicant argues that there are many alternative designs already in existence in the marketplace. According to Applicant, “it is clear that a prohibition on the copying of the particular combination of elements comprising Applicant’s mark would not limit others’ abilities to manufacture chairs, or even plywood chairs for that matter.”²⁹ The Examining Attorney contends that the proposed mark consists of the seat, back and legs that constitute “fundamental and simple elements of chair design,” and that “[t]he placement and shape of these elements determine[] the comfort and ergonomics of the chair.”³⁰

²⁸ TSDR March 25, 2019 Response to Office Action at 172 (Museum of Modern Art).

²⁹ 6 TTABVUE 17 (Applicant’s Brief).

³⁰ 14 TTABVUE 11 (Examining Attorney’s Brief).

The Examining Attorney points to third-party molded plywood chairs with identical or similar designs,³¹ and indeed, “[i]t is probative of functionality that others in the industry use similar designs; they do not have to be identical.” *Change Wind*, 123 USPQ2d at 1465 (citing *Becton, Dickinson*, 102 USPQ2d at 1378). However, Applicant alleges that these third-party chairs are “knockoffs,” and merely show attempts “to profit off the ... goodwill of the iconic Eames Molded Plywood Chair Design.”³²

Because the first two factors show that Applicant’s proposed mark is functional and affects the cost and quality of the chair, we need not address the availability of other designs. *See TrafFix*, 58 USPQ2d at 1005; *Becton, Dickinson*, 102 USPQ2d at 1378 (where “the patent and advertising evidence established functionality, the Board did not need to analyze whether alternative designs exist”). “[O]nce a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.” *Valu Eng’g*, 61 USPQ2d at 1427. “The availability of alternative designs does not convert a functional design into a non-functional design.” *Kistner*, 97 USPQ2d at 1928 (citing *TrafFix*, 58 USPQ2d at 1007). *See also Specialized Seating*, 96 USPQ2d at 1584 (“A novel or distinctive selection of attributes on these many dimensions can be protected for a time by a utility patent or a design patent, but it cannot be protected forever as

³¹ *E.g.*, TSDR November 20, 2019 Office Action at 26-34, 42-51 (various retail websites).

³² 15 TTABVUE 9 (Applicant’s Reply Brief).

one producer's trade dress. When the patent expires, other firms are free to copy the design to the last detail in order to increase competition and drive down the price that consumers pay.”).

The facts in this case illustrate the justification for this policy, given that even when alternatives are considered under this factor, “the question is not whether there are alternative designs that perform the same basic function but whether the available designs work ‘equally well.’” *In re Dietrich*, 91 USPQ2d 1622, 1636 (TTAB 2009) (quoting *Valu Eng'g*, 61 USPQ2d at 1427); see also MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:75 5th ed. Registration of Applicant's proposed mark would not only prevent competitors rightfully seeking to practice the now-expired '490 Patent from replicating the preferred embodiment, but would also deter them from using similar designs that might be deemed infringing. See *In re Vertex Group LLC*, 89 USPQ2d 1694, 1704 (TTAB 2009) (finding that the third *Morton-Norwich* factor favors functionality where registration of proposed mark would deprive competitors of “many” but not all options within the optimal range). A competitor who copies the spine from the '490 Patent to make a comfortable chair would tend to use leg frames with differing heights dictated by the curvature and point of attachment of the spine, and a seat and back, shaped and curved for comfort, that allow for attachment to the spine at the appropriate places. Consequently, many functionally equivalent alternative designs, which necessarily would share many of the functional features of Applicant's proposed mark, would at least arguably resemble Applicant's design to some extent. Competitors “would not know if the features which they are

using in their products, whose overall configurations are not dissimilar from that of the applicant, subject them to a suit for trademark infringement.” *In re R.M. Smith, Inc.*, 219 USPQ 629, 634 (TTAB 1983), *aff’d*, 222 USPQ 1 (Fed. Cir. 1984). We must “ensure that one who seeks to establish trade dress protection in a product configuration does not stifle competition due to uncertainty about exactly which non-patentable product designs adopted by the junior user might comprise infringing trademark configurations.” *In Re Udor U.S.A., Inc*, 89 USPQ2d 1978, 1986 (TTAB 2009).

The record in this case, including the patents, the advertising, and the articles on Charles and Ray Eames and their chair design at issue, makes clear that competitors would be disadvantaged in trying to find alternative designs that would work **equally** well. According to the ‘490 Patent, “the various known seat and back panel supporting structures, conventional and otherwise, leave much to be desired insofar as are concerned ease of manufacture and effectiveness in performing the intended functions.”³³ The proposed mark combines simply-shaped, independently mounted seats and backs to simply-shaped legs in a way that renders the chair comfortable, ergonomic and flexible even when made of hard material, conducive to mass production relatively inexpensively, and reasonably easy to transport because it can be done in separate pieces. Alternative designs would not work equally well in this sense. *See In re Bose*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985) (“If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior

³³ TSDR March 25, 2019 Response to Office Action at 41, Col. 1, lines 16-21.

designs for its de facto purpose, it follows that competition is hindered”). Even Applicant’s own website promotes the chair design as “Much copied but never bettered.”³⁴

D. Comparatively Simple or Cheap Method of Manufacture

The fourth *Morton-Norwich* factor addresses whether the design results from a relatively simple or cheap method of manufacturing the product. *See also TrafFix*, 58 USPQ2d at 1006 (a product feature is functional “if it affects the cost ... of the article.” Again, given our earlier findings, we need not reach the fourth factor, but in the interest of completeness, we address arguments under it.

The proposed mark and evidence about it in the record reflect the simplicity of the chair design, with relatively few pieces. The Examining Attorney points to a statement from the Herman Miller website that the designers “applied the technology they had created to making affordable, high-quality chairs that could be mass-produced using dimensionally shaped surfaces instead of cushioned upholstery.”³⁵

In addition, as noted above, according to the ‘490 Patent, furniture such as the preferred embodiment chair “may be inexpensively manufactured by mass production methods.”³⁶ One museum described that the designers “intended for the [chair] to be

³⁴ TSDR November 20, 2019 Office Action at 9 (hermanmiller.com, quoting *Time* magazine).

³⁵ TSDR November 20, 2019 Office Action at 13 (hermanmiller.com).

³⁶ TSDR March 25, 2019 Response to Office Action at 41, Col. 1, lines 2-5.

an economical, industrially-produced option.... By abandoning upholstery and using plywood, the Eameses made this design less expensive.”³⁷

Applicant fails to provide information about the true cost of manufacturing the chair, and instead claims that we should look to the “price of the Eames Molded Plywood chair itself, which is expensive, with retail prices starting at \$945 per chair.”³⁸ The Examining Attorney “acknowledges that the technology has changed since the initial design of these goods and that the goods are now sold as expensive luxury items,” but that “current demand based on the historical fame of the chair does not indicate that the goods are currently made with more expensive manufacturing methods.”³⁹

While the record suggests that the design can be mass-produced, and the curvature of the seat and back was considered cost-saving at time it was designed in the 1940’s because it avoided upholstery, given the absence of current evidence about the cost of manufacture, we find the record inconclusive on this factor. We decline Applicant’s invitation to rely on the retail price of the chair, because the price does not necessarily correlate with the cost of manufacture, the relevant inquiry under *Morton-Norwich*. Applicant’s chair design has achieved considerable renown, and is a museum piece, which likely drives its retail price. We find this *Morton-Norwich* factor neutral.

³⁷ TSDR March 25, 2019 Response to Office Action at 145 (Kirkland Museum).

³⁸ 6 TTABVUE 25-26 (Applicant’s Brief).

³⁹ 14 TTABVUE 15 (Examining Attorney’s Brief).

E. Applicant's Other Arguments

To the extent Applicant argues that the outer trapezoidal shape of the seat and back of the chair and the narrowing of the chair legs as they descend render the proposed mark non-functional, we disagree. The record includes some indication that the outer shape of the seat back is ergonomic and promotes good circulation. Not only the curves of the seat and back, but also their outer shape, conform to the body. We do not find the narrowing chair legs significant enough in the overall design to avoid functionality. “Whenever a proposed mark includes both functional and nonfunctional features, as in this case, the critical question is the degree of utility present in the overall design of the mark.” *Becton, Dickinson*, 102 USPQ2d at 1373. The proposed mark as a whole is functional, and “a mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.” *Id.* at 1374.

We find this case distinguishable from *In re Honeywell Inc.*, 8 USPQ2d 1600, 1604 (TTAB 1988), *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F.Supp. 2d 217, 225 (SDNY 2004), and the non-precedential cases cited by Applicant for the proposition that having functional elements need not result in overall functionality. The cases involve completely different functionality analyses where, for example, the marks did not read on any utility patents. Moreover, unlike in *Honeywell* and *Cartier*, we find that here, the functional features “outweigh ... the other decorative and non-functional aspects,” and the mark as a whole is considered functional. *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1499 (TTAB 2017). In considering all of

the matter in Applicant's proposed mark, we do not find that the non-functional elements outweigh the overall functionality.

Applicant relies on the issuance of other trademark registrations for chair configurations, including some issued to Applicant, to "demonstrate that chairs comprised of basic elements common to most chairs does not render them unregistrable."⁴⁰ Applicant also cites to *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 2020 USPQ2d 10705 (9th Cir. 2020) for the proposition that other chairs designed by Charles and Ray Eames and sold by Applicant "were found to be protectable trade dress and not functional."⁴¹

In *Blumenthal*, unlike this case, no patents were at issue, and Applicant "introduced abundant evidence that the [Thin Pad and Soft Pad] Eames chairs' overall appearances derive from non-utilitarian design choices." 2020 USPQ2d 10705 at **16. Thus, we do not consider the case factually similar to this one. For much the same reasons, the registrations for different chair configurations would entail highly fact-specific inquiries, different considerations under the *Morton-Norwich* factors, and are not informative here. Each application must be considered on its own merits based on the record in the application under consideration, and neither the USPTO's examining attorneys nor the Board are bound by the decisions of other examining attorneys in other applications. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("The PTO is required to examine all trademark

⁴⁰ 6 TTABVUE 6 (Applicant's Brief).

⁴¹ 6 TTABVUE 11 (Applicant's Brief).

applications for compliance with each and every eligibility requirement . . .”). These registrations are unavailing in our analysis.

Finally, Applicant argues that its design is distinctive. We note that the application is subject to a claim of acquired distinctiveness. Nevertheless, the Trademark Act specifically excludes functional material under Section 2(e)(5) from registration pursuant to Section 2(f) claims of acquired distinctiveness. *See* 15 U.S.C. § 1052(f) (“Except as expressly excluded in subsection[. . .] (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”); *see also TrafFix*, 58 USPQ2d at 1007 (“The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller”).

III. Conclusion

When considering the proposed three-dimensional product configuration mark as a whole, the *Morton-Norwich* factors indicate that it is functional. The patent evidence, the advertisements touting the utilitarian advantages of significant design features of the proposed mark, and the limited availability of alternative designs that would work equally well highlight that the features of the proposed mark affect the cost and quality of the chairs. *See TrafFix*, 58 USPQ2d at 1006. The proposed mark therefore cannot be registered.

Decision: The refusal to register Applicant’s proposed mark is affirmed.