

This Opinion is Not a  
Precedent of the TTAB

Mailed: June 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Interpage International, Inc.*

Serial No. 88586036

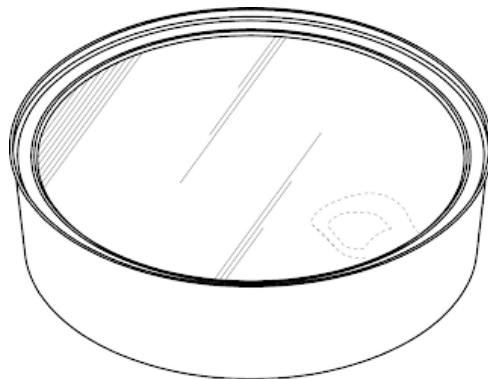
Charles H. Knull of Knull PC,  
for Interpage International, Inc.

Christopher M. Nunley, Trademark Examining Attorney, Law Office 104,  
Zachary Cromer, Managing Attorney.

Before Cataldo, Wellington, and Shaw,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Interpage International, Inc. (“Applicant”) seeks registration on the Supplemental  
Register of the following package configuration design:



for “preserved fish; tinned fish; canned fish” in International Class 29.<sup>1</sup> The mark is described in the application as follows:

The mark consists of a three dimensional trade dress design of a package of Applicant’s goods. The three dimensional product packaging is in the shape of a cylinder. The top of the product packaging is a transparent circle, represented by vertical lines, through which the product may be seen. The dotted lines on the top of the product packaging represents a pull-tab that is not a part of the mark. The solid portions represent the opaque areas of the product packaging.

The Trademark Examining Attorney refused registration of Applicant’s mark under Sections 23(c) and 45 of the Trademark Act (“the Act”), 15 U.S.C. §§ 1091(c) and 1127, on the grounds that Applicant’s mark is “a functional design” and “a generic configuration of packaging that fails to function as a Trademark.”<sup>2</sup>

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. We affirm the refusal to register on the bases that the proposed package configuration design mark is functional and that it fails to function as a mark.

## **I. Applicant’s Prior Application - Preclusion Arguments**

Applicant previously filed an application (“prior application”) that was subject to an appeal decided by the Board. In the prior application, Applicant sought to register what is essentially the same package configuration design as the one at issue in this

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<sup>1</sup> Application Serial No. 88586036, filed on August 20, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use of the mark anywhere and in commerce on December 1, 2012.

<sup>2</sup> 8 TTABVue 3.

appeal and for some of the same goods.<sup>3</sup> Applicant sought registration on the Principal Register under Section 2(f) of the Act based on an allegation of acquired distinctiveness. The Examining Attorney<sup>4</sup> made final a refusal on the ground that the package configuration design is functional, and on the ground that it is not inherently distinctive and Applicant's showing of acquired distinctiveness was insufficient. Applicant appealed and the Board issued a final decision finding the Office did not meet its burden of proof as to the functionality ground, but affirmed the refusal on the ground that Applicant did not satisfy its burden of showing acquired distinctiveness.<sup>5</sup>

Applicant now argues that, based on the Board's decision involving the prior application, "Res Judicata, Collateral Estoppel, and Stare Decisis required the Examiner not to continue to refuse on the basis of functionality," citing TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1217 (October 2018).<sup>6</sup> The referenced section of TMPE and the cases cited therein, however, discuss the preclusion doctrines of "res judicata, collateral estoppel, and stare decisis" only in the context of applicants being precluded, and not the other way around, i.e., preclusion effect on the Office. See also, e.g., *In re Solarwindow Tech., Inc.*, 2021 WL 877769 (TTAB 2021)

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<sup>3</sup> Application Ser. No. 87346100, was filed on February 22, 2017. The package configuration design in that application did not have the dotted outline of the "pull-tab," and was for "canned fish; tinned fish."

<sup>4</sup> The Examining Attorney responsible for the application at issue was also responsible for the prior application.

<sup>5</sup> 10 TTABVUE (Ser. No. 87346100).

<sup>6</sup> Applicant's October 9, 2020 Request for Reconsideration, TSDR p. 1.

(Res judicata applicable and applicant precluded from registration based on a prior final decision involving same applicant, mark, and goods or services, and no change in circumstances.)

Applicant also cites to the Board's decision in *In re Anderson*, 101 USPQ2d 1912 (TTAB 2012), in support of its conclusion that the functionality refusal "must be rejected."<sup>7</sup> However, *Anderson* involved the question of whether a Board decision in a prior inter partes proceeding had preclusive effect on an applicant in an ex parte appeal on the basis of collateral estoppel. *Id.* at 1917 ("Here the examining attorneys seek to invoke the doctrine of collateral estoppel in ex parte proceedings based on a final judgment entered in a prior inter partes case.")

In contemplating any possible preclusion on the Office from raising the same ground for refusal based on that same ground having been reversed in a previous appeal, we keep in mind the Office's role in the examination of trademark applications and ex parte appeals. Specifically, the Office, through the assigned examining attorney, is fulfilling its statutory obligation of determining an applicant's entitlement to registration. 15 USC § 1062 ("Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made [whether] applicant is entitled to registration.") In other words, the Office is performing an administrative function on behalf of the public by allowing the registration of registrable marks and disallowing unregistrable marks, thus helping maintain the integrity Principal or Supplemental registers. "Ex parte cases are those

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<sup>7</sup> 6 TTABVue 9.

in which the conflict arises between an applicant [and the Office], which acts as the representative of the public.” 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 21:1 (5th ed.). Thus, while the Office is a ‘representative of the public,’ it is not a party in an ex parte appeal. See *In re McKee Baking Co.*, 219 USPQ 759, 760 (TTAB 1983) (“In an ex parte proceeding there is only one party [applicant]...”), overruled, in part, on a different ground in *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992).

We further note that there is a strong public interest in preventing the registration of marks that are functional. As the Supreme Court has explicitly stated, “[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.*, 514 U.S. 159, 34 USPQ2d 1161, 1165 (1995). Allowing registration of a functional design inhibits legitimate competition by, in effect, granting a monopoly over a non-reputational, or non-source-identifying, feature of a product. *Id.* at 1163-64. “[T]he 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.” *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). Or, as the Federal Circuit put it, “[i]f 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.” *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985).

Should the Office be precluding from asserting a ground for refusal for a second time, this may obfuscate its role and result in the registration of otherwise unregistrable marks. For these reasons, the Office should not be precluded from raising a functionality ground for refusal, even if the Office failed to meet its burden in proving the ground in a prior appeal proceeding involving the same applicant, same mark, and same goods or services.

Furthermore, although the Board should strive for consistency in our holdings, we are not compelled to reach the same determination as to functionality of Applicant’s package configuration mark, particularly given a different record has been adduced by the Examining Attorney and Applicant in this appeal. *See In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, 2020 BL 293819 (TTAB 2020) (Board’s “duty is to decide each case on its own merits” and “is not bound by decisions of examining attorneys who examined applications for an applicant’s previously registered marks based on different records.”), citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement ... even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) (“[C]onsistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to

proper determinations under the Trademark Act and rules.”); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) (“The issuance of Applicant’s first registration does not require the approval of a second registration if, on the facts of the case, it would be improper to do so under the governing legal standard.”).

Ultimately, the issue of whether the Board is bound by the earlier decision is discretionary. As stated by the Board in a similar context:

The doctrine of stare decisis may be defined as the policy of courts to stand by precedent and not to disturb a settled point. See: *Black’s Law Dictionary*, 5th ed. (1979). Essentially, this doctrine provides that, when a court has once laid down a principle of law as applicable to a certain set of facts, it will adhere to that principle, and apply it to all future cases, where the facts are substantially the same, regardless of whether the parties and properties are the same. *Id.* It is clear, however, that this doctrine is one of policy and whether a previous holding of the court shall be adhered to, modified, or overruled is within the court’s discretion under the circumstances of the case before it. *Id.*

*In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1410 (TTAB 1988) (Board was not bound by stare decisis when presented with a different record responsive to Board’s earlier criticism that the evidence was “lacking”). See also *Flower Indus., Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987) (finding that applicant was not barred under the doctrine of issue preclusion from relitigating its right to register the same mark previously found unregistrable)

In sum, the doctrines of res judicata or collateral estoppel do not preclude the Office from asserting the functionality ground for refusal.

## II. Functionality

Section 23(c) of the Trademark Act provides:

For the purposes of registration on the Supplemental Register, a mark may consist of . . . any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

15 U.S.C. § 1091(c).

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, 58 USPQ2d 1001, 1006 (2001) (citations omitted); *Qualitex*, 34 USPQ2d 1163-64 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). See also *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882; *In re Mars, Inc.*, 105 USPQ2d 1859 (TTAB 2013).

Our determination of functionality is generally guided by the analysis first applied in *In re Morton-Norwich*, 213 USPQ 9, 15-16 (CCPA 1982). See *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1489 (TTAB 2017); *Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1513 (TTAB 2017); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017). *Morton-Norwich* identifies the following inquiries or categories of evidence as 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. These functionality considerations “are not exclusive, however, for functionality ‘depends upon the totality of the evidence.’” *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (quoting *Valu Eng’g*, 61 USPQ2d at 1424). Indeed, in any given case, some of the considerations may not be necessarily relevant to a finding of functionality, nor will they have to weigh in favor of functionality to support a finding of functionality. *Change Wind*, 123 USPQ2d at 1456; *Heatcon*, 116 USPQ2d at 1370. *Cf. Poly-America*, 124 USPQ2d at 1519 (“Petitioner need not present evidence fitting within all four categories in *Morton-Norwich*.”).

Ultimately, the determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *E.g., Valu Eng’g, Inc.*, 61 USPQ2d 1424; *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009). Moreover, we keep in mind that the Examining Attorney has the burden of making a *prima facie* showing that Applicant’s mark is functional. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012).

The Examining Attorney argues that Applicant’s package configuration design has multiple utilitarian advantages—“the pairing of the transparent easy to open lid with a common round shape makes the applicant’s Package one of a few superior designs available.”<sup>8</sup> The Examining Attorney acknowledges that Applicant “has conceded the functionality of the pull tab by dotting it out,” but argues that “the clear

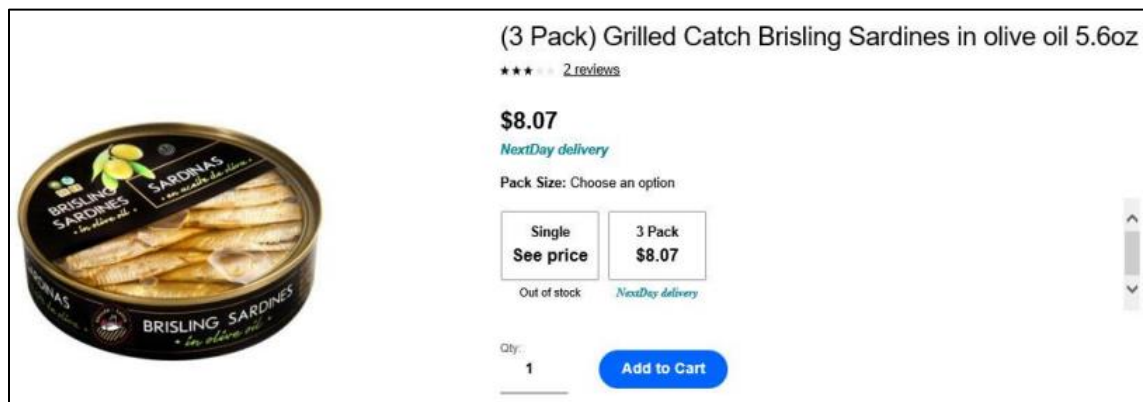
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<sup>8</sup> 8 TTABVue 6.

plastic film is still an essential component of this feature” and it “offers transparency to inspect the goods and is easier to open than a metal lid.”<sup>9</sup>

In support of the refusals, the Examining Attorney submitted the following evidence:

1. Printouts from the Walmart retail website showing fish products for sale in the same or similar product package configuration design Applicant seeks to register:<sup>10</sup>



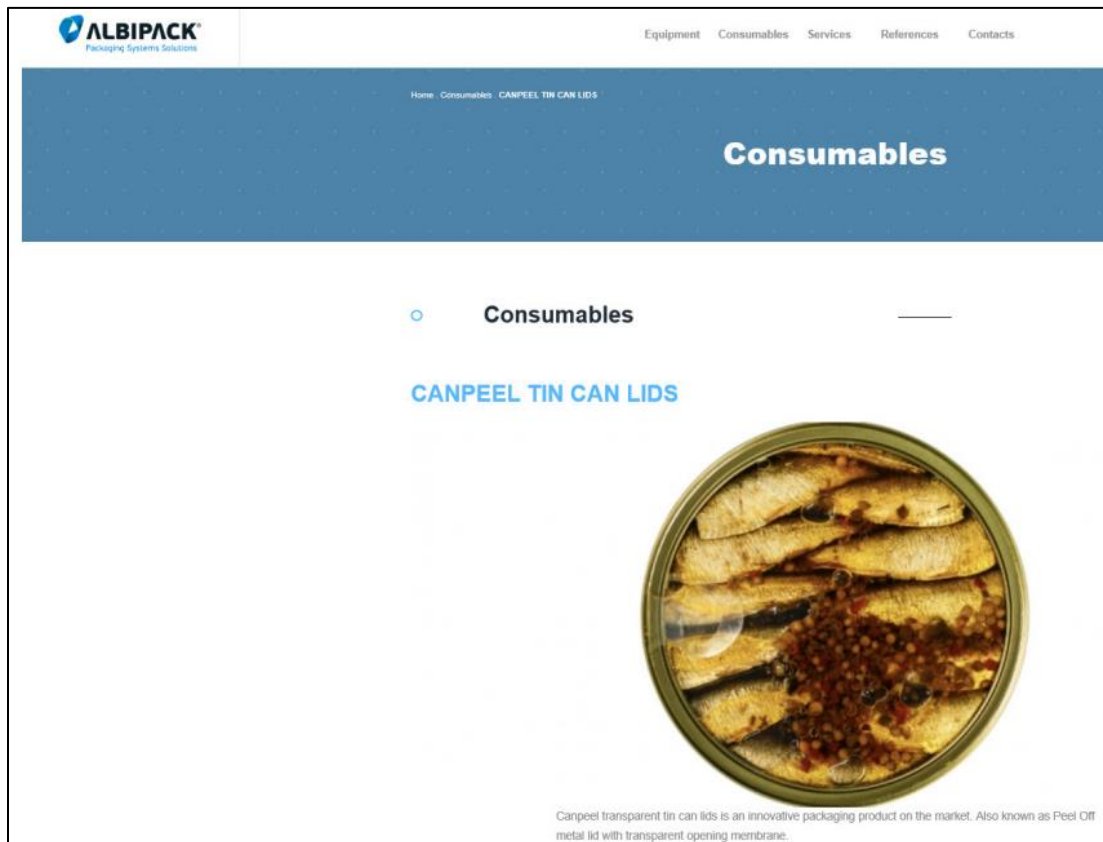
Advertised as “Innovative transparent plastic lid allows you to see the content.”

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<sup>9</sup> *Id.*

<sup>10</sup> September 20, 2019 Office Action, TSDR pp. 2-6.

2. Printouts from the website of Albipack Packaging Systems Solutions, a packaging manufacturer, who makes containers having the same or similar product package configuration design Applicant seeks to register:<sup>11</sup>



Advertised on the website as:

Canpeel transparent tin can lids is an innovative packaging product on the market. Also known as Peel Off metal lid with transparent opening membrane.

The new transparent tin can lids let you look at the contents of the canned food without opening its packaging. This is a great way to present your products to customers in the store so that they can be sure about the quality of your products.

Transparent lids are available in three different sizes: 73mm, 83mm, 99mm and 1/4 Club Can. The covers are manufactured in Switzerland and are of the highest

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<sup>11</sup> *Id.*, TS DR pp. 6-7.

quality, with the same durability properties as ordinary metal lids.




One of the biggest advantages of a transparent lids is that they can be easily opened without special tools. Canpeel lids can be custom made using your design. These lids are mostly used in fish processing factories and fruit preservation companies.

3. Printouts from website of Aspari Packaging Innovations, a packaging manufacturer, who makes containers having the same or similar product package configuration design Applicant seeks to register:<sup>12</sup>



<sup>12</sup> *Id.*, TS DR p. 8.

4. Printout from website of Bandi Foods offering fish products in the same or similar product package configuration design Applicant seeks to register:<sup>13</sup>

		
<p><b>Bandi Smoked Sprats in Oil (Easy Opener) 240g</b></p> <ul style="list-style-type: none"> <li>▪ Product size: 240g / 8.46 oz.</li> <li>▪ Qty in case: 48 units</li> <li>▪ Storage life: 18 months at room temp.</li> <li>▪ Product of: Latvia</li> <li>▪ UPC: 710228339614</li> <li>▪ Product #: 7050</li> </ul>	<p><b>Bandi Smoked Sprats in Oil (Easy Opener) 160g</b></p> <ul style="list-style-type: none"> <li>▪ Product size: 160g / 5.64 oz.</li> <li>▪ Qty in case: 36 units</li> <li>▪ Storage life: 18 months at room temp.</li> <li>▪ Product of: Latvia</li> <li>▪ UPC: 710228339553</li> <li>▪ Product #: 7051</li> </ul>	<p><b>Bandi Smoked Sprats in Oil (Transparent Lid, Easy Opener) 160g</b></p> <ul style="list-style-type: none"> <li>▪ Product size: 160g / 5.64 oz.</li> <li>▪ Qty in case: 36 units</li> <li>▪ Storage life: 18 months at room temp.</li> <li>▪ Product of: Latvia</li> <li>▪ UPC: 710228339539</li> <li>▪ Product #: 7052</li> </ul>

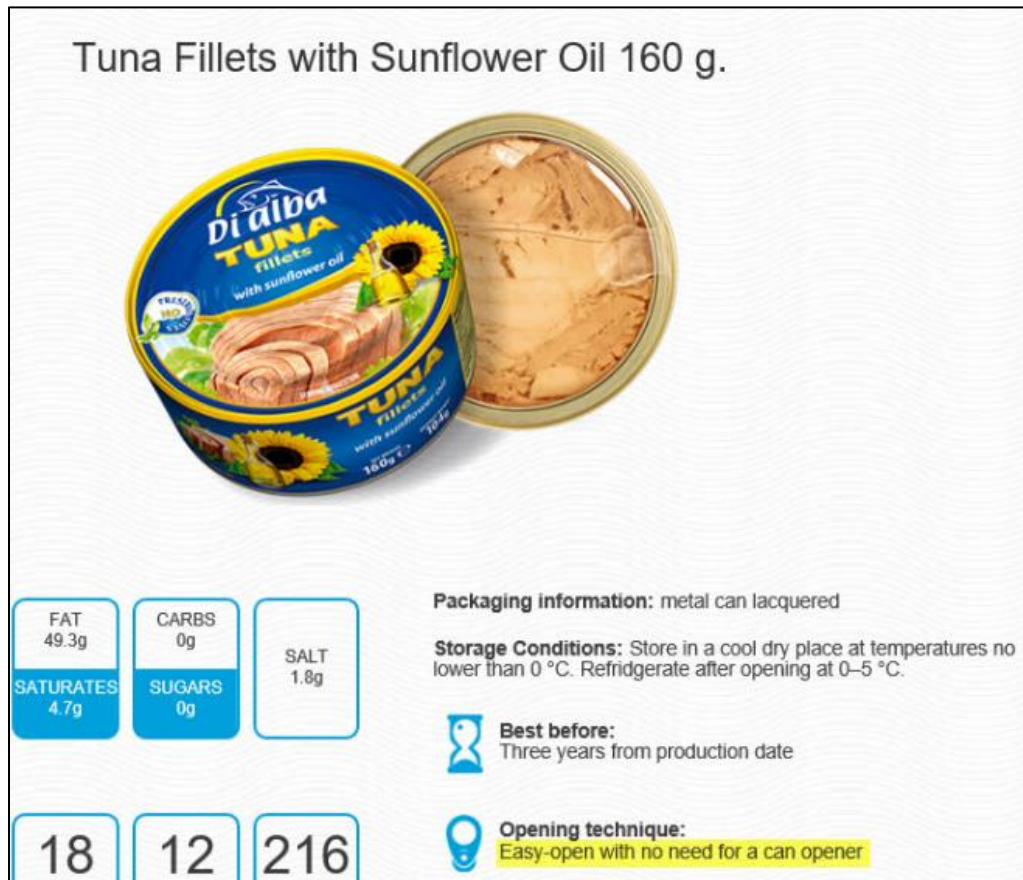
and

		
<p><b>Riga Gold Atlantic Mackerel in Tomato Sauce (Easy Opener) 240g</b></p> <ul style="list-style-type: none"> <li>▪ Product size: 240g / 8.46 oz.</li> <li>▪ Qty in case: 48 units</li> <li>▪ Storage life: 18 months at room temp.</li> <li>▪ Product of: Latvia</li> <li>▪ UPC: 4751001582809</li> <li>▪ Product #: 7023</li> </ul>	<p><b>Riga Gold Sardines in Tomato Sauce (Easy Opener) 240g</b></p> <ul style="list-style-type: none"> <li>▪ Product size: 240g / 8.46 oz.</li> <li>▪ Qty in case: 24 units</li> <li>▪ Storage life: 18 months at room temp.</li> <li>▪ Product of: Latvia</li> <li>▪ UPC: 4751001582823</li> <li>▪ Product #: 7032</li> </ul>	<p><b>Old Riga Big Sprats in Oil Clear Top (Easy Opener) 160g</b></p> <ul style="list-style-type: none"> <li>▪ Product size: 160g / 5.64 oz.</li> <li>▪ Qty in case: 10 units</li> <li>▪ Storage life: 18 months at room temp.</li> <li>▪ Product of: Latvia</li> <li>▪ UPC: 4750265000685</li> <li>▪ Product #: 7030</li> </ul>

<sup>13</sup> *Id.*, TSDR at pp. 9, 14.



5. Printout from the Diavina website offering canned fish products in the same or similar product package configuration design Applicant seeks to register: <sup>14</sup>

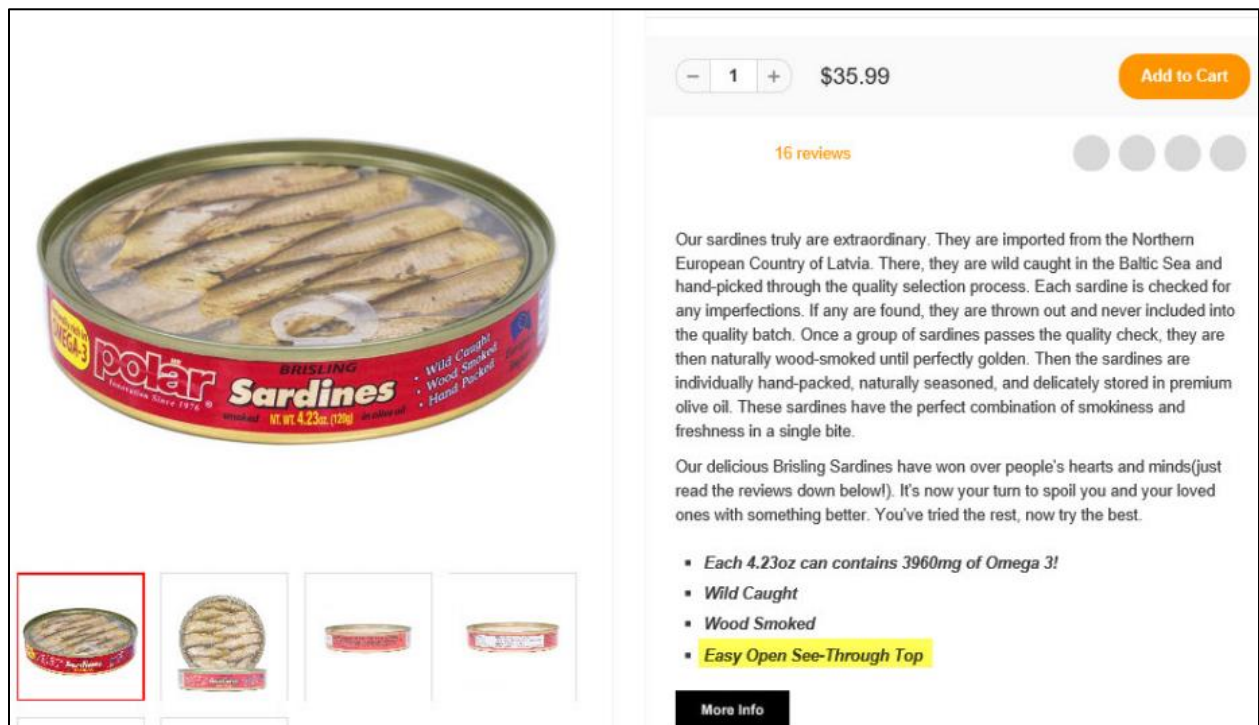


<sup>14</sup> *Id.*, TSDR p. 16.

6. Printout from the John West website offering canned fish products in the same or similar product package configuration design Applicant seeks to register: <sup>15</sup>



7. Printout from the Polar website offering canned fish products in the same or similar product package configuration design Applicant seeks to register: <sup>16</sup>



<sup>15</sup> *Id.*, TSDR p. 17.

<sup>16</sup> *Id.*, TSDR p. 18.

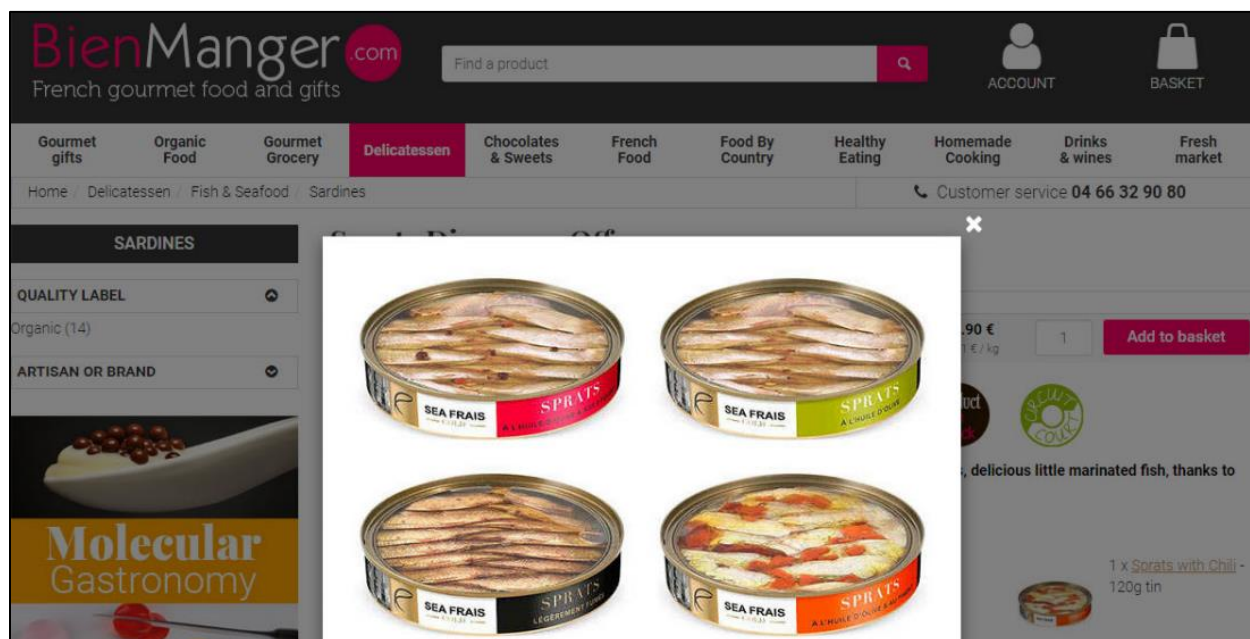
8. Printout from the LuxDeli.com website offering canned fish products in the same or similar product package configuration design Applicant seeks to register:<sup>17</sup>



<sup>17</sup> *Id.*, TSDR p. 20.



9. Printout from the LuxDeli.com website offering canned fish products in the same or similar product package configuration design Applicant seeks to register:<sup>18</sup>



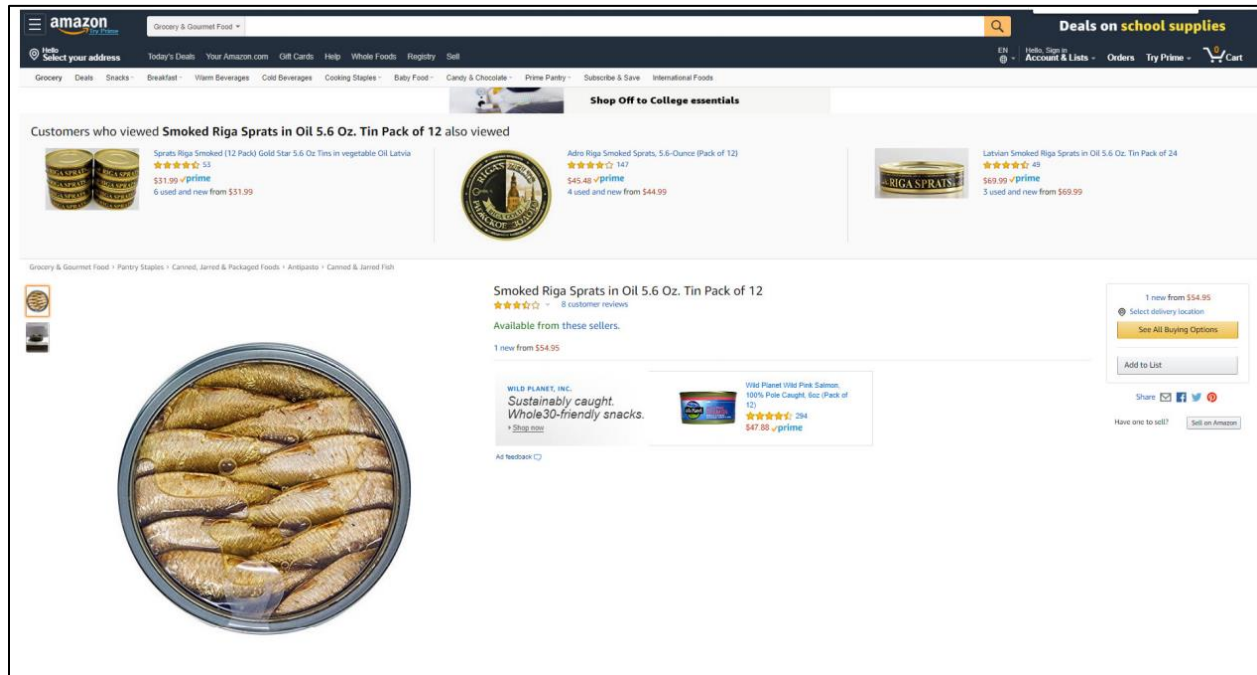
10. Printout from the Kaviari website offering canned fish products in the same or similar product package configuration design Applicant seeks to register:<sup>19</sup>



<sup>18</sup> *Id.*, TSDR p. 21.

<sup>19</sup> *Id.*, TSDR p. 22.

11. Printout from the Amazon website offering canned fish products in the same or similar product package configuration design Applicant seeks to register:<sup>20</sup>



and

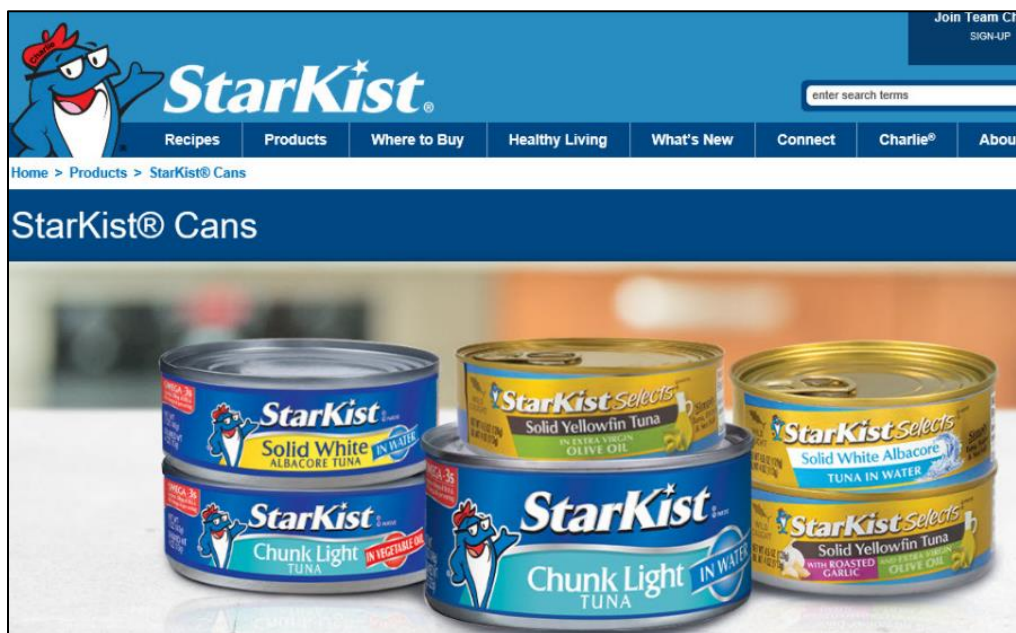


<sup>20</sup> *Id.*, TSDR pp. 26, 33.

12. Printout from the Malincho.Com website offering canned fish products in the same or similar product package configuration design Applicant seeks to register:<sup>21</sup>



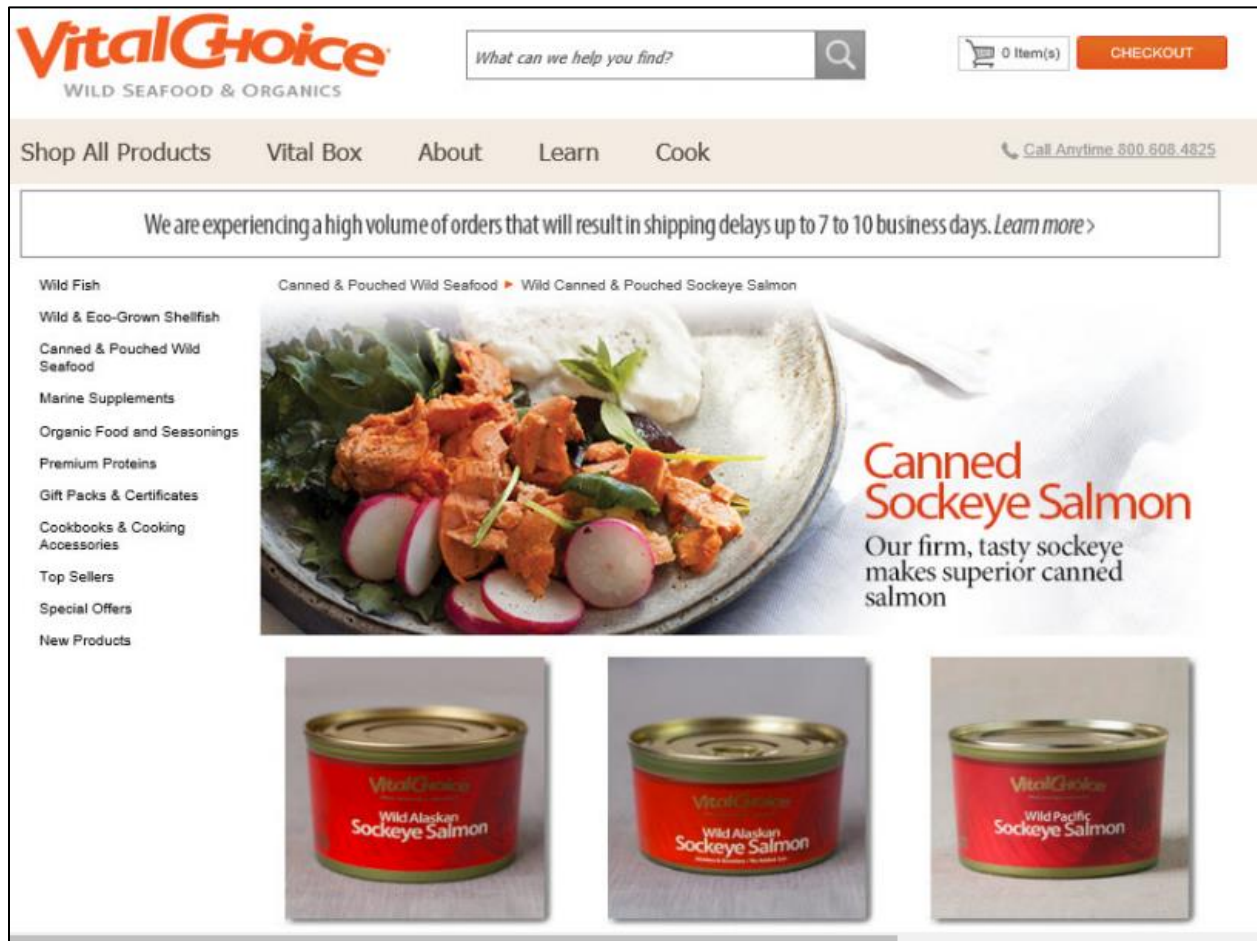
13. Printout from the StarKist website offering canned fish products:<sup>22</sup>



<sup>21</sup> *Id.*, TSDR p. 30.

<sup>22</sup> April 9, 2020 Office Action, TSDR pp. 9-10.

14. Printout from the Vital Choice website offering canned fish products:<sup>23</sup>



<sup>23</sup> *Id.*, TSDR p. 12.



15. Printout from the Chicken of the Sea website offering canned fish products without a transparent top:<sup>24</sup>

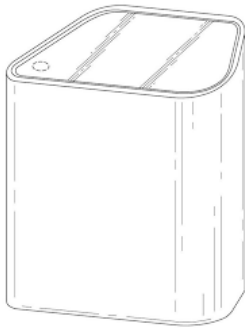


The Examining Attorney also submitted information from Wikipedia for the entries “Steel and tin cans” and “Canned fish.”<sup>25</sup>

<sup>24</sup> *Id.*, TSDR p. 14.

<sup>25</sup> April 9, 2020 Office Action, TSDR pp. 2-6.

Applicant argues that it “does not believe that because of consumer product is subject to being seen through its packaging, that this utility voids the mark from being registered on the Supplemental Register. An attribute that is common to most trade dress packaging marks.”<sup>26</sup> Applicant goes on to argue that it “has not made, nor could it make, a claim that the shape of its mark works better to show the product within than, say, a square package or an envelope package with a window might show the product within it.”<sup>27</sup> Also, in an attempt to overcome the functionality refusal, Applicant submitted copies and Office electronic database printouts for three registrations, two of which are configuration marks on the Supplemental Register:<sup>28</sup>



1. (Reg. No. 6160474) for “wireless routers” and other electronic goods in International Class 9;<sup>29</sup>

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<sup>26</sup> Response filed March 19, 2020, TSDR p. 1.

<sup>27</sup> *Id.*

<sup>28</sup> Attached to Request for Reconsideration filed October 9, 2020. The third registration (Reg. No. 6152839) issued on the Principal Register, but it is not for a configuration mark. Rather the registered mark is a design of a “figure sitting with legs and hands folded over one another” and is used on various personal products and beverages in International Classes 3, 5, and 32. Thus, this registration appears to be irrelevant to our functionality analysis.

<sup>29</sup> Issued on September 20, 2020. The mark is described as: “consist[ing] of an overall three-dimensional trapezoidal-prism shape configuration of the housing for the goods comprised of an angled top with curved corner surfaces transitioning the front, back and side panels to form a continuous surface with tapered sides; the broken lines indicate the location of the button at left and depict changes in surface contour and are not part of the mark.”



2. (Reg. No. 6166054) for “dog park and dog recreational equipment, namely, agility equipment in the nature of platform structures with ramps” in International Class 28.<sup>30</sup>

Applicant contends that these registered marks show that “obtaining a Supplemental register spot for nearly any configuration is reasonably common and has included three [sic] recent Supplemental registrations to illustrate just how functional or generic such can be.”<sup>31</sup>

We find Applicant’s reliance on the two registrations on the Supplemental Register to be entirely misplaced. The marks covered by these registrations are for product configurations, not packaging configuration designs like Applicant’s at issue. Moreover, the goods involved in those registrations, i.e., routers and dog agility equipment, are wholly different from those at issue, i.e., tinned and canned fish. The registrations thus have no relevance or probative value in our functionality analysis of Applicant’s package configuration design. Moreover, it is well-settled that “the prior decisions and actions of other trademark examining attorneys in registering

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<sup>30</sup> Issued on September 29, 2020. The mark is described in the application as: “consist[ing] of a three-dimensional configuration of pet agility equipment having a tan platform connected to two ramps at opposing sides, the platform being supported by four black posts, with two posts being connected at the base with a continuous black board, the base of the ramps being supported by a prominent black footer. The mark includes equipment having a prominent black frame and a walking surface bearing a tan color, and looking like wood. The color white represents outlining and/or shading and is not claimed as a feature of the mark.”

<sup>31</sup> Request for Reconsideration filed October 9, 2020, TSDR p. 1.

other marks have little evidentiary value and are not binding upon the USPTO or the Board. *See USA Warriors Ice Hockey Program*, 122 USPQ2d 1793 n.10. Each case is decided on its own facts, and each mark stands on its own merits.

The evidence adduced by the Examining Attorney, on the other hand, is sufficient for purposes of making a prima facie showing that the “transparent circle ... through which the product may be seen,” feature of Applicant’s package configuration design is functional. As one of the manufactures for such containers touts to its purchasers, which presumably would include food companies like Applicant and its competitors, the see-through top “let[s] you look at the contents of the canned food without opening its packaging. This is a great way to present your products to customers in the store so that they can be sure about the quality of your products.”<sup>32</sup> Indeed, for “canned” or “tinned” fish products like those identified in the application, there is no evidence of the availability to competitors of functionally equivalent designs. Rather, the evidence shows competitors use the same see-through top in precisely the same manner as Applicant’s package configuration design. Again, in this respect, we keep in mind 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*, 34 USPQ2d 1165. Granting Applicant exclusive rights to the proposed package configuration design would

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<sup>32</sup> September 20, 2019 Office Action, TSDR at p. 14.



prevent its competitors from continuing to offer their canned or tinned fish with the see-through top feature.

In sum, we find a prima facie showing has been made that Applicant's proposed package design mark is functional and Applicant has not rebutted this presumption. Accordingly, the refusal under Section 23(c) is affirmed.

### **III. Failure to Function – Generic Packaging**

Product packaging may be incapable of functioning as an indicator of source. “[T]rade dress that cannot serve as an indicator of source is generic and unprotectable.” *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 1326, 50 USPQ2d 1532, 1535 (Fed. Cir. 1999). For example, packaging that is common or basic in an industry or that is a mere refinement of packaging commonly used on the relevant goods will not be perceived as indicating source and is not registrable on the Principal Register under § 2(f) or on the Supplemental Register. *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1555 (TTAB 2009) (noting that a product design may be deemed incapable where it is, “at a minimum, so common in the industry that it cannot be said to identify a particular source.”); *see also Nora Beverages Inc. v. Perrier Grp. of Am. Inc.*, 269 F.3d 114, 60 USPQ2d 1038, 1041 (2nd Cir. 2001) (affirming the district court’s finding that the water bottle manufactured and sold by Nora was generic because “it was used, with minor variations, throughout the entire market of similar products”); *Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 996 F.2d 577, 27 USPQ2d 1189, 1193 (2d Cir. 1993) (stating that “where it is the custom of an industry to package products in a

particular manner, a trade dress in that style would be generic and therefore not inherently distinctive,” such as packaging lime-flavored soda in green twelve-ounce cans, a practice that is so common in the soft drink industry).

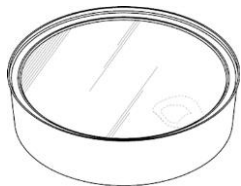
A genericness determination of a product packaging configuration, or trade dress, involves application of “similar two-step inquiry that we apply to word marks, where we first determine the genus of goods or services at issue, and second, determine whether the consuming public primarily regards the matter sought to be registered as a category or type of trade dress for the genus of goods or services.” *In re Odd Sox LLC*, 2019 USPQ2d 370879, 2019 BL 370879 (TTAB 2019); *see also H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) (describing genericness two-step determination).

As to the initial inquiry, we find the relevant category of goods is defined in the application’s identification goods, namely, fish that has been preserved or canned/tinned. *Cf. H. Marvin Ginn*, 28 USPQ at 530. As for the second inquiry, the relevant consumers are those who purchase these goods and this is presumably the general public given these goods are found in grocery stores.

In terms of evidence of genericness, the Board may rely on materials showing competitors’ use of similar packaging. *In re Odd Sox*, 2019 BL 370879, \*7, citing to *Stuart Spector Designs*, 94 USPQ2d at 1555 (“[C]ases have recognized that competitor use is evidence of genericness”); *Nora Beverages*, 60 USPQ2d 1038 (Second Circuit upheld lower district court decision finding a 1.5 liter plastic bottle packaging design for spring water was generic based on others use of the same packaging). As discussed

above, the Examining Attorney submitted evidence showing that Applicant's cylindrical can design with a transparent ("see-through") top has been adopted by numerous competitors in the canned and tinned fish industry.

To wit, there is no meaningful difference between Applicant's package configuration design:



and the packaging used by others for fish products depicted above, e.g.,



Although the packaging design is described in some of the evidence as an "innovative packaging product," it is being offered by packaging companies, like Albipack and Aspari, to different food product companies, and not just Applicant. In other words, Applicant's competitors may, and have, adopted this packaging design for their canned fish products.

Aside from the transparent or see-through lid feature, it is also abundantly clear that the other features of Applicant's package configuration design, namely, the short cylindrical shape with a raised and widened outer rim, is extremely common in the tinned and canned fish marketplace. Indeed, while the ubiquity of tuna sold in short cylindrical cans is a matter of which we can take judicial notice, the evidence makes

clear those features have also been commonly adopted by companies such as StarKist, and that they offer their canned fish products in stackable canned containers identical to Applicant's mark, albeit without the see-through lid, e.g.:



Thus, to the extent that Applicant seeks to rely on any other features of its product package design, other than the see-through lid, we find those features have been so commonly adopted in the industry that they are generic for packaging of tinned and canned fish.

Applicant does not rebut the evidence of showing competitors using the same product package design nor does Applicant argue why such evidence is not probative. Applicant merely references the two previously discussed Supplemental registrations for configuration marks of a router and dog agility equipment, argues that “[t]hese examples could as easily be found to be generic using the Examiner’s findings, which are unsupported by evidence or law beyond the aggravating position so often taken

that one examiner's decision cannot be used against another examiner's position no matter how preposterous the position is shown to be."<sup>33</sup>

In sum, the evidence establishes that consumers of canned or tinned fish will primarily regard the applied-for product package design as a common type of container for tinned or canned fish, rather than as a source indicator for Applicant's goods in particular. In view of the above, we find Applicant's product packaging design to be generic and thus unable to function as a trademark.

**Decision:** The refusal to register Applicant's product package configuration design is affirmed on the grounds of functionality and that it fails to function as a mark because it consists of generic packaging for the goods.

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<sup>33</sup> 6 TTABVUE 10.