

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing: April 17, 2025

Mailed: May 13, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shibumi Shade, Inc.

Serial No. 90785780

Serial No. 90785791

William S. Fultz and Kelli A. Ovies of Womble Bond Dickinson (US) LLP,
for Shibumi Shade, Inc.

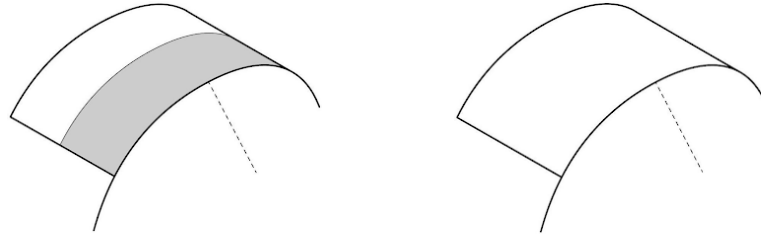
Kathryn Browning, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.

Before Pologeorgis, Cohen, and Elgin,
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:

Shibumi Shade, Inc. (“Applicant”) seeks registration on the Principal Register of
the trade dress depicted below for “Canopies of textile or synthetic materials” in
International Class 22.¹

¹ Application Ser. Nos. 90785780 (striped) (the ’780 Application) and 90785791 (solid color) (the ’791 Application) both were filed on June 21, 2021 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 June 26, 2016.



The applications include the following amended description of the marks (the matter in brackets is included only in the '780 Application):

The mark consists of a three-dimensional configuration comprising the design of a rectangular canopy [with two horizontal stripes,] attached to a curved frame along one side and unattached on the other three sides. On both sides the curved frame extends beyond the point where the canopy is attached thereto. The matter shown in dotted lines is not part of the mark and serves only to show the position of the mark.

To show how Applicant uses its applied-for marks in connection with the goods identified in the applications, we reproduce images from Applicant's specimens of use below:



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 non-distinctiveness refusals, Applicant overcame those with claims of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).

After the Examining Attorney made the functionality refusals final, Applicant filed a request for reconsideration and appealed. The Examining Attorney issued Subsequent Final Office Actions maintaining the refusals. The appeals were consolidated then proceeded with briefing and an oral hearing.²

We have reviewed the entire record and all of the arguments, whether discussed in this opinion, or not. We **affirm** the refusals to register.

I. Evidentiary Issue

Prior to proceeding to analyze the merits of the case, we address an evidentiary issue. Applicant cites to six design patents (Nos. D989350, D990605, D1005525, D1007004, D1007005, and D1014687) in support of its argument that the proposed marks are not functional.³ Applicant does not cite in its brief to any place in the records where the issued patents may be found, and we have not located them.

² The appeals were consolidated by the Board on October 9, 2024 and briefed together. 7 TTABVUE. Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's online docketing system. Citations to the prosecution record refer to the .pdf version of the TSDR system. *See In re Integra Biosciences Corp.*, Ser. No. 87484450, 2022 TTAB LEXIS 17, at *6 (TTAB 2022). For ease of reference, we refer to the record in Serial No. 90785780.

³ 8 TTABVUE 18-20.

Applicant did, however, make of record three design patent applications (Nos. 29/709,175,⁴ 29/753,433,⁵ and 29/860,120)⁶ with its May 18, 2023 Request for Reconsideration. The declarations from Applicant's witnesses do not establish that the design patents listed above actually issued. Applicant's owner testified only that: "We have obtained several design patents for the design of the Shibumi Shade."⁷ Its expert witness, Joel Delman, affirmed only that he was informed by Applicant's counsel that "Applicant owns recently-allowed design patent application[s],"⁸ which is not sufficient to make the issued patents of record. In any case, we do not know which, if any, of the six purportedly issued design patents corresponds to which of the three applications of record.

The Board does not take judicial notice of patent application files and registration records. *See In re Jimmy Moore, LLC*, Ser. No. 86353015, 2016 TTAB LEXIS 382, *7 (TTAB 2016) (denying request for judicial notice of issued patent). Applicant should have made any issued patents of record during prosecution, or in a request for reconsideration. *See id.* at *6 ("there was clearly time prior to the appeal being filed for Applicant to file a request for reconsideration in order to make the patent[s] of record.").

⁴ *Id.* at TSDR 174-81. *See also* March 23, 2022 Response to Office Action, at TSDR 30-45 (App. No. 29/709,175).

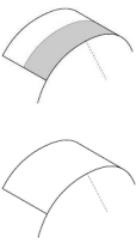






⁵ May 18, 2023 Request for Reconsideration at TSDR 182-96.

⁶ *Id.* at TSDR 197-204. Applicant listed a fourth application in its request for reconsideration (No. 29/851,339, *see id.* at TSDR 16), but did not supply a copy of this application for the record.

⁷ April 11, 2024 Response to Office Action at TSDR 43 (Declaration of Dane Barnes ¶ 26).

⁸ *See id.* at 173 (Declaration of Joel Delman)

We note, however, that Applicant referred to the issued design patents by number in its April 11, 2024 office action response by including the same chart of drawings from the patents as is reproduced in its brief:⁹

Applicant's Marks	US D989350	US D990605	US D1005525	US D1007004	US D1007005	US D1014687
						

The Examining Attorney did not inform Applicant that the chart was insufficient to make the issued patents of record. Although she did not refer to the design patents by number in her brief, a fair reading of the Examining Attorney's argument is that they were considered because they are a main point of Applicant's argument.¹⁰ "[D]esign patents are typically claimed according to their drawings." *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010). Accordingly, we deem the information regarding the design patents to have been stipulated into the record to the extent that we have considered only the specific drawings that Applicant provided in the chart above and Applicant's arguments pertaining thereto. *Cf. In re 1st USA Realty Profls. Inc.*, Ser. No. 78553715, 2007 TTAB LEXIS 73, *3 (TTAB

⁹ April 11, 2024 Response to Office Action at TSDR 34.

¹⁰ Indeed, it appears to us that the Examining Attorney referred to the design patents as if they had been properly made of record. *See* 10 TTABVUE 5 ("In response to the examining attorney's requests, on May 18, 2023, the applicant submitted copies of both its relevant utility and design patents."); *id.* at 7 ("As mentioned above, the applicant owns design patents for its rectangular canopy attached to a curved frame.").

2007) (considering evidence of trademark registrations in chart to be stipulated into the record).

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)); see also *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 850 n.10 (1982). 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*”). That case identifies the following non-exclusive inquiries,

or categories of 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 (TMEP) § 1202.02(a)(v) (Nov. 2024). If we find that features of the mark are essential to the use or purpose of the article or if it affects the cost or quality of the article, 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*, 532 U.S. at 33, (“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.”).

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 marks are 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) and *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1579 (Fed. Cir. 1988)).

A. Applicant's Patents

We start with the first *Morton-Norwich* factor – “the existence of a utility patent disclosing the utilitarian advantages of the design,” which “is strong evidence that the features claimed therein are functional.” *TrafFix*, 532 U.S. at 29. “One who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.” *TrafFix*, 532 U.S. at 30. Accordingly, absent a contrary showing, this factor can be dispositive. *See In re Howard Leight Indus. LLC*, Ser. No. 76439661, 2006 TTAB LEXIS 229, *31 (TTAB 2006) (finding utility patent alone sufficient basis for holding product configuration functional).

In response to the Examining Attorney's information requirement, Applicant submitted copies of seven utility patents, listed below:

Title	U.S. Patent No.	Issue Date
Shading System and Method of Use ¹¹	10,190,330 (the '330 Utility Patent)	January 29, 2019
Shading System and Method of Use ¹²	10,753,117 (the '117 Utility Patent)	August 25, 2020
Shading System and Method of Use ¹³	11,111,690 (the '690 Utility Patent)	September 7, 2021
Shading System and Method of Use ¹⁴	11,255,103 (the '103 Utility Patent)	February 22, 2022
Shading System and Method of Use ¹⁵	11,299,904 (the '904 Utility Patent)	April 12, 2022
Shading System and Method of Use ¹⁶	11,536,046 (the '046 Utility Patent)	December 27, 2022
Shading System and Method of Use ¹⁷	11,634,924 (the '924 Utility Patent)	April 25, 2023

We must take into account the entirety of the patents, for even if there is no utility patent that claims the exact configuration for which trademark protection is sought, “statements in a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Becton, Dickinson*, 675 F.3d at 1375.

We also keep in mind the written description requirement found in 35 U.S.C. § 112 (“Section 112”), which states:

The specification [of the patent] shall contain a written description of the invention, and of the manner and process

¹¹ May 18, 2023 Request for Reconsideration at TSDR 33-47 (Exhibit 1).

¹² *Id.* at TSDR 48-62 (Exhibit 2).

¹³ *Id.* at TSDR 63-77 (Exhibit 3).

¹⁴ *Id.* at TSDR 96-110 (Exhibit 5).

¹⁵ *Id.* at TSDR 127-41 (Exhibit 7).

¹⁶ *Id.* at TSDR 111-26 (Exhibit 6).

¹⁷ *Id.* at TSDR 78-95 (Exhibit 4).

of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

To satisfy the written description requirement in Section 112, the disclosure of the specification must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of *the invention*.” *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1366 (Fed. Cir. 2009) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (emphasis in original)). “[U]nder proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” *Id.* (quoting *Vas-Cath*, 935 F.2d at 1565 and citing *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1322 (Fed. Cir. 2002) (“Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed.”)). Furthermore, the “best mode” requirement in Section 112 “ensures that the public receives knowledge of the preferred embodiments for practicing the claimed invention.” *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1360 (Fed. Cir. 2011) (quoting *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001)).¹⁸

¹⁸ The MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2165 (Jan.2024) explains that, under Section 15 of the Leahy-Smith America Invents Act (AIA), although the best mode requirement is no longer a basis for patent invalidation, it remains a requirement for examination.

The Examining Attorney argued that the utility patents, and in particular the '117 Patent, demonstrate that the configurations shown in the applied-for marks are functional as a whole.¹⁹ Applicant countered that neither the '117 Patent nor Applicant's other utility patents claim the exact configuration of the applied-for marks or attribute functional significance to the overall designs for which Applicant seeks registration: that is, the rectangular shape of the canopy, the proportions of the canopy's sides to the front and back, the curved shape of the frame, or (as applied to the '790 Application) the stripes on the canopy.²⁰

Upon review of the seven utility patents of record, we have elected to focus our analysis on the '046 Utility Patent and the '904 Utility Patent, rather than the '117 Patent. According to these patents' abstracts, the invention relates to:

A system for providing shade onto a surface is described herein. The system includes a canopy configured for engagement with, and aerial suspension by, a frame. The frame includes a plurality of sections configured for end-to-end alignment from a left end to a right end of the frame. Each section is configured to engage with any adjacent sections to form the frame. The ends of the frame are secured to the surface, thereby aurally suspending the canopy and providing shade to the surface.²¹

More particularly, the '046 and '904 Utility Patents – as do all of Applicant's utility patents – pertains to a novel system to provide shade, consisting of a fabric canopy

¹⁹ 10 TTABVUE 5-6. The language and drawings of the utility patents (all of which are related) overlap a great deal. We think it clear that the Examining Attorney reviewed all of the utility patents made of record before choosing the '117 Patent as a representative example.

²⁰ *See generally* 8 TTABVUE 14-18.

²¹ May 18, 2023 Request for Reconsideration at TSDR 112 ('046 Utility Patent); *id.* at 128 ('904 Utility Patent).

connected on one side to a frame constructed of connected segments (i.e., poles), and aeri- ally supported by wind on the other three sides. The patent specifications explain that the invention solves the problem of “ineffective” and “impractical” shading systems, such as those which

include rigid canop[ies] susceptible to being shifted or unanchored by wind. Other systems are cumbersome to transport or assemble, due to the number of parts involved, steps required during setup and/or low shade to weight ratios.

Accordingly, there remains a need for systems and methods including flexible canopy structures partially supported by wind and configured for easy transport and assembly.²²

The drawings in the '046 and '904 Utility Patents depicting the preferred embodiment are very similar to the drawings of the applied-for marks. Figure 1 in both patents, reproduced below, “is a perspective view of system for providing shade according to one or more embodiments of disclosed subject matter”:²³

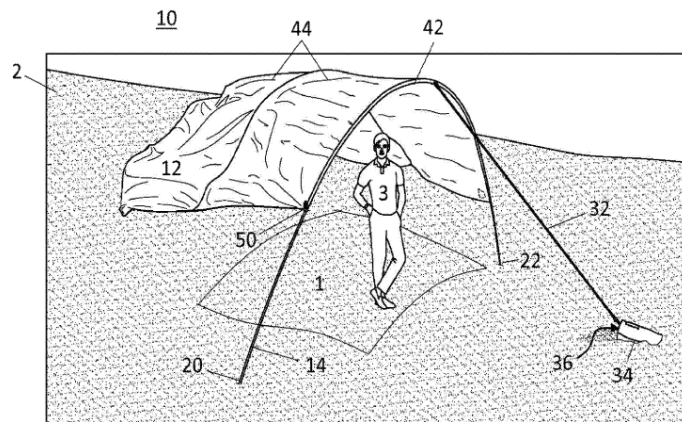


FIG. 1

²² *Id.* at TSDR 122 ('046 Utility Patent, Column 1); *id.* at 137 ('904 Utility Patent, Column 1).

²³ *Id.* at TSDR 114 (drawing), 123 (Column 3) ('046 Utility Patent); *id.* at 130 (drawing), 138 (Column 3) ('904 Utility Patent).

The specifications in both patents explains Figure 1 as follows:

FIG. 1 depicts one embodiment of a system **10** for providing shade **1** onto a surface **2**. The system **10** may include a canopy **12** configured for engagement with, and aerial suspension by, a frame **14**. The canopy **12** may include one or more lightweight materials, the material including one or more of the following properties: ripstop, polyester, blackout, light diffusion, light modification, and waterproof. The canopy **12** may be unitarily constructed or may include a plurality of coupled sections **44** and/or selectively engageable sections **44**.²⁴

Figure 2 in both patents further depicts one embodiment of the frame in “transport configuration”:²⁵

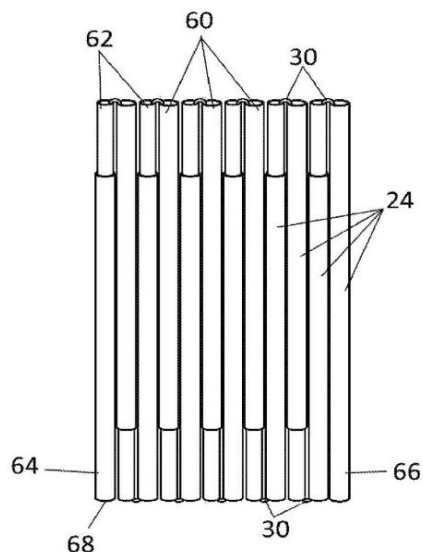


FIG. 2

The patents explain:

A first section **64** may define the left end **20** of the frame **14** and a last section **66** may define the right end **22** of the frame **14**. The first section **64** may include a single male

²⁴ *Id.* at TSDR 123 ('046 Utility Patent, Column 4); *id.* at 138 ('904 Utility Patent, Column 4). The numbers in bold, in original, refer to the numbered elements in the patent drawings.

²⁵ *Id.* at TSDR 115 ('046 Utility Patent); *id.* at 131 ('904 Utility Patent).

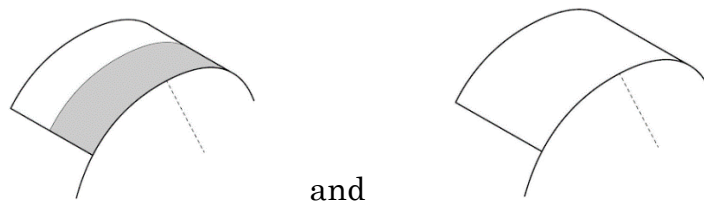
end **62** or female end **60**, with the other end being the left end **20** and/or cap **68** (FIG. 2 depicts first section 64 having a male end **62** and cap **68**):²⁶

The patents further explain the preferred embodiment, also depicted in the drawings, as follows:

In some embodiments of the system **10**, the sections **24** of the frame **12** may form a curved shape when in the supporting configuration A curved shape may be formed when the male and female ends **60**, **62** are co-extensive with curved axis the remaining portions of the sections **24**.²⁷

In other words, the patents' specifications and drawings disclose a shading system where the segments are fitted together to form a single frame, which, in the preferred embodiment, are formed into a curved (i.e., arched) shape.

Figure 1 on both patents is very similar to the applied-for marks



except that Applicant has excluded the cord (numbered 32 in the drawings) which is attached to a counterweight or anchor (numbered 34) from the proposed marks by depicting it in dotted lines in the marks' drawings. However, the '046 and '904 Utility Patents, and in particular, the preferred embodiment of the patents, disclose features that serve a functional purpose for the shading system and are placed in the appropriate positions for use in the applied-for marks — namely a rectangular canopy

²⁶ *Id.* at TSDR 124 ('046 Utility Patent, Column 5); *id.* at 139 ('904 Utility Patent, Column 5).

²⁷ *Id.* at TSDR 124 ('046 Utility Patent, Column 6); *id.* at 139 ('904 Utility Patent, Column 6).

and a curved frame. *See Grote Indus., Inc. v. Truck-Lite Co.*, Opp. No. 91196923, 2018 TTAB LEXIS 105, *26 (TTAB 2018) (“We consider the entirety of a patent – both claims and disclosures – and have found functional applied-for marks depicting the preferred embodiment described in a utility patent.”) (citations omitted); *In re Lincoln Diagnostics Inc.*, Ser. No. 74100207, 1994 TTAB LEXIS 1, *22 (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); *see also In re Heatcon, Inc.*, Ser. No. 85281360, 2015 TTAB LEXIS 360, *17-22, 37-38 (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).

We acknowledge Applicant’s argument in its brief and at oral argument that its patents are not limited to the preferred embodiments depicted therein, and expressly permit other shapes.²⁸ *See Cisco Sys. v. TQ Delta, LLC*, 928 F.3d 1359, 1364 (Fed. Cir. 2019) (“it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited”) (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004)). But that does not mean that the preferred embodiment in a utility patent is not supporting evidence that it is best way to practice the invention.

²⁸ *See, e.g.*, 11 TTABVUE 5.

Next, we turn the patent claims. As mentioned above, Applicant maintains that, although a frame and shade canopy in its applied-for marks are illustrated in the drawings of its utility patents including Figure 1, the claims (which describe the metes and bounds of the invention) are not directed to these features.²⁹ We disagree with Applicant's argument particularly in light of the claims of the '046 and '904 Utility Patents.

In the '046 Utility Patent, independent Claim 1 and dependent Claims 7, 10, and 11 provide as follows (emphasis in bold added):³⁰

1. A system for providing shade onto a surface, the system comprising:

a frame including a plurality of sections and being maneuverable between a transport configuration and a supporting configuration, the sections including:

a first section defining a left end of the frame with a corkscrew shape and engaged with the surface;

a last section defining a right end of the frame with a corkscrew shape and engaged with the surface;

one or more adjacent sections coupled into alignment between the first section and the last section, the one or more adjacent sections additionally comprising a cable extending therethrough and providing supporting tension to the alignment in the supporting configuration and allowing the one or more adjacent sections to be maneuvered between the transport configuration and the supporting configuration, the adjacent sections being

²⁹ See 8 TTABVue 7.

³⁰ May 18, 2023 Request for Reconsideration at TSDR 125-26 ('046 Utility Patent, Columns 8-9). A dependent claim must add a limitation to those recited in the independent claim. See 35 U.S.C. § 112 (“[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.”) (emphasis added). Each claim in a patent is presumed to have a different scope. *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380 (Fed. Cir. 2006) (citing cases).

configured to engage with the first section and the last section in the supporting configuration;

a canopy extending between a suspension end and an opposing trailing end, the suspension end of the canopy being engageable with the frame about the one or more adjacent sections of the frame, wherein the trailing end of the canopy is spaced apart from the portion of the frame in the supporting configuration such that the canopy is supportable by the frame and at least partially supportable by wind in a first configuration for providing shade to the surface;

at least one elastic strap including a rubber component that is engageable with or coupled to the suspension end of the canopy for securing the canopy to the frame, the at least one elastic strap including the rubber component having a higher coefficient of friction with respect to a coefficient of friction of the plurality of sections of the frame; and

a container capable of housing and transporting the components of the system therein as well as acting as a counterweight that is coupleable to one or both of the frame and the canopy, and engageable with the surface to retain the frame in the supporting configuration;

wherein the at least one elastic strap includes a strap fastener on one end configured for fastening to a canopy fastener on the other end thereof, the at least one strap being configured to wrap about the one or more adjacent sections of the frame and fasten the strap fastener to the canopy fastener and fasten to itself for securing the canopy to the frame.

....

7. The system of claim 1, wherein the one or more adjacent sections of the frame **form a curved shape** when in the supporting configuration.

....

10. The system of claim 1, wherein the canopy has at least **one set of parallel sides**.

11. The system of claim 1, wherein the **trailing end of the canopy defines a tail.**

Independent Claim 13, and dependent Claims 14, 15, and 17 provide (emphasis in bold added):³¹

13. A system for providing shade onto a surface, the system comprising:

a frame defined by a plurality of sections that include a left end, a right end, and a plurality of sections positioned between the left end and the right end and comprising a cable extending therethrough, each of the plurality of sections having one or both of a male end and a female end making the plurality of sections thereby engageable with at least one adjacent section to define the frame in a supporting configuration and thereby disengageable to define the frame in a transport configuration, wherein each of the left end and the right end has a corkscrew shape effective for engaging a surface;

a canopy extending between a suspension end and an opposing trailing end, the suspension end of the canopy extending between a left end and a right end, the suspension end of the canopy including a plurality of fasteners including at least one fastener that engages the canopy with the frame and at least one fastener that secures the canopy in position relative to the frame, wherein the trailing end of the canopy is spaced apart from the portion of the frame in the supporting configuration such that the canopy is supportable by the frame and at least partially supportable by wind in a first configuration for providing shade to the surface; and

a container capable of housing and transporting the components of the system therein as well as acting as a first anchor that is coupleable to one or both of the frame and the canopy, and engageable with the surface to retain the frame in the supporting configuration;

wherein the at least one fastener that secures the canopy in position relative to the frame is elastic, the at least one

³¹ *Id.* at TSDR 126 (Columns 9-10).

elastic fastener having a higher coefficient of friction with respect to a coefficient of friction of the frame.

14. The system of claim 13, wherein the canopy has at least **one set of parallel sides**.

15. The system of claim 13, wherein the **trailing end of the canopy defines a tail**.

....

17. The system of claim 13, wherein the one or more sections of the frame **form a curved shape** when in the supporting configuration.

The patent claims cover each of the elements of the applied-for marks: a rectangular canopy (i.e., a shape consisting of “at least one set of parallel sides”); attached to a single “curved” frame on one side and supported by wind on the other three sides; and a trailing end of the canopy creating a “tail” when in use. In essence, the configuration depicted in Applicant’s applied-for marks and described in the applications is explicitly claimed in the ’046 Utility Patent.

Turning to the ’904 Utility Patent, independent Claim 1 and dependent claim 8 claim:³²

1. A system for providing shade onto a surface, the system comprising:

at least one frame being directly engageable with the surface such that when the frame is directly engaged with the surface, the at least one frame is configured to lie within a plane substantially perpendicular to the surface, wherein the at least one frame comprises:

a plurality of sections arrangeable so that a first section and a second section are each directly engaged with the surface at first ends thereof and are coupleable to one

³² *Id.* at TSDR 140-41 (’904 Utility Patent, Columns 8-9).

another about opposing, second ends or are each respectively coupleable to first and second ends of at least one intermediate section arranged therebetween, and

at least one aligning component affixed to one or more of the plurality of sections of the frame such that the plurality of sections are maneuverable between a compactly configured transport configuration and a supporting configuration where the plurality of sections are aligned;

a canopy extending between a suspension end and an opposing trailing end and engageable, with the frame about a portion of the frame wherein in the supporting configuration, the canopy is capable of being supported by a wind force applied to the canopy and the at least one frame at least at the suspension end of the canopy such that the canopy extends at an angle relative to the plane, the angle being non-coplanar with the plane and varying with the wind force to provide shade to the surface;

a cord having a first end and a second end, the first end or the second end of the cord being coupleable to one or both of the at least one frame and the canopy;

an anchor coupleable to the other of the second end or the first end of the cord and being in contact with the surface so that the frame remains substantially within the plane when the wind force is applied to the canopy; and

a container capable of both transporting all of the components of the system and acting as the anchor.

....

8. The system of claim 1, wherein, when the at least one frame is directly engaged with the surface, **the frame forms a curved shape.**

Independent Claim 10 and dependent claim 17 provide:³³

10. A system for providing shade onto a surface, the system comprising:

³³ *Id.* at TSDR 141 (Columns 9-10).

at least one frame comprising a plurality of sections including a first section, a second section, and at least one adjacent section arranged between the first section and the second section such that the first and second section are engaged or coupled into an alignment to configure the frame in a supporting configuration with a left end that is engageable with the surface and a right end that is engageable with the surface;

a canopy extending between a suspension end and an opposing trailing end and engageable, with the frame about a portion of the frame, wherein in the supporting configuration, the canopy is capable of being supported by a wind force applied to the canopy and the at least one frame at least at the suspension end of the canopy for providing shade to the surface;

a cord selectively engageable to one or both of the at least one frame and the canopy; and

a container capable of both transporting all of the components of the system and acting as an anchor, the anchor being coupleable to the cord so that the at least one frame remains in the supporting configuration.

....

17. The system of claim 10, wherein, when the at least one frame is directly engaged with the surface, **the frame forms a curved shape.**

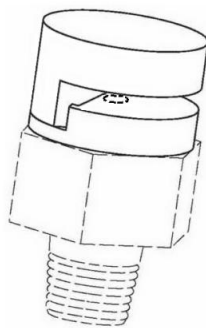
Like the '046 Utility Patent, the '904 Patent also specifically claims the curved (i.e. arched) shape of the frame depicted in the applied-for marks.

“When the patent claims are compared to the trademark [applications], it is readily apparent how important the elements of the trademark, as described in the trademark [application], are to the patentability of the invention. That is, each of the elements comprising the trademark is an essential element of the patent.” *Kistner Concrete Prods. v. Contech Arch Techs., Inc.*, Can. No. 92048733, 2011 TTAB LEXIS

8, *35 (TTAB 2011). In this case, the placement of the single frame, the arched (or curved) shape comprised of the connected flexible poles, and the support of the wind on one side contribute to the flexibility of the canopy structure, support and ease of shifting in the wind, easy transport and assembly, and when used in connection with a rectangular-shaped canopy attached to a gently curved frame, a low weight to shade ratio.

Applicant relies on a litany of Board cases to show that “a patent may not be evidence of functionality in regard to things of a ... ‘mere design’ nature which happen to be disclosed in the patent but which are not attributed any functional significance therein.”³⁴ We have reviewed these cases and find them distinguishable.

For example, in *In re UDOR U.S.A., Inc.*, Ser. No. 78867933, 2009 TTAB LEXIS 61 (TTAB 2009), the applicant sought registration of the following configuration for goods identified in the application as “metal spray nozzles” in International Class 6, which was also the subject of a utility patent:



³⁴ 8 TTABVUE 15 (quoting *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199 (CCPA 1969)). Applicant also relied on a federal district court case concerning a preliminary injunction in a patent infringement case, applying Ninth Circuit law. *See* 8 TTABVUE 15. We are not bound by this authority, as we apply the law set forth by the Federal Circuit and its predecessor. At any rate, this case also is distinguishable from the issues presented in the present appeal and we will not burden this opinion with a discussion of the differences.

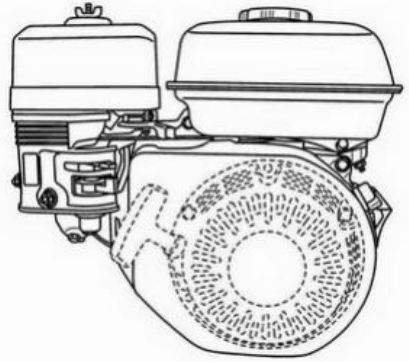
The Board found that relevant features of the patented device — namely, inner workings that permitted different fluid spray patterns to emerge — were not depicted in the trademark drawing. *Id.* at *8. The Board found:

As we understand the teachings of this utility patent, it is clear that the spray patterns of these removable/changeable nozzle heads are determined by rather complex principles of physics. Combinations of the design of several key internal features result in the interaction of several fluid streams, with fluid velocities and dispersion patterns calibrated to set pressures. While we do not purport to understand fluid mechanics, we accept the teachings of this patent that the tuned interaction of pressurized fluids hitting an impingement surface and the deflection ridges determines the variety of dispersion patterns of these various nozzle heads. These features are internal, largely non-visible components of the spray nozzle that are neither shown nor described in the trademark drawing, and some of which are not readily apparent without disassembly of the spray nozzle.

Id. at *10. The portions of the device visible in the drawing — the round shape of the nozzle head — were not shown to have inherent utilitarian value based upon the claims of the patented technology. *Id.* Although the drawings did depict a round nozzle head, the claims concerned the inner workings of the nozzle head. Thus, “the novel and non-obvious features claimed for this patented spray nozzle would function identically, irrespective of the shape of the portion of the spray nozzle head visible in the trademark product design configuration.” *Id.* at *11. In this case, however, the patent claims are directed to the outward shape of the patented beach shade, which is evident in the trademark drawings.

In *Kohler Co. v. Honda Giken Kogyo K.K.*, Opp. No. 91200146, 2017 TTAB LEXIS 450 (TTAB 2017), the applicant sought registration of the product configuration mark

shown below for “engines for use in construction, maintenance and power equipment,” in International Class 7:

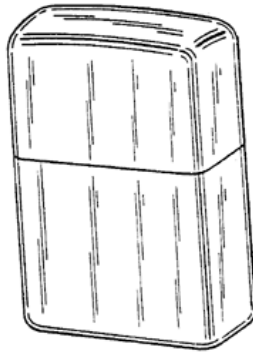


The Board found that a utility patent of record

shows various views of the GX Engine, and mentions the relative location and shape of the engine’s fuel tank and air cleaner, including in the claims, but it does not ascribe any functional benefits to those features. The patent claims are directed to the external structure and internal workings of the air cleaner and the precleaner themselves, which are internal components that are not part of the applied-for mark.

Id. at *103-04. The opposer did not argue that the patented internal features “necessarily dictates the appearance of any of the claimed [external] elements of Applicant’s design.” *Id.* at 104. Again, this is distinguishable from the case before us.

The case of *In re Zippo Mfg. Co.*, Ser. No. 74570070, 1999 TTAB LEXIS 130 (TTAB 1999), concerned a product configuration for a cigarette lighter “having slightly rounded edges and corners, and a curvature in the shape of a slight arc in the top of the lighter”:



The embodiment of the invention illustrated in the expired patent of record depicted a lighter with square corners and edges and straight lines, not the trademark sought by the applicant. Moreover, like *UDOR* and *Kohler*, the Board found that “the claims relate to the internal mechanism of the lighter. While the lighter configuration applicant seeks to register is designed to accommodate this internal mechanism, the patent discloses nothing of inherent utilitarian value about a lighter configuration with slightly rounded edges and corners, and a curvature in the shape of a slight arc in the top thereof.” *Id.* at *4-5. Again, this case is distinguishable from Applicant’s beach shade, where the evidence shows that its function dictates its shape.

Finally, in the case of *In re Weber-Stephen Prods. Co.*, Ser. No. 73181226, 1987 TTAB LEXIS 52 (TTAB 1987), the applicant sought registration of the three different configurations of barbeque grills shown below for, inter alia, barbecue grills and various barbeque grill accessories in Classes 11 and 21:



The Board examined two utility patents. Although the drawings in the first patent depicted a cooking grill with a round bowl supported on a tripod leg arrangement, “nothing in the patent discloses any utilitarian advantages of this particular design.” *Id.* at *14. The second patent was directed to a tray accessory, but nothing in the patent required it to be used with a round bowl or tripod leg arrangement. *Id.* at *15. Unlike the case before us, the shape of the grill was not the subject of any of the patents’ claims. The Board also noted the applicant’s concession that it was not attempting to claim exclusive rights in “covered grills or even in circular or spherical covered grills, but rather seeks only protection of its own unique shape. This statement is borne out by a number of consent agreements in infringement suits filed by applicant” against competitors who marketed round grills. *Id.* at *17 n.9. Equivalent evidence is not in this record.

Turning to Applicant’s other evidence, Mr. Delman testified that:

I understand that the Examining Attorney takes the position that the [’117, ’330, and ’690] Utility Patents “disclose the utilitarian advantages of the design of the applicant’s canopy, specifically the design of flexible poles and a rectangular fabric that relies on the wind for support.” I disagree with this statement, because while

some of the elements in Applicant's applied-for mark are mentioned in the ['117, '330, and '690] Utility Patents, none of the ['117, '330, and '690] Utility Patents claim the same overall configuration as shown in Applicant's applied-for mark[s].... Further, none of the ['117, '330, and '690] Utility Patents state or suggest that the particular shape of the canopy shown in Applicant's applied-for mark [– much less its two-toned nature –] provides any utilitarian advantage. I also disagree with the Examining Attorney's statement because neither poles nor flexibles poles are part of Applicant's applied-for mark.³⁵

Curiously, Mr. Delman did not review or address the claims of the '046 or '904 Utility Patents, which we find to be most relevant. Even if his testimony rings true in the context of the '117, '330, and '690 Patents, we would find it inapplicable to the '046 and '904 Utility Patents. Moreover, “poles” are part of Applicant's mark, because (as shown by Applicant's advertising, described further below) they comprise the frame described in the application.³⁶

Here, there is no element of the applied-for marks as described in the applications, save the two-toned shading of the mark in the '780 Application, which is not essential to the patented invention; and this shading is too incidental to transform the overall functionality of the applied-for mark into a nonfunctional mark. In short, “the functional features far outweigh any nonfunctional aspect of the arrangement which is incidental and hardly discernible as a separate element from the functional parts.” *Heatcon*, 2015 TTAB LEXIS 360, at *37.

³⁵ May 18, 2023 Request for Reconsideration at TSDR 172 (Delman Declaration).

³⁶ See *infra* text accompanying note 39.

In summary, at least the '046 and '904 Utility Patents include claims covering the same functional features of the frame and/or canopy that, as set forth in the description, comprise the applied-for marks. Although these patents explicitly state that other embodiments of the claimed inventions are possible (such as an “L” shaped angle in the frame rather than a curve),³⁷ the specification and claims, along with the drawings showing a curved frame and rectangular canopy, satisfy 35 U.S.C. § 112 because this configuration works best.

Accordingly, the '046 and '904 Utility Patents are strong and explicit evidence that the applied-for marks have overall utilitarian benefits. *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).³⁸

B. Advertising Touting the Utilitarian Advantages of the Applied-For Marks

The second *Morton-Norwich* factor considers the “advertising materials in which the originator of the design touts the design’s utilitarian advantages,” 671 F.2d 1332, 1340-41. (citations omitted). The Examining Attorney made of record pages from Applicant’s website at shibumishade.com. These excerpts include instructions on how to set up Applicant’s beach shade (*italics in original; emphasis in bold added*):³⁹

³⁷ May 18, 2023 Request for Reconsideration at TSDR 124, 139 (Column 6) ('046 and 904 Utility Patents).

³⁸ Having found that the '046 and '904 Utility Patents support a finding of functionality, we need not address the other utility patents of record.

³⁹ October 25, 2021 Office Action at TSDR 31-32; May 6, 2022 Office Action at TSDR 53-54.



Step 1

CONNECT the pole segments to form one long pole and lay the assembled pole on the sand perpendicular to wind direction.

Tip: Think tent poles; they're held together with a bungee.



Step 2

THREAD the canopy onto the pole (gently) through the channel in the fabric. The fabric is extremely lightweight, and too much force from the pole end could cause the fabric to snag and create a small tear. In really windy conditions, threading on a little bit of fabric at a time is best.

Tip: Take extra care when sliding the canopy on to the pole to avoid accidental nicks and tears in the fabric!



Step 3

INSERT each end of the pole securely in the sand at an angle (NOT straight up-and-down), to a depth of about 6 inches.

The pole should form a **long, gentle curve, and reach about 6.5 feet tall**, and the opening of the canopy should face the wind, leaning just slightly forward in to the breeze.

*Tip: * * This step is important! To avoid accidentally overflexing your poles, and to maximize shade coverage, you want the pole to have a long, gentle curve.*

Check out the photo below for a good example:



Shibumi Shade arch with a long, gentle curve.

These instructions clearly explain that a height of 6.5 feet and the “long gentle curve” depicted in the applied-for marks avoids overflexing (and potentially breaking) the poles forming the frame and maximizes shade coverage from the canopy — both utilitarian advantages of this shape.⁴⁰

Another page depicts the ease of setting up the shade, touting that “Set Up Is A Breeze,” because “Shibumi Shade is lightweight and easy to carry (4 lbs or less) and assembles in less than 3 minutes **with just one set of hands**”:⁴¹

⁴⁰ Applicant’s counsel contended at oral argument that the shape of the constructed beach shade could be taller or flatter depending on the user-selected distance between the end poles of the frame, indicating the shape is not functional. While true, the instructions by Applicant provide the best method for setting up the beach shade, which also reflects the applied-for marks. Applicant’s counsel did not adequately answer the panel’s questions as to why, given counsel’s argument, these applied-for configuration marks do not constitute “phantom marks.” See *In re Int’l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1368 (Fed. Cir. 1999) (“‘Phantom’ marks with missing elements ... encompass too many combinations and permutations to make a thorough and effective search possible. The registration of such marks does not provide proper notice to other trademark users, thus failing to help bring order to the marketplace and defeating one of the vital purposes of federal trademark registration.”); see also TMEP § 1214.01. But we need not sua sponte address that question here.

⁴¹ October 11, 2023 Office Action at TSDR 54 (emphasis added).



The clear import of Applicant’s advertising is that the single arched or curved frame depicted in Applicant’s applied-for marks enables one person to set the shade up quickly by planting one pole and then the other, providing a utilitarian advantage. Applicant’s website features its customer’s views explaining that the product is “much easier to put up than a tent or umbrella”⁴² and the shade is “easily adjusted through the day as the sun move[s] across the sky,”⁴³ presumably because the structure can be repositioned by one person by replanting only one side of the curved frame and allowing the other to stay firmly planted.⁴⁴

This advertising confirms Applicant’s arched frame and canopy design has at least the following utilitarian advantages: (1) ease of set-up; (2) maximization of shade;

⁴² *Id.* at TSDR 87 (customer review on Applicant’s website).

⁴³ October 11, 2023 Office Action at TSDR 59 (customer review on Applicant’s website).

⁴⁴ *See* August 28, 2024 Subsequent Final Office Action at 14, 15, 43, 45 (explaining that the similar designs permit easy repositioning if the wind direction has shifted by moving one side of the frame).

and (3) ease of repositioning to follow the movement of the sun or direction of the wind.

The second category of *Morton-Norwich* evidence strongly supports a determination that the applied-for marks are functional.

C. Alternative Designs and Cost of Manufacture

We note that, once functionality is found based on other considerations, there is no need to consider further *Morton-Norwich* factors. *E.g.*, *Creative Edge*, 2019 TTAB LEXIS 127, at *19 (quoting *Becton, Dickinson*, 675 F.3d at 1376; and citing *TrafFix*, 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.”)). Nonetheless, we address the third and fourth factors for completeness.

The third *Morton-Norwich* factor concerns the availability to competitors of functionally equivalent designs. Applicant points to examples in the record of alternative designs for beach shades that are not aurally-supported, such as umbrellas, tents, and staked shades.⁴⁵ Applicant’s co-founder Dane Barnes submitted a declaration stating that “Applicant’s competitors can and do use a wide variety of canopies that employ countless different shapes, shading patterns, and frame systems but that achieve the same purpose as Applicant’s product.”⁴⁶ But Applicant failed to explain how these other products (umbrellas, tents, and staked shades)

⁴⁵ 8 TTABVue 9, 13, and 21-22.

⁴⁶ March 23, 2022 Response to Office Action at TSDR 27 (Barnes Declaration).

provide the same identified utilitarian advantages as Applicant's beach shade, aside from the broad function of providing shade from the sun.

The Examining Attorney points to examples of competitors in the record which extol "the same utilitarian advantages of the applied-for product design. Specifically, information from third-parties shows that a fabric canopy attached on one side of a structure with minimal surface contact is desirable," citing the following:⁴⁷

Million Shades:⁴⁸



Solbello:⁴⁹



⁴⁷ 10 TTABVUE 10.

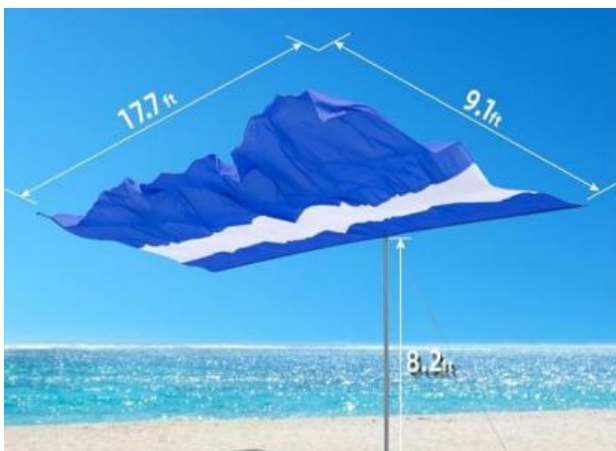
⁴⁸ August 28, 2024 Subsequent Final Office Action at TSDR 106.

⁴⁹ *Id.* at TSDR 118.

Shark Fin:⁵⁰



Tenrai:⁵¹



⁵⁰ *Id.* at TSDR 126.

⁵¹ *Id.* at TSDR 138.

Serial Nos. 90785780 and 90785791

Other examples in the record include:

Boyxco/Beach Shade:⁵²



Shade Sock:⁵³



⁵² *Id.* at TSDR 110.

⁵³ *Id.* at TSDR 128.

One additional example in the record, SunSail, also features an arched frame but a differently shaped canopy:⁵⁴



Although competitors sell alternative beach shade designs that (like Applicant’s design) work with the wind and not against it, we cannot determine from this evidence that these designs work “equally well” as Applicant’s product. *Valu Eng’g*, 278 F.3d at 1276 (citation omitted). If competitors cannot achieve the utilitarian advantages provided by Applicant’s applied-for configuration without copying it, then the design is “essential to the purpose” of the shade and “affects the ... quality of the article.” See *Inwood*, 456 U.S. at 850 n.10; *TrafFix*, 532 U.S. 23 at 25.

Moreover, it is not necessary for a finding of functionality that there are a few other designs available; it is sufficient if the product design Applicant seeks to register is one of only a few superior designs. See *Bose*, 772 F.2d at 872. In such

⁵⁴ *Id.* Two additional products in the record, one by Beach Shade (October 11, 2023 Office Action at TSDR 9) and another “generic” product (August 28, 2024 Subsequent Final Office Action at TSDR 29), are highly similar to Applicant’s product, such that we would not call them “alternative designs.”

circumstances, to issue a trademark registration covering Applicant's design would frustrate the policies of patent law whereby competitors should be free to practice the invention upon the expiration of Applicant's patents. *See TrafFix*, 532 U.S. at 34 ("The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity."), *cited in McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, Can. No. 92067618, 2021 TTAB LEXIS 167, *50 (TTAB 2021).

We also observe that Applicant contends it has taken action against some products based on its design patents.⁵⁵ The evidence Applicant's enforcement efforts is vague and non-specific. In particular, we cannot determine whether Applicant has attempted to enjoin sale of any of these products based on its design or utility patents, which would suggest that they are not available alternative designs. In this case, we find the third *Morton-Norwich* factor to be neutral.

The fourth *Morton-Norwich* factor considers whether the design results in a comparatively simple or cheap method of manufacturing the product. Because the Examining Attorney offered little relevant evidence of record on the fourth factor, we find it also to be neutral. *See Becton, Dickinson*, 675 F.3d at 1376 (finding fourth factor neutral for insufficient evidence); *Creative Edge*, 2019 TTAB LEXIS 127, at *20 (same).

⁵⁵ See April 11, 2024 Response to Office Action at TSDR 44 (Barnes Decl. ¶¶ 27-29).

D. Applicant's Other Arguments and Evidence

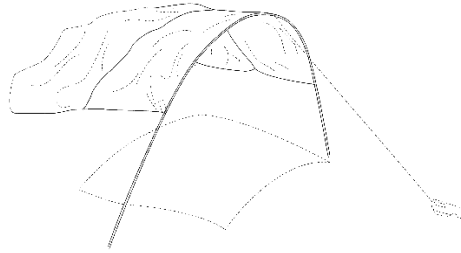
With the majority of features of Applicant's applied-for marks claimed in the '046 and '904 Utility Patents and explained by Applicant in its advertising as providing utility, Applicant "carr[ies] the heavy burden of showing that the feature[s are] not functional, for instance by showing that [they are] merely an ornamental, incidental, or arbitrary aspect of the device." *McGowen Precision Barrels*, 2021 TTAB LEXIS 167, at *53 (quoting *TrafFix*, 532 U.S. at 30).

Applicant contends that it chose the shape of its product for aesthetic reasons, and its design patents are proof that the applied-for marks are non-functional.⁵⁶ Unlike a utility patent, "[a] design patent protects the nonfunctional aspects of an ornamental design[.]" *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). A design patent appearing to cover the applied-for mark 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).⁵⁷

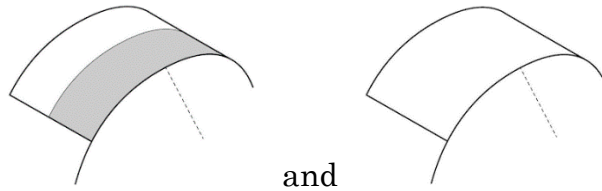
⁵⁶ 8 TTABVUE 17-20 and n.19.

⁵⁷ 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).

For example, Patent No. D989350 (the '350 Design Patent) depicts the following drawing:⁵⁸



This design is similar to Applicant's applied-for marks



in that all are comprised of a rectangular canopy that is attached on one side to a curved frame and supported by wind on the other three sides.⁵⁹

At the same time, however, the drawing depicted above from the '350 Design Patent (and the drawings from Applicant's other design patents) are 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).⁶⁰ We

⁵⁸ The drawings from Applicant's other design patents appear to be identical or highly similar to that of the '350 Design Patent depicted herein, and Applicant has not pointed out any significant differences between them.

⁵⁹ Recall that the applied-for marks are described as: "a three-dimensional configuration comprising the design of a rectangular canopy [with two horizontal stripes,] attached to a curved frame along one side and unattached on the other three sides. On both sides the curved frame extends beyond the point where the canopy is attached thereto."

⁶⁰ Thus, we disagree somewhat with the testimony of Applicant's expert witness Joel Delman, an industrial designer, who testified that the USPTO's allowance of the design patent applications "strongly supports the protectability of Applicant's applied-for mark and refutes

must examine the totality of the evidence, including Applicant's utility patents and advertising. In this case, the strong evidence of functionality from the '046 and '904 Utility Patents and Applicant's website rebuts whatever proof of non-functionality may result from the existence of Applicant's design patents.

Applicant distinguishes *Loggerhead Tools*, 2016 TTAB LEXIS 260, relied on by the Examining Attorney, arguing that the design patent in that case "did not depict the same design for which the applicant sought a trademark registration [and] that is not the case here."⁶¹ We could, perhaps, apply the local of *Loggerhead* here, where the parabolic shape of the arch depicted in Applicant's design patents is not identical to the rounded arch in the applied-for marks. But even if *Loggerhead* is distinguishable on its facts, the presumptive non-functionality of a proposed mark arising from "identity between the design patent and proposed mark," *Loggerhead Tools*, 2016 TTAB LEXIS 260, at *8, may be overcome by other evidence of functionality, as we have in this case with Applicant's utility patents and advertising. *OEP Enters*, 2019 TTAB LEXIS 278, at *20-21.

We also are not persuaded by Applicant's argument that

[T]here are aspects of the applied-for trade dress to which the advertising referenced by the Examining Attorney simply does not apply, such as the rectangular shape of the

the Examining Attorney's functionality refusal." May 18, 2023 Request for Reconsideration at TSDR 173. Moreover, Mr. Delman does not appear to be qualified as an expert in the field of trademark registration, and we give no weight to those legal conclusions. *See In re Loggerhead Tools, LLC*, Ser. No. 85700986, 2016 TTAB LEXIS 260, *13 (TTAB 2016) (declining to give consideration to expert opinions on functionality of product design, as "we will not substitute the opinion of a witness, even an expert witness, for our evaluation of the facts") (citations omitted).

⁶¹ 11 TTABVUE 4.

canopy (including its particular dimensions), the specific places on the curved frame at which the canopy attaches, and (in the case of the mark that is the subject of Serial No. 90785780) the two-toned appearance of the canopy. Conversely, there are important aspects of Applicant's underlying product to which the statements on Applicant's website apply but that are not part of Applicant's Marks. For example, Applicant's shade comes with an anchor and cord to keep the shade upright in wind, and the anchor and cord are an important part of why Applicant's beach shades won't "blow away in high winds" – yet neither the anchor nor the cord is part of Applicant's Mark.⁶²

Applicant has not demonstrated that its design does not function (i.e. stay upright or provide shade) without the dotted-out cord and anchor (a sandbag). We can infer from Applicant's advertising and utility patents (as well as third party evidence of record) that Applicant's product is more stable in high winds when using a cord and anchor as a counterweight. Applicant, however, also touts that "[a]s little as 3 mph of wind is all it takes to keep the canopy floating effortlessly."⁶³ Evidence supplied by the Examining Attorney suggests that a similar "cordless" shade without a counterweight "works well in low to medium wind."⁶⁴ Applicant's utility patents do not require a cord and anchor; this is disclosed only in some of the claims.⁶⁵ The size and shape of the canopy and its attachment at a higher or lower point on the arch

⁶² 8 TTABVue 20-21.

⁶³ August 28, 2024 Subsequent Final Office Action at TSDR 59.

⁶⁴ *Id.* at TSDR 39, 43.

⁶⁵ *See, e.g.*, May 18, 2023 Request for Reconsideration at TSDR 122 ('046 Utility Patent, Column 2) ("According to at least one embodiment of the disclosed subject matter, the system further includes a cord coupled to an anchor and engageable with, or coupled to, the canopy or frame, the anchor configured for housing weight.").

could result in more or less shade, or more or less friction on the poles to keep the canopy in place, all functional considerations.

Nonetheless, “[w]hen 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*, 675 F.3d at 1373. “[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.

Here, the functional features “outweigh ... the other decorative and nonfunctional aspects,” and the marks as a whole are functional. *Kohler*, 2017 TTAB LEXIS 450, at *99-100 (citation omitted).

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 utility patents, and in particular the ’046 and ’904 Utility Patents, and advertising establish the functional benefits of Applicant’s applied-for marks. 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; *Kohler*, 2017 TTAB LEXIS 450, at *96. The third and fourth *Morton-Norwich* factors are neutral and Applicant’s other evidence does not tip the balance in its favor.

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

Decision

The refusals to register under Trademark Act Section 2(e)(5) are **affirmed**.