

**IN THE UNITED STATES PATENT AND TRADEMARK C  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 75/701,707  
Mark: Drawing of a Marine Heat Exchanger  
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DURAMAX MARINE, LLC, )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 R.W. FERNSTRUM & COMPANY, )  
 )  
 Applicant. )

Opposition No. 119,899



Commissioner for Trademarks  
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11-19-2004  
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #66

**OPPOSER'S TRIAL BRIEF**

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Abbreviations

Dep. Ex.                   =       Deposition Exhibit

Ex.	=	Exhibit
ONR	=	Opposer's Notice of Reliance
P. Fernstrum Tr.	=	Paul Fernstrum Transcript
S. Fernstrum Tr.	=	Sean Fernstrum Transcript
Tab A through F	=	Tab A through F, respectively, of Opposer's Notice of Reliance
Tr. Tes. Dep.	=	Trial Testimony Deposition

## **I. Introduction**

R.W. Fernstrum & Company ("Fernstrum" or "Applicant") filed a service mark application to register a line drawing of one of its many models of marine heat exchangers or keel coolers, and Duramax Marine, LLC ("Duramax Marine" or "Opposer") has opposed the application. The bases for the opposition are as follows. First, Fernstrum cannot obtain a registration of a picture of one of the products that Fernstrum manufactures and sells, because it is merely descriptive under Section 2(e)(1) of the Trademark Act. Second, registration should be refused under Section 2(e)(5) of the Trademark Act because a registration should not be issued for a picture of a functional product having only functional features, and the Fernstrum keel cooler shown in the mark that is the subject of Serial No. 75/701,707 is entirely functional. Third, the results of a survey filed by Fernstrum in support of its effort to overcome the refusal to register because the drawing is merely descriptive under Section 2(e)(1) of the Trademark Act, by alleging it has acquired distinctiveness under Section 2(f) of the Trademark Act, was fatally defective in that the survey was not based on the mark that is the subject of Serial No. 75/701,707.

## **II. Description of the Record**

The most relevant evidence of record includes application Serial No. 75/701,707; Applicant's Response to Opposer's First Set of Requests for Admissions; Applicant's Answers to Opposer's First Set of Interrogatories Nos. 3(b), 11(a), 13, 15, 22, 23, 24, 26, 28 and 29; Applicant's Response to Opposer's Second Set of Requests for Admissions No. 12; the discovery depositions of Messrs. Paul Fernstrum and Sean Fernstrum; the trial testimony depositions of Messrs. Michael Brakey, Richard Lockhart and Jeffrey Leeson, together with Opposer's Trial Exhibits Nos. 1-41 directed to the foregoing deponents; and the trial testimony depositions of

Messrs. Paul Boudreaux, Todd Boudreaux, Steven Garver, Kyle McHugh and David Culpepper, Esq., together with Opposer's Trial Exhibits Nos. 1-27 directed to the latter deponents.

**III. Statement of the Issues Relating to the Opposition to Serial No. 75/701,707**

1. Whether Applicant can obtain a service mark registration on a nearly exact picture of one of the many models of a one-piece keel cooler or marine heat exchanger to which the services of the service mark relate, pursuant to 15 U.S.C. 1052(e)(1), Section 2(e)(1) of the Trademark Act;

2. Whether Applicant can obtain a service mark registration on a realistic drawing of a one-piece keel cooler or marine heat exchanger having only functional features, pursuant to 15 U.S.C. 1052(e)(5), Section 2(c)(5) of the Trademark Act; and

3. Whether Applicant can obtain a service mark registration where Applicant attempted to overcome a refusal to register the mark under Section 2(e)(1) of the Trademark Act as being merely descriptive, by attempting to establish acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. §1502(f) based on a survey conducted in a separate litigation using photographs of an unrecognizable portion of an actual keel cooler of a different model than that which is the subject of the application, which portion omitted key portions (namely the header assemblies) of the keel cooler depicted in the service mark application, rather than the drawing which constitutes the service mark application being opposed.

**IV. Facts**

**A. The Drawing of Serial No. 75/701,707 and Examples Thereof are Realistic Views of the Fernstrum Keel Cooler.**

Fernstrum and its predecessor have been in the business of making marine heat exchangers for about 50 years (Tab B, Answer to Opposer's Interrogatory 3(b)). The Fernstrum marine heat exchanger or keel cooler was the first to have rectangular coolant flow tubes to

compact the unit to fit into a smaller footprint, i.e., the area on a ship's hull where the keel cooler is mounted. (Tab E, P. Fernstrum Tr., p. 9, l. 25 – p. 10, l. 22; p. 12, l. 6) Robert Fernstrum obtained U.S. Patent No. 2,832,218 (Tab F, Ex. ONR-4) which issued in 1945 covering his invention. For many years, Fernstrum has designated its keel cooler with the trademark GRIDCOOLER (Tab A, Ex. 2). Fernstrum keel coolers are characterized by parallel rectangular tubes. (Tab E, P. Fernstrum Tr., p. 58, l. 15 – p. 59, l. 3) The coplanar relationship helps in keeping the Fernstrum keel cooler compact. (Tab E, P. Fernstrum Tr., p. 58, l. 20 – p. 59, l. 12; p. 70, l. 10-15) The rectangular cross section of the tubes improves their heat transfer capacity over round tubes. (Tab E, P. Fernstrum Tr., p. 12, l. 6-16; p. 58, l. 20 – p. 59, l. 12) Fernstrum has been using drawings similar to those of the present application being opposed since the mid-1950's, and use of the present drawing commenced in 1974. (Tab B, Answer to Opposer's Interrogatory 3(b); Tab E, S. Fernstrum, Dep. Ex. 3) Although it has been used for many years, it was never understood as being a service mark (or a trademark). (S. Garver Tr. Tes. Dep., p. 8, l. 7 – p. 9, l. 2) The drawing that is the subject of Serial No. 75/701,707 is a picture of one of the marine heat exchangers or keel coolers manufactured and sold by Fernstrum. (Tab E, P. Fernstrum Tr., p. 120, l. 3-10; M. Brakey Tr. Tes. Dep. p. 15, l. 24 – p. 16, l. 17; p. 17, l. 6-9; p. 23, l. 12-14; p. 25, l. 6-7, l. 11-13; p. 25, l. 23 – p. 26, l. 24) A comparison of photographs of different models of the Fernstrum keel cooler with the drawing in Fernstrum's trademark application Serial No. 75/701,707 shows the close similarity of the service mark to the product to which the services of the application being opposed are directed. (Serial No. 75/701,707, p. 000069; Tab E, S. Fernstrum Dep. Ex. 3, pp. 0220 (000023), 0258 (000060), 0260 (000062), 0265 (000067); 0327 (000129), 0352 (000154), 0358 (000160), 0442 (000244) and 0449

(000251)) Fernstrum has admitted that it is seeking to register, in two-dimensional format, a picture of its one-piece keel cooler. (Tab C, Applicant's Response to Request for Admission 11)

Fernstrum has for many years shown in its advertisements pictures of its keel cooler, emphasizing the compactness of the Fernstrum keel coolers. (Tab E, P. Fernstrum Tr., p. 61, l. 12-23) This is set forth in numerous examples of Fernstrum's advertisements. (Tab B, Fernstrum's Response to Interrogatory No. 11, pp. 0218 (000021), 0226 (000029), 0242 (000045), 0256 (000058), 0259 (000061) 0263 (000065), 0266 (000068), 0269 (000071), 0270 (000072), 0271 (000073), 0273 (000075), etc.)

Fernstrum has continuously contended that its service mark is a picture of the Fernstrum keel cooler viewed from any direction facing the header (i.e. the end of the keel cooler for receiving heated coolant fluid from an engine or other heat source for flow into the coolant flow tubes between the headers, or for receiving cooled coolant fluid from the coolant flow tubes for flow to the heat source). Fernstrum has submitted representative specimens showing the actual use of the mark it is trying to register. (Tab B, Applicant's Response to Interrogatory 11(a); Tab E, S. Fernstrum Dep. Ex. 3., pp. 0198 (000001)-0494 (000296)) Referring to the aforementioned exhibit, it can be seen that Fernstrum contends that the trademark is a picture of its keel cooler viewed facing the right-hand corner of the header (Tab E, S. Fernstrum Dep. Ex. 3, pp. 0200 (000003), 0204-0208 (000007-000011) 0211 (000014), 0218 (000021), 0225 (000028), 0260 (000062), 0274 (000076), 0281 (000083), 0290-0291 (000092-000093) and 0370-0371 (000172-000173)), or facing the front (Tab E, S. Fernstrum Dep. Ex. 3, pp. 0272 (000074), 0277 (000079), 0388 (000190) and 0407 (000209), or as a view directed to the left corner (Tab E, S. Fernstrum Dep. Ex. 3, pp. 0201 (000004), 0269 (000071), 0231 (000073), 0273 (000075) and 0450 (000252)).

The picture of Fernstrum's keel cooler that is the subject of Serial No. 75/701,707 (p. 0069) or of the examples showing Fernstrum's mark (pp. 0070-0071) were either photographs or made from photographs of the Fernstrum keel cooler. (Tab E, Fernstrum Tr., p. 25, l. 19 – p. 27, l. 8) Referring to the file history of Serial No. 75/701,707, the picture in the application was originally a photograph that was touched-up, and from it a line drawing was made for the application. (Tab B, Answer to Interrogatory 11(b); Tab E, S. Fernstrum Dep. Ex. 3, pp. 0198-0494 (000001-000296); S. Fernstrum Tr., p. 43, l. 12 – 25; p. 44, l. 17 – p. 45, l. 6) The drawing in the '707 application could have been traced from a photograph of the Fernstrum unit (Brakey Tr. Tes. Dep., p. 63, l. 21-25 – p. 64, l. 11) and is a realistic picture of a Fernstrum keel cooler (Garver Tr. Tes. Dep., p. 7, l. 15 – p. 8, l. 15).

Fernstrum has supplied numerous pictures of its keel coolers which are examples of its use of the trademark in Serial No. 75/701,707. (Tab E, S. Fernstrum Dep. Ex. 3) However, those pictures are realistic pictures of the Fernstrum keel cooler (Brakey Tr. Tes. Dep., p. 71, l. 7-9; p. 74, l. 9-25; p. 77, l. 8-17; p. 79, l. 3-9; p. 80, l. 14 – p. 82, l. 7; p. 84, l. 22 – p. 106, l. 23; p. 102, l. 7 – p. 103, l. 1; p. 104, l. 13 – p. 105, l. 1; p. 116, l. 2 – p. 120, l. 4; p. 119, l. 8-14; p. 123, l. 15-17; p. 124, l. 14-25; Lockhart Tr. Tes. Dep., p. 46, l. 24-25; p. 47, l. 13-19; p. 49, l. 5-21; P. Boudreaux Tr. Tes. Dep., p. 25, l. 22 – p. 26, l. 6 – p. 27, l. 16; McHugh Tr. Tes. Dep. Ex. 6; McHugh Tr. Tes. Dep., p. 23, l. 20 – p. 24, l. 11; T. Boudreaux Tr. Tes. Dep. Ex. 13, pp. 1194-1211; T. Boudreaux Tr. Tes. Dep., p. 9, l. 24 – p. 12, l. 9, l. 13 – p. 14, l. 12) Other Fernstrum promotional materials show examples of the drawing which is the subject of the presently opposed service mark, and they also show clear representations of the Fernstrum keel cooler. (Lockhart Tr. Tes. Dep. Ex. 19, 21, 23, 26 and 32; Lockhart Tr. Tes. Dep., p. 12, l. 11 – p. 13, l. 4, l. 20 – p. 14, l. 3; p. 39, l. 8-16; p. 16, l. 14-18; p. 18, l. 17 – p. 19, l. 4; p. 20, l. 10-17; p. 44, l.

17 – p. 45, l. 5; p. 22, l. 16 – p. 23, l. 8; p. 45, l. 6-15; p. 28, l. 20 – p. 29, l. 10; p. 45, l. 16 – p. 46, l. 9, 24-25; p. 47, l. 13-19) Sean Fernstrum, Vice President, Operations, of Fernstrum (Tab B, Answer to Opposer's Interrogatory No. 1), has stated that the differences between the drawing in Serial No. 75/701,707 and the examples of the use of the Fernstrum mark (Tab E, S. Fernstrum Dep. Ex. 3, pp. 0198-0494 (000001-000296) were only minor changes that would not detract from the fact that the drawings of the Fernstrum keel cooler were very realistic. (Tab E, S. Fernstrum Tr., p. 73, l. 21-25; p. 76, l. 19-20; p. 77, l. 15 – p. 78, l. 6; p. 81, l. 5-24; p. 85, l. 14 – p. 86, l. 12; p. 89, l.20 – p. 91, l. 21) With respect to S. Fernstrum Dep. Ex. 3, page 0202 (000005), Sean Fernstrum distinguished the picture from a real keel cooler by the omission of minor components, support bolts and electrodes. (Tab B, Applicant's Revised Response to Initial Request for Production No. 1; S. Fernstrum Tr., p. 78, l. 13 – p. 80, l. 19) Turning to S. Fernstrum Dep. Ex. 3, pp. 0203-0204 (000006-000007), Sean Fernstrum could not tell whether the picture of the keel cooler could have been made from a photograph or a real product. (Tab E, S. Fernstrum Tr., p. 81, l. 1 – p. 82, l. 13) Sean Fernstrum explained that the picture of the service mark sought to be registered was either a drawing or a photograph (Tab E, S. Fernstrum Tr., p. 85, l. 25 – p. 86, l. 3). With respect to S. Fernstrum Dep. Ex. 3, p. 0260 (000062), Sean Fernstrum said that he was not sure if the picture was a photograph or a drawing. (Tab E, S. Fernstrum Tr., p. 129, l. 19 – p. 130, l. 14) Fernstrum's advertiser has photographs of existing units from which they make their advertisements showing the various versions of the mark shown in Serial No. 75/701,707. (Tab E, S. Fernstrum Tr., p. 26, l. 2 – p. 27, l. 8; p. 34, l. 7-20; p. 43, l. 11-25; p. 44, l. 17 – p. 45, l. 6; p. 73, l. 21-25; p. 103, l. 23 – p. 104, l. 21) With respect to Fernstrum's current catalog (Tab E, P. Fernstrum Dep. Ex. 12; P Fernstrum Tr., p. 97, l. 17-21), the pictures of Fernstrum's products look like photographs, could have been photographs or

could be line drawings made from photographs. (Tab E, P. Fernstrum Tr., p. 107, l. 14-21) Even Fernstrum's trademark registration showing their keel cooler in front of a globe depicts the keel cooler in exactly the same way as the mark of the present opposition (Tab E, P. Fernstrum Tr., p. 137, l. 8-22), and that it was described as being a photograph. (Tab E, P. Fernstrum Tr., p. 137, l. 14-15)

In addition to using various versions of the drawing of the Fernstrum keel cooler that is the subject of U.S. Serial No. 75/701,707, the same type of drawing was used on Fernstrum's patent applications. Fernstrum's U.S. Patent No. 4,338,993 (Tab E, S. Fernstrum Dep. Ex. 13) includes a picture of a Fernstrum keel cooler (Tab E, Brakey Tr. Tes. Dep., p. 126, l. 20-25; p. 128, l. 25 – p. 129, l. 22), and this product is still in use. (P. Boudreaux Tr. Tes. Dep., p. 9, l. 8 – p. 10, l. 1; p. 16, l. 6–21; p. 27, l. 10-16). Sean Fernstrum testified that it had some differences from the drawing of Serial No. 75/701,707. The differences he noted included a support plate with support bolts, the threading on the nozzle. There was some question as to whether or not it was a perspective view or an isometric view. (Tab E, S. Fernstrum Tr., p. 163, l. 16 – p. 164, l. 8; p. 165, l. 2 – p. 167, l. 25) Third parties having no affiliation with either Duramax Marine or Fernstrum have described the drawing in Serial No. 75/701,707 as a realistic depiction of a keel cooler. (P. Boudreaux, Tr. Tes. Dep., p. 9, l. 24 – p. 10, l. 1; p. 16, l. 6-8; McHugh Tr. Tes. Dep., p. 7, l. 17-22; p. 8, l. 16-21; p. 10, l. 16-23) Of course, by statute, a patent applicant is required to set forth a drawing necessary for an understanding of a product to be patented (35 U.S.C. §113).

Fernstrum made keel coolers of the type shown in Serial No. 75/701,707 and on the various uses of the trademark that is the subject of the application. For example, the picture of the keel cooler shown in the *Work Boat* advertisement (Tab E, S. Fernstrum Dep. Ex. 3, p. 0269)

was stated to be a D-10-60 Fernstrum keel cooler (Tab E, S. Fernstrum Tr., p. 83, l. 7 – p. 85, l. 7; p. 112, l. 17 – p. 113, l. 9).

The marine heat exchanger shown in Serial No. 75/701,707, and in the various uses of the picture as contended by Fernstrum, is a picture of a completely functional unit. There is nothing that is ornamental or fanciful on the Fernstrum keel cooler (Tab E, S. Fernstrum Tr., p. 120, l. 9-15; McHugh Tr. Tes. Dep., p. 7, l. 17-22; p. 8, l. 16-21; p. 10, l. 15-23) or the picture thereof; there is no aspect that is merely a desirable or attractive feature; and, there is no portion of the drawing that would allow one to know that the unit came from Fernstrum. (Tab E, S. Fernstrum Tr., p. 120, l. 9-21; P. Boudreaux Tr. Tes. Dep., p. 30, l. 8-14; p. 31, l. 18 – p. 32, l. 9)

Even though Fernstrum's U.S. Patent No. 2,382,218 expired in 1962, it had a virtual monopoly on one-piece keel coolers until about 1997. (Brakey Tr. Tes. Dep., p. 80, l. 9-11) Fernstrum filed a trademark application, U.S. Serial No. 75/382,250 on October 30, 1997. (Tab E, P. Fernstrum Dep. Ex. 72) This trademark application was directed to the three-dimensional keel cooler of which a two-dimensional version is shown in U.S. Serial No. 75/701,707. (Tab E, P. Fernstrum Dep. Ex. 72; P. Fernstrum Tr., p. 37, l. 3-20; p. 38, l. 6 – p. 39, l. 5) The drawings for the application of Serial No. 75/382,250 are virtually identical with the drawing in application Serial No. 75/701,707, except that the lines are dotted for the headers and exterior side tubes in the '250 application (since the application was for the three-dimensional view of the parallel coolant flow tubes) and are solid in Serial No. 75/701,707. (Tab E, P. Fernstrum Dep. Ex. 72; P. Fernstrum Tr., p. 52, l. 17-23; p. 76, l. 7 – p. 77, l. 23; J. Leeson Tr. Tes. Dep., p. 13, l. 15-24; p. 14, l. 8-21) The application for Serial No. 75/382,250 included a photograph of the Fernstrum keel cooler, demonstrating the two headers and the coolant flow tubes between them, although the application was only directed to the coolant flow tubes. (Neither the drawing nor

the photographs from Serial No. 75/382,250 have page numbers, but they are located between pages nos. 0495 and 0496 of Tab E, P. Fernstrum Dep. Ex. 72.) As in the '707 application of the present opposition, the drawing of the '250 application was nearly identical to a photograph of the Fernstrum keel cooler. (Tab E, P. Fernstrum Dep. Ex. 72; Brakey Tr. Tes. Dep., p. 47, l. 4-7; p. 58, l. 24 – p. 59, l. 8) As discussed below, Fernstrum subsequently abandoned Serial No. 75/382,250. (Tab E, P. Fernstrum Dep. Ex. 72; P. Fernstrum Tr., p. 37, l. 14 – p. 39, l. 5; p. 94, l. 23 - p. 95, l. 15; p. 97, l. 6-13; Settlement and Mutual Release, Culpepper Tr. Tes. Dep. Ex. 27, para. 15)

**B. The History of Fernstrum Trying to Protect Its Keel Cooler Design.**

Fernstrum had terminated its long-standing distributorship arrangement with Donovan Marine, Inc., a marine equipment distributor for the Gulf states, and Donovan Marine asked Duramax Marine if it could supply it with one-piece keel coolers of the type it had been distributing for Fernstrum. After Duramax Marine began supplying Donovan Marine with one-piece keel coolers, Duramax Marine commenced an extensive research and development project, one result of which was U.S. Patent No. 6,575,227. (Tab F, Ex. ONR-6) As explained in the '227 patent, this new keel cooler is more efficient than the keel cooler of Fernstrum in that it has a higher rate of coolant flow within the keel cooler and increased heat conduction into the ambient sea water. (Tab F, Ex. ONR-6, col. 8, l. 55-65; col. 10, l. 31-53 and 61-66) One of the aspects of the new keel cooler of Duramax Marine is a bevel on the upstream and downstream faces of the keel cooler. (Tab F, Ex. ONR-6, Fig. 13, 00110, l. 31-53, Fig. 13) Duramax Marine has adopted the trademark DURACOOLER for its new keel cooler. (Brakey Tr. Tes. Dep., p. 151, l. 4-10; Lockhart Tr. Tes. Dep., p. 7, l. 14 –p. 8, l. 10)

Donovan Marine brought a lawsuit in the State of Louisiana against Fernstrum on a number of grounds including unreasonable restraint of trade, unfair and deceptive trade practices, and breach of contract. Fernstrum removed the litigation from the Louisiana court to the U.S. District Court in New Orleans. Another lawsuit was pending between Fernstrum and East Park Radiator and Battery Shop, Inc. ("East Park") wherein Fernstrum had accused East Park of alleged infringement of Fernstrum's GRIDCOOLER trademark, alleged infringement of Fernstrum's trade dress rights to the three-dimensional configuration of the parallel coolant flow tubes with the rectangular configuration, unfair competition, dilution and state unfair trade practice. The District Court consolidated the cases between Fernstrum and Donovan Marine and between Fernstrum and East Park. Fernstrum filed a counterclaim, and among other things, alleged that Donovan Marine had infringed the three-dimensional trade dress of the Fernstrum keel cooler, unfair competition and state unfair trade practice.

In the litigation before Judge Lemmon in the U.S. District Court in New Orleans, after Fernstrum had put on its case, Judge Lemmon instructed Fernstrum to attempt to settle the litigation. (Brakey Tr. Tes. Dep., p. 129, l. 23 – p. 131, l. 3; p. 133, l. 6 – p. 134, l. 5; p. 137, l. 8-12, 25 – p. 138, l. 2, 8-22) A term sheet (Culpepper Tr. Tes. Dep. Ex. 26) was drawn up by David Culpepper, Esq., the attorney representing Donovan Marine, as the result of negotiations between the lawyers representing each of the parties to the litigation (Fernstrum and East Park) and representing Duramax, Inc., the predecessor to Duramax Marine. Michael Brakey, who was prepared to testify as an expert on keel coolers, was present during the negotiations (Culpepper Tr. Tes. Dep., p. 4, l. 11 – p. 5, l. 17; Brakey Tr. Tes. Dep., p. 130, l. 2 – p. 131, l. 3; p. 140, l. 4-10; p. 141, l. 13 – p. 142, l. 7), as was Paul Fernstrum, the president of Fernstrum. There was nothing in the term sheet that would preclude Duramax Marine from opposing an application by

Fernstrum to register a drawing of its keel cooler. (Culpepper Tr. Tes. Dep., p. 5, l. 18 – p. 6, l. 24) The term sheet was the basis for the actual "Settlement and Mutual Release Agreement" (Culpepper Tr. Tes. Dep. Ex. 27) entered into by the same parties who signed the term sheet. (Culpepper Tr. Tes. Dep., p. 7, l. 1-19; Brakey Tr. Tes. Dep., p. 142, l. 15 – p. 144, l. 3) The latter Agreement had nothing that would preclude Duramax Marine from opposing the present application of Fernstrum. (Culpepper Tr. Tes. Dep., p. 8, l. 20 – p. 10, l. 9)

**C. Fernstrum Unsuccessfully Attacked Duramax Marine's Advertising Campaign.**

Fernstrum nevertheless continued bringing legal action against Duramax Marine in an apparent effort to keep Duramax Marine from selling its keel cooler. Fernstrum filed a complaint against Duramax Marine before Judge Enslin, the Chief U.S. District Judge for the U.S. District Court, Western District of Michigan, on September 17, 2000. Fernstrum was objecting to an advertising term "best by test" used by Duramax Marine in promoting its new keel cooler, which it designates with the trademark DURACOOLER. Fernstrum had alleged that the "test" used in the foregoing slogan was "literally false," and "an unqualified superiority claim that is a false and misleading representation of fact." Duramax Marine had gone to great expense in developing and testing improved one-piece keel coolers. (Brakey Tr. Tes. Dep., p. 14, l. 14 – p. 15, l. 2) Fernstrum had moved for a preliminary injunction, and a hearing on this matter was held in Kalamazoo, Michigan, on December 5, 2000, before Judge Enslin. Michael Brakey again testified regarding the tests used in the new keel cooler developed by Duramax Marine. (Brakey Tr. Tes. Dep., p. 144, l. 8 – p. 145, l. 9) Judge Enslin issued a written decision entitled, "Court's Ruling Regarding Motion for Preliminary Injunction." (Brakey Tr. Tes. Dep. Ex. 11) Judge Enslin stated the following in the ruling:

In this case, the context for regarding these advertising claims is not the large consuming public, but rather a small group of very technically informed naval architects, marine engineers, shipwrights and large boat owners...In the context of naval architects, marine engineers, shipwrights, and large boat owners, such buyers are unlikely to find the defendant's testing claims were literally false or that the testing either was unreliable or otherwise insufficient to prove the propositions asserted. (Brakey Tr. Tes. Dep. Ex. 11, p. 19)

The Court denied Fernstrum's request to enjoin Duramax Marine's use of the "best by test" verbiage. (Brakey Tr. Tes. Dep. Ex. 11, p. 146, l. 20- p. 147, l. 20)

**D. The Present Opposition Against Fernstrum's Service Mark Application.**

Fernstrum filed U.S. Serial No. 75/701,707 on May 10, 1999, which is the subject of the present opposition. As noted above, the drawings for both Serial No. 75/382,250 (drawing of three-dimensional unit) and Serial No. 75/701,707 are virtually identical, except that for the three-dimensional keel cooler, the drawings only had solid lines for the rectangular tubes and dotted lines for the rest of the keel cooler. (Tab E, P. Fernstrum Ex. 72, unnumbered page between pp. 0495 and 0496; P. Fernstrum Tr., p. 76, l. 15 – p. 77, l. 23)

The application in Serial No. 75/701,707 included the drawing of the Fernstrum keel cooler as noted above, and three advertisements showing what appear to be photographs in that they have shading indicating reflections on their surface (Serial No. 75/701,707, pp. 0070-0071). As discussed below, they may have been photographs or based on photographs. Referring to the prosecution of this application, the Examining Attorney issued an Office Action on November 8, 1999 (Serial No. 75/701,707, p. 0072; Tab E, P. Fernstrum Tr., p. 115, l. 13-21), and refused to register the mark because she said it was merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1) (Serial No. 75/701,707, p. 0072). The Office Action said that the mark is merely descriptive if it describes a characteristic, function, feature, etc., of the mark. The Office Action further stated:

...applicant seeks to register a fairly straightforward representation of its marine heat exchanger for custom manufacture of marine heat exchangers....A picture of the product applicant is custom manufacturing is telling a great deal about what the product looks like but indicates very little about the commercial source of the product. Indicating the commercial source of a product is the work of a trademark. Showing a picture of the goods is the work of marketing and advertising....

It is extremely dubious whether any among the relevant buying public will perceive the proposed mark as a service mark. (Serial No. 75/701,707, pp. 0072, 0073)

The Examining Attorney further refused registration because the proposed mark did not function as a service mark to identify and distinguish the applicant's services from those of others and to indicate their source. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127; TMEP §1301.02. She said the mark did not function as a service mark because it is merely informational, citing *In re Signal Companies, Inc.*, 228 U.S.P.Q. 956 (TTAB 1986). The Examining Attorney went on to state that the mark appeared to be a pictorial representation of the Applicant's marine heat exchangers, the product of its custom manufacturing service. She said that it was informational in that it showed the customer what the goods looked like, i.e., it was simply a picture of the goods. (Serial No. 75/701,707, p. 0073)

In replying to the Office Action, Fernstrum did not respond to those points upon which the Examining Attorney had relied in refusing to register the mark because it was merely descriptive and did not function as a service mark. Rather, Fernstrum attempted to establish that its mark had acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f). (Serial No. 75/701,707, p. 0075) Fernstrum supported its claim that the design of the heat exchanger had acquired distinctiveness or secondary meaning upon the submission of a document entitled *A Survey of Secondary Meaning of the Shape and Appearance of the Fernstrum Keel Cooler Tubing* by the Sorensen Marketing Management Corporation

(September, 1998). ("Sorensen Survey") (Serial No. 75/701,707, pp. 0082-0177) Fernstrum stated that the purpose of the Sorensen Survey was to determine whether the appearance of the heat exchanger had acquired secondary meaning. (Serial No. 75/701,707, p. 0076) The Amendment includes the following statement:

The purpose of the survey was to determine whether the appearance of the heat exchanger had acquired secondary meaning. Survey, at p. 3...The interview subjects were shown three photographs of the tubing of the heat exchanger and instructed to look at them as if they were examining a catalog or brochure. Survey, at p. 8. (Serial No. 75/701,707, pp. 0076-0077)

The Sorensen Survey is 82 pages long and includes an Exhibit C, which constitutes three items identified as "survey photographs." These photographs (Serial No. 75/701,707, pp. 0111-0113) are not the service mark that is the subject of Serial No. 75/701,707, and unless someone knew beforehand what they were, they would not be able identify them. The photographs show only the tubes, not the remainder of the keel cooler (including the headers at the opposite ends of the tubes) shown in the application being opposed. (Serial No. 75/701,707, p. 0111-0113; Brakey Tr. Tes. Dep., p. 32, l. 25 – p. 33, l. 8; p. 42, l. 14 – p. 43, l. 2; p 43, l. 21 - p. 44, l. 7; p. 45, l. 5-9; Garver Tr. Tes. Dep. Ex. 8; Garver Tr. Tes. Dep., p. 10, l. 10-24; T. Boudreaux Tr. Tes. Dep. Ex. 8; T. Boudreaux Tr. Tes. Dep., p. 21, l. 1-9) The testimony of a Duramax Marine engineer, when shown the photographs on pages 0111, 0112 and 0113 of Serial No. 75/701,707, did not know what the photographs were and identified them as parallel lines (Leeson Tr. Tes. Dep., p. 14, l. 24 – p. 15, l. 6). A third party shipyard owner said that the photographs looked like "skid marks." (P. Boudreaux Tr. Tes. Dep., p. 32, l. 16-20) Thus, those who were questioned for the foregoing Sorensen Survey were never shown the service mark that was the subject of Serial No. 75/701,707.

The Sorensen Survey itself was never conducted for use in the prosecution of Serial No. 75/701,707. The survey was taken for the earlier trial discussed above, *Donovan Marine v. Fernstrum* at the U.S. District Court in New Orleans, prior to the filing of Serial No. 75/701,707. (Tab E, P. Fernstrum Tr., p. 121, l. 16; p. 122, l. 19; p. 123, l. 24 – p. 124, l. 3) The *Donovan Marine v. Fernstrum* case involved Fernstrum's unsuccessful attempt to prove the infringement of the alleged trademark of the actual keel cooler coolant flow tubes (running between the headers), which was the subject of U.S. Serial No. 75/382,250. Moreover, the persons who were questioned for the interview were shown photographs of the tubes which consisted of parallel lines (Tab E, P. Fernstrum Tr., p. 124, l. 13-18), and those who participated in the Sorensen Survey were never shown the headers which form a significant portion of the mark of Serial No. 75/701,707. (Tab E, P. Fernstrum Tr., p. 126, l. 4-14)

Further in response to the Office Action, Fernstrum argued that the subject matter sought to be registered functions as the service mark. (Serial No. 75/701,707, p. 0077) Fernstrum argued that every marine heat exchanger is custom manufactured for a customer. (Serial No. 75/701,707, p. 0078) Keel coolers which are of the type shown in Serial No. 75/701,707, namely a single-pass keel cooler, are the most popular keel coolers made by Fernstrum. (Tab E, P. Fernstrum Tr., p. 117, l. 4-6) The custom manufactured keel coolers made by Fernstrum constitute virtually every keel cooler they make, since any change in any dimension yields a new model. (Tab E, P. Fernstrum Tr., p. 102, l. 9 – p. 103, l. 12) For example, Fernstrum made about 8,000 units from 1990 to 2000. (Tab E, S. Fernstrum Tr., p. 5, l. 18-21, p. 6, l. 15-19) Any change in any keel cooler makes the keel cooler a custom-designed keel cooler (Tab E, P. Fernstrum Tr., p. 102, l. 4-25), yet all of the custom-designed keel coolers have standard model numbers. After receiving the foregoing Amendment introducing the Sorensen Survey, a Notice

of Publication was issued, as shown on the cover sheet of the file history (Serial No. 75/701,707, p. 0062), and the service mark that is the subject of the present opposition was published for opposition on May 9, 2000.

**E. The Difference Between the Keel Cooler of Duramax Marine and the Keel Cooler of Fernstrum.**

A visible difference between the keel cooler built and sold by Fernstrum and the keel cooler built and sold by Duramax Marine is a bevel on part of the fore and aft header of the keel cooler of Duramax Marine. (Tab F, Ex. ONR-6; Brakey Tr. Tes. Dep., p. 151, l. 4-10; Tab E, S. Fernstrum Dep. Ex. 24) However, the bevel only takes up a small part of a keel cooler. (Tab G(1), Brakey Tr. Tes. Dep., p. 151, l. 19 – p. 152, l. 3, 8-13) Accordingly, one viewing a picture of a keel cooler as shown in Serial No. 75/701,707 often would not be aware as to whether it is the product of Fernstrum or any other company such as Duramax Marine or East Park. (Brakey Tr. Tes. Dep., p. 151, l. 3, 8-13; p. 152, l. 20 – p. 154, l. 10, 17 – p. 155, l. 4, 25 - p. 156, l. 8; p. 157, l. 8-12, 19 – p. 158, l. 18; p. 159, l. 16 – p. 160, l. 2) Moreover, if one of the examples of the Fernstrum keel cooler were viewed from certain angles, the presence or absence of a bevel would not be apparent. (Brakey Tr. Tes. Dep., p. 161, l. 15 – p. 162, l. 1) Advertisements for the DURACOOLER keel cooler of Duramax Marine could be displayed so as not to make the bevel apparent to the viewer. (Lockhart Tr. Tes. Dep. Ex. 13; Lockhart Tr. Tes. Dep., p. 50, l. 8 – p. 51, l. 20; p. 52, l. 4 – p. 53, l. 4) Third parties well versed in the keel cooler business (P. Boudreaux Tr. Tes. Dep., p. 5, l. 3 – p. 9, l. 7; McHugh Tr. Tes. Dep., p. 5, l. 8 – p. 6, l. 20) could not tell who made a keel cooler of the type shown in Serial No. 75/701,707 (P. Boudreaux, Tr. Tes. Dep., p. 17, l. 9-13) or as shown in Fernstrum advertisements if the name Fernstrum were omitted. (P. Boudreaux Tr. Tes. Dep., p. 21, l. 10 – p. 22, l. 18; McHugh Tr. Tes. Dep. Ex. 4, Ex. 7; McHugh Tr. Tes. Dep., p. 18, l. 8-24; p. 19, l. 5-17; p. 25, l. 21 – p. 26, l. 12) Third

parties would not be able to tell if a bevel was present on a keel cooler because of the view the picture of the keel cooler was made from, and if it were mounted on a vessel. (P. Boudreaux Tr., p. 27, l. 17 – p. 30, l. 7)

**F. Potential Damage to Third Parties if a Registration Issues From Serial No. 75/701,707.**

Fernstrum has been aggressive in protecting its actual or alleged trademark rights, making the possibility of its obtaining a registration from Serial No. 75/701,707 of real concern to Duramax Marine. Fernstrum has unsuccessfully attacked its competitors and the marketing people for their competitors in court (Culpepper Tr. Tes. Dep., p. 4, l. 7 – p. 5, l. 6-17) or threatened to do so. (T. Boudreaux Tr. Tes. Dep. Ex. 16; T. Boudreaux Tr. Tes. Dep., p. 6, l. 16 – p. 9, l. 26) Fernstrum had accused East Park of "knocking off" its keel cooler (whose U.S. Patent No. 2,832,218 had expired over 40 years earlier) (Tab F, Ex. ONR-4), and further accused East Park of using a picture of the keel cooler which is the subject of Serial No. 75/701,707 in its telephone directory advertisement. (T. Boudreaux Tr. Tes. Dep. Ex. 16, Ex. C; Ex. 13; T. Boudreaux Tr. Tes. Dep., p. 14, l. 16 – p. 16, l. 11) This was part of the above-discussed federal lawsuit *R. W. Fernstrum & Company, Inc. v. Donovan Marine et al.* (T. Boudreaux Tr. Tes. Dep. Ex. 17; T. Boudreaux Tr. Tes. Dep., p. 16, l. 12 – p. 20, l. 3, 16-25)

Fernstrum has unsuccessfully tried to stop Donovan Marine, East Park and Duramax Marine in the federal District Courts both in Louisiana and in Michigan from marketing keel coolers which had been covered by a patent which expired 42 years ago. Fernstrum is now trying to register a service mark as a basis for further intimidating its competitors from advertising their one-piece keel coolers.

V. **Argument**

A. **A Service Mark Application Cannot be Registered Where It Only Consists of a Picture of a Product Which is an Important Feature or Characteristic of the Services Defined in the Application.**

The drawing in Serial No. 75/701,707 is simply a picture of one of the many models of keel coolers designed, manufactured and sold by Fernstrum. It is either a line drawing made from a photograph of a Fernstrum keel cooler or an exact drawing of a Fernstrum keel cooler. Since it is a visual reproduction of one of the very products to which the services of Serial No. 75/701,707 apply, it cannot be registered. A visual representation which constitutes merely an illustration of one's product is unregistrable under § 2(e)(1) of the Trademark Act just as is a merely descriptive word. (*In re Underwater Connections, Inc.*, 221 U.S.P.Q. 95 (TTAB 1983); *In re AMF Inc.*, 181 U.S.P.Q. 848 (TTAB 1974); *Godman Shoe Co. v. Dunn & McCarthy, Inc.*, 137 U.S.P.Q. 896 (TTAB 1963); *In re Ratcliff Hoist Co., Inc.*, 157 U.S.P.Q. 118 (TTAB 1968); *Ex parte Alexander*, 114 U.S.P.Q. 547 (Com'r. Pats. 1957); Gilson et al., *Trademark Protection and Practice*, Section 2.03, n. 9 (2002 Ed.)) A visual representation constituting merely an illustration of the applicant's product is unregistrable with respect to the services where the pictorial representation is an important feature or characteristic of the services. *In re Eight Ball, Inc.*, 217 U.S.P.Q. 1183; *In re Underwater Connections, supra*; *Interpayment Services Ltd. v. Docters & Thiede*, 66 U.S.P.Q.2d 1463, 1466 (TTAB 2003).

B. **A Mark Cannot be Registered Where the Mark is a Pictorial Representation of a Functional Product.**

1. **Each Component of the Drawing in Serial No. 75/701,070 is Functional.**

There is nothing ornamental, fanciful or arbitrary in the drawing of the keel cooler in Serial No. 75/701,707. The flow tubes with the rectangular cross sections extending between the

headers provide enhanced surface area for heat conducted outwardly from heated coolant flowing through the tubes, in a more compact size than other types of tubes, such as round tubes. (Tab E, P. Fernstrum Tr., p. 12, l. 6-16) This renders a keel cooler more compact than other keel coolers of a given heat-flow capacity. (Tab E, P. Fernstrum Tr., p. 61, l. 1-23; p. 70, l. 12-15) The headers at both ends of the coolant flow tubes are designed and constructed to either receive cooled coolant from the coolant flow tubes for discharge through a nozzle to the engine or other heat source or to receive hot coolant from the engine.

**2. Every Aspect of the Keel Cooler Shown in Serial No. 75/701,070 is Described and Shown in the Fernstrum Patents.**

Each feature of the keel cooler shown in Serial No. 75/701,707 is described in the basic Fernstrum patent (Tab F, Ex. ONR-4; Tab B, Answer to Req. for Admission No. 2). A nearly identical representation of the keel cooler of Serial No. 75/701,707 is shown in Fig. 1 of Fernstrum's U.S. Patent No. 4,338,993 (Tab F, Fig. 1, U.S. Patent No. 4,338,993). The U.S. patent statutes require a patent applicant to describe its invention in such full, clear and precise terms so as to disclose the invention to those skilled in the art to which the invention pertains. (35 U.S.C. §112, second paragraph) By using virtually the same drawing for its patent applications as it has put in the service mark application being opposed, Fernstrum cannot obtain a valid service mark registration.

As the Court of Customs and Patent Appeals (now the Court of Appeals for the Federal Circuit) has stated, one cannot extend patent protection, or obtain the equivalent to extend patent protection, by obtaining a federal trademark registration which could be infinite in duration. *In re Deister Concentrator Co, Inc.*, 289 F.2d 496, 129 U.S.P.Q. 314 (C.C.P.A. 1961), citing *The J.R. Clark Co. v. Murray Metal Products Co.*, 219 F.2d 313, 104 U.S.P.Q. 224 (C.C.P.A. 1955).

3. **Legal Precedent Fully Supports a Refusal to Register Fernstrum's U.S. Serial No. 75/701,770.**

Service mark application Serial No. 75/701,707 is extremely close to an application reviewed at length in *In re Deister Concentrator Company, Inc.*, 289 F.2d 496, 129 U.S.P.Q. 314 (C.C.P.A. 1961) cited above. In the *Deister Concentrator* case, a trademark application was filed which consisted of a two-dimensional figure of a substantially rhomboidal outline, which was the outline of the top surface of a concentrating or cleaning table, known in the art as a shaking table. A shaking table is used for separating solid particles suspended in a flowing film of water. This was unlike the shape of the top of the tables used by the competitors of the appellant in that case because the competitors had rectangular decks rather than the rhomboidal shape. Also, as to the term of use of the mark in the present case, the appellant had been using its "distinctive outline shape" for more than 50 years and had obtained a registration about 40 years prior to the above decision for the words "DEISTER OVERSTROM Diagonal Deck." The Examiner in that case had rejected it on the ground that it did not appear that the trademark was capable of distinguishing the applicant's goods from those of others. The applicant filed 30 affidavits and other evidence intended to show that the trade did in fact recognize shaking tables with those particular tops as appellant's goods. The Examiner continued the rejection, saying that the shape of applicant's tabletops was utilitarian and must be characterized as functional. The Board affirmed the rejection stating that the rhomboidal design was functional and could not be a trademark, citing *In re Bourns*, 45 C.C.P.A. 817, 252 F.2d 579, 117 U.S.P.Q. 36 (C.C.P.A. 1958); *Alan Wood Steel Co. v. Watson*, Com'r Pats., 150 F.Supp. 861, 113 U.S.P.Q. 311 (D.C. D.C. 1957).

Judge Rich, delivering the opinion of the C.C.P.A., affirmed the decision of the Board. Judge Rich's decision described the law with respect to Section 2(f) of the Trademark Act in detail.

The court first dealt with the two cases relied upon by the Board. With respect to *In re Bourns, supra*, a case involving the appearance of a potentiometer, they said that the mark was unregistrable resulting from considerations of utility rather than appearance. There was no showing in that case that appearance as a whole, or any element of it, was intended to indicate source or was capable of doing so. With respect to *Alan Wood Steel Co. v. Watson, supra*, and *Ex parte Alan Wood Steel Co.*, 101 U.S.P.Q. 209 (P.O. Examiner in Chief), involving a mark that was a raised non-skid pattern produced on steel flooring, wherein 70 affidavits were filed to show that the design did in fact enable the affiants to recognize the plates as the product of the applicant, the mark was not registered. In affirming the decision of the Examiner in Chief, the District Court for the District of Columbia said that the configuration of goods sought to be registered was "utilitarian" or "functional," citing the *The J.R. Clark Co. v. Murray Metal Products Co., supra*.

Judge Rich cited the following from the *J.R. Clark v. Murray Metal Products Co. supra* decision:

Were the law otherwise, it would be possible for a manufacturer or dealer, who is unable to secure a patent on his product or on his design, to obtain a monopoly on an unpatentable device by registering it as a trademark. The potential consequences to the public might be very serious, because while a patent is issued for only a limited term, a trademark becomes the permanent property of its owner and secures for him a monopoly in perpetuity. [113 U.S.P.Q. at 312.]

The C.C.P.A. agreed with the foregoing quote. It referred again to the *Alan Wood Steel Co., supra*, case with the following quote: "A novel shape or appearance that is functional in

character may not acquire any secondary meaning that would render it subject to exclusive appropriation *as a trademark*. 113 U.S.P.Q. at 312."

Judge Rich then went on to explain how to determine whether a novel shape or appearance is "functional" or whether any shape that performs a utilitarian function falls in that category. He said that a functional feature has been defined in the *Restatement of the Law of Torts*, Section 742, as a feature of goods which affects their purpose, action or performance, or the facility or economy of processing, handling or using them. He said that the courts have accepted this definition and have also held "functional" the shape, size or form of an article which contributes to its utility, durability or effectiveness or the ease with which it serves its function, citing cases.

Judge Rich went on to explain that the socioeconomic policy supported by the general law is the encouragement of competition by all fair means, and that encompasses the right to copy, very broadly interpreted, except where copying is unlawfully prevented by a copyright or patent. 129 U.S.P.Q. at 319. The C.C.P.A. explained that the only significance of the existence of an expired patent on the article copied is that it adds another reason for saying that the public has the right to copy it, it being basic to the patent system that the public may copy when any term of a patent comes to an end, with certain exceptions, not applicable here. This right to copy is derived not from the patent law, but rather from the inherent right in the public under the general law except to the extent that the patent law may remove it.

The decision of the C.C.P.A. went on to explain that a registration on the Principal Register can only occur if the applicant would have a right under the general law to prevent others from using or copying it, absent a copyright or patent. The Lanham Act does not create trademarks, although it may create some new substantive rights in the trademarks. *Id.* at 319.

The court asked whether the applicant has the "exclusive right to use" the shape sought to be registered. The applicant, supported by affidavit evidence (corresponding to the survey in the present application to register the drawing of a keel cooler), gave a two-fold response: (a) that its alleged mark had "become distinctive of the applicant's goods in commerce," (the language of § 2(f), 15 U.S.C. 1052(f)); and (b) that it had acquired a "secondary meaning." *Id.* at 320. This is analogous to the application at hand to register the drawing of the Fernstrum keel cooler.

The decision of the C.C.P.A. made the following comments regarding § 2(f). The C.C.P.A. said:

There is nothing whatever in the section [§ 2(f)] saying what shall be registered. It is purely negative, saying that if a mark has become distinctive, nothing "herein" shall prevent registration.... This leaves the question of trademark ownership, which is a prerequisite to registrability, to be determined by law other than section 2(f).

The court then referred back to an earlier-stated truism, that "A trademark distinguishes one man's goods [or services] from the goods [or services] of others; but not everything that enables goods [or services] to be distinguished will be protected as a trademark." *Id.* at 320.

With respect to the "secondary meaning" aspect of the argument in the *Deister Concentrator* case, Judge Rich referred to an earlier cited truism that some trademarks are words or configurations which are protected because they have acquired a "secondary meaning"; but not every word or configuration that has a de facto "secondary meaning" is protected as a trademark. *Id.* at 320. The court said that courts will not support exclusive rights in any word or shape which, in their opinion, the public has the right to use in the absence of patent or copyright protection. In the present opposition, the patent rights in Fernstrum's one-piece keel cooler have long since expired, and anyone could copy them absent some contract right to the contrary.

The court referred to the "Shredded Wheat" case, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S.Ct. 109, 39 U.S.P.Q. 296 (1938), where the Supreme Court said that the sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all, and in the free exercise of which the consuming public is deeply interested. 39 U.S.P.Q. at 300. The C.C.P.A., still referring to the *Kellogg* case, said with respect to the name "Shredded Wheat," which was claimed to have acquired a secondary meaning:

The evidence shows only that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff's factory at Niagara Falls. 39 U.S.P.Q. at 299.

Thus, "Shredded Wheat" had a de facto "secondary meaning" as an indication of source, but the court refused to attach any legal consequence to that "secondary meaning." The Supreme Court said that when an article may be manufactured by all, a particular manufacturer can no more assert exclusive right in a form to which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than with a particular producer. The Supreme Court said that the Kellogg Co. was free to use the pillow-shaped form of shredded wheat, subject only to the obligation to identify its product lest it be mistaken for that of the National Biscuit Co. The same rule should apply to the present case. Fernstrum should not be able to get a registration for the picture of a keel cooler, and anyone should be able to use it so long as they do not misrepresent the source of the keel coolers. Duramax Marine has used its trademark DURACOOLER in association with its keel cooler and has never been alleged of passing its product off as one from Fernstrum or any other entity. The C.C.P.A. said that the public acceptance of a functional feature as an indication of source is therefore not determinative of right to register. Preservation of freedom to copy "functional" features is the determining factor.

With respect to functionality, the 80,000-100,000 models of keel coolers, including the one shown in Fernstrum's trademark application Serial No. 75/701,707, is, without question, functional. The keel cooler of Fernstrum is the subject of U.S. Patent No. 2,382,218 (R.W. Fernstrum 1945). (Tab F, Ex. ONR-4) Fernstrum conceded its claim that the coolant flow tubes with the rectangular cross section is functional in the litigation which took place in the District Court in New Orleans in 1998. The settlement agreement (Culpepper Tr. Tes. Dep. Ex. 27) reflects the conclusion of that litigation. Duramax Marine has done extensive technical research into improving the one-piece keel cooler, as evidenced by its U.S. Patent No. 6,575,227 (Ex. ONR-6). This keel cooler looks very much like the Fernstrum keel cooler shown in Serial No. 75/701,707. A photograph of the keel cooler of Duramax Marine is shown in Exhibit 35, Deposition Exhibit 24, and a line drawing of another model of the Duramax Marine keel cooler is shown in Exhibit 36, Deposition Exhibit 23. Photographs of a keel cooler made by East Park are shown in Exhibit 37, Deposition Exhibit 62.

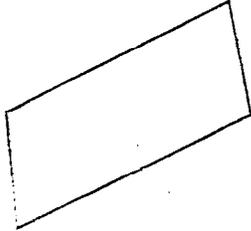
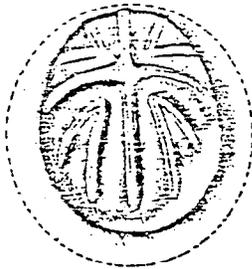
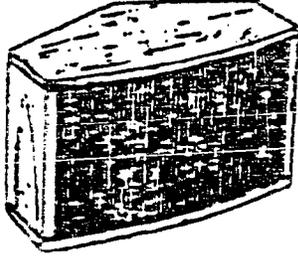
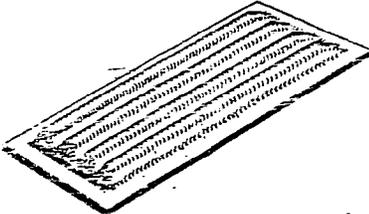
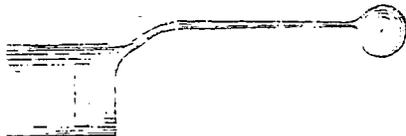
The C.C.P.A. held in the *Deister Concentrator* case that the rhomboidal shape was functional. This was a two-dimensional drawing of a three-dimensional object, just like the application in the present opposition. The court said that they were not denying registration merely because the shape possesses utility, but because the shape is *in essence* utilitarian. The C.C.P.A. affirmed the decision of the Board. The drawing of the Fernstrum keel cooler is a drawing of a completely functional product. This Fernstrum product is also *in essence* utilitarian; registration should be denied.

**4. Fernstrum Cannot Obtain a Registration on a Realistic Picture of Its Keel Cooler Having Only Functional Features on the Basis of Acquired Distinctiveness.**

Fernstrum was able to convince the Examining Attorney that the drawing of its keel cooler in Serial No. 75/701,707 had acquired distinctiveness. Fernstrum was able to overcome the refusal to register the mark on the grounds it is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), and the refusal to register because it allegedly did not function as a service mark. However, marks which are merely descriptive (as in the present case) can never be registered if they comprise any matter that, as a whole, is functional. (15 U.S.C. 1052(f), Sec. 2(f) of the Trademark Act)

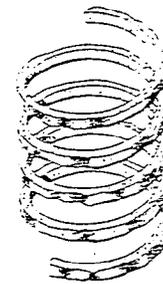
As explained above, functionality has long been relied upon by the courts to prevent the registration on functional shapes. Functional features can only be protected by patent law, and not by trademark law. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 131 L.Ed.2d 248, 115 S.Ct. 1300, 34 U.S.P.Q.2d 1161 (1995) As explained herein, even if a functional feature has achieved secondary meaning by consumer recognition, that feature – such as the picture of a keel cooler – cannot serve as a legally protectable mark. *Crescent Tool Co. v. Kilborn & Bishop*, 247 F. 299 (2d Cir. 1917); *A.C. Gilbert Co. v. Shemitz*, 45 F.2d 98 (2d Cir. 1930), *In re North American Phillips Corp.*, 217 U.S.P.Q. 926 (TTAB 1983). The preclusion against the registration of any mark which is functional is statutorily not registrable, and cannot be registered regardless of whether or not it has become distinctive of the applicant's goods or services in commerce. 15 U.S.C. §1052(f), Sec. 2(f) of the Trademark Act.

Thus, as also in the present situation, marks which only depict functional goods cannot be registered. The following chart, shown in *McCarthy's on Trademarks and Unfair Competition*, §7:85, Vol. 1, Fourth Ed. depicts this:

<u>Case</u>	<u>Serial No. or Reg. No.</u>	<u>Drawing</u>
<i>In re Deister Concentrator Co., Inc.</i> , 289 F.2d 496, 129 U.S.P.Q. 314 (C.C.P.A. 1961)		
<i>Mine Safety Appliances Co. v. Electric Storage Battery Co.</i> , 405 F.2d 901, 160 U.S.P.Q. 413 (C.C.P.A. 1969)	S/N 87,507	
<i>In re Bose Corp.</i> , 772 F.2d 866, 227 U.S.P.Q. 1 (Fed. Cir. 1985) (held functional in that it contributes to efficient and superior design as an enclosure, court noting that applicant's promotional materials lauded the shape as a functional part of the sound system)	S/N 127,803	
<i>Oxford Pendaflex Corp v. Rolodex Corp.</i> , 204 U.S.P.Q. 249 (TTAB 1979) <i>See In re Business Forms Finishing Services, Inc.</i> , 170 U.S.P.Q. 56 (TTAB 1971) (rounded shape of an index tab)	S/N 73,723	
<i>In re Diamond Crystal Salt Co.</i> , 161 U.S.P.Q. 502 (TTAB 1969)	S/N 250,745	
<i>In re Lindy Pen Co.</i> , 159 U.S.P.Q. 634 (TTAB 1968)	S/N 232,123	

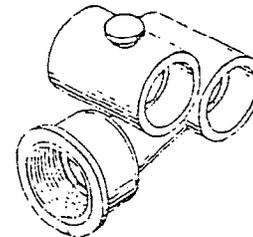
*Universal Frozen Foods Co. v. Lamb-Weston, Inc.*, 697 F. Supp. 389, 7 U.S.P.Q. 2d 1856 (D. Or. 1987) (held to be a functional shape because this shape yields both marketing and manufacturing efficiencies, some of which were touted by plaintiff in advertising)

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*In re Vico Products Mfg. Co.*, 229 U.S.P.Q. 364 (TTAB 1985), recons. denied, 229 U.S.P.Q. 716 (TTAB 1986) (The shape is a three-part venturi pipe used to mix air and water to produce a whirlpool bath. Held to be functional in a utilitarian sense because it works better in that shape.)

S/N 358,424



*In re Babies Beat, Inc.*, 13 U.S.P.Q.2d 1729 (TTAB 1990) (The applicant's own sale literature advertised that its baby bottle shape was designed "for even the youngest and smallest babies' hands to hold." The bottle shape was held functional and not registerable as a mark.)

S/N 689,947



*In re Witco Corp.*, 14 U.S.P.Q.2d 1557 (TTAB 1989) (applicant's own promotional materials advertised that its ribbed neck bottle for motor oil "provides stability when pouring the oil" into the engine, the bottle shape was held functional and not registerable as a mark)

S/N 655,594



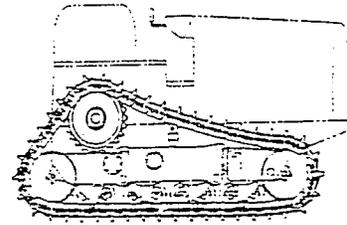
*In re American National Can Co.*, 41 U.S.P.Q.2d 1841 (TTAB 1997) ("[A]pplicant's configuration design is a superior one for metal beverage containers. It appears that there are a limited number of ways to strengthen can sidewalls, and vertical fluting, such as that employed by applicant, appears to be one, if not the best, way." Held not to be registerable as a trademark for beverage containers.)

S/N 74/166,615



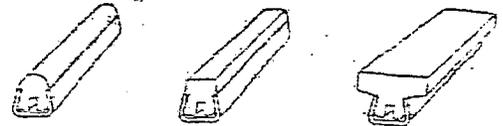
*In re Caterpillar Inc.*, 43 U.S.P.Q.2d 1335 (TTAB 1997) (both utility patent and applicant's advertising disclosed utilitarian advantages of the elevated sprocket design shown)

S/N  
74/404,325

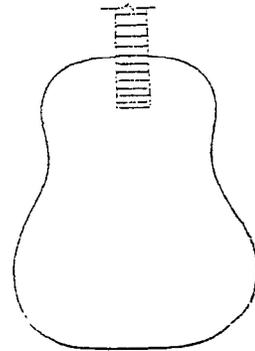


*Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 U.S.P.Q.2d 1422 (Fed. Cir. 2002)

Oppn. Nos.  
94,922,  
94,937 &  
94,946



*In re Gibson Guitar Corp.*, 62 U.S.P.Q.2d 1948 (TTAB 2001) (applicant's advertising promoted the shape as producing better music)



*M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 U.S.P.Q.2d 1086, 2001 WL 1167788 (TTAB 2001) (following *Brunswick* case: shape of roof vent is functional because the vents "blend in or match the roof tiles with which they are used better than alternative products.")

S/N  
75/177,079;  
S/N  
75/177,081;  
S/N  
75/177,082



*Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 63 U.S.P.Q.2d 1587 (9<sup>th</sup> Cir. 2002)

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A patent is strong evidence of functionality. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 121 S.Ct. 1255, 1260, 149 L.Ed.2d 164, 58 U.S.P.Q.2d 1001 (U.S. 2001). The existence of

disclosing the utilitarian features of the configuration is ve  
conclusive, evidence of the functionality in which trademark significance is alle  
*on Trademarks and Unfair Competition*, §7:89.1, Vol. 1, Fourth Ed., citing *Zipp*  
*Rogers Imports, Inc.*, 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963) (ciga  
shape disclosed in expired patent; shape not protectable under unfair competition  
*Shenango Ceramics, Inc.*, 362 F.2d 287, 150 U.S.P.Q. 115 (C.C.P.A. 1966) (under  
shape disclosed in utility patent as functional and thus barred from registration as a trad  
*Mine Safety Appliances Co. v. Electric Storage Battery Co.*, 405 F.2d 901, 160 U.S.P.  
(C.C.P.A. 1969) (utility patent relied on in part to find functionality of hard hat design;  
*Telesco Brophay, Ltd.*, 170 U.S.P.Q. 427 (TTAB 1971); *In re Oscar Mayer & Co.*, 189 U.S.  
295 (TTAB 1975) (functional purpose of ribs or grooves on molded plastic package for me  
proven by disclosure of utility patent, number of which was marked on the package itself); *In r*  
*Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 U.S.P.Q. 9, (C.C.P.A. 1982) (dictum); *In r*  
*Avocet, Inc.*, 223 U.S.P.Q. 517 (TTAB 1984), recons. denied, 227 U.S.P.Q. 566 (TTAB 1985)  
(bicycle seat design held functional based upon utility patent); *In re Leo Peters*, 6 U.S.P.Q.2d  
1390 (TTAB 1988) (utility patent makes it clear that the container configuration was designed  
with definite functional advantages which are peculiar to that shape); *In re Cabot Corp.*, 15  
U.S.P.Q.2d 1224 (TTAB 1990) (a pillow-shaped package was held to be functional in part based  
on disclosures in a utility patent); *In re Lincoln Diagnostics, Inc.*, 30 U.S.P.Q.2d 1817, 1823  
(TTAB 1994) (medical apparatus held functional shape based in part on expired utility patent  
that disclosed several utilitarian advantages of the design); *Atlantis Silverworks, Inc. v. 7<sup>th</sup> Sense,*  
*Inc.*, 42 U.S.P.Q.2d 1904 (S.D.N.Y. 1997) ("[E]ach of the elements which together constitute  
plaintiff's claimed trade dress—the catch mechanism, the PVC mini-disk and the seed beads—are

described in the patent's specification and in the patent claims as functional elements in the ring." The ring design was held to be functional.); *In re Caterpillar Inc.*, 43 U.S.P.Q.2d 1335 (TTAB 1997) ("The fact that the utility patent discloses the utilitarian advantages of applicant's elevated sprocket configuration design is strong evidence of the de jure functionality of the configuration in which applicant alleges trademark significance."); *Disc Golf Ass'n Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 489 U.S.P.Q.2d 1132 (9<sup>th</sup> Cir. 1998) (utility patent found to be strong evidence in support of finding of functionality); *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 162 U.S.P.Q. 552 (C.C.P.A. 1969) ("...it is clear to us that the Best patent incontrovertibly establishes primary functionality. Summary judgment was therefore correctly granted.").

In the present situation, the functional attributes are disclosed and claimed in U.S. Patent No. 2,382,215 (Tab F, Ex. ONR-4). Sean Fernstrum testified that the keel cooler shown in Serial No. 75/701,707 is totally functional, having no ornamental, or merely desirable or attractive features. (Tab E, S. Fernstrum Tr., p. 120, l. 9-15) Accordingly, it cannot be the subject of a U.S. trademark registration.

The Supreme Court has said that, when an article may be manufactured by all, a manufacturer can no more assert an exclusive right in a form to which the public has become accustomed to seeing the article, and which, in the minds of the public, is primarily associated with the article rather than with a particular producer. *Kellogg Co. v. National Biscuit Co.*, *supra*. In the present situation, anyone may manufacture the Fernstrum keel cooler shown in the application being opposed since the patent thereon expired over 40 years ago (unless restricted by some contractual obligation, which would have no bearing on the issue of whether the mark should be registered). The public has become accustomed to viewing the picture of the Fernstrum keel cooler, and the minds of the public are more accustomed to the keel cooler rather

than to its producer. (P. Boudreaux Tr. Tes. Dep., p. 18, l. 1-9, p. 21, l. 10 – p. 22, l. 4; McHugh Tr. Tes. Dep., p. 8, l. 16-21, p. 11, l. 20 – p. 12, l. 1)

**5. A Registration of Serial No. 75/701,707 Will Jeopardize Competitors of Fernstrum in Showing Pictures of Their Respective Keel Coolers.**

The granting of a registration for U.S. Serial No. 75/701,707 will arm Fernstrum with a means for attacking present or future competitors offering for sale one-piece keel coolers. There is no restriction against any new party to introduce into the marketplace a keel cooler exactly like that being sold by Fernstrum and shown in its Serial No. 75/701,707, since the patent protection has long expired. (Tab F, Ex.-ONR-4) Any such new competitor who shows a picture of its keel cooler, as did East Park in its Telephone Yellow Page advertisements (T. Boudreaux Tr. Tes. Dep. Ex. 16, pp. 1189-1190, 1212, 1220), runs the risk of a trademark infringement suit under 15 U.S.C. §1117(a), Sec. 35(a) of the Trademark Act, if Serial No. 75/701,707 were to mature into a registration. If Duramax Marine or East Park were to show a picture of one of their keel coolers where the bevel is not apparent or not understood by a viewer, they would run the risk of a trademark infringement suit by Fernstrum. This is not a risk that Fernstrum should be able to use to threaten its competitors now or in the future.

**C. Assuming that Fernstrum Would be Able to Establish That Its Service Mark is Not Merely Descriptive, the Evidence Which it Supplied That it Had Become Distinctive of Its Services Was Fatally Flawed.**

As explained in the "Facts" portion hereof (Section IV, B), Fernstrum had filed the Sorensen Survey that did not show the service mark of the present application but rather showed photographs very dissimilar from the application drawing. Those photographs were simply rectangular elongated items, and not the picture of the keel cooler of Serial No. 75/701,707. As explained earlier, Fernstrum should not even have been permitted to file evidence to show that its service mark had acquired distinctiveness, since the mark, as a whole, is functional as set forth in

15 U.S.C. 1052(f), Section 2(f) of the Trademark Act, but even if it were able to file such evidence, those participating in the survey were shown something other than the subject of the foregoing application. This deficiency should render the evidence, i.e., the Sorensen Survey, so defective as to invalidate the survey, and it should have been excluded from the evidence showing that the Fernstrum mark had acquired distinctiveness, or at least be given very little weight.

A survey is admissible into evidence if it tends to make the existence of any fact more probable or less probable than it would have been without the evidence, and should only be inadmissible if its flaws destroy all of its relevance. *Conopco, Inc., d/b/a Calvin Klein Cosmetics Company and Calvin Klein Cosmetics Corporation v. Cosmair, Inc. et al.*, 49 F.Supp.2d 242; 1999 U.S. Dist. LEXIS 6608; 52 Fed.R.Evid.Serv. 154 (S.D.N.Y. 1999). To have substantial probative value, a survey must be designed to examine the impression presented to the consumer by the accused product. *Conopco, Inc., supra*. Survey evidence has sometimes been received grudgingly by the courts and given little weight because of deficiencies in the manner of conducting the survey. *McCarthy on Trademarks and Unfair Competition*, §32:170. Surveys having slanted questions or serious methodological defects may be excludable as irrelevant of the true state of mind of potential purchasers. *Sears Roebuck & Co. v. All States Life Ins. Co.*, 246 F.2d 161, 141, U.S.P.Q. 19 (5<sup>th</sup> Cir. 1957), *cert. den.* 355 U.S. 894, 2 L.Ed.2d 192, 78 S.Ct. 268, 115 U.S.P.Q. 427 (1957). (Survey held inadmissible for not being truly illustrative of what the public thinks to permit one party to propound questions chosen on its behalf.); *Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F.Supp. 1189, 217 U.S.P.Q. 1137 (E.D. N.Y. 1983) (While holding for plaintiff, the court said "The trustworthiness of surveys depends upon foundation evidence that...(3) the questions to be asked of interviewees were framed in a clear,

precise and non-leading manner.... 217 U.S.P.Q. at 1149); *Starter Corp. v. Converse, Inc.*, 170 F.3d 286, 50 U.S.P.Q.2d 1012 (2d Cir. 1999) (District Court properly excluded a survey from evidence because the survey questions were irrelevant.) The probative worth of a survey may be of little weight. *Hilson Research, Inc. v. Society for Human Resources Management*, 27 U.S.P.Q.2d 1423, 1437 (TTAB 1993) (The questions raised an issue as to whether the interviewees actually understood what was being asked.)

It is improper, as in the present situation, to show interviewees photographs which are not true representations of the trademark. *McCarthy on Trademarks and Unfair Competition*, §32:171. Just as it is improper to try to prove secondary meaning for trade dress in a particular product feature by showing interviewees the whole product, which included non-protectable, functional features, *McCarthy on Trademarks and Unfair Competition*, §32:171, it is even more improper to just show only non-protectable functional features which are part of a whole product which itself is completely functional. *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 U.S.P.Q.2d 1065, 1072 (7<sup>th</sup> Cir. 1995) (A survey is worthless when it only is directed to a part of a product when the entire product is mostly functional.)

Showing interviewees photographs that are not true representations of the trademark are irrelevant. *McCarthy on Trademarks and Unfair Competition*, §32:171. This is borne out in *American Luggage Works, Inc. v. United States Trunk Co.*, 158 F.Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op. 161 F.Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957); *aff'd* 259 F.2d 69, 118 U.S.P.Q. 424 (1<sup>st</sup> Cir. 1958) The survey was seriously defective in that the interviewees were shown a photograph of the item to be protected (luggage), rather than the item to be protected itself. This is similar to the present situation where the interviewees were only shown a photograph of a (functional) portion of the actual product, rather than of the trademark

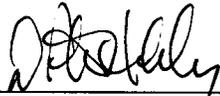
that is the subject of the application being opposed. Therefore, the Sorenson Survey should be determined to be entirely irrelevant, and Fernstrum's efforts to establish acquired distinctiveness under 15 U.S.C. 1052(f), Section 2(f) of the Trademark Act, should be held insufficient under the latter statute.

**VI. Conclusion**

For the reasons set forth above, application Serial No. 75/701,707 filed by Fernstrum should be refused registration.

Respectfully submitted,

Date: November 15, 2004

By: 

DPH/SM/ck

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

Application Serial No. 75/701,707

Mark: Drawing of a Marine Heat Exchanger

Published in the Official Gazette at Page TM 400 on May 9, 2000

DURAMAX MARINE, LLC, )  
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 Opposer, )  
 )  
 )  
 v. )  
 )  
 R.W. FERNSTRUM & COMPANY, )  
 )  
 )  
 Applicant. )

Opposition No. 119,899

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**OPPOSER'S TRIAL BRIEF**

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing OPPOSER'S TRIAL BRIEF, and any document noted as being enclosed or attached, was served via first class U.S. mail, postage prepaid, on the date noted below to:

Samuel D. Littlepage, Esq.  
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Washington, DC 20036-3506

Date: November 15, 2004

By:   
D. Peter Hochberg

**CERTIFICATE OF MAILING**

I hereby certify that the foregoing OPPOSER'S TRIAL BRIEF, and any document noted as

being enclosed or attached, was filed via first class U.S. mail, postage prepaid, on the date noted below to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Date: November 15, 2004

By: Christine A. Kotran  
Christine Kotran