

THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB

Oral Hearing:
September 27, 2007

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Triforest Enterprises, Inc.
v.
Nalge Nunc International Corporation

Opposition No. 91165809
to application Serial No. 76572253
filed on January 26, 2004

Clement Cheng, Esq. of Law Offices of Clement Cheng for
Triforest Enterprises, Inc.

Donald F. Frei of Wood, Herron & Evans, L.L.P. for Nalge
Nunc International Corporation.

Before Hairston, Kuhlke and Taylor, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Nalge Nunc International Corporation (applicant), has
applied to register on the Principal Register the product
design mark shown below for a "plastic water bottle, sold
empty."¹

¹ Serial No. 76572253, filed on January 26, 2004; alleging first
use of the mark anywhere and in commerce on April 4, 1992.
Applicant submitted a claim of acquired distinctiveness under
Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).



Applicant describes its mark as follows:

The mark consists of a plastic water bottle as shown, namely, a plastic water bottle having a transparent, generally cylindrical container body with rounded shoulders interconnecting the upper and lower extremities of a cylindrical sidewall to a relatively narrow container neck and a generally flat, circular container bottom, respectively; an opaque screw cap releasably engaged with threads on the upper portion of the neck and having a button connected to the center of its top surface via a short stem; and a strap terminating in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, wherein the ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately 0.4 and the ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8.

Triforest Enterprises, Inc. (opposer) has opposed registration, alleging in pertinent part, that:

The 76572253 mark is functional and does not have secondary meaning. In fact, when one looks at the bottle it is simply a Boston Round, which has been in the marketplace for many years.

...

Opposition No. 91165809

The highly functional nature of the claimed trademark suggests that the bottle does not have secondary meaning. There's nothing distinctive about any of the features listed. The features are very common and highly desirable functional characteristics that improve the strength and ease of use of the bottle.

(Notice of Opposition, pp. 1 and 5)

In its answer, applicant has denied the allegations of the notice of opposition.

The record consists of the pleadings and the involved application. Opposer submitted the testimony deposition, with exhibits, of its president, Steven Lin. Applicant submitted the testimony depositions, with exhibits, of Paul Comeau, applicant's Director of Engineering; Margaret Gregory, applicant's Director of Consumer Products Business, Sales and Marketing; Frederic Edelstein, a buyer for CDI International, a distributor of beverage-ware; Robert Cross, president of Equinox, a purchaser of applicant's plastic water bottles; and Samuel L. Belcher, owner of Sabel Plastechs, Inc., a consulting company in the plastics industry. Also, applicant submitted under notice of reliance, opposer's responses to applicant's discovery requests, and copies of third-party design patents and trademark registrations.

Both parties have filed briefs and an oral hearing was held.

Preliminary and Evidentiary Matters

The first matter we address is applicant's paper, filed October 20, 2006, captioned "Objections To Trial Testimony Of Steven Lin and Motion For Determination Adverse To Opposer." Applicant maintains that opposer's president, Steven Lin, during cross-examination, refused to answer questions relevant to the issue of functionality involved in this proceeding, that is, questions relating to the manufacturing costs of opposer's own drinking bottle. In view of Mr. Lin's refusal to answer such questions, applicant requests that the Board presume that Mr. Lin's answer would have been unfavorable to opposer's position in this case. Specifically, applicant requests a determination that the method for manufacturing applicant's bottle is more expensive and complex than the method for manufacturing opposer's functionally equivalent drinking bottle. Opposer has not filed a brief in response to applicant's motion.

Trademark Trial and Appeal Board Manual of Procedure

(TBMP) Section 707.03(d) provides in relevant part, that:

When an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. However, a witness may properly refuse to answer a question asking for information that is, for example, privileged or confidential.

...

Accordingly, where the witness in a testimony deposition refuses to answer a particular question; no court action is sought; and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer

Opposition No. 91165809

would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony.

As discussed infra, one of the factors the Board considers in determining whether a product design is functional is whether the design is cheaper and simpler to manufacture than alternative and competitive designs. Because opposer is a competitor of applicant and, thus, opposer's drinking bottle may be considered an alternative and competitive design, applicant's cross-examination questions of Mr. Lin concerning the costs of opposer's drinking bottle were relevant to the issue of functionality. Moreover, while Mr. Lin objected to the questions on the ground of confidentiality, a protective order was already in place in this proceeding to maintain the confidentiality of any information so designated. In view thereof, we find that Mr. Lin should have answered the questions concerning the manufacturing costs of opposer's bottle. Having failed to do so, and inasmuch as opposer has not responded to applicant's motion, the motion is granted such that we will presume that Mr. Lin's answers to the questions would have been unfavorable to opposer's position in this case. In other words, we will presume that Mr. Lin's answers would have revealed that the method of manufacturing applicant's drinking bottle is more expensive and complex than the method of manufacturing opposer's drinking bottle.

Opposition No. 91165809

The second matter for our consideration is applicant's paper, filed March 13, 2007, captioned "Objections to and Motion to Strike Portions of Opposer's Reply Brief and Motion For Sanctions." Applicant contends that opposer's reply brief (1) is primarily "mere attorney argument lacking any evidentiary support;" (2) contains exhibits that were not properly introduced during opposer's testimony period; and (3) contains references to the confidential testimony of applicant's witness, Margaret Gregory, in violation of the parties' protective order. Applicant requests that the Board strike from opposer's reply brief such arguments, exhibits, and testimony. In addition, applicant requests that sanctions be entered against opposer for failure to prosecute the opposition in good faith.

Opposer has filed a brief in response to applicant's motion. Opposer maintains that all of the arguments in its reply brief are supported by the testimony of its president, Mr. Lin. In addition, while opposer acknowledges that the reply brief exhibits were not made of record during its testimony period, it requests that the Board consider the exhibits as "demonstrative." Also, while opposer contends that the Gregory testimony was not confidential, it states that if the Board deems the testimony confidential, the "Board could simply seal the reply brief rather than strike the Margaret Gregory statement." (Opposer's response at

11). Lastly, opposer contends that sanctions against it are not warranted because it has prosecuted this case properly and has submitted sufficient evidence to prove its case.

The Board generally will not strike statements in a party's brief. However, statements made in a party's brief will be given no consideration unless they are supported by evidence properly introduced at trial. TBMP Section 704.06(b). Suffice it to say that to the extent that opposer's reply brief contains statements not supported by evidence properly introduced at trial, we have given these statements no consideration.

Insofar as the exhibits attached to opposer's reply brief are concerned, TBMP Section 704.05(b) provides that exhibits and other evidentiary materials attached to a party's brief on the case will be given no consideration unless they were properly made of record during the time for taking testimony. In this case, we have given no consideration to the exhibits attached to opposer's reply brief because they were not properly made of record during opposer's testimony period.

With respect to applicant's request that the Board strike the reference to the Margaret Gregory testimony in opposer's reply brief, we note that applicant marked the entire Gregory deposition as confidential. However, only those pages of the deposition which actually contained

information which is truly confidential in nature, such as sales and advertising figures, should have been marked confidential. In this case, the testimony in question is not truly confidential in nature and therefore, we decline to strike it from opposer's reply brief.

Insofar as applicant's motion for sanctions is concerned, suffice it to say that in view of our decision on the merits in this case, applicant's motion in this regard is moot.

As the third and final matter, we note that opposer pleaded in the notice of opposition that applicant's bottle design "is functional and does not have secondary meaning." (emphasis added). However, opposer did not pursue at trial the issue of whether, assuming the bottle design is not functional, it has acquired distinctiveness as a trademark. Also, opposer's brief is silent on this issue. In view thereof, we consider opposer to have dropped this claim. Thus, the only issue for decision herein is whether the product design is functional.

Standing

Standing is not an issue in this case. Opposer has alleged and shown that it is a direct competitor of applicant in the sale of plastic water bottles, the goods which are the subject matter of the mark at issue. See

generally Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 828 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

Opposer's Arguments and Evidence

It is essentially opposer's position that the bottle design applicant seeks to register is functional overall because virtually every element of the mark outlined in the description thereof has a utilitarian advantage. Further, opposer maintains that applicant's bottle design is functional because it consists of a common "Boston Round" bottle shape to which opposer has simply added a functional tether cap with ring and button.

Steven Lin, opposer's president, testified with respect to the asserted utilitarian advantages of applicant's bottle design. Specifically, Mr. Lin testified that:

- (1) plastic is "probably the best solution nowadays for making a container;" it is "durable and more chemical inured" (Lin dep. at 19);
- (2) transparent bottles "allow the user to see through;" "[t]he scientist wants to see what's grow[ing];" "people want to see what's the color of the product they are drinking);" (Lin dep. at 19-20);
- (3) a generally cylindrical body "is stronger than any other shape;" it is "more durable and [holds] more liquid with the same amount of material;" "[t]he roller labels

Opposition No. 91165809

applicator actually can only be used" on this shape bottle"
(Lin dep. at 20);

(4) the advantage of rounded shoulders is "[w]hen you mold the plastic, it has to be smooth to open the mold;" "with this taper, the mold can be easily (sic) to open;" (Lin dep. at 21);

(5) the opaque screw cap "is made of polypropylene" which is a "very cheap material, and it's softer material to create a leak-proof function for the cap;" "people can dye any color they want to create a different color cap" (Lin dep. at 21-22);

(6) there is one small annular ring and one large annular ring because "[t]he bottom ring has to be larger than the neck itself to be able to go into" the bottle neck (Lin dep. at 24);

(7) the .4 and .8 ratios of the container body are "the typical Boston Round bottle ratio[s]" (Lin dep. at 24); and

(8) the 500 ml size is also "typical" of a Boston Round bottle. (Lin dep. at 26).

Opposer also submitted a photograph of one of its own drinking bottles; excerpts from two third-party websites which contain pictures of bottles that are referred to as "Boston Round" bottles; and photographs of several drinking bottles (three of which have tethered lids) which opposer characterizes as "Boston Round" bottles. Finally, opposer

Opposition No. 91165809

submitted copies of three utility patents owned by third-parties which it maintains are evidence that the applicant's tether assembly, in particular, is functional.

Specifically, opposer submitted No. 524,159 for a "Stopper Or Cover For The Mouths Of Bottles;" No. 4,595,130 for a "Reversible Pouring Spout Assembly For Containers;" and No. 4,526,289 for a "Screw Stopper For A Can."

Applicant's Arguments and Evidence

Applicant, on the other hand, argues that opposer failed to set out, much less apply, any of the appropriate factors for determining whether a product design mark is functional. Applicant maintains that the factors to be considered are set forth in *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), namely, (1) whether there exists a utility patent directed to the design, (2) whether the applicant touts the utilitarian advantages of the design in advertisements, (3) whether there are alternative and competitive designs, and (4) whether the design is cheaper and simpler to manufacture than alternative and competitive designs.

Applicant contends that there is no utility patent directed to its plastic water bottle design. Specifically, Margaret Gregory, applicant's Director of Consumer Products Business, Sales and Marketing, testified that applicant does

not own and has never applied for a utility patent covering its plastic water bottle. (Gregory dep. at 42).

Further, applicant points out that there are no advertising or promotional materials of record that tout the utilitarian advantages of the bottle design.

Applicant also maintains that there are numerous alternative bottle designs available to competitors. In this regard, applicant points to the following cross-examination testimony of opposer's president, Mr. Lin, when shown photographs of competitors' bottles:²

Q. Would you agree with me that the bottle depicted in Exhibit 40 does not fall within the scope of the mark sought by Nalgene?

A. Yes.

Q. And would Exhibit 40 function equally as well as the water bottle sought by Nalgene?

A. This is a squeezable bottle. It's not - it's a squeezable bottle. Other than that, it holds water. It's a water bottle.

Q. Okay. So the answer is "yes"?

A. Yes.

Q. Does the bottle depicted in Exhibit 42 fall within the scope of the mark sought by Nalgene?

A. Yes.

Q. It does?

A. No, it doesn't. Sorry. I didn't pay attention. It doesn't.

Q. So you would agree with me, then, that the bottle depicted as Exhibit 42 would function equally as well as a water bottle exhibiting the mark sought by Nalgene?

A. Yes.

Q. Would you agree with me that Exhibit 43 does not fall within the scope of the mark sought by Nalgene?

A. Yes.

² Mr. Lin and several of applicant's witnesses refer to applicant as "Nalgene" and to its bottle design as the "Nalgene bottle." Applicant apparently is referred to as "Nalgene" in the industry.

Opposition No. 91165809

Q. And does it function equally as well as a water bottle?

A. Yes.

Q. That demonstrates the mark sought by Nalgene?

A. Yes.

Q. In your opinion, does the bottle depicted in Exhibit 44 fall within the scope of the mark sought by Nalgene?

A. No, it's not a Boston Round.

Q. Does it function equally well as a water bottle than the - a bottle demonstrating the mark sought by Nalgene?

A. Yes.

(Lin dep. at 145-152).

Applicant submitted over fifteen additional examples of bottles that it contends are competitive and alternative designs to its water bottle design.

Finally, applicant maintains that its bottle is not cheaper or simpler to manufacture than alternative and competitive designs. Applicant maintains that there are several drawbacks and difficulties associated with the manufacturing process for its bottle. According to applicant, it is difficult to maintain a consistent wall thickness and shape with its bottle design which adds to the manufacturing costs; the three components of applicant's bottle enclosure, i.e., the tether, the cap and a button on the cap, add to the bottle's manufacturing costs; and the ultrasonic process used in welding the button to the cap adds to the bottle's manufacturing costs.

In this regard, applicant relies on the testimony of its Director of Engineering, Paul Comeau. Mr. Comeau

reviewed the features of a large number of competitor's water bottles and testified as followed:

Q. Based on the review of these bottles and based on your experience in manufacturing water bottles, would you say that there are competitive water bottles on the market to the Nalgene narrow mouth bottle that are competitive from a manufacturing standpoint?

A. Yes.

Q. -to the Nalgene narrow mouth bottle?

A. Very much so.

Q. Would you say there are competitive water bottles on the market that are less costly to manufacture than the Nalgene narrow mouth bottle?

A. Yes.

(Comeau Dep at 36-37).

In addition, applicant relies on the testimony of Samuel L. Belcher, owner of Sabel Plastechs, Inc., a consulting company in the plastics industry. Mr. Belcher, who has 45 years experience in the plastic industry, testified as follows:

Q. Solely by the design of [Nalge's narrow mouth water bottle], does that put the manufacturer at a competitive advantage over competitors from a cost of manufacturing standpoint?

A. I don't think so at all ...

Q. Do you think you could design an enclosure assembly that costs less to manufacture than the closure described in [Nalge's narrow mouth water bottle]?

A. Yes.

Q. In your prospective design, could you design it so that the cap is retained by a tether?

A. Yes.

Q. And do so, but still make it cost less than [Nalge's narrow mouth water bottle]?

A. Yes. Yes ...

(Belcher dep. at 66-67).

Applicant also argues that in view of Mr. Lin's refusal to answer questions concerning the manufacturing costs of opposer's own drinking bottles, the Board must presume that opposer's bottles are not more expensive to manufacture than applicant's bottles. Thus, applicant argues that opposer is not at a competitive disadvantage in this regard.

Analysis

As applicant correctly notes, in determining whether a product design is functional, the Board is guided by the Morton-Norwich case and the four factors set forth therein.

With respect to the first factor, namely, whether there exists a utility patent directed to applicant's applied-for mark, there is no utility patent of record which discloses the utilitarian features of the overall design sought to registered. While opposer has submitted three utility patents which it contends show that the tether assembly on applicant's bottle design is functional, we note that our primary reviewing court has stated in *In re Teledyne Indus., Inc.*, 692 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982):

Simply dissecting appellant's trademark into its design features and attributing to each a proven or commonly known utility is not, without more, conclusive that the design, considered as a whole, is de jure functional and not registrable. In other words, merely labeling each design feature as "useful" or as "serving a utilitarian purpose" cannot, as a matter of law, render the entire configuration de jure functional." (citations omitted)

Opposition No. 91165809

Moreover, we note that the three utility patents are not especially relevant to the issue of functionality herein because they are not directed to applicant's applied-for mark, namely, a plastic water bottle, but rather third-party designs in the nature of a gasoline can, a bottle stopper, and a screw stopper for a can that generates an acoustic signal when closed. In other words, they do not cover or remotely resemble applicant's applied-for mark.

With respect to opposer's contention that applicant's bottle design is functional because it is in the shape of a common "Boston Round" bottle, it is clear that applicant did not originate or design the shape of its bottle, but has used a pre-existing bottle shape. Indeed, it appears that the "Boston Round" bottle has been used in the scientific field. This fact, however, does not render applicant's design functional. See *In re Cabot Corp.*, 15 USPQ2d 1224, 1228 (TTAB 1990) ["[T]he fact that the pillow pack container may be in the public domain does not necessarily preclude its use as a trademark"].

With respect to the second factor, whether applicant touts the utilitarian advantages of its bottle design in advertisements, there is no evidence of touting in the record.

With respect to the third factor, whether there is evidence that alternative designs are available to

competitors, the record is replete with evidence of alternative designs. Applicant has submitted examples of over fifteen such designs and on cross-examination, opposer's president, Mr. Lin, even acknowledged the existence of four alternative designs. A review of these alternative designs reveals that while each incorporates some of the features of applicant's bottle design, there are still other features which give each design an overall look that is different from applicant's design. For example, in contrast to applicant's bottle design, one of the alternative bottle designs has indented panels, another is collapsible, and still another incorporates hand grips on the sides. In short, the record shows that there are a variety of bottle designs available to competitors.

With respect to the fourth factor of whether applicant's bottle design is cheaper or simpler to manufacture, opposer offered no evidence that the design is the result of a comparatively simple or inexpensive method of manufacture. Indeed, the testimony of Mr. Comeau and Mr. Belcher indicates that, on the contrary, applicant's bottle design is more costly and complex to manufacture than a number of alternative and competitive designs. Further, in view of Mr. Lin's refusal to answer questions concerning the manufacturing costs of opposer's own bottles, we have presumed that applicant's bottle is more expensive and

Opposition No. 91165809

complex to manufacture than opposer's own bottle such that opposer is not at a competitive disadvantage in terms of manufacturing costs.

Accordingly, when we consider the totality of the evidence bearing on the Morton-Norwich factors, we conclude that applicant's bottle design is not functional. We reach this conclusion because the design is not disclosed by a utility patent, there is no evidence of touting, there are a significant number of functionally equivalent alternative designs, and there is no evidence that applicant's particular bottle design is the result of a comparatively simple or inexpensive method of manufacture. The mere testimony of opposer's president, Mr. Lin, as to the purported utilitarian advantages of the individual elements of applicant's bottle design is not persuasive of a different result. This testimony, in the absence of any other evidence on the above factors which supports opposer's position, is simply insufficient to demonstrate that applicant's bottle design is functional.

As indicated, opposer did not pursue the issue of whether applicant's bottle design has acquired distinctiveness, and therefore we need not address this issue.

Decision: The opposition is dismissed.