

ESTTA Tracking number: **ESTTA436955**

Filing date: **10/20/2011**

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

Proceeding	91182064
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Date	10/20/2011
Attachments	Opposer's Trial Brief.pdf ( 46 pages )(481484 bytes )

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

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AS HOLDINGS, INC. )  
 )  
Opposer, )  
 )  
v. ) Opposition No. 91182064  
 )  
H&C MILCOR, INC. f/k/a )  
AQUATICO OF TEXAS, INC. ) Serial Number: 76/461,157  
 ) Mark: Miscellaneous Design:  
Applicant. ) (Pipe Boot Product Design)

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OPPOSER'S TRIAL BRIEF

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## DESCRIPTION OF THE RECORD

### OPPOSER'S EXHIBITS

Opposer's 1		Second ReNotice of Deposition of Applicant Pursuant to Fed.R.Civ.P. 30(b)(6)
Opposer's 2		Applicant Portals Plus Product Catalog
Opposer's 3		Applicant Portals Plus Medium Pipe Boot Technical Product Information from Applicant's website. ALP00476
Opposer's 4		Applicant Portals Plus Medium Pipe Boot Technical Product Information from Applicant's website (Opposer's Exhibit 3), with hand drawn addition. ALP00476
Opposer's 5		Applicant's advertisement, including Portals Plus and Milcor logos, from Snips trade publication dated January 2008; Vol 77, No. 1
Opposer's 6		Applicant Portals Plus Installation Instructions from Applicant's website. ALP00479
Opposer's 7		Excerpts from websites for Milcor and Portals Plus, including Portals Plus and Milcor logos. ALP00458-462
Opposer's 8		Applicant Portals Plus Product Selection list from Applicant's website, including pipe boot information. ALP00463 – ALP00472
Opposer's 9		Applicant Portals Plus Pipe Flashings Technical Product Information from Applicant's website, including pipe boot information. ALP00473 – ALP00478
Opposer's 10		Applicant Portals Plus Adapter Rings Technical Product Information from website. ALP00480 – ALP00481
Opposer's 11		Drawing and description of Applicant's mark as alleged in response in application file at time of publication.
Opposer's 12		Applicant's expired U.S. Patent No. 4,211,423, Resech, entitled Roof Seal Device; ALP00209 – ALP00216
Opposer's 13		Applicant Portals Plus Installation Instructions for Pipe Boots
Opposer's 14		Hand drawn sketch of left side of hypothetical pipe boot by Attorney for Applicant, Dillis Allen, with hand drawn additions points A and B by Attorney for Opposer, Terence J. Linn
Opposer's 20		Color photograph of Opposer's black pipe boot with 13-inch base and stamp of "ALPHA SYSTEMS EPDM 1" on the base (Applicant's Physical Exhibit 2)
Opposer's 21		Color photograph of Opposer's black pipe boot with 13-inch base and stamp of "CUT ABOVE RIB" (Applicant's Physical Exhibit 2)
Opposer's 22		Color photograph of Opposer's white pipe boot with 13-inch base (Applicant's Physical Exhibit 1)

Opposer's 23		Color photograph Bridgestone/Firestone black pipe boot with 13-inch base and stamp "BFDP EPDM" on the bottom horizontal ring (Applicant's Physical Exhibit 4)
Opposer's 24		Color photograph of Opposer's black pipe boot with 9-inch base and stamp of "ALPHA SYSTEMS EPDM 2" (Applicant's Physical Exhibit 3)
Opposer's 25		Color photograph of Opposer's black pipe boot with 9-inch base and stamp of "cut above rib" (Applicant's Physical Exhibit 3)
Opposer's 26		Color photograph of Opposer's black pipe boot with 9-inch base and stamp of "CUT ABOVE RIB" (Applicant's Physical Exhibit 3)
Opposer's 27		Color photograph of Firestone/Bidgestone black pipe boot with 9-inch base and stamp of "FBPCO" on the base (Applicant's Physical Exhibit 5)
Opposer's 28		Color photograph of Firestone/Bidgestone black pipe boot with 9-inch base and "pipe flashing ½-1-1 ½-2 ½ epdm" on the base (Applicant's Physical Exhibit 5)
Opposer's 29		Print-out of GenFlex Roofing Systems website pages, 9 pages
Opposer's 30		Collection of first pages of U.S. Patents naming Michael J. Hubbard as an inventor
Opposer's 31		Firestone Technical information sheets for pipe boots and flashings, 5 pages
Opposer's 32		Bridgestone/Firestone black pipe boot with 13-inch base (Applicant's Physical Exhibit 4), shown with clamping band
Opposer's 33		Bridgestone/Firestone black pipe boot with 13-inch base (Applicant's Physical Exhibit 4), shown with clamping band
Opposer's 34		Color photograph of Opposer's black pipe boot with 13-inch base (Applicant's Physical Exhibit 2), shown with clamping band
Opposer's 35		Color photograph of Opposer's black pipe boot with 13-inch base (Applicant's Physical Exhibit 2), shown with clamping band
Opposer's 36		Color photograph of Opposer's black pipe boot with 9-inch base (Applicant's Physical Exhibit 3) show with clamping band
Opposer's 37		Color photograph of Opposer's black pipe boot with 13-inch base (Applicant's Physical Exhibit 2) and Opposer's black pipe boot with 9-inch base (Applicant's Physical Exhibit 3) shown side by side
Opposer's 38		Color photograph of Bridgestone/Firestone black pipe boot with 13-inch base (Applicant's Physical Exhibit 4), shown with clamping band

## APPLICANT'S EXHIBITS

Applicant's 1 (Steimle)		Hand drawn sketch of left side of hypothetical pipe boot by Attorney for Applicant, Dillis Allen,
Applicant's 1 (Kintzele)		White 13-inch base pipe boot with stamping on base of "Alpha Systems EPDM 1"
Applicant's 2		Black, 13-inch base pipe boot with stamping on base of "Alpha Systems EPDM 1"
Applicant's 3		Black, 9-inch base pipe boot with the stamping on base "Alpha Systems EPDM 2"
Applicant's 4		Black, 13-inch base pipe boot with stamping on the bottom horizontal circumference of "BFDP EPDM"
Applicant's 5		Black, 9-inch base pipe boot with the stamping of "BFPCO" and "PIPE FLASHING ½-1-1 ½-2 ½, EPDM"
Applicant's 6		1-color photograph of pipe boot stamped 'PFDP EPDM' on bottom horizontal circumference
Applicant's 7		1 color photograph of pipe boot, 13-inch base depicting stamp on base "Alpha Systems EPDM 1"
Applicant's 8		1 color photograph of white 13-inch base pipe boot
Applicant's 9		1-page, hand drawn document depicting steps on pipe boot, dated 11-12-08, Labeled "Exh A"
Applicant's 10		1-page, document labeled as "Exh B", dated 11 (12 13) 08, hand-drawn diagram depicting steps of pipe boot
Applicant's 11		26-pages, documents marked "Confidential" from Maple Mold Technologies
Applicant's 12		52-pages, Portals Plus web-site print-outs
Applicant's 13		222-pages, United States Patents on various seals for roof vent pipes or similar articles
Applicant's 14		21-pages, purchasing specifications from Firestone Specialty Products to Alpha Systems
Applicant's 15		1-page, hand drawing of EPDM, TPO & PVC for GenFlex Mold Types by Mr. Hubbard
Applicant's 17		Photos of Pipe Boot Insert for BFPD [Ex 4]
Applicant's 18		Portals Plus Invoices to Firestone (2005, 2006)
Applicant's 21: A portion only, remainder is stricken from record		"Firestone Product Specifications," pages 2-7 of Exhibit. Pages 1, and 8-11 of Exhibit were stricken by Orders dated December 20, 2010 and August 4, 2011
Applicant's 22		Modified Defendant's Exhibit 9 Drawing

## PATENTS

U.S. Patent No. 4,211,423	07/08/1980	Resech/ Roof Seal Device
U.S. Patent No. Des 269,454	06/21/1983	Houseman/ Seal for Roof Vent Pipe or Similar Article
U.S. Patent No. Des. 287,872	01/20/1987	Eriksson/ Sealing Device for Surrounding the Point of Emergence of a Pipe from a Wall or Floor
U.S. Patent No. 917,167	04/06/1909	Shaw/ Roof Flashing
U.S. Patent No. 2,985,465	05/23/1961	Church/ Roof Flange Construction
U.S. Patent No. 3,704,894	12/05/1972	Didszuhn/ Bellows Sleeve
U.S. Patent No. 3,807,110	04/30/1974	Kaminski/ Multipurpose Roof Penetrating Curb
U.S. Patent No. 4,010,578	03/08/1977	Logsdon/ Roof Flashing Structure
U.S. Patent No. 4,211,423	07/08/1980	Resech/ Roof Seal Device
U.S. Patent No. 4,318,547	03/09/1982	Ericson/ Device Used for the Connection of Pipes
U.S. Patent No. 4,342,462	08/03/1982	Carlesimo/ Adjustable Seal Member for Conduit to Manhole Junction
U.S. Patent No. 4,535,998	08/20/1985	Katz/ Sealing Device for Hydraulic Energy Dissipator of the Telescopic Type
U.S. Patent No. 4,570,943	02/18/1986	Houseman/ Sealing Flashing for Buildings with Interlocking Ring Members
U.S. Patent No. 4,574,548	03/11/1986	Tupman/ Column Reglet
U.S. Patent No. 4,664,390	05/12/1987	Houseman/ Weather Seal Device for Conduit Extending through Ridge Surface
U.S. Patent No. 4,673,034	06/16/1987	Hansen/ Cased Water Wells Having Flexible Pad
U.S. Patent No. 4,676,513	06/30/1987	Tiegs/ One-Piece Split Boot for Universal Joint
U.S. Patent No. 4,730,421	03/15/1988	Leeland/ Pitch Box
U.S. Patent No. 4,937,991	07/03/1990	Orth/ Flashing Unit for Sealing Roof Penetrations
U.S. Patent No. 5,067,291	11/26/1991	Evensen/ Pass-Through Roof Seal System
U.S. Patent No. 5,176,408	01/05/1993	Pedersen/ Seal Device for Pipes Passing Through Roof Structures
U.S. Patent No. 5,826,919	10/27/1998	Bravo/ Flexible Penetration Fitting
U.S. Patent No. 5,988,698	11/23/1999	Bravo/ Flexible Penetration Fitting
U.S. Patent No. 6,353,184	03/05/2002	Daoud/ Low Profile Adapter for Variable Size Heat Shrink Tubing Joint
U.S. Patent No. 6,362,427	03/26/2002	Daoud/ Low Profile Adapter for Variable Size Tubing
U.S. Patent No. 6,591,561	07/15/2003	Evensen/ Waterproof Roof Deck Post Construction
U.S. Patent No. 6,640,503	11/04/2003	Evensen/ Waterproof Roof Deck Post Construction and Method
U.S. Patent No. 6,647,682	11/18/2003	Bishop/ Drain Pipe Connector

**Patent and Trademark Office File History for Application Serial No. 76/461,157**

## **DEPOSITION TRANSCRIPTS**

### **Opposer Submitted:**

Deposition of Sean Steimle – Public and Confidential Transcripts

Deposition of Christopher Carl Kintzele – Public and Confidential Transcripts

Deposition of Michael John Hubbard – Public and Confidential – Trade Secret Transcript

### **Applicant Submitted:**

Deposition of David Smith, Jr. – Non-Confidential and Confidential Transcripts

Deposition of David Smith, III – Non-Confidential and Confidential Transcripts

Deposition of John Wayne Merryman – Non-Confidential Transcript

Deposition of Sean Steimle – Non-Confidential Transcript, minus page 5, line 22 through page 7, line 21 which were stricken by Orders dated December 20, 2010 and August 4, 2011

Deposition of Larry Devitt – Non-Confidential Transcript, minus page 6, line 5 through page 8, line 24, which were stricken by Order dated December 20, 2010 and August 4, 2011

## STATEMENT OF THE ISSUES

1. Whether the mark for which registration is sought is functional and therefore unregistrable.
2. Whether the mark for which registration is sought lacks distinctiveness and is therefore unregistrable.
3. Whether Applicant has proven that the mark for which registration is sought has acquired secondary meaning or acquired distinctiveness under §2(f) of the Trademark Act.
4. Whether Applicant improperly amended the application during prosecution to add subject matter sought to be registered as all or part of the mark and therefore registration should be denied.

## I. INTRODUCTION

The opposed application is for the physical shape of a utilitarian object that is commonplace in the building industry. The configuration sought to be registered is a type of pipe flashing used to form a seal around a pipe where it protrudes up through the roof of a building, commonly called a “pipe boot.” As established by Applicant’s own marketing materials and expired utility patent, third party patents and the additional evidence of record, Applicant’s grab-bag collection of features is functional and lacks distinctiveness:

- (a) a lower frusto-conical surface 10 provides a range of sizing about a standard pipe size to “securely seal all pipes,” provides a seating area for the band that clamps the boot in place on the pipe, and the slope makes it easier to slide the boot down over a pipe as well as easier to remove the part from a mold during manufacture;
- (b) an arcuate ring 11 provides “supreme tear resistance,” “reinforcement,” and a “cutting guide,” provides a stop that prevents the clamping band from sliding up off the boot, and the curved shape facilitates removal of the part from a mold during manufacture;
- (c) the annular nearly vertical surface 12 provides a cutting area for the associated standard pipe size located just above the cutting guide rib, so the boot “is severable along the top edge of a selected one of the tubular portions...which has a diameter matching that of a pipe within a larger size range”;
- (d) the horizontal annular surface 13 provides “steps” between standard pipe sizes to “securely seal all pipes,” reduces the boot height and reduces the material that would otherwise be located under the clamping band and therefore wrinkle and leak; and
- (e) the frusto-conical upper surface 14 of the “steps” provides a size range about the next smaller pipe size to “securely seal all pipes” and facilitates assembly and manufacture.

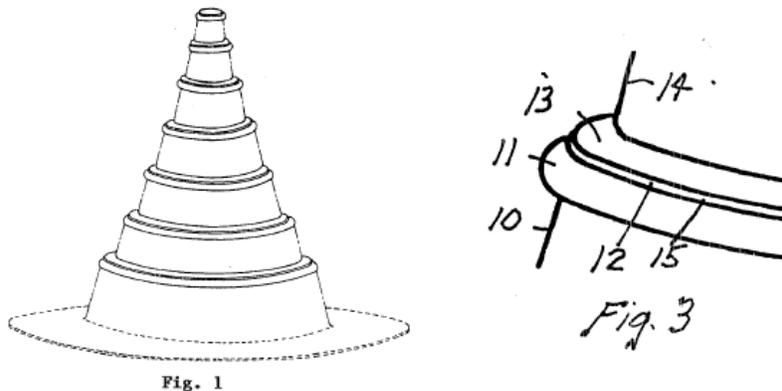
No evidence was introduced of marketing the configuration, or even the identified features, as being a trademark. Virtually no probative evidence was introduced that would support a finding of acquired distinctiveness, and in any event this functional configuration is not registerable.

Moreover, the original application drawing did not include the very features that Applicant now argues are the non-functional, distinctive aspect of the configuration. Those features were only later added to the application drawing after the application was refused. Applicant's efforts to obtain what in essence is a perpetual patent must be denied.

## II. RECITATION OF THE FACTS

### 1. The Mark Sought to be Registered

The proposed mark is for the goods “non-metal building materials, namely, pipe flashing for use in sealing openings for pipes” in International Class 19. As published the proposed mark is for the physical configuration of an item as referenced in the drawing (Fig. 1) and description below, with the reference numerals in the description relating to a Figure 3 submitted during prosecution and also shown below:



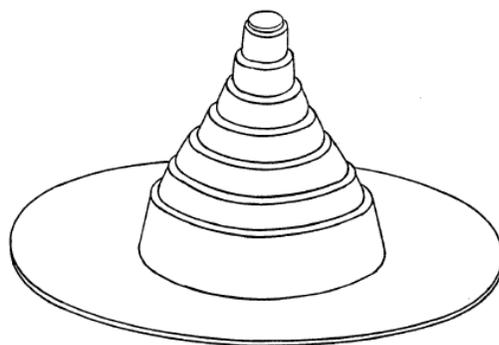
The mark consists of a plurality of frusto-conical steps arranged with the largest diameter step at the bottom and the smallest diameter step at the top as shown above in Fig. 1.

Each of the steps, as shown in Fig. 3 above, consists of: (1) a lower frusto-conical surface 10; (b) a circular ring 11 with a semi-circular cross section and a vertical plane;

(c) a short annular nearly vertical frusto-conical surface 12; (d) a flat horizontal annular surface 13, and; (e) a frusto-conical surface 14 extending upwardly from the inner reach of surface 13. Applicant makes no claims to the shape of the boot portions in dotted lines.

## 2. History of Prosecution - Serial No. 76/461,157

The subject application Serial No. 76/461,157 was filed October 18, 2002. The original application recited as goods “Pipe Flashing” in International Class 11 and was entitled “PIPE BOOT Product Design.” The original application stated that “the trademark is the outer configuration of the goods...” and in transmitting the application Applicant’s counsel represented “that the present mark is for the actual shape of the product which is a rubber pipe boot, and is not intended to be a pictorial design placed on the product itself.” The drawing as originally submitted depicted the proposed mark as follows without ribs on the steps:

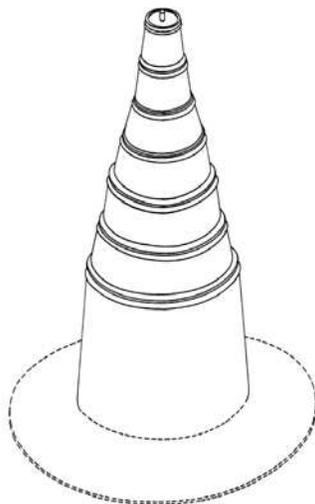


With the application a document was transmitted entitled “Affidavit Under 37 CFR 2.41(b) (Sec 2, 60 Stat. 428; 15 USC 1052),” in which the Affiant, Ronald W. Resech, represented that he was the President of the then applicant. (Hereinafter the “Resech Affidavit.”)

In an Office Action mailed June 5, 2003, a refusal was entered on the basis that the proposed mark was functional and also on the basis that the proposed mark was a non-distinctive configuration. In the action the Examining Attorney noted the drawing requirements regarding dotted lines and required a new drawing, as well as suggested an amendment of the goods and class. The Examining Attorney further required information be provided by the Applicant, in

particular asking whether the proposed mark had been the subject of a design or utility patent, pending or expired, and other information relevant to functionality.

On December 4, 2003 the Applicant mailed an amendment which submitted a new drawing shown below:



That new drawing added raised circular ribs that were not present in the original drawing of the mark and included dashed lines only at the base of the pipe boot. In the response the Applicant submitted arguments with reference to the Figure A shown below:

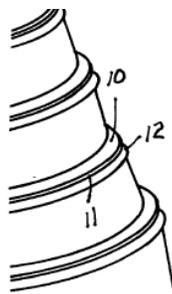
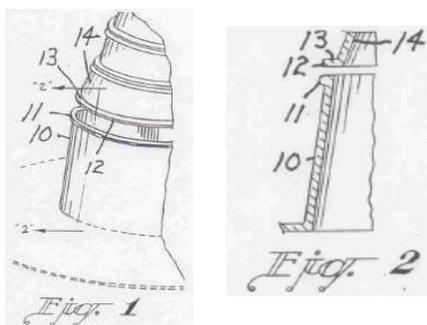


FIG. A

In that argument Applicant stated “Referring to Fig. A, a fragment of the Pipe Boot is illustrated. The horizontal ring surface 10, the vertical annular lip 11, and the arcuate rim 12 are completely non-functional and are what identifies to the public and the industry that this boot or pipe flashing emanates from Portals Plus, Inc.” In responding to the Examining Attorney’s request

for information, the Applicant stated: “In response to the examining attorney’s request at the bottom of page 2 of the Office Action, the proposed mark has not been the subject of a design or utility patent.” Applicant submitted additional materials related to the Examining Attorney's descriptiveness inquiry and argued registerability under Section 2(f). The goods and class were amended at that time to those as published.

In an Office Action dated March 30, 2004, the Examining Attorney maintained and made the refusal final. On September 28, 2004 Applicant responded by mailing a Notice of Appeal addressing the functionality refusal. In the Applicant’s appeal brief, Applicant directed argument and discussion toward Figures 1 and 2 shown below. Fig. 1 below was argued to purportedly depict a fragmentary view of a Portals Plus “mark” taken directly from the drawing also illustrated at the cross section drawing Fig. 2 (page 3 in Applicant’s Appeal Appendix), shown exploded at an exemplary cut line by the installer.

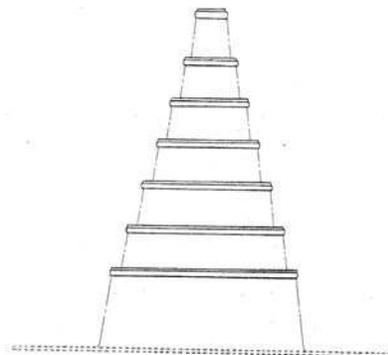


The Applicant argued relative to Figs. 1 and 2 (Appeal Brief page 3.):

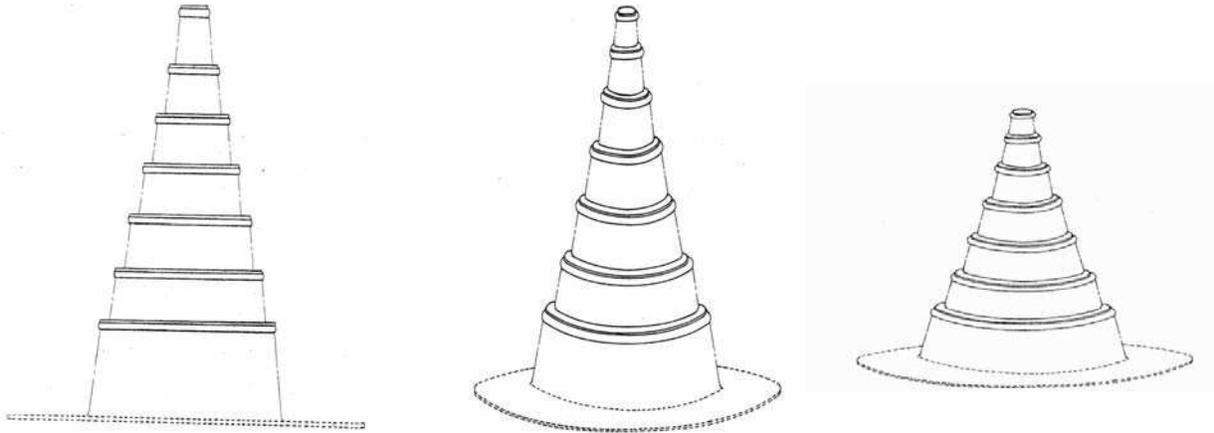
Each of the steps includes a lower frusto-conical portion 10, a semi-circular annular band 11, a small vertical wall 12 where the installer’s cut line is to take place, the horizontal ledge or step 13 that the appellant maintains is distinctive, and an upper frusto-conical portion 14. When the installer makes his cut immediately above semi-circular annular ring 11, he separates the lower portion 10, 11, from the upper portion 13, 14, and the upper portion 13, 14 is discarded. Thus, wall 13 has no function whatsoever in this design, and the design would work equally well if the horizontal step 13 were eliminated and the upper frusto-conical portion 14 were molded directly on top of the semi-circular annular band or rim 11, in line with frusto-conical portion 10.

Since the Applicant only addressed the functionality refusal, the application was remanded and the Examining Attorney clarified in an Office Action dated May 19, 2005, that the application was refused both under § 2(e)(5) and in the alternative under §§ 1,2, and 45 of the Act, (15 U.S.C. §§ 1051, 1052, and 1127), without a sufficient claim of acquired distinctiveness under §2(f) having been made. In an amendment dated November 21, 2005, the Applicant reiterated its previous argument regarding functionality as being applicable to distinctiveness and recited a list of the five items (numbered 11-14 relative to the Figs. 1 and 2 previously depicted herein) that purportedly comprise the distinctive aspect of Applicant's product design.

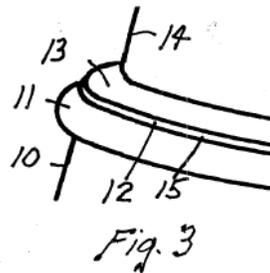
Yet another Office Action was issued on January 29, 2006, to address questions generated by the Applicant's amendment. Regarding the drawing the Examining Attorney noted that the drawing reflected the entirety of the whole pipe boot design with the exception of the base which was designated as the configuration mark, but the description submitted in the amendment appeared to be directed to only a portion of the pipe boot. Moreover the description of that configuration did not match the drawing of record. In a response dated July 19, 2006, the Applicant submitted yet another drawing as shown below, and in its remarks reiterated its arguments with reference to the figure 2 previously shown above.



In the subsequent Office Action dated August 30, 2006, the Examining Attorney again objected to the drawings. In amendment dated February 28, 2007, the Applicant once again submitted a new set of drawings as shown below:



In that amendment in response the Applicant included the following argument directed to the Fig 3 included in the arguments and as shown below:



The following Fig 3 illustrates applicant's distinctive design. It should be noted that in Fig. 3, a cut line is made at 15 to illustrate the non-functionality of this step 13, which is discarded after cutting between 11 and 12.

In any event the distinctiveness of the present mark is evidenced by a combination of shapes illustrated in Fig. 3; that is: (a) the frusto-conical surface 10; (b) the arcuate ring 11; (c) the annular nearly vertical surface 12; (d) the horizontal annular surface 13, and (e) the frusto-conical outer surface 14. Thus, it is a combination of all five of these shapes that defines the present design and trademark. (Emphasis in original.)

In still another Office Action dated May 16, 2007, the Examining Attorney requested a description of the mark. In a response dated November 15, 2007 Applicant reiterated its

arguments regarding Fig. 3 and provided the description which was eventually published verbatim with the proposed mark.

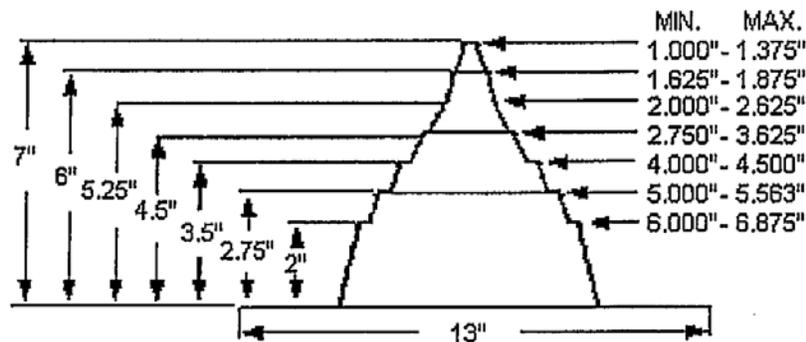
### 3. Applicant's Marketing of the Functional Features Alleged to be a Trademark

Applicant markets its pipe boot specifically promoting the functionality of the product configuration, and in particular the functionality of the particular features it now argues to be non-functional. Applicant does not promote the configuration of this product as a trademark, such as in "look for" type advertising.

Applicant's catalog (OE 2)<sup>1</sup> describes the functional aspects of Applicant's pipe boot pipe flashings:

The conically shaped steps of the Portals Plus pipe flashing will securely seal all pipes and the large double thick molded rib at the top of each step offers supreme tear resistance and reinforcement, as well as a cutting guide. Utilizing the Pipe Flashings eliminates the workmanship error in field fabrication and makes flashing pipes a clean, consistent approach." (OE 2, p. 14, OE 9; Steimle p.31-36.)

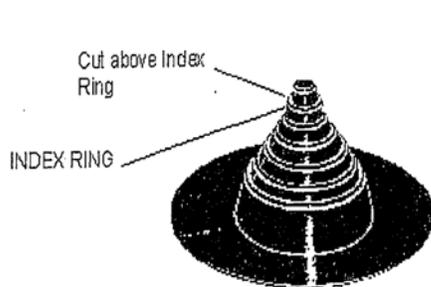
In Applicant's Technical Product Information carried on its website for pipe flashings, the medium pipe boot is depicted. (OE 3.) In that Technical Product Information the conically shaped steps of the pipe boot used to mate with various stock pipe diameters are reflected in a dimensional diagram which is shown below (OE 3):



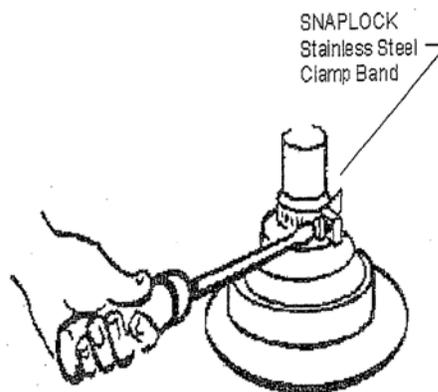
<sup>1</sup> "OE \_\_\_\_\_" means Opposer Exhibit(s) Number "\_\_\_\_\_".

As depicted in OE 3, the steps along the side of the pipe boot are located and dimensioned at standard pipe sizes. (Steimle 45-46, 67-68; Devitt p. 33.) The horizontal walls create a jump from one standard pipe size to the next, with the angled walls providing a range around each of those standard pipe sizes. (OE 3; Steimle 39-41, 50-52, 67-68; Devitt p. 33, 37-38.) For standard pipe sizes the ribs provide cutting guides, and the boot is cut in the short vertical wall above the rib. (Steimle p. 33-34, 67; Devitt p. 36.)

Applicant's pipe boots are cut to size and then clamped onto the pipe using a clamping band. As indicated under the heading "Specification" the Technical Product Information requires "the medium pipe boot shall also include Portals Plus Snaplock Clamp." (OE 3; Steimle p.39-41.) That Specification further requires that attachment of the medium pipe boot to a roof system is to be done in accordance with the "Portals Plus Installation Instructions." As established by Applicant's Installation Instructions, a user is to determine the proper step of the pipe boot to accommodate the particular pipe being installed, and then cut the boot using the index ring as a guide: "Select proper step of the flashing and cut off above index ring. Remember: When in doubt, cut the smaller size." (OE 6, step 2; OE 13.)



**STEP 2**  
 Select proper step of the flashing and cut off above index ring. **REMEMBER:** When in doubt, cut the smaller size. Clean and prime flange in accordance with roofing manufacturer's recommendations.



**STEP 4**  
 Using the Stainless Steel SnapLock Clamp, place at top of boot and tighten to projection.

In step 4 a clamping band is placed over the remaining top step of the pipe boot and clamps the neck about the pipe: “Using the stainless steel Snaplock Clamp, place at top of boot and tighten to projection.” (OE 6; OE 13.)

Applicant markets its products on its website under Product Selection, including marketing materials for its various pipe boots. (OE 8, p. ALP00466; Steimle p 61-63.) Those marketing materials likewise describe the functional aspects of the Applicant’s pipe boots:

Pipe Flashings (boots) - for economical flashing of single ply roofing systems. Pipe boots (or witches’ hats) are economical flashings designed for single pipe penetrations through single ply roofs. Virtually any common pipe size can be accommodated with one of these boots. The conically shaped steps of the Portals Plus Pipe Boots will securely seal all pipes and its large double thick molded rib at the top of each step offers superior tear resistance and reinforcement, as well as a cutting guide for installation. The Portals [sic] Plus Stainless Snaplock Clamp maximizes the secure seal at the penetration. Utilizing the Pipe Boots eliminates workmanship errors in field fabrication and makes flashing pipes a clean, consistent approach. (OE 8, p. ALP00466; Steimle 63.)

Additional marketing materials distributed by Applicant on its website, under the heading Pipe Flashings Technical Product Information, similarly depicts four different styles of pipe flashing, the small pipe boot, the medium pipe boot, the large pipe boot and the Quadraseal flashing. (OE 9; Steimle 63.) Those marketing materials likewise describe the functional aspects now sought to be registered as a trademark by Applicant.

“The “Pipe Boot” is an economical flashing designed for single pipe penetrations on single ply rubber roofs. The unit will accommodate virtually all pipe sizes: 1.75” and 2.75” on Small Pipe Boot, 1” through 6” on Medium Pipe Boot, and 8” through 12” on Large Pipe Boot. ... The conically shaped steps of the Portals Plus pipe flashing will securely seal all pipes and the large double thick molded rib at the top of each step offers supreme tear resistance and reinforcement, as well as a cutting guide. Utilizing the Pipe Flashings eliminates the workmanship error in field fabrication and makes flashing pipes a clean, consistent approach.” (OE 9 p. ALP00473.)

Other marketing materials distributed by Applicant do not even depict the pipe boot configuration sought to be registered by Applicant. (OE 5, 7.)

Applicant sells roofing accessories, such as flashings, membranes, drains, roof drains, roof vents, expansion joints, as well as other products. (Steimle 11-12.) As confirmed and shown in Applicant's catalog, Applicant sells a number of different products, not just pipe boots. (OE 2)<sup>2</sup>. The logo of Applicant is depicted on the upper left corner of its catalog, and comprises the company name PORTALS PLUS overlaying a silhouette of one of its products, as shown below (OE 2):



The product shown in silhouette in Applicant's logo is a product marketed by Applicant as a "pipe portal system," the product shown at page 4 of Applicant's catalog. (OE 2 Cover, p. 4; Steimle 22-23; Devitt p. 29.) That pipe portal system is a product different from the pipe boot for which Applicant seeks registration. (OE 2, p. 4, 14; Steimle 16; Devitt p. 29-30). This logo is used by Applicant in other marketing, such as advertising for Applicant and its related companies. (OE 5, OE7; Steimle 55.) This logo is the trademark Applicant uses to market the activities of the Portals Plus company, and is the logo Applicant uses for all of its Portals Plus products and throughout its packaging and other product sales materials. (Steimle 30, 55.)

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<sup>2</sup> Products of Applicant included in its catalog at least include: **retrofit flashing** (OE 2 p.3; Steimle 22), **pipe portal system** (OE 2 p.4; Steimle 22-24), **double pipe portal system** (OE 2 p.5; Steimle 24), **roof drains** (OE 2 p.8; Steimle 24), **parapet/scupper drain** (OE 2 p.10; Steimle 24), **alumi-flash** (OE 2 p.12; Steimle 24-25), **deck mate** (OE 2 p.13; Steimle 25), **pipe flashings** (OE 2 p.14; Steimle 25-26), **premolded corners** (OE 2 p. 15; Steimle 28).

Applicant's product catalog depicts on its cover at least nine different products of Applicant which also appear elsewhere in the catalog, none of which are the pipe boot argued by Applicant to be its trademark. (OE 2; Steimle 27- 29; Devitt p. 30.)<sup>3</sup> There is no depiction on the cover of Applicant's catalog of the pipe boot for which Applicant seeks registration. (OE 2; Steimle 30; Devitt p. 30.)

Every page of Applicant's catalog, including the pages with pipe flashings, carries Applicant's pipe portal silhouette logo. (OE 2.) Under the heading Pipe Flashings in Applicant's catalog, four different products are shown. (OE 2, p.14.) Of the four items, namely the small pipe boot, medium pipe boot, large pipe boot, and Quadraseal 412R<sup>4</sup>, only the medium pipe boot is depicted in the drawing published as Applicant's trademark. There is no evidence of record reflecting use of the current pipe boot as a trademark or the listed features as a trademark, such as "look for" type advertising.

Applicant believes the configuration of Applicant's pipe boot is superior to the configuration of competitor's products. (Devitt p. 34.) Customers purchase Applicant's pipe boot because the customers believe Applicant's pipe boot works better than boots of other companies. (Devitt p. 34.) Applicant's intent is that customers believe Applicant's pipe boot works better than boots of other companies and Applicant markets its pipe boot as performing better than those of competitors because of the various features of its pipe boot. (Devitt p. 34.)

#### **4. Applicant's Expired Patent No. 4,211,423**

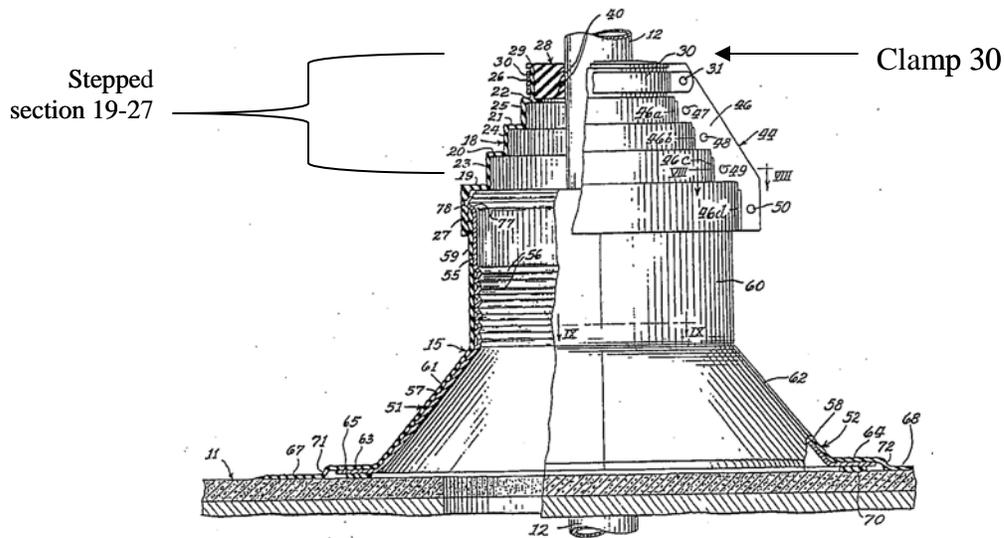
The original Applicant, Portals Plus, Inc., was the owner of now expired U.S. Utility

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<sup>3</sup> The products depicted on the cover of Applicant's catalog (OE 2), in addition to the logo with a silhouette of the **pipe portal system** (Steimle 29-30), include the **roof drain** (Steimle 27-28), **premolded corner- outside corner** (Steimle 28); **scupper drain** (Steimle 28), **premolded corner- inside corner** (Steimle 28), **retrofit flashing** (Steimle 28), **alumi-flash** (Steimle 28), a **breather or vent** (Steimle 28-29), **equipment rails** (Steimle 29), and **deck mate** (Steimle 29).

<sup>4</sup> A Quadraseal is a pipe flashing but not a pipe boot. (Steimle p. 26.)

Patent No. 4,211,423 (“’423 patent”; OE 12; Steimle 75-76). That patent includes figures such as representative Figure 1 below:



The Abstract of Applicant’s ‘423 patent recites: “A split boot is secured to the upper end of a tubular portion on the base sections and is of a stepped, severable construction for accommodating pipes or other objects of various larger sizes.” The Summary of the Invention likewise references the functionality of this configuration: “most preferably of a stepped, severable construction for accommodating pipes or other cylindrical objects of various larger sizes.” (OE 12, Col. 1, lines 67- Col. 2, line 4.)

The ‘423 patent specification’s Description likewise discusses the functionality of the elastic stepped configuration for sealing about pipes that protrude through a roof.

Pipe seal means are secured to the upper end of the base and include a split boot 18 of a flexible elastomeric material which preferably has a plurality of annular step portions 19 – 22 in vertically spaced planes and tubular portions 23 – 26 progressively smaller diameters joining the inner edge of each of the step portions and the outer edge of the next higher step portion. An additional tubular portion 27 extends around the upper end of the base. The boot 18 is severable along the top edge of a selected one of the tubular portions 23 – 27 which has a diameter matching that of a pipe within a larger size range, such as from 3 ½ to 6 inch pipe, for example. For smaller sizes of pipe, a split annular plug 28 is provided.

The plug 28 has an outwardly projecting annular flange 29 which overlies the upper most tubular portion 26 of the boot 18 and a clamp 30 is disposed around the tubular wall portion 26, a screw 31 being extended through the ends of clamp 30. (OE 12, Col. 3, lines 40 – 58.)

When the boot 18 is severed for use with a larger size of pipe, the clip 44 is correspondingly severed. (OE 12, Col. 4, lines 53-54.)

The '423 patent describes the functional cutting of the reduced diameter steps to size the boot to different pipe sizes:

If the device is used with a pipe or other cylindrical object having a diameter greater than that corresponding to the upper tubular portion 26 of the boot 18, the boot 18 is cut at the upper edge of the appropriate one of the tubular portions 23 – 25 prior to installation, the clip 44 is also cut at a corresponding level and a clamp similar to clamp 30 is installed around such tubular portion.

If the device is used with a pipe or other cylindrical object having a diameter corresponding to the upper tubular portion 26, the clamp 30 is used to clamp the portion 26 directly to the pipe or other object. (OE 12, Col. 6, lines 49 – 60.)

Claim 6 of the '423 patent claimed the progressive stepped configuration of the flexible boot section in order to accommodate different sizes:

6. In a device as defined in claim 4 for use with a cylindrical object, said split boot having a plurality of annular step portions in vertically spaced planes and tubular portions of progressively smaller diameters joining the inner edge of each step portion and the outer edge of the next higher step portion, said boot being severable along the top edge of a selected tubular portion having a diameter matching that of said object. (OE 12; Col. 8.)

## **5. Third Party Patents**

Additional utility patents depict the features now attempted to be monopolized by Applicant for itself. Third party patents disclose a “stepped” construction that accommodates different standard pipe sizes and is cut to adjust to the appropriate pipe. (AE 13, Patent 3,807,110; Patent 5,826,919 Patent 5,988,698.) The use of arcuate ribs on the stepped regions is disclosed as useful to hold the clamp in place, as well as provide a cutting guide with the cut being made above the rib:

A plurality of circumferential beads 52 running around the sleeve above each hose clamp help to keep the hose clamps in place at their respective points along the sleeve. The beads are also useful in that they can be used as guides for trimming from the boot any portion of the sleeve that will not be used. For example, if the boot is used to seal a large diameter pipeline, the portion of the sleeve above the bead at the first hose clamp can be trimmed such as with a utility knife. (AE 13, Patent 5,826,919 Col. 5 lines 7-15; AE 13, Patent 5,988,698 Col. 5 lines 7-15).

Numerous third party patents disclose a tapered or conical approach in order to accommodate the different diameter pipes and include ribs at the standard pipe locations. (AE 13 4,664,390, Patent 5,176,408, Patent D269, 454). These ribs are disclosed as being used to establish cutting of the pipe boot to different pipe sizes and reinforcing at the cut:

Spaced along the tapered portion 18 are a plurality of external ridges 14 denoting where the sleeve may be cut off to suit elongate members of different diameters. The ridges also provide a reinforcement about the edge of the open end of the sleeve so formed. (AE 13, Patent 4,664,390 Col. 4 lines 32-36; AE 13, Patent 5,176,408 Col. 5 lines 37-42).

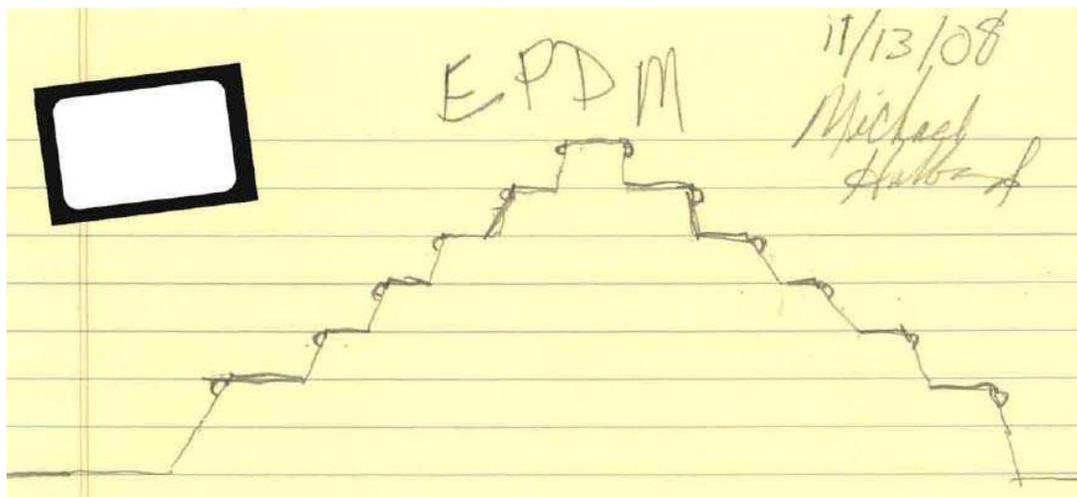
## **6. Third Party Uses**

Michael Hubbard is Senior Development Chemist for Opposer. (Hubbard p. 8.)<sup>5</sup> Mike Hubbard was employed for years at the roofing product supply company Genflex Roofing Systems (“GenFlex”), a company with about \$125 million in sales and a subsidiary of Gencorp, previously named General Tire. (Hubbard p. 6-9, 24, 39-40, 104; OE 29.) For many years Genflex sold pipe boots having a stepped boot configuration, with tapered vertical sections between the steps and an annular rib at the upper end of each tapered vertical wall. A rough

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<sup>5</sup> Mr. Hubbard has a degree in chemistry and worked from 1983 to 1992 at the company ADCO Products, mainly working on adhesives and sealants for the roofing industry. (Hubbard p. 6-8, 102-03.) Mr. Hubbard is a member of ASTM and chaired two different committees for ASTM, was the Technical Chair for the Single Ply Roofing Institute (SPRI), and the NIST-CRADA association that deals with adhesive seams. (Hubbard p. 109.) While at ADCO Mr. Hubbard invented and was granted a patent relating to adhesive tape on the bottom of a pipe boot, and is the inventor on approximately eighteen patents. (Hubbard p. 108, 109-110, 113-14; OE 30.) In 1992 Mr. Hubbard began working at GenFlex Roofing Systems where he was employed until 2006 as Head of Technology with responsibility for new products development among other duties. (Hubbard p. 8, 24, 103-04; OE 29.) Mr. Hubbard was responsible for all products and systems of GenFlex, which systems include pipe boots. (Hubbard p. 104-05.) When GenFlex was purchased by Firestone in 2006, Mr. Hubbard went to Opposer to avoid a move. (Hubbard p. 6-9, 104.)

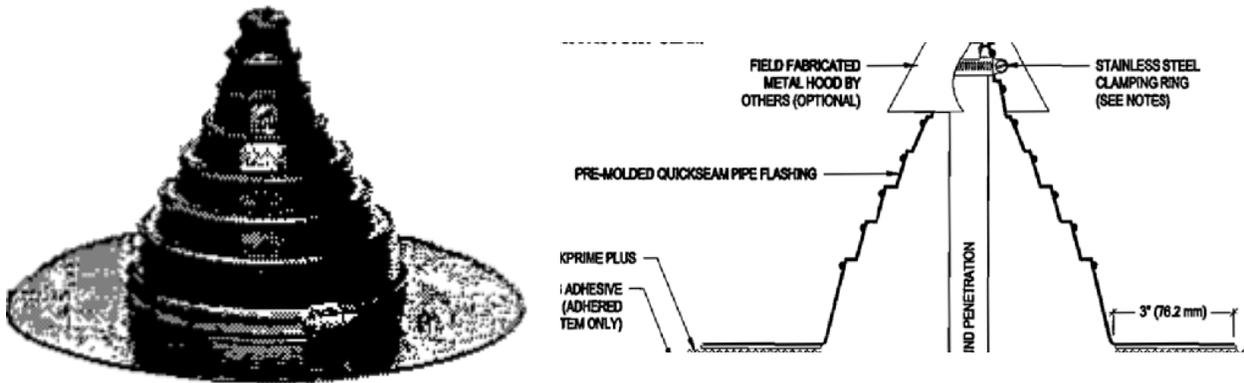
depiction of this pipe boot profile is depicted below (Hubbard p. 25-27; AE 15):



At GenFlex, for installation the pipe boots were cut to the desired pipe size above the rib and a band clamped around the boot beneath the rib. (Hubbard p. 50-51, 56; see Hubbard p.122-25, OE 32-38.) While working at GenFlex Mr. Hubbard installed many pipe boots as part of the company's testing programs. (Hubbard p. 24-25; Merryman p. 17-18.)

GenFlex was purchased by Firestone in 2006. (Hubbard p. 6-9, 104.) The pipe boots sold by GenFlex were very similar to those of the Firestone pipe boot exhibits, although GenFlex did not put the Firestone name on its pipe boots. (Hubbard p. 74-75, 77; OE 4, 5.) GenFlex owned molds that were used to make pipe boots then sold by GenFlex, with the various pipe boots all made from different materials to match the different roofing systems of GenFlex. (Hubbard p. 9-12.) Those molds owned by GenFlex pre-dated Mr. Hubbard's 1992 hiring at GenFlex, and GenFlex sold the pipe boot before that 1992 hiring date (Hubbard p. 26-28, 39). GenFlex had these pipe boots made by two different molding companies, and sold the pipe boots during the same time period that Opposer alleged it sold pipe boots that are the subject of this Opposition. (Hubbard p. 38-39.) It is Opposer's understanding that Firestone is now making its own pipe boots. (Hubbard p. 144; Smith Jr. p. 11.)

Firestone sold pipe boots having similar construction to that sought for registration by Applicant (OE 31). A picture and diagram from Firestone's Technical Information Sheet showing the stepped boot construction with annular rings is shown below (OE 31):



Firestone's Technical Information Sheet lists the ranges of pipe diameters targeted by the stepped configuration and the drawings include instructions for cutting above the rib for the selected pipe size and affixing the clamping band below the rib: "STAINLESS STEEL CLAMPING RING (SEE NOTES)," "NOTES... 2. PRE-MOLDED QUICK SEAL PIPE FLASHING MAY BE CUT TO HEIGHT, BUT NO LOWER THAN REINFORCING RING (NO WRINKLES OR FOLDS UNDER CLAMPING RING)." (OE 31.) Firestone's pipe boot specifications make repeated reference to FIRESTONE, in text and on drawings, and make no reference to any other manufacturer. (AE 14.)

Companies that sell pipe boots similar to that sought to be registered include GAF, Johns-Manville, Firestone, Carlisle, Mule-Hide, Versico, Dow/JP Stevens, Duralast, and possibly others. (Hubbard p. 81-85.) Applicant's designated witness admitted that other companies sell pipe boots. (Steimle p. 21.)

“BFDP” molded into a pipe boot refers to Bridgestone, Firestone and identifies Firestone as the source of the pipe boot. (Kintzele p. 11, 76; Merryman p. 8, 10-11; AE4; OE 23.)

Likewise, “FBCO” refers to Firestone Building Products and means the pipe boot comes from Firestone. (Kintzele p. 77, 81; AE 5; OE 27, 28.) Opposer molds “Alpha Systems” into its pipe boots. (Kintzele p. 75-76, 78-79, 81; AE 1, 2, 3; OE 7, 8, 13, 20, 22, 24, 25.) No source of origin other than these three labels is shown in the pipe boots of record. (Kintzele p. 77.)

## **7. Other Evidence of Functionality**

The angled surfaces 10, 14 make it easier to pull the pipe boot down over a pipe, because a straight sided surface would have too much surface area in contact with the pipe, and the slope also make it easier to get the pipe boot out of the mold. (Hubbard p. 128-29; Kintzele p. 47.)

The horizontal steps bring the pipe boot sides down to standard size pipes. Absent these steps the pipe boot would have to be too tall to accommodate the size range or would have to use too severe of an angle that required too much material and promote a wrinkle under the clamp where water could leak in. (Hubbard p. 127-28, 132-34; Kintzele p. 48; See OE 4; See relative height to diameter comparison of OE 37.) The relative sizes of the clamping ring to the regions under the ribs on the Firestone and Opposer’s pipe boots are shown in the photos of OE 32-36 and 38.

The ribs 11 are used in cutting the pipe boot to the dimension of the pipe and also to keep the clamp from sliding off the boot. (Hubbard p. 129-30; Kintzele p. 45-47.) The curved shape of the ribs is easier to get out of a mold than a shape with corners. (Hubbard p. 45, 130; Smith Jr. p. 38-40<sup>6</sup>.) The small vertical surface 12 above the rib provides the location for cutting the boot along the rib. (Hubbard p. 130, 138, 140; Smith III p. 13; Steimle p. 67; Devitt p. 36.)

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<sup>6</sup> Opposer is in the commercial roofing business and specializes in various product molding or forming. (Smith Jr. p. 27; Kintzele p. 25.) The President of Opposer previously owned another business, Roofing Products, International (“RPI”), in addition to running Opposer. (Smith Jr. p. 27, 33, 35.) Prior to the sale of RPI in 1997, that company had also made and sold pipe boots.

Opposer's pipe boots themselves depict the stepped boot structure, list the standard pipe sizes targeted by those steps and advise the boot is to be "Cut Above Rib." (OE 21.)

#### **8. Origin of Opposer's Pipe Boot**

Opposer is in the commercial roofing business. (Smith Jr. p. 27.) The President of Opposer previously owned another business, Roofing Products, International ("RPI"), in addition to running Opposer. (Smith Jr. p. 27, 33, 35.) Prior to the sale of RPI in 1997, that company had made and sold pipe boots. (Smith Jr. p. 17.)

Prior to getting into the business of making pipe boots, Opposer would buy and then resell pipe boots from Firestone Building Products. (Kintzele p. 11-12, 51, 62.) Opposer specializes in thermal forming, adhesive manufacturing and injection molding, and Opposer was asked by several companies to make pipe boots for them. (Smith Jr. p. 27; Kintzele p. 25.) One of those companies, Firestone Building Products, approached Opposer and inquired whether Opposer could manufacture Firestone's pipe boots, and in June 2006, Opposer decided to move forward with a pipe boot. (Smith Jr. p. 12-13, 27; Kintzele p. 20; Hubbard p. 42.) Opposer therefore bought pipe boots from Firestone and sent them with specifications to a mold manufacturer. (Kintzele p. 24-25; Smith Jr. p. 21.) At the time Firestone approached Opposer Firestone had two designs, one of which was made in South Carolina, but Firestone preferred the other type of material. (Smith Jr. p. 41.) Opposer would have provided pipe boots to Firestone on a private label basis with the Firestone name on the pipe boots, as well as sold Opposer's own pipe boots bearing the Alpha name. (Smith Jr. p. 13).

Prior to making the pipe boot for Firestone Opposer made a patent check of the product through patent counsel. (Smith Jr. p.15-16, 27; Kintzele p. 30, 82.) Opposer was and is not aware that the Firestone pipe boot is a design of Opposer. (Smith Jr. p. 15, 27; Kintzele p. 23.)

The Firestone pipe boot had the qualities that were deemed acceptable by roofing contractors, and worked in the commercial applications Opposer hoped to sell to. (Kintzele p. 32, 51-52.)

Opposer is prepared to introduce a competitive product onto the market, has made metal tooling for manufacturing the product and has contacted customers regarding potential purchase of the product. (Kintzele p. 26-28; Hubbard 20, 44-45, 65-66; Smith Jr. p. 23; Smith III p. 6, 12; See AE11.) Those tooling were completed in March 2007, and Opposer has made pipe boots from that tooling. (Kintzele p. 7-9, 22; Hubbard p. 22.)

#### **9. Applicant's Evidence of Secondary Meaning**

Applicant submitted virtually no evidence of secondary meaning. During prosecution of the subject application Applicant submitted an "Affidavit Under 37 CFR 2.41 (b)" signed by Applicant's then president, Ronald W. Resech, and dated September 30, 2002 (the "Resech Affidavit").<sup>7</sup> That affidavit states that the pipe boots are manufactured to accommodate pipes from 1 inch up to 6 inches in diameter, and regarding the shape admits: "The conically shaped steps of the Portals Plus pipe flashing design will securely seal all pipes and the large double thick molded rib at the top of each step offers supreme tear resistance and reinforcement, as well as a cutting guide." Applicant had designated Mr. Resech as an expert to testify on Applicant's behalf, but Mr. Resech never testified.

The Resech Affidavit appears to refer to excerpts of a catalog in the PTO file that bears a 2002 copyright notice, with one page possibly marked Exhibit A. Although the cover of that catalog bears the Portals Plus logo and depicts a number of different products, the cover does not depict the subject pipe boot. The Resech Affidavit references a piece of paper (Exhibit B) that is

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<sup>7</sup> As is subsequently discussed herein, Opposer objects to consideration of this ex parte Affidavit as probative evidence regarding any issues in this Opposition. Opposer objects to this Affidavit and the attachments thereto as hearsay, lack of authenticity and competency, as well as not entered during the testimony period in this proceeding and without agreement by Opposer.

alleged to show annual sales figures for the years 1995 – 2001. That document was clearly one put together for the affidavit and the underlying sales documents or business records summaries are not submitted or disclosed. The Resech Affidavit references a piece of paper (Exhibit C) that is alleged to show annual advertising costs and catalog literature costs from 1997 – 2001, and trade show costs from 1996 – 2001. That document likewise was clearly one put together for the affidavit and the underlying financial documents or business record summaries are not submitted or disclosed.

The Resech Affidavit Exhibit C sheet refers to the Advertising Costs as those “that include pipe boots,” while the catalog, literature costs are similarly referenced as those “that include pipe boots.” As reflected in Applicant's catalog (OE 2), Applicant sells a number of different products and there is no way to determine the number of different products included in the materials encompassed by Exhibits B and C or the percentage of the costs actually dedicated toward pipe boots, if the document were to be accepted at all. Likewise, the sheet Exhibit C references trade shows at which the pipe boot was shown, but there is no way to determine how many total products were shown at these shows or the percentage of these costs that would be attributed to pipe boots. The advertisements and trade show displays were not themselves submitted, but there is no evidence of record of any advertising reflecting “look for” type marketing of the pipe boot. Documents reflecting other companies' marketing items apparently are submitted, but at best these reflect a large number of other products and no advertising of a pipe boot shape being a trademark. During prosecution from time to time Applicant’s counsel sent additional documents with a response, but those were not accompanied by an affidavit.

During testimony Applicant submitted virtually no evidence as to adoption, history, sales or marketing volume for the subject product, whether in dollar or placement volume.

### III. ARGUMENT

#### 1. Applicant's Product Configuration is Functional

Under §2(e)(5) a mark that is functional is not registerable. 35 USC §1052(e)(5). The Supreme Court has cautioned, “product design almost invariably serves purposes other than source identification.” *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1004 (2001). A product feature is functional and cannot serve as a trademark if the feature is essential to the use or purpose of the article or if it affects the cost or quality of the article. *TrafFix*, 58 USPQ2d at 1006; *In re Dietrich*, 91 USPQ2d 1622, 1626 (TTAB 2009); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1718 (TTAB 2010). When the design is dictated by the underlying functional aspects of the physical design of the product, the design “affects the quality” of the product. *Dietrich*, 91 USPQ2d at 1633.

Four factors which may be considered in determining whether a product design is functional include:

- (1) The existence of a utility patent that discloses the utilitarian advantages of the design;
- (2) The touting by the originator of the design in advertising material of the utilitarian advantages of the design;
- (3) Facts showing the unavailability to competitors of alternative design; and
- (4) Facts indicating that the design results from relatively simple or cheap method of manufacturing the product. (*Dietrich*, 91 USPQ2d at 1626.)

In considering patents, review to determine functionality is not limited to review of the patent claims, but the Board may also consider the disclosures in the patent. *Dietrich*, 91 USPQ2d at 1627; *Mag Instrument*, 96 USPQ2d at 1718. Third party patents are equally probative since ownership of the patent is not relevant. *American Flange & Mfg. Co. v. Rieke Corp.*, 80 USPQ2d 1397, 1404 (TTAB 2005). When a feature of a device is found to affect the quality of the device, there is no need to proceed further to consider if there is a competitive necessity for the feature. *TrafFix*, 58 USPQ2d at 1006; *Dietrich*, 91 USPQ2d at 1636. In such a case the

availability of alternative designs does not detract from the functional character of the design. *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 UASPQ2d 1912, 1928 (TTAB 2011); *Dietrich*, 91 USPQ2d at 1636. Moreover, a determination that a product configuration is functional concludes the analysis, since the non-registerability of a functional design cannot be overcome by a showing of secondary meaning. *TrafFix Devices*, 532 U.S. 23, 33, 34 – 35, 58 USPQ2d 1001, 1007 (2001); *American Flange v. Rieke*, 80 USPQ2d at 1411; see 35 USC §1052(e)(5) (“Except as expressly excluded in subsections ... (e)(5)”).

Section 2(e)(5) of the Trademark act refers to registration being denied if the mark comprises any matter that as a whole is functional. Although the statute references the matter as a whole, the law is clear that the inclusion of a nonfunctional feature does not make an otherwise functional configuration distinctive and registerable. *Kistner*, 97 USPQ2d at 1919. For an overall product configuration to be recognized as a trademark, “the *entire* design must be arbitrary or non de jure functional.” *Kistner*, 97 USPQ2d at 1919 (quoting *Textron, Inc. v. U.S.I.T.C.*, 753 F.2d 1019, 224 USPQ2d 625, 628-29 (Fed.Cir. 1985)(emphasis in original).

In the present proceeding evidence of functionality is overwhelming. The Applicant’s own advertising touts the functional attributes provided by each of the concatenated features that Applicant now alleges as a mark. Applicant’s own patent describes, and claims, the functional structure of a stepped, severable boot construction that accommodates a variety of pipe sizes, and targets standard pipe sizes. Third party patents likewise disclose functional attributes for each of the alleged features of Applicant’s purported mark. Third party product literature discusses the functional features. These features each therefore affect the quality of the article. In addition, some of the features argued by Applicant make the molded product easier to remove from the mold, such as the “frusto-conical” surfaces and an “arcuate” rib, and thus affect the cost as well

as the quality. It is Applicant's stated intent that it make customers believe that the configuration performs better than other configurations and Applicant believes that it is successful in convincing customers of this functional advantage of the configuration.

An applicant bears the ultimate burden on the issue of functionality, and once an opposer has made a prima facie case of functionality the burden shifts to the applicant. *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1429 (Fed. Cir. 2002); *American Flange v. Rieke*, 80 USPQ2d at 1404. In this instance the purported mark is unquestionably functional, not only because one of the recited features is functional, but in this case each and every feature is categorically functional. By Applicant's own admissions these features are functional:

- (a) A lower frusto-conical surface 10 - As reflected in Applicant's marketing materials and instructions, this provides a range of sizing about a standard pipe size to "securely seal all pipes." As stated in Applicant's marketing materials, instructions, patent and third party patents, this area provides a seating area for the band that clamps the boot in place on the pipe, and as explained by witnesses the slope makes it easier to slide the boot down over a pipe as well as easier to remove the part from a mold.
- (b) An arcuate ring 11 - As admitted by Applicant's marketing materials and instructions and in third party patents, this ring provides "supreme tear resistance," "reinforcement," a "cutting guide," and provides a stop that prevents the clamping band from sliding up off the boot. As explained by witnesses, the curved shape facilitates removal from a mold.
- (c) The annular nearly vertical surface 12 - As reflected in Applicant's marketing materials, instructions, patent and third party patents, this region provides a cutting area for the associated standard pipe size located just above the cutting guide rib, so the boot

“is severable along the top edge of a selected one of the tubular portions...which has a diameter matching that of a pipe within a larger size range.”

(d) The horizontal annular surface 13 – As reflected in Applicant’s marketing materials, instructions, patent and third party patents, and as explained by witnesses, these surfaces provide a “stepped” configuration between standard pipe sizes to “securely seal all pipes,” reduce the boot height and reduces the material that would otherwise be located under the clamping band and therefore reduces the potential to wrinkle and leak.

(e) The frusto-conical upper surface 14 – As reflected in Applicant’s marketing materials and instructions; this upper surface of the “stepped” configuration provides the range of sizing about the next smaller standard pipe size to “securely seal all pipes” and facilitate assembly. As explained by witnesses, the slope also makes it easier to slide the boot down over a pipe as well as easier to remove the part from a mold. The unsubstantiated comments by Applicant’s attorney that these surfaces are completely unnecessary and non-functional since these regions are cut off and discarded are specious, if not misleading. These upper sections are used for smaller pipe sizes and therefore allow the one pipe boot to accommodate a number of different pipe sizes. This feature is functional even though some customers may not take advantage of the feature. *American Flange*, 80 USPQ2d at 1408.

In view of the functionality of the product configuration sought to be registered, the other issues such as lack of distinctiveness become moot.

**2. Applicant’s Product Configuration is Not Distinctive and Acquired Distinctiveness Has Not Been Proven**

The Trademark Act provides that to be registerable, the subject matter must be a trademark, and to be a trademark the device must identify and distinguish the products of a

person. 35 USC §§1051, 1052 (“...by which the goods of the applicant may be distinguished from others...”) and 1127 (“trademark... to identify and distinguish his or her goods...”). As specified under §2 of the Act, a mark that is merely descriptive of the goods in question is not registerable. 35 USC §1051(e)(1). The Supreme Court has clarified that a product configuration can never be inherently distinctive, and is registerable on the Principal Register only with a showing of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *In re Craigmyle*, 224 UPSQ2d 791 (TTAB 1984). Of course, as noted, the non-registerability of a design that is functional cannot be overcome by a showing of acquired distinctiveness. *TrafFix Devices*, 532 U.S. 23, 33, 34 – 35, 58 USPQ2d 1001, 1007 (2001); *American Flange v. Rieke*, 80 USPQ2d at 1411.

In this instance there is no dispute that the item sought to be registered is the physical configuration of an actual product, and therefore is not inherently distinctive. Lest there be any doubt, Applicant pursued registration under §2(f), which itself is a concession that the mark is not inherently distinctive. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 1577, 6 USPQ2d, 1001, 1005 (Fed. Cir. 1988); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1679-80 (TTAB 2007).

An opposer must establish a prima facie case of lack of distinctiveness, after which the burden shifts to the applicant to prove registerability under §2(f). *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1578-80, 6 USPQ2d 1001 (Fed.Cir. 1988); *American Flange v. Rieke*, 80 USPQ2d at 1411. In this instance Opposer has submitted overwhelming evidence as to the prima facie functionality and non-distinctive character of the configuration sought to be registered. That evidence includes utility patents, marketing materials of Applicant that tout the functional attributes of Applicant’s configuration and other marketing materials that make no

reference to the purported design. Just as in *Mag Instrument*, 96 USPQ2d 1723 – 24, there is no evidence that Applicant undertook any form of “look for” advertising campaign regarding Applicant’s product configuration. This product configuration is but one of many utilitarian and functional constructions sold by Applicant. Third parties have sold pipe boots having similar, if not identical, configuration.

In order to meet its burden to establish registerability under §2(f), an applicant must show that the primary significance of the alleged features in the minds of consumers is not the utilitarian parts of the product but the source of that product. *Mag Instrument, Inc. v. Brinkman Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010). In this proceeding Applicant has not submitted direct evidence of the mindset of consumers, except to the extent of an admission against interest by Applicant’s witness that customers buy the product because of the way the pipe boot works, and in particular has not submitted direct evidence of acquired distinctiveness of this configuration in the minds of the purchasing public. Although circumstantial evidence of acquired distinctiveness can include advertising expenditures, a successful advertising campaign is not in itself necessarily enough to prove secondary meaning, particularly when there is no “look for” type of advertising. *Mag Instrument*, 96 USPQ2d at 1723. Those advertising activities are of even less probative if the expenditures involve advertising of a number of different items and there is no allocation of advertising expenses to the different items. E.g. *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007).

Regarding the circumstantial evidence in this case, the marketing materials of Applicant nowhere promote Applicant’s pipe boot shape as a source identifier. The catalog of Applicant depicts numerous products on its cover, none of which are the pipe boot in question. Applicant’s advertisements of record show a different logo of Applicant which Applicant’s witnesses admit

is the trademark that Applicant uses to market its products. The ex parte Resech Affidavit does not establish the relative size of the marketing activities regarding this product, whether relative to the trade in general or even to the marketing Applicant undertakes for its other products. One cannot determine from the Resech Affidavit what percentage of the unsubstantiated advertising expenditures should be apportioned to the pipe boot, since Applicant has numerous products and the Resech Affidavit does not provide this information. *Target Brands*, 85 USPQ2d at 1681.

Moreover, affidavits of an applicant's employees are biased and of little probative value on the issue of secondary meaning. See *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971); *Kayser-Roth Corp. v. Greene, Tweed & Co.*, 159 USPQ 494, 498 (TTAB 1968).<sup>8</sup> Here the affiant, Mr. Resech, was allegedly going to testify on behalf of Applicant. Rather than proceed with the testimony of Mr. Resech, over the objection of Opposer Applicant elected to request a resetting of the period for Applicant to take expert testimony and identified a different expert. Notwithstanding the Board granting the motion of Applicant to substitute a new expert and resetting the period, Applicant did not take the testimony of the substitute expert. The credibility of the Resech Affidavit is highly suspect and is of little or no probative worth.

Sales figures spanning a number of years without any context in the particular trade to which they relate, such as market share for the product or how the sales of this product ranks in terms of sales of the trade, do not elevate a descriptive mark to the status of a distinctive mark. E.g. *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007). Even large sales figures show only that a product is popular and do not show that the relevant customers of such

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<sup>8</sup> Until 2009 ex parte affidavits filed during prosecution, although part of the application file of record, were not considered at all for their substantive content unless the applicant authenticated and properly introduced them through a witness during the testimony period, something that the Applicant did not do here. E.g. *Trademark Board Manual of Procedure (TBMP)*, 704.04; *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993), aff'd, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994)((2)(f) affidavit); *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101, 1102 fn.3 (TTAB 1982)(Affidavit submitted for purposes of § 2(f) in application).

products have come to view the alleged mark as the applicant's source-identifying mark. *Target Brands*, 85 USPQ2d at 1681. Testimony by an applicant's principal regarding the product configuration sought to be registered is an industry leader in sales is not probative when the applicant does not produce the underlying sales information and information on product share is not provided. See e.g. *In re Valkenberg*, 97 USPQ2d 1757, 1766-67 (TTAB 2011). No meaningful business records summarizing sales information were made of record. The Resech Affidavit mentions sales volumes, but no substantiating documents were made of record or even produced. No evidence was made of record that would put this information into context in the industry or in the context of Applicant's sales of other products. As previously noted the Resech Affidavit is highly suspect and is of little or no probative worth.

There is no competent proof in this proceeding of when use of applicant's specific pipe boot began, and in no event is there evidence of exclusive use. As provided under the regulations: "The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony." 37 CFR §2.122(b)(2). Applicant made no effort to introduce such evidence through testimony during the testimony period.

During discovery counsel for Applicant repeatedly intimated the notion that pipe boots of Firestone and of others were manufactured by Applicant and therefore these are not third party uses that negate distinctiveness. Regardless of whether Firestone at some point obtained some pipe boots from Applicant, there is no evidence that all pipe boots sold by Firestone were

obtained from Applicant. To the contrary, the evidence would establish that some pipe boots of Firestone came from manufacturers other than Applicant and from multiple manufacturers. More importantly, the products and marketing materials of record establish that Firestone pipe boots are marketed and sold under the Firestone brand and company trade name, and no other companies are indicated as being the source of Firestone's pipe boots. The same holds true for the other third party companies. There is no evidence that all of the products from any one of these third parties originate from Applicant, and there is no evidence that these third parties market these products as being sourced from Applicant.

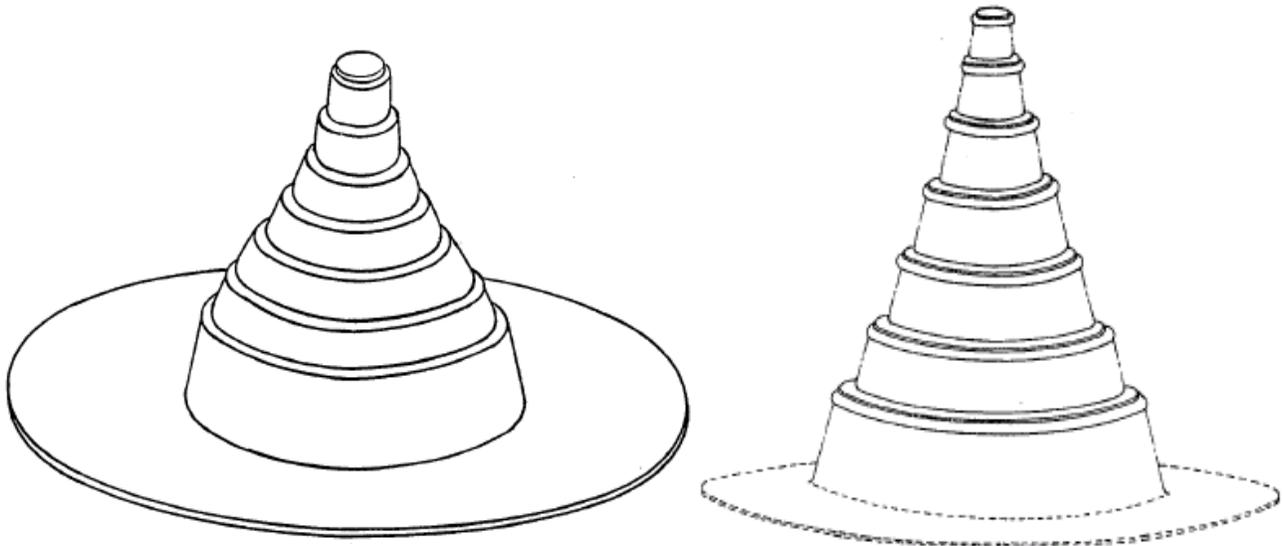
Even if Applicant could prove it was the source for pipe boots sold by Firestone and that one hundred percent of Firestone pipe boots originate from Applicant under a private label arrangement, such private label sales defeat a claim of secondary meaning. *American Flange & Mfg. Co. v. Rieke Corp.* 80 USPQ2d 1397, 1409 (TTAB 2005); see *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1203-04 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 UPSQ2d 1120 (Fed.Cir. 1994); *Alexander Binzel Corp. v. Nu-Tecsys Corp.*, 785 F.Supp. 719, 722, 22 USPQ2d 1793 (N.D. Ill. 1992); *Filter Dynamics International, Inc. v. Astron Battery, Inc.*, 311 N.E.2d 386, 395, 183 USPQ2d 102 (2d Dist. Ill. App. Ct. 1974). There is no indication to the purchasing public that the pipe boots are anything but Firestone products and nothing that would generate acquired distinctiveness in Applicant for this product as opposed to acquired in Firestone. Once again, the same applies to other third parties.

During discovery Applicant's counsel likewise repeatedly intimated some degree of copying by Opposer of Applicant's product, of which no evidence was introduced. Not only does the evidence establish that Opposer did not copy Applicant's product, but with regard to a product configuration, even if Applicant could prove that copying had occurred copying does not

infer acquired distinctiveness. *In re Valkenberg*, 97 USPQ2d 1757, 1766-67 (TTAB 2011).

### 3. Applicant Improperly Materially Altered Its Drawing After Filing

Under Trademark Rule 2.72 the drawing in a trademark application may not be amended if the amendment constitutes a “material alteration” of the drawing in the application. *In re Pierce Foods Corp.*, 230 USPQ 307, 308-09 (TTAB 1986). Under that rule, an amendment to the drawing may be made “only if” the specimens originally filed support the amendment, *and* the proposed amendment does not materially alter the mark. Both of these requirements must be met. Regarding the second requirement, Rule 2.72 further provides: “The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.” 37 CFR §2.72(a)(2). A comparison of the original drawing to the published drawing is made below:



In this instance Applicant has added material to the drawing that include the very features that Applicant is now arguing form its trademark: “(b) a circular ring 11 with a semi-circular cross section and a vertical plane; (c) a short annular nearly vertical frusto-conical surface 14

extending upwardly from the inner reach of surface 13.” The Applicant did not provide the Examining Attorney with this description until the end of prosecution. The stated features “(b) a circular ring 11 with a semi-circular cross section and a vertical plane; (c) a short annular nearly vertical frusto-conical surface 14 extending upwardly from the inner reach of surface 13” did not reside in the original application description and misleads as to the subject matter that was originally shown in the drawing as filed and described.

That Applicant added these after refusal is all the more indicative of material alteration. The Examining Attorney noted the rule for configuration cases that portions are to be shown in broken or dashed lines and that a description be provided. In response Applicant did not convert the original drawing into one with portions shown in broken lines as would be expected. Instead, when the revised drawing was submitted Applicant added subject matter to the drawing. The absence of these features from the original drawing would raise an inference that Applicant recognized that the mark as originally presented was not registerable, and therefore additional product features were added to the mix in an untimely effort to manufacture a collection that would be registerable. At a minimum it is indicative that Applicant's counsel, who had reviewed all of the information provided by Applicant, did not even recognize these features as being part of a trademark at the time the application was filed.

#### **4. Registration of the Alleged Mark Will Damage Opposer and Opposer Has Standing**

Opposer is in the commercial roofing business. Opposer has made substantial preparations regarding sales of a pipe boot. Opposer has been asked by a number of customers to provide a pipe boot. Opposer has had made and purchased a final metal mold that would be used to make pipe boots and has made pipe boots from that mold. Opposer has discussed the possible sales of pipe boots with customers. At least one of the pipe boots prepared to be sold by

Opposer utilizes a configuration that is similar to that sought to be registered by Applicant. (OE 20, 21, 22.) As a potential competitor to Applicant on this product for which Applicant has sought registration, for Applicant to be awarded a registration for this functional and non-distinctive design would damage Opposer in view of the substantial preparations Opposer has made for production and sale of pipe boots. E.g. *Saint-Gobain Corp., v. 3M Co.* 92 USPQ2d 1425, 1428 (TTAB 2007).

#### **5. Opposer Maintains Its Objections to Evidence of Applicant**

Opposer renews its objection to the proposed exhibits and testimony taken by Applicant which was stricken from the record in the decision mailed December 20, 2010, and as confirmed in the decision on motion for reconsideration mailed August 24, 2011, namely: Applicant's Exhibit 16 and any testimony in relation thereto, including testimony of Sean Steimle on November 12, 2009, page 5 line 22 through page 7 line 21; Applicant's Exhibit 20 and any testimony in relation thereto, including Devitt page 6 line 15 through page 8, line 4; and pages 1 and 8 through 11 of Applicant's Exhibit 21 and any testimony in relation thereto, including Devitt page 8, lines 5 through 24. These materials were not properly identified during pre-trial disclosures and not produced during discovery. Opposer promptly moved to strike these exhibits and testimony. For the same reasons as stated in Opposer's motion and for which the orders striking these materials were granted, Opposer renews its objection.

Opposer objects to the testimony of Devitt, page 39, lines 6 through 21, as hearsay, lack of personal knowledge and lacking foundation. Applicant's counsel inquired as to the mental state of customers, to which Mr. Devitt responded to this subject which is outside his personal knowledge without any foundation for his testimony on this question or legal basis for

knowledge of this mental state. This testimony is inadmissible under Fed.R.Civ.P. 602, 701, 802.

Opposer objects to Devitt page 22, line 10 through page 25, line 25, as being leading and lacking foundation for a hypothetical and outside the witness's personal knowledge. This testimony is inadmissible under Fed.R.Civ.P. 602, 611(c), 701.

Opposer objects to Steimle (November 12, 2009) page 13, lines 13 through page 15, line 16 as leading and lacking in foundation and in personal knowledge. This testimony is inadmissible under Fed.R.Civ.P. 602, 611(c).

Opposer objects to the Resech Affidavit and any materials referenced in the Resech Affidavit from being considered as evidence for the substantive content of the Resech Affidavit and associated materials. This information and materials are unsubstantiated hearsay, and Opposer further objects to the materials submitted with the Affidavit as lacking authenticity and competency. Under the rules the parties are able to stipulate to the entry of testimony via affidavits. 37 CFR §2.123(b). In this proceeding the parties did not stipulate to submission of testimony by way of affidavit. The pieces of paper referred to in the Resech Affidavit as Exhibits B and C are clearly not business records and the underlying documents and information were not produced by Applicant. There is not sufficient authentication or competency established regarding the other items attached to the Resech Affidavit.

The acceptance of such an ex parte affidavit, without first requiring an agreement of the parties to submission of evidence by affidavit, would provide an applicant with a significant unfair advantage over an opposer. An applicant would be able in essence to manufacture and introduce any testimony it wished by affidavit submitted during ex parte prosecution, yet an opposer is unable to submit evidence by way of affidavit without agreement between the parties.

For many years the Board had not accepted ex parte affidavits filed during prosecution for the substantive content of those affidavits, although the documents do form part of the application file of record. That there is an ex parte affidavit in the application file, however, does not make it competent, the attachments authentic or any of the materials probative. E.g. *Trademark Board Manual of Procedure (TBMP)*, 704.04; *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993), aff'd, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994)((2)(f) affidavit); *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101, 1102 fn.3 (TTAB 1982)(Affidavit submitted for purposes of § 2(f) in application); see *UMG Recordings, Inc. v. Charles O'Rourke*, 92, USPQ2d 1042, 1047 (TTAB 2009); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993); *Omega SA v. Compucorp.*, 229 USPQ 191, 195 (TTAB 1985); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985). Even in court proceedings the Federal Rules of Civil Procedure do not allow the admission of an ex parte written statement to be submitted absent proof of an exception to the hearsay rule. Fed.R.Civ.P. 802, 803. To the extent that the Board may have made a change in this approach, the Resech Affidavit is not probative or competent. See *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1357 (Fed. Cir. 2009).

#### **IV. SUMMARY**

The product configuration sought to be registered by Applicant is functional and is not proper subject matter for a trademark registration. Applicant's description of the purported trademark reads like a utility patent claim, and with good reason, Applicant is seeking to obtain pseudo patent protection for a configuration that has long been in the public domain. Applicant is seeking to obtain a perpetual monopoly for a collection of utilitarian features, each and every

one of which Applicant itself marketed as providing functional benefits. Applicant owned a now expired patent that disclosed and claimed many of the features sought to be registered.

Additionally, the configuration sought to be registered is not distinctive and does not function as a trademark. Applicant has not proven secondary meaning has attached to this configuration.

Finally, Applicant did not originally seek to protect the configuration now sought to be registered. Features of the configuration that Applicant now argues were improperly added to the drawing after filing. For this reason alone Applicant's application should be denied.

The opposition should be sustained and judgment entered in favor of Opposer, registration being denied to Application Serial No. 76/461,157.

Respectfully submitted,

October 20, 2011

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CERTIFICATE OF SERVICE

I hereby certify that on October 20, 2011, a true and correct copy of Opposer's Trial Brief was sent via First Class Mail, postage prepaid to Attorney for Applicant as follows:

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