

This Opinion Is Not a
Precedent of the TTAB

Mailed: March 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Chris W. Taylor Jr.

v.

Three Frog, LLC
—————

Opposition No. 91255161
—————

J. Curtis Edmondson of Law Offices of J. Curtis Edmondson, LLC dba Edmondson
IP Law, for Chris W. Taylor Jr.

Stephen McArthur of The McArthur Law Firm PC,
for Three Frog, LLC.

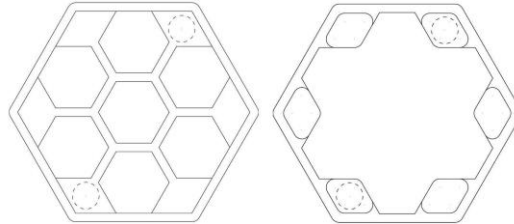
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Before Lynch, Acting Deputy Chief Administrative Trademark Judge,
Zervas and Dunn, Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, citations in this decision differ from the citation form recommended in the Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 101.03 (June 2023). This decision cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this decision employs citations to the LEXIS legal database and cites only precedential decisions. Until further notice, however, practitioners should continue to adhere to the practice set forth in TBMP § 101.03.

Precedential decisions of the Board, and precedential decisions of the Federal Circuit involving Board decisions that issued January 1, 2008 or after may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB reading

Three Frog, LLC (Applicant) seeks registration on the Principal Register, with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), of the following configuration:



for “dice boxes, namely, boxes specially adapted for storing dice; wooden boxes specially adapted for storing board game components or dice; board game and tabletop game accessories, namely, accessories in the nature of boxes specially adapted for storing board game components or dice,” in International Class 28.² The application states:

The mark consists of a three-dimensional configuration of the interior of a hex shaped box with a honeycomb configuration of seven interior hexagonal indentations on the bottom of the box and the design of a six point star, having flat points, on the top of the box. The broken lines depicting circular magnets indicate placement of the mark on the goods and are not part of the mark.

Color is not claimed as a feature of the mark.

room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

² Application Serial No. 88125640 filed September 20, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and in commerce since at least as early as October 2, 2014. The application claims ownership of Registration No. 5390970 for the word mark HEX CHEST (CHEST disclaimed) for “wood boxes.”

Citations to the application file refer to the USPTO’s Trademark Status & Document Retrieval (TSDR) system and identify the documents by date, and page in the downloadable .pdf version. Otherwise, citations refer to the Board’s TTABVue online docket system.

Chris W. Taylor Jr. (Opposer) filed a notice of opposition that he subsequently amended to plead that the configuration is a functional design for the goods under Section 2(e)(5) of the Act, 15 U.S.C. § 1052(e)(5), and is non-distinctive product design trade dress lacking acquired distinctiveness under Sections 1, 2, and 45 of the Act, 15 U.S.C. §§ 1051-1052, 1127.³ Applicant's answer largely denies the salient allegations of the operative notice of opposition, but admits the following:

3. (in relevant part) Applicant admits that the 20-sided icosahedron die is an iconic Dungeons & Dragons ("D&D") die.

10. (in relevant part) Applicant admits that "Mr. Rousseau", a hobbyist, released a video in December 2014 showing a design that was explicitly based off of Applicant's Honeycomb Design⁴ that Applicant had publicized months earlier on Kickstarter and Reddit.

23. and 26. (in relevant part) Applicant admits that it filed an intellectual property complaint with Thingiverse.com⁵ against Opposer for distributing unauthorized counterfeits of Applicant's original Honeycomb Design.⁶

³ 16 TTABVUE.

⁴ The answer defines "Applicant's Honeycomb Design" as "the dice box design described in Application number 8812564[0]" (17 TTABVUE 2) and as stated above the application describes the mark in part as a "honeycomb configuration."

⁵ As indicated below, Thingiverse.com is an online community that facilitates the sharing of designs for 3D-printable objects.

⁶ 26 TTABVUE. Applicant pleaded the equitable affirmative defenses of acquiescence, laches, estoppel, waiver, and unclean hands in its Answer but did not pursue them in its final brief, so they are forfeited or waived. *CBC Mortg. Agency v. TMRR, LLC*, 2022 TTAB LEXIS 295, *3-4 (TTAB 2022). Applicant also asserted that its mark has acquired distinctiveness or is inherently distinctive and that the notice of opposition fails to state a claim upon which relief can be granted. The former is not an affirmative defense but merely amplifies Applicant's denials in the answer, and the latter was made moot by the Board's February 28, 2022 order granting in part and denying in part the cross-motions for summary judgment after examining the sufficiency of the amended notice of opposition. 23 TTABVUE.

I. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed application.

Opposer submitted:

- Unsworn statement by Opposer Chris W. Taylor, Jr.;⁷
- The August 26, 2021 declaration by Opposer submitted in support of his motion for summary judgment;⁸

Notices of reliance with attachments:

- Excerpts from the subject application file;⁹
- Complaint and exhibits from the district court action brought by Applicant against a third party;¹⁰
- Excerpts from U.S. Copyright Office records pertaining to Applicant's copyright claim for the configuration that is the subject of this proceeding;¹¹
- Excerpts from USPTO records pertaining to a third-party patent application for a dice box;¹²
- January 14, 2019 DMCA notice to Thingiverse from Applicant alleging infringement of "Copyright (case number 1-6886106851) and Trade Dress (serial number 8812564[0]) for hex shaped dice boxes with beehive interior designs;"¹³

⁷ 27 TTABVUE 235-36.

⁸ 27 TTABVUE 233-34.

⁹ 27 TTABVUE 4-165.

¹⁰ 27 TTABVUE 207-27.

¹¹ 27 TTABVUE 167-96.

¹² 27 TTABVUE 198-205.

¹³ 27 TTABVUE 231. We take judicial notice of the U.S. Copyright Office webpage explaining that the Digital Millennium Copyright Act (DMCA), 17 U.S.C. §. 512, amended U.S. copyright law to, inter alia, create the notice-and-takedown system, which allows copyright owners to inform online service providers about infringing material so it can be taken down, failing which online service providers may have monetary liability for copyright infringement based on the actions of their users. See The Digital Millennium Copyright Act at

Applicant submitted:

- Testimony declaration by Quentin Weir, co-founder and managing partner of Applicant dba Elderwood Academy, and exhibits;¹⁴
- Testimony declarations by Mike Cameron,¹⁵ Doug Johnson,¹⁶ Justus Hughes,¹⁷ Ken Gruhl,¹⁸ and Matt Colville,¹⁹ third-parties working in the field of tabletop games, including dice games.

Notices of reliance with attachments:

- Deposition of Opposer Chris W. Taylor, Jr.;²⁰
- Opposer's responses to Applicant's requests for admission;²¹
- Internet materials, namely online Reddit posts.²²

Opposer chose not to cross-examine Applicant's witnesses or submit rebuttal testimony or evidence. Because Opposer's trial brief was untimely and therefore not

<https://www.copyright.gov/dmca/>. *In re Int'l Fruit Genetics, LLC*, 2022 TTAB LEXIS 403, *4 (TTAB 2022) ("We therefore take judicial notice of the text of the 1991 Act of the [International Union for the Protection of New Varieties of Plants] Convention and its Explanatory Notes, as well as the publicly available facts on the UPOV website at <https://www.upov.int> about the Convention and its administration.").

¹⁴ 36 TTABVUE. The answer uses Three Frog, LLC interchangeably with Applicant and Elderwood (26 TTABVUE 2).

¹⁵ 31 TTABVUE.

¹⁶ 32 TTABVUE.

¹⁷ 33 TTABVUE.

¹⁸ 34 TTABVUE.

¹⁹ 35 TTABVUE.

²⁰ 29 TTABVUE.

²¹ 30 TTABVUE.

²² 37 TTABVUE.

considered,²³ and Opposer chose not to file a rebuttal brief, Applicant's trial brief is the only brief of record.

We dismiss the opposition.

II. Evidentiary Matters

Applicant objects to consideration of Opposer's two statements submitted as testimony on the grounds that one is unsworn and the other untimely.²⁴ With respect to the requirements for a sworn statement, Trademark Rule 2.2(n), 37 C.F.R. § 2.2(n), provides (emphasis in original):

The term **verified statement**, and the terms **verify, verified, or verification** as used in this part refers to a statement that is sworn to, made under oath or in an affidavit, or supported by a declaration under § 2.20 or 28 U.S.C. 1746, and signed in accordance with the requirements of § 2.193.

28 U.S.C. 1746 provides (emphasis added):

Wherever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath, or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than a notary public), **such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated**, in substantially the following form:

- (1) If executed without the United States: "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).
(Signature)".
- (2) If executed within the United States, its territories, possessions, or commonwealths: "I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

²³ 42 TTABVUE.

²⁴ 43 TTABVUE 13-15.

(Signature)".

The statement by Opposer Chris W. Taylor, Jr. begins "I, Chris W. Taylor, Jr., pursuant to 28 U.S.C. § 1746 declare as follows" and is subscribed and dated, but fails to state that the statement is true under penalty of perjury.²⁵

On its face, 28 U.S.C. 1746 provides no leeway to treat a statement that omits the reference to "true under penalty of perjury" as compliant with its requirements. Instead, as shown above, the statute requires the statement to be "in substantially" the same form as the listed examples including that language. The required language being absent from Opposer's statement, and a mere reference to the statute being insufficient, we agree that Opposer's statement is unsworn and cannot be considered as testimony. See *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 TTAB LEXIS 95 (TTAB 2019) (Declaration given no consideration because "Neither the original declaration nor the substitute declaration substantially complies with 28 U.S.C. § 1746 due to the absence of the wording 'under the laws of the United States' or its substantial equivalent."); *In re Dermahose Inc.*, 2007 TTAB LEXIS 25, *13-14 (TTAB 2007) ("In effect, the common feature of oaths, sworn statements, unsworn declarations under penalty of perjury, and declarations under Rule 2.20 is that the person making the statement is subjecting himself or herself to criminal penalties for making statements that the person knows are not true.").²⁶

²⁵ 27 TTABVUE 235-36.

²⁶ Because this statement largely reiterates the statements made in Opposer's August 26, 2021 declaration regarding his interest in producing hexagonal boxes and his communications with Applicant, we find that excluding the statement does not affect the disposition of this proceeding.

We come to a different result with respect to the sworn statement executed prior to Opposer's trial period. With respect to the requirements for a timely testimony statement, Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a), provides, in relevant part:

The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

Opposer's thirty-day trial period closed October 3, 2022. The declaration by Opposer Chris W. Taylor, Jr. submitted under notice of reliance was executed August 26, 2021, and so the testimony was not taken during Opposer's trial period.²⁷ However, the submission of a stale declaration is an error that can be corrected on reasonable objection by timely re-execution of the declaration. *See Int'l Dairy Foods Ass'n v. Interprofession du Gruyère*, 2020 TTAB LEXIS 268, *3 n.12 (TTAB 2020), *aff'd*, *Interprofession du Gruyère v. U.S. Dairy Exp. Council*, 575 F. Supp. 3d 627 (E.D. Va. 2021), *aff'd*, *Interprofession du Gruyère v. U.S. Dairy Exp. Council*, 61 F.4th 407 (4th Cir. 2023). Because Applicant waited until filing its brief to object to the stale declaration instead of raising the defect when the declaration was filed (which would have afforded Opposer the opportunity to cure), Applicant waived or forfeited its objection. *Moke Am. LLC v. Moke USA, LLC*, 2020 TTAB LEXIS 18, *19 (TTAB 2020) ("we find that Applicant waived its objection to the admissibility of the Mini Mania sales records because Applicant failed to assert its objection promptly after Opposer

²⁷ 27 TTABVUE 233-34.

introduced the Todd Rome declaration into evidence”), *reversed on other grounds*, 671 F. Supp.3d 670 (E.D. Va. May 3, 2023); *cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 1991 TTAB LEXIS 38, *2 n.2 (TTAB 1991) (“[A]pplicant waived its objection to the premature taking of the trial deposition, which could have been corrected upon seasonable objection”).

III. Opposer’s Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020), (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020). Demonstrating “a real interest in [preventing the registration of] a trademark under [Trademark Act Sec.] 1064 [and 1063]” satisfies the zone-of-interests requirement, and demonstrating “a reasonable belief of damage by the registration of a trademark” satisfies the proximate causation requirement. *Id.* at 1306.

Here, as set forth above, Applicant’s answer states “Applicant admits that it filed an intellectual property complaint [with] Thingiverse.com against Opposer for distributing unauthorized counterfeits of Applicant’s original Honeycomb Design.”²⁸

²⁸ 17 TTABVUE 9-10.

Because Applicant's answer also states "Elderwood is the original creator of the dice box design described in Application number 88125640 (the "Honeycomb Design"),²⁹ on its face, the admission establishes that Opposer distributes dice boxes highly similar to the "Honeycomb Design" dice box design that Applicant seeks to register, and Applicant has taken action to stop Opposer's distribution. *See Kellogg Co. v. Pack'Em Enters. Inc.*, 1990 TTAB LEXIS 3, 10 n.9 (TTAB 1990) (pleadings "have evidentiary value to the extent that they define the issues and contain admissions"), *aff'd*, 951 F.2d 330 (Fed. Cir. 1991). Opposer's August 26, 2021 declaration corroborates the admissions, averring that Opposer has "designed hexagonal boxes in the past and [] printed hexagonal boxes using 3D printers," and that Opposer received the take-down notice from Applicant.³⁰

In short, we find that the admissions and declaration establish Opposer's interest in preventing registration of Applicant's dice box configuration on the grounds asserted and Opposer's reasonable belief that he would be damaged by registration of Applicant's dice box configuration. *See Int'l Dairy Foods Ass'n*, 2020 TTAB LEXIS 268, *34 (entitlement based in part on defendant sending plaintiff a cease-and-desist letter).³¹

²⁹ 17 TTABVUE 2.

³⁰ 27 TTABVUE 233-34.

³¹ Opposer may not rely on Applicant's July 1, 2020 complaint and exhibits in a district court action against a third party "to support claims that Opposer has an expectation of a lawsuit." *Three Frog, LLC v. Metallic Dice Games, LLC, et al*, Case 4:20-cv-11789-SDD-DRG (USDC-ED-MI), 27 TTABVUE 3. In that complaint Applicant pleaded its rights to its registered HEX CHEST word mark, and not the specific dice box configuration at issue here. 27 TTABVUE 207-27. The reference to the purported infringing use of HEX CHEST on "copycat wooden boxes" and attached exhibits with photographs of the third party's alleged

We are not persuaded by Applicant's arguments that Opposer lacks entitlement to its statutory claim because Opposer is not in the business of selling dice boxes, did not create the 3D print file for a hexagonal dice box that was the original basis for Applicant's copyright infringement complaint to Thingiverse, and is a mere intermeddler.³² While the first two arguments are accurate in some respects, they lack the context of Opposer's digital business model, and so do not support Applicant's conclusion that Opposer is a mere intermeddler.

As shown below, while Opposer does not sell dice boxes directly or exclusively, he has a commercial interest in the dice box configuration being available to use because he has designed dice boxes in the past for his website and the videos from which he derives income. As also shown below, while Opposer did not create the 3D print file for a hexagonal dice box that was the basis for Applicant's take down notice submitted to Thingiverse, Opposer did not merely upload a 3D print file but modified it, and uploaded his own version to Thingiverse, resulting in Applicant's notice.

In the discovery deposition submitted by Applicant, Opposer testified:

Q. What kind of design is involved in your business?

A. 3D models. It's directly related to the 3D printing.

Q. And what kind of 3D models do you make?

A. Literally anything from retention rings for model rocket engines, nose cones, small boxes, aesthetic artistic models. Pretty much anything.

Q. And do you sell those?

A. I sell them, but not in the sense that you think. So yes.

Q. In what sense do you sell them?

similar configuration is insufficient to demonstrate that Applicant also was enforcing its rights to the configuration. The parties settled the case and there were no findings by the court. On September 15, 2020, plaintiff/Applicant filed a dismissal with prejudice. 24 TTABVUE.

³² 43 TTABVUE 15-21.

A. My business is an indirect sales model. So I don't take this and sell it to you. I take this, I make it available, and I profit from that action.

Q. How do you profit from making a 3D printed model available?

A. PayPal, Patreon. It's my primary source of income.³³

...

A. ...I make content, and they reward me with money. Or they use my --

Q. Sorry. Say that again, please.

A. Or they'll use my affiliate links on my content, and that will also pay me. So all of my income is very indirect.

Q. And so, like, in a case with a 3D model, where would you include affiliate links?

A. Everywhere. In the model site. On my primary website. On the video.

Q. And what would those links be to?

A. Usually Amazon. That's my primary income source.

Q. Affiliate links to Amazon?

A. Correct.³⁴

...

A. I do edited videos of particular content. For example, relevance to case in point, people were interested in boxes. So I designed and printed a box. I showed people how to design and print a box, and I showed people how to model it. I showed people how to successfully print it, how to make the machines, do what they're supposed to do.³⁵

....

Q. How many videos on dice boxes have you done?

A. I think two. You have links for them. We sent them during the questionings.

Q. Sure. And I want to know what you remember. So if you remember, you can say so. If you don't remember, you can say so. That's -- I don't want you to guess, but if you --

A. I've made approximately -- I've made approximately 2,000 videos. So exact remembrance is not going to happen. It's approximate. I believe it was approximately two. Possibly three. They're all available online.

Q. What was the date of your first dice box video?

A. Two years ago. · November of 2019. · November of 2018. The date will be on the video.

³³ 29 TTABVUE 7.

³⁴ 29 TTABVUE 8.

³⁵ 29 TTABVUE 8.

Q. Okay. And you included affiliate links in those videos?

A. Yes. All the --

Q. Is that right?

A. -- videos include a standard set of links that go up with every single video.

Q. And are those links to Amazon?

A. Amazon, eBay, Gearbest, AliExpress. You can look at one of my videos. You'll see there's two dozen links in there.³⁶

...

Q. So you wouldn't recall selling 10,000 dice boxes?

A. I think there's a confusion on your part about how I sell dice boxes. I make them available online. Sometimes custom orders. People then download them and manufacture them themselves on their own machines. So you could go to Thingiverse right now, download my dice box, print it, send me a tip, and I would never know you actually printed one. I would never know if you printed ten or a hundred. That's just not how my indirect medium works. I don't have a order receipt for a dice box, and then I ship a dice box. That's not how my medium works. It's all digital.

Q. Have you ever manufactured a dice box yourself and then sold it?

A. Indirectly, yes. I would print some out, bring them to shows and give them to my loyal viewers who pay me.³⁷

...

Q. The hex box that you printed in 2018, what kind of file did you print that from?

A. STL. That's a stereolithographic file.

Q. Is that a standard file for 3D printing?

A. Yes, it is. It's a -- well, standard file for 3D modeling.³⁸

...

Q. So the STL file, did you create that?

A. The initial one, no. I copied it.

Q. From where?

A. The -- what was the guy's name? He posted it to Thingiverse. Agrif --

Q. Aaron Griffith?

³⁶ 29 TTABVUE 9.

³⁷ 29 TTABVUE 9. Opposer's discovery responses corroborate the testimony that while Opposer has no direct sales, he makes dice boxes similar to Applicant's dice box and has given them away. 30 TTABVUE 7-9.

³⁸ 29 TTABVUE 11.

A. Yes. He posted files to Thingiverse. I download the file, like any other Thingiverse file, and said, “I like this. I want to make my own version.” So I did.³⁹

The excerpts from his deposition make clear that Opposer has a commercial interest in dice box configurations and that Opposer modified and posted the dice box design which Applicant alleged was a violation of his rights in the configuration, and which Applicant now seeks to register.⁴⁰

Finally, the record includes excerpts from a Reddit subreddit (or user-created online message board) devoted to 3D printing that includes Opposer’s negative comments about Applicant’s complaints to third parties about the use of dice box configurations alleged to infringe Applicant’s rights, and Opposer’s expressed willingness to contest Applicant’s assertion of rights in the configuration.⁴¹ We disagree that these comments undermine or negate the evidence of Opposer’s commercial interest in dice box configurations; any assertions by Opposer that the opposition serves the interests of others does not affect our finding that the opposition serves Opposer’s commercial interest.

The record supports Opposer’s entitlement to bring his statutory claims.

IV. Claim that the Configuration is Functional

With respect to this claim, Opposer pleaded:

³⁹ 29 TTABVUE 11. Opposer’s discovery responses corroborate that Opposer did not merely upload a third party’s dice box design. 30 TTABVUE 14.

⁴⁰ Contrary to Applicant’ argument (43 TTABVUE 17) that it lodged only a copyright complaint against Opposer, as stated above Applicant’s DCMA alleged infringement of both Applicant’s copyright and the “trade dress” that is the subject of the opposed application.

⁴¹ 30 TTABVUE 11 (Opposer authenticating his Reddit posts); 37 TTABVUE 1-14 (Reddit posts).

31. The product design depicted in the '640 Application contains several key features which are merely functional or aesthetically functional, including a) the use of exactly seven (7) slots to hold the seven (7) dice used for D&D play, b) hexagonal-shaped slots to accommodate the D20 and other polygonal dice used in D&D play, and c) an overall configuration of seven (7) hexagonal-shaped slots that form a hexagonal tessellation.⁴²

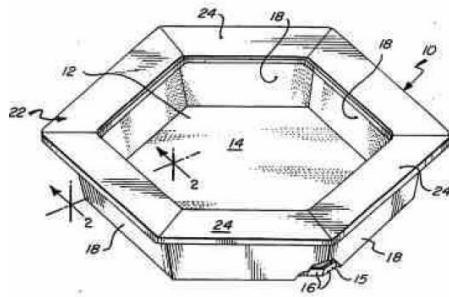
Section 2(e)(5) of the Trademark Act prohibits registration of “a mark which . . . comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). Under the statute, functional matter is unregistrable on the Principal and Supplemental Registers. 15 U.S.C. § 1052(e)(5); 15 U.S.C. § 1091(c). Where, as here, Opposer pleads both utilitarian functionality and aesthetic functionality, we consider functionality under two tests.

Under the first test, matter is functional in the utilitarian sense if “it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 24 (2001) (citation omitted). In making our determination of functionality under this test, relying on *In re Morton Norwich Prods., Inc.*, 671 F.2d 1332 (CCPA 1982), we consider (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design’s utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing. *Id.* at 1340-41. It is not required that all four factors be proven in every case, and the factors are not exclusive because functionality “depends upon the

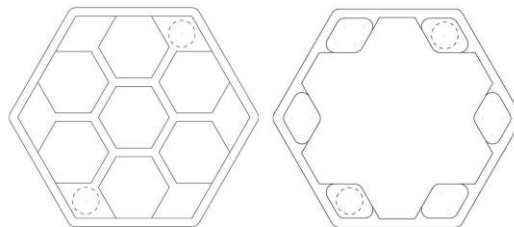
⁴² 16 TTABVUE 11.

totality of the evidence.” *Valu Eng’g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273 (Fed. Cir. 2002).

Here, there is no utility patent of record that discloses the utilitarian features of Applicant’s dice box configuration. Opposer submitted utility Patent No. 4648602 for a “dice game apparatus” comprising in part a hexagonal dice box:⁴³



While Applicant’s dice box configuration has an overall hexagonal shape, it does not resemble the patented dice game apparatus, either as to its honeycomb side or its six point star side:



“Simply dissecting appellant’s alleged trademark into its design features and attributing to each a proven or commonly known utility is not, without more,

⁴³ 27 TTABVUE 198-205. The patent describes the utility of the hexagon shape as “The number of sidewalls and rim portions are selected in accordance with the maximum number of players which can use the apparatus to participate in a game and are formed from a material which can be written upon and erased, such as slate.” 27 TTABVUE 198. This utility is not shared by Applicant’s hexagon configuration, which does not include a rim for writing and is not a game apparatus but a box for dice.

conclusive that the design, considered as a whole, is de jure functional and not registrable.” *In re Teledyne Indus., Inc.*, 696 F.2d 968, 971 (Fed. Cir. 1982).

With respect to the second and fourth factors, there is no record evidence of Applicant touting the utilitarian advantages of its dice box design⁴⁴ or the dice box configuration resulting in a comparatively simple or cheap method of manufacturing.⁴⁵

With respect to the third factor, whether there is evidence that alternative designs are available to competitors, in his response to Applicant’s requests for admission Nos. 28 and 29, Opposer admits:⁴⁶

In a Dice Container containing inner compartments for holding dice, the inner compartments could be shaped like a circle, square, or triangle, or a different polygonal shape other than a hexagon.

The outer profile of a Dice Container could be shaped like a circle, square, or triangle, or a different polygonal shape other than a hexagon.

In addition, the record includes dozens of alternate configurations for a dice box, with a representative sampling shown below:

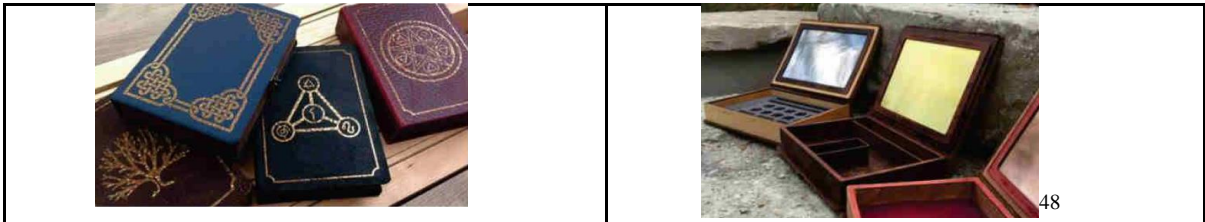
⁴⁴ We have considered the third-party statements submitted by Applicant in support of its claim of acquired distinctiveness that describe Applicant’s dice box configuration as including “hex spaces that keep your dice from rolling around” (27 TTABVUE 63) and “the standard array of seven [dice] you need to play most RPGs fits well inside the carved out honeycomb of holders.” (27 TTABVUE 99). Because the record shows that all dice boxes are variations of open designs that hold many dice, or compartmentalized designs that hold a limited number of dice separately, we do not regard this as touting an advantage of Applicant’s particular configuration.

⁴⁵ The articles and reviews discussing Applicant’s goods emphasize the craftsmanship of choosing, sanding, and polishing the wood to make the box, but do not link any aspect of the dice box design to its manufacturing process. 27 TTABVUE 30, 35, 40, 48, 57-58, 73.

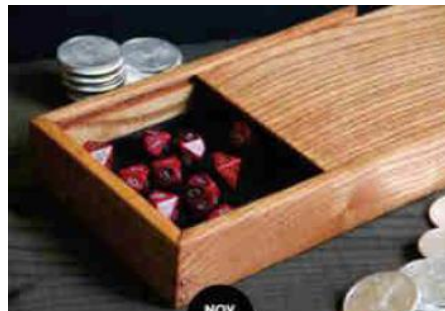
⁴⁶ 30 TTABVUE 14-15.



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⁴⁷ 27 TTABVUE 33.

⁴⁸ 27 TTABVUE 34.

⁴⁹ 27 TTABVUE.

⁵⁰ Application, December 4, 2018 Office Action TSDR 8.



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⁵¹ 33 TTABVUE 5.

⁵² 31 TTABVUE 10.

⁵³ 31 TTABVUE 5.

⁵⁴ 35 TTABVUE 8.



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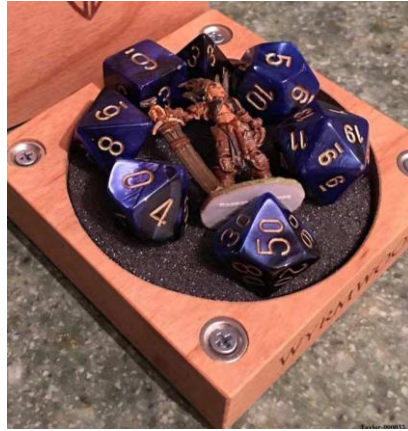


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⁵⁵ 35 TTABVUE 16.

⁵⁶ 35 TTABVUE 23.

⁵⁷ 35 TTABVUE 24.



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As noted above, the *Morton Norwich* factors are not exclusive, and we address the U.S. Copyright Office’s file regarding Applicant’s claim for copyright registration of the work HEX CHEST. The file comprises an acknowledgement of Applicant’s August 23, 2018 application; the October 24, 2018 refusal of registration by the Supervisory Examiner, citing the statutory definition of a “useful article” pursuant to 17 U.S.C. § 101 as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information,” because Applicant’s

⁵⁸ 35 TTABVUE 38.

⁵⁹ 35 TTABVUE 45.

HEX CHEST work is “a useful article that does not contain any copyrightable authorship necessary to sustain a claim to copyright”; the April 9, 2019 denial of Applicant’s first request for reconsideration “[b]ecause the separable features of this design are common and familiar shapes or designs that do not contain the requisite amount of creativity”; Applicant’s July 16, 2019 Second Request For Reconsideration; and the U.S. Copyright Office’s June 26, 2020 notice of a new entry in the file.⁶⁰

Clearly, because the record does not include a U.S. Copyright Office final judgment addressing Applicant’s second request for reconsideration, there is no basis for consideration of whether its prior judgment precludes re-litigation here.⁶¹ *See In re Vox Populi Registry Ltd.*, 25 F.4th 1348 (Fed. Cir. 2022) (“This case does not involve traditional concepts of res judicata or collateral estoppel since the proceeding is ex parte and not adjudicatory.”); *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 601 n.2 (Fed. Cir. 2016) (“there is no suggestion in *B&B Hardware [Inc. v. Hargis Indus.]*, 135

⁶⁰ 27 TTABVUE 167, 169-80, 183-86, 188, 192. The decision of the U.S. Copyright Office on Applicant’s second Request for Reconsideration, presumably the new entry referenced in the June 26, 2020 notice, is not part of the trial record. Opposer’s August 26, 2021 declaration asserts that Applicant was never granted a copyright registration for its dice box configuration. 27 TTABVUE 233.

⁶¹ As background, we note that the U.S. Copyright Office may refuse to register claims that do not meet the statutory requirements for copyright registration (17 U.S.C. § 410(b)); that the applicant may appeal that decision within the U.S. Copyright Office via administrative procedures known as first and second requests for reconsideration (37 CFR 202.5(b)-(c)); that a decision issued by the Review Board in response to a second request for reconsideration constitutes final agency action with respect to the issues addressed (37 CFR 202.5(g)); and an applicant may appeal that decision under the Administrative Procedure Act by instituting a judicial action against the Register of Copyrights in federal district court (5 U.S.C. § 500 *et seq.*). See Compendium of U.S. Copyright Office Practices, Third Edition (2021), Ch. 1700 Administrative Appeals, available at <https://www.copyright.gov/comp3/>.

S. Ct. 1293, 1300 (2015)] that an examiner’s decision to register a mark or to refuse registration satisfies the traditional requirements of issue preclusion.”⁶²

Although not bound by them, nothing precludes us from considering the ex parte findings of the U.S. Copyright Office examiner that Applicant’s configuration is a useful article and does not include copyrightable matter. However, this record does not persuade us that the finding that Applicant’s dice box has “an intrinsic utilitarian function” for copyright purposes is equivalent to a finding that the configuration “is essential to the use or purpose of the article or if it affects the cost or quality of the article,” the test laid out by the Supreme Court for trademark functionality. *See TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. at 24. *See also Carano v. Vina Concha Y Toro S.A.*, 2003 TTAB LEXIS 263, *8 (TTAB 2003) (“the statutory schemes set out in the Copyright Act and the Trademark Act are entirely separate and independent, and protect different rights even when those rights arise from the same words and/or designs.”).

⁶² Similarly, because the record shows only ex parte action by the U.S. Copyright Office, and not a final decision, there is no question of comity here. “Comity is defined as: The principle in accordance with which the courts of one state or jurisdiction will give effect to the laws and decisions of another, not as a matter of obligation, but out of deference and respect.” *Vancouver Plywood Co. v. U.S.*, 860 F.2d 409, 412 (Fed. Cir. 1988) (citing Black’s Law Dictionary (5th ed. 1979)); *accord Fioravanti v. Fioravanti Corrado S.R.L.*, 1986 TTAB LEXIS 90, *26-27 (TTAB 1986) (“The question is whether, under the doctrine of forum non conveniens, it would be appropriate for us to determine the validity of a registration in Italy under Italian law, where the issue of validity is crucial to determination of the claim before us. The alternative ... is to suspend, permitting the foreign tribunal to make the determination respecting the rights of the parties which then can be afforded ‘comity’ in the United States proceeding.”).

Having considered all evidence of record, we find that Opposer has failed to demonstrate that Applicant's mark is functional under the utilitarian functionality test.

Under the second test, a mark is aesthetically functional and prohibited from registration if, rather than utilitarian advantage in terms of product performance, the design provides other competitive advantages. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170 (1995) (“if a design’s ‘aesthetic value’ lies in its ability to ‘confer a significant benefit that cannot practically be duplicated by the use of alternative designs,’ then the design is ‘functional.’ ... The ‘ultimate test of aesthetic functionality,’ ... is whether the recognition of trademark rights would significantly hinder competition.”) (citation omitted); accord *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. at 33 (“Where the design is functional under the *Inwood [Labs., Inc. v. Ives Labs., Inc.]*, 456 U.S. 844, 850 n.10 (1982)] formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.”); *In re Florists’ Transworld Delivery Inc.*, 2013 TTAB LEXIS 115, *3 (TTAB 2013) (a feature is prohibited from registration “if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage”).

As set forth above, Opposer’s scant evidentiary submission includes Opposer’s August 26, 2021 declaration, the district court complaint against a third party and

take-down notice issued against Opposer, excerpts from the application file, a dice game apparatus patent, and Applicant's correspondence with the U.S. Copyright Office. Opposer submitted no evidence regarding how products are developed and marketed in the dice box field, what features are sought by purchasers of a dice box, or why Applicant's configuration presents a superior dice box design. *Cf. Florists' Transworld Delivery*, 2013 TTAB LEXIS 115, *23 ("When we consider the evidence in the record, we find that the examining attorney has demonstrated *prima facie* that there is a competitive need for others in the industry to use the color black in connection with floral arrangements and flowers. Competitors who, for example, want to offer flowers for bereavement purposes, Halloween or to imbue an element of elegance or luxury to their presentations through packaging therefor will be disadvantaged if they must avoid using the color black in such packaging.").

The record shows that there are several alternate dice box designs available, and, as set below again for convenience, Opposer has admitted that non-hexagonal shapes may form the exterior shape and interior compartments of a dice box:

In a Dice Container containing inner compartments for holding dice, the inner compartments could be shaped like a circle, square, or triangle, or a different polygonal shape other than a hexagon.⁶³

The outer profile of a Dice Container could be shaped like a circle, square, or triangle, or a different polygonal shape other than a hexagon.

⁶³ 30 TTABVUE 14-15. The admission that the hexagon shape offers no advantage in holding individual dice is corroborated by the testimony declarations of third-parties Mike Cameron, Justus Hughes, Ken Gruhl, and Matt Colville. 31 TTABVUE 7-8, 33 TTABVUE 5-6, 34 TTABVUE 6, and 35 TTABVUE 4.

See Grote Indus. v. Truck-Lite Co., LLC, 2018 TTAB LEXIS 105, *41 (TTAB 2018) (“Grote has not established a competitive need for use of the Penta-Star Pattern. The record shows that the parties and others offer equivalent lights with many diverse designs, including at least one that features six diodes arranged differently from the Penta-Star Pattern.”), *judgment rev’d and vacated by consent decree*, No. 1:18-cv-00599 (W.D.N.Y. June 8, 2022). On this record, we cannot find a competitive need for others in the industry to use the configuration in the proposed mark.

Having considered all evidence of record, we find that Opposer has failed to demonstrate that Applicant’s mark is aesthetically functional under the second test.

Accordingly, we dismiss Opposer’s functionality claim under Trademark Act Section 2(e)(5).

V. Claim that the Configuration is a Non-distinctive Product Design without Acquired Distinctiveness

Product designs are not inherently distinctive, and can be registered as a mark only on a showing of acquired distinctiveness. *AS Holdings, Inc. v. H & C Milcor, Inc.*, 2013 TTAB LEXIS 388, *28 (TTAB 2013) (*citing Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (“[C]onsumers are aware of the reality that, almost invariably, even the most unusual of product designs -- such as a cocktail shaker shaped like a penguin -- is intended not to identify the source, but to render the product itself more useful or more appealing.”)). This is consistent with Applicant’s amendment to seek registration of its dice box configuration under Section 2(f), which constitutes a concession that the configuration is not inherently distinctive. *See In re Snowizard, Inc.*, 2018 TTAB LEXIS 435, *4 (TTAB 2018) (“By

seeking registration under Section 2(f) of the Trademark Act, Applicant has effectively conceded that its asserted mark [consisting of a three-dimensional configuration of a concession trailer or snowball vendors] is not inherently distinctive.”).

“There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, but the burden is heavier for product configurations than for word marks.” *Honeywell Safety Prods. USA, Inc. v. ERB Indus., Inc.*, 2023 TTAB LEXIS 100, *120 (TTAB 2023). A mere statement of five years’ use (or longer) is generally not sufficient. *In re Ennco Display Sys. Inc.*, 2000 TTAB 235, *23 (TTAB 2000). However, this heavier burden on the Applicant is lessened in this case by the evidence of alternative dice box designs and the lack of evidence of use of a similar design in the dice box industry.

When determining whether a product’s design has acquired distinctiveness, the Board considers the following factors described by the U.S. Court of Appeals of the Federal Circuit:

- (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by consumer surveys);
- (2) length, degree, and exclusivity of use;
- (3) amount and manner of advertising;
- (4) amount of sales and number of customers;
- (5) intentional copying; and
- (6) unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. Int’l Trade Comm’n, 909 F.3d 1110, 1120 (Fed. Cir. 2018); *accord Snowizard*, 2018 TTAB LEXIS 425, *16 (“[T]he Court of Appeals for the Federal Circuit, our primary reviewing court, recently collected into a set of factors the kinds

of evidence and inquiries to be considered in assessing whether a mark has acquired distinctiveness”).

Here, in support of its claim of acquired distinctiveness Applicant submitted five declarations of third parties Mike Cameron, Doug Johnson, Justus Hughes, Ken Gruhl, and Matt Colville to demonstrate that Applicant’s dice box configuration is associated with Applicant under the first *Converse* factor.⁶⁴ We find these declarations somewhat persuasive. While not identified as purchasers of Applicant’s dice boxes, each declarant is part of the tabletop gaming business (competitor of Applicant in selling tabletop games and accessories for RPGs including Dungeons & Dragons, online retailer of tabletop RPG games including Dungeons & Dragons who sells dice boxes, retailer of luxury dice marketed through tabletop gaming conventions, and two tabletop game designers and players) and so in a position to encounter different kinds of dice boxes. While each declaration follows the same formula in averring recognition of Applicant’s dice box configuration, including the same specific features (such as the hexagon shape and beehive arrangement of internal hexagonal slots) that distinguish it from other dice boxes, each declaration also varies in length and detail, but each declarant plainly states that he is unaware of other products that use the same or similar design elements to Applicant’s dice box.⁶⁵

⁶⁴ 32, 33, 34, and 35 TTABVUE.

⁶⁵ Id.

While there is no evidence of intentional copying in the dice box industry, with respect to the remaining *Converse* factors, Applicant submitted the declaration of Quentin Weir, co-founder and managing partner of Applicant. Mr. Weir averred that Applicant has been selling its dice box configuration since 2014; that sales have grown exponentially since 2015; that its use has been exclusive except for a few hobbyists such as Opposer that may sell or give away a miniscule amount of dice boxes; that Applicant has expended more than \$1,000,000 promoting its product line from 2015 to 2022, with its dice box configuration its main product; that Applicant has advertised through tabletop gaming conventions, social media, Google Ads, and through various influencers on YouTube, Instagram, or in podcasting; that since 2015 the promotion of the dice box configuration at conventions has reached 2 million visitors; that Applicant's dice box configuration may be purchased from Amazon and Etsy and through ten distributors as well as through Applicant's website, and at conventions; that Applicant is one of the three biggest sellers of dice boxes in the industry and each of the three companies makes unique dice box designs that are recognizable as originating from their respective manufacturer; that Applicant sends cease-and-desist letters to entities found to be selling copies of its dice box configuration and no party has continued to manufacture the copied die boxes after receiving the letter; and that the people who use dice boxes are generally very involved gamers that are likely to recognize that different-shaped dice boxes originate from different companies.⁶⁶

⁶⁶ 36 TTABVUE 2-15. The testimony of Mike Cameron (31 TTABVUE 7) and Justin Hughes (33 TTABVUE 4) corroborates that Applicant is one of the three biggest sellers of dice boxes

Mr. Weir's declaration also asserts that Applicant's dice box configuration has been the subject of unsolicited media coverage in many articles appearing in game industry publications and websites, namely Geek and Sundry, Table Top Gaming News, Dice Tower News, Multiverse, Gameosity, Board Games Enhanced, Geek Dad, Bleeding Cool, Living Dice, Beasts of War, and Drop the Die.⁶⁷ The excerpted reviews are representative:

DICE Tower News

First up is a board game accessory, and that is the Hex Chest Remasters from Elder Wood. These are essentially hand crafted dice carrying cases that allow you to carry 7 dice in a beautifully made wooden chest. As per their previous projects, the craftsmanship of these are excellent, and they come in a variety of wood colors and an even larger variety of lid carvings to choose from.⁶⁸

Gameosity.com

These are the perfect stocking stuffer for any roleplayer. I just bought myself one of the mini chests and Andrew picked up a full sized one. They have magnetic enclosures, a variety of cover designs and you can opt for an open design (Just an empty box) or hex spaces that keep your dice from rolling around inside. They're really nice quality and fit almost any dice set. You can them at elderwoodacademy.com⁶⁹

We find Mr. Weir's testimony to be detailed, cohesive, and persuasive. It is unrebutted.

While one *Converse* factor is neutral, all others weigh in favor of finding that Applicant's dice box configuration has acquired distinctiveness. Based on the evidence of long and substantially exclusive use, industry recognition, sales and

in the industry and each of the three have signature designs that are recognizable as coming from each company.

⁶⁷ 36 TTABVUE 9-10 (declaration) and 122-95 (articles and reviews).

⁶⁸ 36 TTABVUE 135.

⁶⁹ 36 TTABVUE 138.

advertising expenditures, and unsolicited media attention, we find that Applicant's dice box configuration has acquired distinctiveness, and Opposer's claim that Applicant's dice box configuration is non-distinctive trade dress must fail.

VI. Decision

The opposition is dismissed.