

**This Opinion is Not a
Precedent of the TTAB**

Hearing Date: September 12, 2023

Mailed: November 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Trevari Media, LLC

v.

Laurent Colasse
—

Cancellation No. 92078038
—

Jason B. Witten of Witten Law, Ltd.
for Trevari Media, LLC.

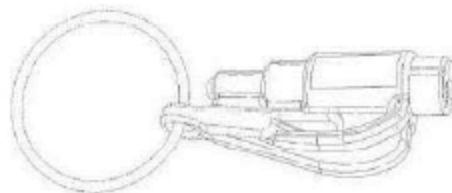
Guy Cumberbatch of Patent4you, Inc.
Michael D. Harris of SoCal IP Law Group LLP
for Laurent Colasse.

—

Before Coggins, Hudis and Allard,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Laurent Colasse (“Respondent”) is the owner of record of the following product design mark:



registered on the Principal Register for a “[s]pring-loaded glass-breaking device” in International Class 8.¹ The mark was registered based upon a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

Color is not claimed in the Registration as a feature of the mark. The Registration describes the mark as follows:

The mark consists of the overall three-dimensional configuration of a spring-loaded **glass-breaking device**. The device has a cylindrical housing having a stepped shape which is widest at the right that encloses a spring loaded spike; the spike not being part of the mark. A generally cylindrical safety sheath projects from the right side of the housing; the safety sheath not being part of the mark. A ball partly projects from the left side of the housing; the ball not being part of the mark. A lateral finger beginning on the right end of the housing extends away from and then to the left parallel to the housing to define a slot in which is mounted a **seat-belt cutting blade**. A keyring clip attaches between the housing and the finger and occludes the slot and cutting blade; the keyring clip not being part of the mark. A keyring attaches to the keyring clip; the keyring not being part of the mark. The broken lines only indicate placement of these ancillary features and are not part of the mark. (Emphasis added).

For our purposes, we refer to Respondent’s mark as the design of a “GLASS-BREAKING/SEAT-BELT CUTTING Device.”

In its Petition for Cancellation,² Trevari Media, LLC d/b/a Adventures With Purpose (or “AWP”) (“Petitioner”), seeks to cancel the ’245 Registration for

¹ Registration No. 4461245 (the “’245 Registration”) was issued on January 7, 2014. A Declaration of Use for this Registration under Trademark Act Section 8, 15 U.S.C. § 1058, has been accepted, and a Declaration of Incontestability for this Registration under Trademark Act Section 15, 15 U.S.C. § 1065, has been acknowledged.

² 1 TTABVUE. References to the pleadings, the evidence of record and the parties’ briefs are to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number and coming after this designation are the page and paragraph references, if applicable.

Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device on the ground that Registrant's mark, as a whole, is functional under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5).³ Applicant denied the salient allegations of the Petition for Cancellation in its Answer.⁴

The case is fully briefed, and a hearing was held before a Panel of the Board. Petitioner bears the burden of proving its Trademark Act Section 2(e)(5) claim by a preponderance of the evidence. *See Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1520 (TTAB 2017) ("We conclude, based on the preponderance of the evidence, that Respondent's registered configurations are functional."). Having considered the evidentiary record, the parties' arguments and applicable authorities, as explained below, we find that Petitioner has carried this burden, and grant the Petition.

³ Petitioner also alleged that Respondent obtained the Registration by fraud under Trademark Act Section 14(3), 15 U.S.C. § 1064(3). In its Order of February 11, 2022, the Board dismissed Petitioner's fraud claim with leave to replead. 10 TTABVUE 11. Upon Petitioner's failure to timely replead its fraud claim, the Board in subsequent Orders of July 6, 2022 and August 8, 2022 dismissed this claim with prejudice. 16 TTABVUE 2 and 17 TTABVUE 4. We therefore decide this proceeding solely on Petitioner's functionality claim.

⁴ Answer, 12 TTABVUE 5-9. Respondent's "Affirmative Defenses" that Petitioner "has not met the burden of proof [for] showing that the '245 Mark is functional;" Petitioner "fails to properly analyze the disclosure in the prior patents" asserted against Respondent's mark; and that there are "numerous alternative designs on the market for glass-breaking tools that demonstrate that the design embodied in the '245 Mark is non-functional and not needed for competition" are merely amplifications of Respondent's denials of Petitioner's claims. Although it is permissible to amplify a denial of an allegation in a pleading, such amplifications are not (and should not be pled as) separate "defenses," and we do not treat these defenses as such here. *NPG Records, LLC v. JHO Intel. Prop. Holdings LLC*, 2022 USPQ2d 770, *23-24 (TTAB 2022).

I. Accelerated Case Resolution and the Evidentiary Record

As suggested by the Board during a Discovery Conference held on August 4, 2022,⁵ the parties on August 27, 2022, agreed to proceed to trial by way of Accelerated Case Resolution (“ACR”).⁶ In its ACR Order of August 31, 2022, the Board construed the parties’ agreement made during a prior telephone conference (held on August 11, 2022), along with their ACR Stipulation, as providing that:

- (i) the parties waive pretrial disclosures;
- (ii) the parties agree to forego trial;
- (iii) The parties shall submit ACR briefs accompanied by any evidence,⁷ which may be submitted in the form of declarations or affidavits, and which will be treated as the final record and briefs;
- (iv) the Board will decide any disputed facts as part of the final decision; and
- (v) the Board’s decision in this ACR proceeding is final, and judicially reviewable as set forth in Trademark Rule 2.145, 37 C.F.R. § 2.145.

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent’s involved ’245 Registration. In addition, the parties introduced the following evidence attached to and/or accompanying their ACR briefs:

⁵ Discovery Conference Order of August 8, 2022, 17 TTABVUE 9.

⁶ Stipulation to ACR Schedule of August 27, 2022, 18 TTABVUE. Further discussion of the Board’s ACR procedures may be found at TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 702.04 et seq. (2023).

⁷ An alternative and preferred method is that the parties file their evidence in advance of their ACR briefs, so that the parties in their briefs can (and should) cite to the TTABVUE record by docket and page numbers.

A. Petitioner's Evidence⁸

- Declaration of Petitioner's Counsel, Jason Witten, as transmittal for Petitioner's evidence.
- Page captures from the website of Respondent's company, Resqme, Inc.
- US Patent No. 6,418,628 B1 (the "US '628 Patent") to Robert W. Steingass ("Steingass"), for "Spring-Loaded Car Window Breaker and Retractable Safety Sheath," issued on July 16, 2002.
- EP 1 372 787 B1 (the "EU '787 Patent") to Steingass and David J. Kolacz ("Kolacz") for "Spring-Loaded Car Window Breaker and Retractable Safety Sheath," issued on February 2, 2005.
- Testimony Declaration of David Kolacz ("Kolacz Decl.").
- Portions of the transcript from the deposition of Steingass ("Steingass Tr.").⁹
- Portions of the transcript from the deposition of Kolacz ("Kolacz Tr.").¹⁰

⁸ Petitioner's main evidence appears at 26 TTABVUE 43-219.

⁹ Steingass' deposition was taken by Petitioner on December 8, 2022, via subpoena and deposition notice to Respondent during the parties' discovery period. Petitioner filed only select pages (but no exhibits) from the Steingass transcript with its ACR Brief. Normally, because Steingass is not a party, Petitioner would not have been permitted to file any portions of the Steingass transcript as evidence except in limited circumstances including by stipulation of the parties. Trademark Rule 2.120(k)(2), 37 C.F.R. 2.120(k)(2). Even if Petitioner could have done so, normally Respondent would only have been permitted to file additional pages from this transcript "which should in fairness be considered so as to make not misleading what was offered by" Petitioner. Trademark Rule 2.120(k)(4), 37 C.F.R. 2.120(k)(4). As we note below, Respondent filed with its ACR Brief the entire Steingass transcript with most (but not all) of the exhibits marked at his deposition. All of this was done without objection by either party. Notably moreover, pursuant to the parties' ACR Stipulation, 18 TTABVUE, and the Board's ACR Order, 19 TTABVUE, the parties were allowed to "submit ACR briefs accompanied by **any evidence**, ... which will be treated as the final record and briefs." 19 TTABVUE 2. (Emphasis Added). The parties' ACR Stipulation and the Board's ACR Order thus provided for exceptions to the Board's rules for the introduction of evidence. *See, e.g., Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2 (TTAB 2020) (parties stipulated to file testimony and documentary evidence submitted together with their main briefs in lieu of trial); *Lebanon Seaboard Corp. v. R & R Turf Supply, Inc.*, 101 USPQ2d 1826, 1828 (TTAB 2012) (parties stipulated to a schedule that did not include testimony periods, but resulted in the concurrent submission of briefs and supporting evidence). We cite in this opinion to the pages of the Steingass deposition transcript filed by Respondent.

¹⁰ Kolacz's deposition was taken by Respondent on January 6, 2023 (apparently by agreement, because no deposition subpoena or notice was made of record) after the parties' discovery period closed on December 4, 2022. 18 TTABVUE 3. We note the parties' ACR Stipulation identifies the close of discovery, in error, as December 4, 2023, and provided for

- Assignment, inter alia, of the EU '787 Patent from its prior owner, Task Force Tips, Inc. to nov8 Private Limited, a company of which Respondent was President at the time of the transfer. The Assignment is dated April 15, 2010.
- A copy of the '245 Registration from the USPTO's TESS database, and portions of its registration file history.¹¹
- Portions of Respondent's interrogatory answers.¹²
- Copies of correspondence exchanged between the parties, and between Respondent and third parties, prior to the filing of this proceeding.
- U.S. Patent No. 4,134,206 to Ewald H. Beermann, for "Cutter for Vehicle Safety Belts," issued on January 16, 1979.
- Still shots from YouTube videos showing the use of Petitioner's and Respondent's glass-breaking/seat-belt cutting devices (use of glass-breaking portions only).
- Images of RESQME (Respondent's) glass-breaking/seat-belt cutting device, in packaging.

B. Respondent's Evidence¹³

- Declaration of Respondent's Counsel, Michael Harris, as transmittal for Respondent's evidence.

no "testimony periods." In any event, from our reading of the transcript, Respondent's deposition of Kolacz was in the nature of cross-examination to Kolacz's testimony declaration submitted by Petitioner, pursuant to Trademark Rule 2.123(a)(1), 37 C.F.R. § 2.123(a)(1). Petitioner filed only select pages (but no exhibits) from the Kolacz transcript with its ACR Brief. This was improper. Trademark Rule 2.123(f)(2), 37 C.F.R. § 2.123(f)(2), requires that the entirety of such transcripts, and accompanying exhibits, be filed with the Board. As noted below, however, Respondent filed the entirety of the Kolacz deposition transcript and most (but not all) of the exhibits thereto. We therefore cite in this opinion to the pages of the Kolacz deposition transcript filed by Respondent.

¹¹ Making a TESS copy of the '245 Registration, and copies of portions from its registration file history, was unnecessary, because (as noted in the main text above) the Registration and its file history are automatically of record.

¹² Petitioner did not include the signature page from Respondent's interrogatory answers. Because we do not know whether these interrogatory answers were verified, we do not consider them. *See Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1152 n.28 (TTAB 2016) ("[U]nverified answers to interrogatories are not competent evidence").

¹³ Respondent's evidence appears at 28 TTABVUE 31-304 and 29 TTABVUE 2-110.

- Transcripts, and most (but not all) of the exhibits, from the testimony depositions of Kolacz (deposition taken by Respondent) and Steingass (deposition taken by Petitioner).¹⁴
- A plain copy of the '245 Registration, and a copy of the Notice of Acceptance/Acknowledgement of Respondent's maintenance filing pursuant to Trademark Act Sections 8 and 15.¹⁵
- Testimony Declaration of Respondent, Laurent Colasse ("Colasse Decl."), with exhibits.
- Testimony Declaration of Benjamin Duprat, an employee of Respondent's company Resqme, Inc., with exhibits.

C. Petitioner's Rebuttal Evidence¹⁶

- Rebuttal Declaration of Petitioner's Counsel, Jason Witten, as transmittal for Petitioner's rebuttal evidence.
- Additional portions of the transcript from the Testimony Deposition of Kolacz.¹⁷
- Testimony Declaration of Jared Leisek ("Leisek Decl."), majority member of Petitioner.
- Copies of correspondence exchanged between Respondent and third parties, and correspondence exchanged between these third parties and Petitioner, after the filing of this proceeding.

II. Evidentiary and Briefing Issues

Before proceeding to the merits of the proceeding, we address Respondent's numerous motions and objections directed to Petitioner's briefs and some of Petitioner's evidence.

¹⁴ Respondent should have filed all of the exhibits marked during these testimony depositions.

¹⁵ As we said of Petitioner's evidence, Respondent's making a plain copy of the '245 Registration and copy of the Notice of Acceptance/Acknowledgement of Respondent's maintenance filing was unnecessary because the Registration and its file history are automatically of record.

¹⁶ Petitioner's rebuttal evidence appears at 30 TTABVUE 29-61.

¹⁷ As already noted, Petitioner's filing of only portions of the Kolacz Testimony Deposition transcript was improper. All citations in this opinion are to the pages of the Kolacz Testimony Deposition transcript filed in its entirety by Respondent.

After the parties filed their ACR briefs, Respondent moved to strike Petitioner's ACR Rebuttal Brief, or portions thereof, because it: (1) was too long, (2) repeats arguments from Petitioner's main ACR Brief on the merits, (3) contains improper rebuttal, and (4) contains statements without support from the record. In this same motion, Respondent moved to strike the materials attached to Petitioner's ACR Rebuttal Brief as improper rebuttal evidence.¹⁸

In Respondent's ACR Brief, it moves to strike the Kolacz Declaration, including any reliance thereon by Petitioner in its ACR Briefs, because: (1) Petitioner did not provide a proper expert's report for Kolacz, and (2) Kolacz is not qualified to be an expert in this proceeding. Respondent also moves to strike portions of Petitioner's ACR Brief discussing: (1) Respondent's allegations of infringement made prior to the filing of this proceeding, and (2) how a user grips Respondent's device in order to use it.¹⁹

A. Respondent's Motions Directed to Petitioner's Briefs

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it believes will be to its advantage. Accordingly, when a brief on the case has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof. Rather, any objections that an adverse party may have to the contents of such a brief should be stated in a responsive brief, if allowed, and will be

¹⁸ Respondent's Motion to Strike, 34 TTABVUE.

¹⁹ Motion(s) to Strike within Respondent's Brief, 28 TTABVUE 13-28.

considered by the Board in its determination of the case, and any portions of the brief that are found by the Board to be improper will be disregarded. *See Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (motion to strike portions of plaintiff's trial brief denied; issues sought to be stricken are possible factors in considering likelihood of confusion and Board is capable of weighing relevance and strength or weakness of arguments presented in briefs).

The gravamen of Respondent's motion to strike the portion of Petitioner's ACR Brief pertaining to Respondent's allegations of infringement made prior to the filing of this proceeding is that Petitioner did not properly authenticate the correspondence on which these allegations were based. This is a procedural objection to Petitioner's evidence, which should have been included in Respondent's motion to strike so that Respondent would have the opportunity to cure. *RLP Ventures, LLC v. Panini Am., Inc.*, 2023 USPQ2d 1135, at *2 (TTAB 2023). This motion is denied.

Respondent's motion to strike the portion of Petitioner's ACR Brief discussing how a user grips Respondent's device in order to use it is based upon our ruling on the admissibility of Kolacz's expert testimony. Because we find below that Kolacz's testimony is admissible, this motion is denied.

In its Order of June 7, 2023,²⁰ the Board ruled that Petitioner's Rebuttal ACR Brief was not overly long. We see no reason to revisit that ruling.

We deny that portion of Respondent's motion to strike those portions of Petitioner's Rebuttal ACR Brief on the basis that it repeats arguments from

²⁰ 35 TTABVUE.

Petitioner's main ACR Brief or contains statements without support from the record, for the reasons discussed in *Rocket Trademarks*, 98 USPQ2d at 1071. "The Board is capable of weighing the relevance and strength or weakness of arguments presented in briefs; this precludes the need to 'strike' arguments." *Id.* To the extent that any of the parties' arguments lack support in the record, we give them no consideration. "Attorney argument is no substitute for evidence." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

We discuss below that portion of Respondent's motion to strike those portions of Petitioner's ACR Rebuttal Brief that rely on improper rebuttal evidence.

B. Respondent's Motion Directed to Improper Rebuttal

The evidence submitted with Petitioner's ACR Rebuttal Brief consists of a Rebuttal Transmittal ACR Declaration from Petitioner's counsel, portions of the transcript from Kolacz's testimony deposition, the Leisek Declaration, and Respondent's infringement/take-down notices to Shopify on which Petitioner sold its glass-breaking/seat-belt cutting device. The Rebuttal Transmittal ACR Declaration from Petitioner's counsel itself contains no evidentiary material. There is no reason to strike it. We already said in the footnotes above that it was improper for Petitioner to have filed only portions of the transcript from Kolacz's testimony deposition. We are relying on the transcript from Kolacz's testimony deposition in its entirety, as filed by Respondent. This part of Respondent's motion is denied.

That part of Respondent's motion to strike the Leisek Declaration, the infringement/take-down notices Respondent sent to Shopify on which Petitioner sold

its glass-breaking/seat-belt cutting device, and those portions of Petitioner's ACR Rebuttal Brief in reliance thereon is well taken. "This rebuttal evidence was not submitted for the proper purpose of denying, explaining or discrediting ... [Respondent's] case but instead was clearly an attempt by ... [Petitioner] to strengthen its case-in-chief. (citation omitted). The burden is on ... [Petitioner], in the first instance, to come forward ... [when filing its own ACR Brief and evidence] with proof of the essential elements of its claim" *Wet Seal, Inc. v. FD Mgt., Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007). Merely because the parties agreed to ACR does not mean the Board dispenses with all rules of fairness in the presentation of evidence. Respondent's motion to strike the Leisek Declaration and the infringement/take-down notices Respondent sent to Shopify is granted, and we give no consideration to any arguments in Petitioner's ACR Rebuttal Brief that rely on this evidence.

C. Respondent's Motion to Strike the Kolacz Declaration

Respondent moves to strike the Kolacz Declaration, including Petitioner's arguments in reliance thereon, on the grounds that: (1) Kolacz did not provide a proper expert's report, and (2) Kolacz is unqualified as an expert.

Pursuant to the parties' ACR Stipulation,²¹ approved by the Board,²² expert witness disclosures were due on November 5, 2022. As this was a Saturday, these

²¹ ACR Stipulation, 18 TTABVUE.

²² Board Order, 19 TTABVUE.

disclosures could have been timely made on Monday, November 7, 2022.²³ On November 7, Petitioner filed and served a “Notice of Disclosure of Non-Retained, Non-Reporting Hybrid Lay/Expert Witness” (“Expert Witness Disclosure”),²⁴ stating in relevant part:

Petitioner ... hereby provides notice to the Court [sic] of a non-retained, non-reporting hybrid lay/expert witness. The witness’s name is David Kolacz. He is the primary designer of the design trademark at issue in this matter. Reg. No. 4,461,245 (the ’245 Mark). For this reason, he is primarily a lay witness, but qualifies as an expert in the design of the ’245 Mark. Therefore, in an abundance of caution, Petitioner is disclosing him as a non-retained, non-reporting hybrid lay/expert witness. ... Petitioner has timely served upon Registrant the disclosure required pursuant to FRCP Rule 26(a)(2)(C).

On the same day that Petitioner’s Expert Witness Disclosure was made, November 7, 2022, Petitioner also produced to Respondent the Kolacz Declaration (which was signed on October 13, 2022).²⁵ Until filing its ACR Brief, Respondent did

²³ Trademark Rule 2.196, 37 C.F.R. § 2.196; *cf. Nat’l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 n.6 (TTAB 2008) (where discovery period closed on Saturday, service of written discovery requests the following Monday was not untimely).

²⁴ Petitioner’s Expert Witness Notice, 20 TTABVUE.

²⁵ Petitioner’s ACR Brief, 30 TTABVUE 21. The early execution of Kolacz’s Declaration normally would have rendered it inadmissible. *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, *3-4 (TTAB 2019) (“Absent a stipulation or Board order, a testimony affidavit or declaration must be taken – that is, executed – during the testimony period, as required by Rule 2.121(a).”). However, pursuant to the parties’ ACR Stipulation, 18 TTABVUE, and the Board’s ACR Order, 19 TTABVUE, there were no “testimony periods.” Rather, the parties were allowed to “submit ACR briefs accompanied by any evidence, which may be submitted in the form of declarations or affidavits, and which will be treated as the final record and briefs.” 19 TTABVUE 2. Thus, the dictates of Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a) do not apply here. In any event, Respondent never objected that Kolacz’s Declaration was (or, what would normally have been) prematurely executed; thus waiving the objection to the extent any such objection was possible under the ACR Stipulation and Order.

not object to Petitioner's Expert Witness Disclosure and Kolacz Declaration, request a further report from Kolacz, or move the Board for a further report.

Without much analysis to explain its reasoning, Respondent asserts that Kolacz is an expert on behalf of Petitioner "retained or specially employed to provide expert testimony in the case," and as such was required to provide a report containing:

(i) a complete statement of all opinions the witness will express and the basis and reasons for them; (ii) the facts or data considered by the witness in forming them; (iii) any exhibits that will be used to summarize or support them; (iv) the witness's qualifications, including a list of all publications authored in the previous 10 years; (v) a list of all other cases in which, during the previous 4 years, the witness testified as an expert at trial or by deposition; and (vi) a statement of the compensation to be paid for the study and testimony in the case.

Fed. R. Civ. P. 26(a)(2)(B).²⁶

Even were we to find Kolacz to be a "retained or specially employed" expert under this Rule (and as discussed below we find he is not), Petitioner's Expert Witness Disclosure and the Kolacz Declaration provided on the same date satisfy Items (i)-(iii) (with the only "exhibit" Kolacz having relied upon being the EU '787 Patent), and the first half of Item (iv) (qualifications) of the Rule. As noted above, Respondent cross-examined Kolacz on January 6, 2023. On cross-examination, Kolacz provided the remaining items required by the Rule: list of publications (none), prior expert witness testimony (none), and compensation (none, except for travel expenses).²⁷ Thus, the expert witness reporting requirements ultimately having been met

²⁶ Respondent's ACR Brief, 28 TTABVUE 17.

²⁷ Kolacz Tr., 28 TTABVUE 47-49.

(presuming Kolacz was the type of expert for which a full report was required under the rule), we see no basis for Respondent to complain that it was prejudiced.

Further, if Respondent believed it was short-changed by Petitioner's simultaneous production of its Expert Witness Disclosure and the Kolacz Declaration, Respondent was not without an immediate remedy of which Respondent failed to avail itself. A procedural objection that is curable, such as the production of a purportedly insufficient expert's report, must be seasonably raised, or it will be deemed waived. *Cf. Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *4-5 (TTAB 2020) (discussing curable vs. noncurable objections to testimony affidavits and exhibits, waiver of objections and timeliness of objections), *reversed on other grounds*, 2023 WL 3232601, Civil No. 3:20-cv-00400 (E.D. Va. May 3, 2023). That is exactly what the respondent did in *RTX Scientific, Inc. v. Nu-Calgon Wholesaler, Inc.*, 106 USPQ2d 1492 (TTAB 2013); that is, within two weeks from receiving an insufficient expert's disclosure on behalf of the petitioner, timely moving to exclude the expert's testimony or alternatively to compel a full written expert report. *Id.* at 1493. While the motion to exclude was denied as premature, *Id.*, the Board did compel production of the further report. *Id.* at 1496. Here, not having timely moved for the production of a full report in compliance with Fed. R. Civ. P. 26(a)(2)(B), we find Respondent waived its right to seek exclusion of Kolacz' testimony on the basis of an inadequate report.

Even if Respondent had not waived this objection, we further find that Petitioner's Expert Witness Disclosure and the Kolacz Declaration comply with the provisions of Fed. R. Civ. P. 26(a)(2)(C) for "Witnesses Who Do Not Provide a Written Report,"

because these documents provide: (i) the subject matter on which Kolacz was expected to present evidence; and (ii) a summary of the facts and opinions to which Kolacz was expected to testify. *Id.*

To determine whether Kolacz was a “retained or specially employed” expert required to provide a full report under Fed. R. Civ. P. 26(a)(2)(B), we need to consider whether he was a percipient witness who happens to be an expert or an expert who without prior knowledge of the facts giving rise to this proceeding was recruited by Petitioner to provide expert opinion testimony. *RTX Scientific*, 106 USPQ2d at 1495 (citing *Downey v. Bob’s Discount Furniture Holdings, Inc.*, 633 F.3d 1, 6-7 (1st Cir. 2011)). “[Where] the expert comes to the case as a stranger and draws the opinion from facts supplied by others, in preparation for trial, he reasonably can be viewed as retained or specially employed for that purpose, within the purview of Rule 26(a)(2)(B).” *Id.* In other words, “[w]here an expert’s opinion testimony arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation, that expert is ‘retained’ for purposes of Rule 26(a)(2)(B) and that rule therefore requires a written report.” *Id.*

Kolacz is a co-inventor listed in the EU '787 Patent²⁸ which, as we discuss below, is the principal basis for Petitioner’s claim that the design of Respondent’s GLASS-BREAKING/SEAT-BELT CUTTING Device is functional. Kolacz’ entire testimony declaration²⁹ comprises an explanation of the two embodiments of the

²⁸ EU '787 Patent, 26 TTABVUE 85-103.

²⁹ Kolacz Decl., 26 TTABVUE 104-08.

invention disclosed and claimed in the EU '787 Patent, the function of each element of each such embodiment, and certain design considerations therefore. Kolacz was a percipient witness to the development of the invention disclosed and claimed in the EU '787 Patent. Kolacz did not come to this proceeding as a stranger to that invention. The opinions Kolacz expressed in his declaration were not drawn from facts supplied by others. Kolacz therefore was not a “retained or specially employed” expert required to provide a full report under Fed. R. Civ. P. 26(a)(2)(B); thus, Petitioner’s disclosures under Fed. R. Civ. P. 26(a)(2)(C) were appropriate and sufficient. We therefore deny Respondent’s motion to exclude Kolacz’ declaration testimony on the ground of failing to timely provide a sufficient expert report.

Respondent further asserts that Kolacz is unqualified to render an expert opinion on the functionality of the design of its GLASS-BREAKING/SEAT-BELT CUTTING Device.³⁰ However, that was not Kolacz’s testimony. Rather, as we noted generally above, Kolacz’s entire testimony declaration comprises an explanation of the two embodiments of the invention disclosed and claimed in the EU '787 Patent, the function of the elements of each such embodiment, and certain design considerations therefore (which we discuss in much greater detail below). Particularly as to the Second Embodiment, Kolacz testifies to: (1) how the internal glass-breaking mechanism works, (2) the function and purpose of the outer casing (particularly its shape), and (3) the reasoning for the placement and configuration of the seatbelt

³⁰ Respondent’s ACR Brief, 28 TTABVUE 21-27.

cutting device that includes an accompanying hook with wings.³¹ What disturbs Respondent about this testimony is Kolacz's use of the term "functional" to describe these features.

While the USPTO no longer makes this distinction,³² we find it useful here to distinguish between what the U.S. Court of Appeals for the Federal Circuit used to refer to as "de facto functional," which means that the design of a product has a function (and "may" qualify for trademark protection), and "de jure functional," which means that the product is in its particular shape because it works better in this shape (and cannot so qualify). *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994) (quoting *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir.1984)). In our view, it is the former to which Kolacz testified; it is the latter that is for us to decide.

From Kolacz's cross-examination testimony it is clear that, when he used the term "functional" in his declaration to describe the various aspects of the invention claimed and disclosed in the EU '787 patent, he meant that each aspect of the invention accomplishes its intended purpose as it was designed; including the shape of the housing and the placement and configuration of the seatbelt cutting device that includes an accompanying hook with wings.³³ What we need to decide is whether Kolacz was qualified to give this testimony.

³¹ Kolacz Decl., 28 TTABVUE 106-108, ¶¶ 9-17.

³² See TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1202.02(a)(iii)(B) (November 2023).

³³ Kolacz Tr., 28 TTABVUE 57-61, 68-70.

The tenor of Respondent's critique of Kolacz's background is that he does not qualify as a "scientific expert" of the type discussed in *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 592-94 (1993), and that Kolacz did not undertake a sufficient, methodologically sound study of the type required by such an expert. However, "there are many different kinds of experts, and many different kinds of expertise." *Kumho Tire Co., Ltd. v. Carmichael*, 526 U.S. 137, 150 (1999). This includes "experts who are not scientists." *Id.* at 141. As the trier of fact, under Fed. R. Evid. 702, we have the discretionary authority to determine reliability of Kolacz's testimony in light of the particular facts and circumstances of this particular proceeding. *Id.* at 158.

As noted, Kolacz is a co-inventor listed on the EU '787 Patent. From 1991 until 2022, he was a design engineer for new products at Task Force Tips, Inc. Prior to that, Kolacz was a design engineer for General Electric. Kolacz has a Bachelor of Science in Mechanical Engineering, and was the primary designer of the invention disclosed and claimed in the EU '787 Patent.³⁴ Step-by-step, Kolacz in his declaration discusses the evolution of the First and Second Embodiments of that invention, and how each aspect of the invention operates for its intended purpose as designed.³⁵ On cross-examination, Kolacz provides further detail regarding the reasons for the shape of the housing, as well as the placement and configuration of the seatbelt cutting device, of the Second Embodiment of that invention.³⁶ We cannot envision anyone

³⁴ Kolacz Decl., 26 TTABVUE 105, ¶¶ 1-4.

³⁵ Kolacz Decl., 26 TTABVUE 105-08, ¶¶ 5-17.

³⁶ Kolacz Tr., 28 TTABVUE 57-61, 68-70.

more qualified to provide this testimony. In light of the particular facts and circumstances of this particular proceeding, we find Kolacz's testimony reliable as to the purposes for which it was offered.

Had Kolacz strayed beyond the areas of his expertise as discussed above, or opined on the ultimate issue in this case (whether the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device is legally functional), Respondent's arguments might have had merit. *See Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *2 (TTAB 2019) (sustaining objection to portion of declaration opinion testimony beyond witness' area of expertise and where witness opined on the ultimate disposition of the claim; objection to declaration testimony overruled where the specific statements objected to not identified). However, Kolacz did not do that. We therefore deny Respondent's motion to exclude Kolacz's declaration testimony on the grounds that he is unqualified as an expert.

III. Prosecution of the Application underlying the '245 Registration

As noted, the '245 Registration for Respondent's design of a GLASS-BREAKING/SEAT-BELT CUTTING Device was issued based upon a claim of acquired distinctiveness under Trademark Act Section 2(f). When Respondent filed his Application underlying the '245 Registration, he included a Declaration (the "Colasse File History Decl.") in support of that acquired distinctiveness claim.

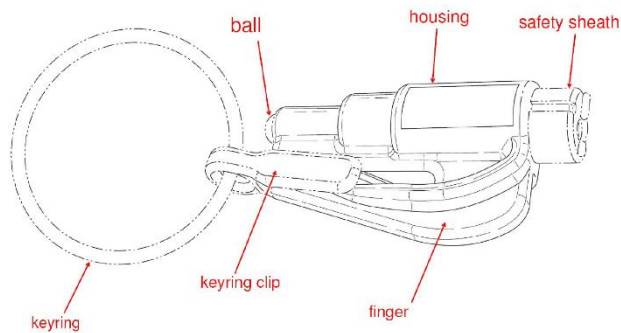
Respondent's Declaration reads in part:

I am president of Innovation Distributing Inc., ... doing business as ResQMe ("The Company") I have licensed the rights to use the mark to The Company. ... The Company has adopted the mark of the product design depicted on the accompanying drawing ("the mark"), and has been using the mark for spring-loaded glass-breaking devices for use in

emergencies. The mark consists of the overall three-dimensional design of the device. The broken lines depicting a key ring indicates placement only and is not part of the mark. ... **The device was the subject of European Patent No. 1372787B1** and, as can be evidenced by comparison to the drawings of that patent, the particular rendition of the present trade dress design is not *de jure* functional. (Emphasis added).³⁷

In both Office Actions issued by the USPTO, the Examining Attorney required Respondent to provide a more precise description of his mark and provide a new drawing delineating those portions of his GLASS-BREAKING/SEAT-BELT CUTTING Device in which Respondent was claiming trademark rights versus those in which he was not.³⁸ Respondent complied with the Examining Attorney's requirements,³⁹ with the final results as shown on pages 1-2 of this decision.

As part of his correspondence with the USPTO, Respondent provided the following labeled drawing of his design mark, which we find useful:



³⁷ Colasse File History Decl., Application of January 11, 2013, at 8. Page references herein to the file history of the '245 Registration refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer.

³⁸ Office Action of April 29, 2013, at 1-2; and Office Action of August 20, 2013, at 1.

³⁹ Office Action Response of June 20, 2013, at 1-3; First Office Action Response of August 22, 2013, at 1-3; Second Office Action Response of August 22, 2013, at 1-4

The description of the mark in the '245 Registration, set forth at the beginning of our decision, disclaims away many features of Respondent's design mark in which he "does not" claim rights. Moreover, the drawing of the mark in the '245 Registration is not entirely clear. We therefore confirmed with Respondent's counsel during oral argument that the portions of the mark in which Respondent "does" claim rights are: (1) the shape of the housing, and (2) the configuration of what Kolacz described in his declaration as the "hook" surrounding the cutting blade, which is labeled in the drawing immediately above as the "finger." In the final analysis, however, it is "the drawing of the mark, not the words an applicant [or its counsel] uses to describe it, [that] controls what the mark is." *In re Change Wind Corp.*, 123 USPQ2d 1453, 1459 n.6 (TTAB 2017).

IV. The Parties

Respondent is the CEO of Resqme, Inc. ("Resqme"). This company is Respondent's exclusive licensee of the product design mark that is the subject of the '245 Registration. Resqme sells a device for breaking a vehicle window in an emergency. This device conforms to the configuration of the '245 Registration. Respondent polices the trademarks of Resqme, Inc. including the design mark that is the subject of the '245 Registration, primarily by filing take down notices with the online vendors.⁴⁰

Petitioner promotes itself under the name Adventures With Purpose (or "AWP") as a volunteer group that seeks to solve missing-person cold cases.⁴¹ To fund its

⁴⁰ Colasse Decl., 29 TTABVUE 47, 51-52, ¶¶ 1-4, 6, Exh. C (Respondent's website).

⁴¹ Colasse Decl., 29 TTABVUE 61-62, Exh. G (Petitioner's website).

operations, Respondent sells various items bearing the Adventures With Purpose mark, including t-shirts, hoodies, hats, patches, stickers, pins, wristbands, fishing magnets, and a 2-in-1 emergency window breaker and seat belt cutter survival keychain.⁴²

V. Entitlement to Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277, at *4 (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)); *see also Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022); *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *1 (TTAB 2020).

⁴² Captured pages from Respondent's website; Colasse Decl., 29 TTABVUE 57-60, 66-67, 70-71, Exhs. E, F, H and K.

Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic*, 2020 USPQ2d 10837, at *3; *Empresa Cubana*, 111 USPQ2d at 1062. There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277, at *4. Thus, “a party that demonstrates a real interest in cancelling a trademark under [Trademark Act Section 14, 15 U.S.C.] § 1064 has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 1064.” *Id.*, 2020 USPQ2d 11277, at *7.

Petitioner made of record a number of e-mails sent during the summer of 2021, prior to the filing of this proceeding, comprising assertions made by Respondent’s company, Resqme, that Petitioner’s window breaker/seat-belt cutter device infringes Respondent’s rights in the design mark of the ’245 Registration – including not only in direct correspondence to Petitioner but also in take-down notices to Facebook on which Petitioner sells its accused device.⁴³ Petitioner therefore has demonstrated that its interest in cancellation of the ’245 Registration falls within the zone of interests protected by the Trademark Act and that Petitioner has a reasonable belief that damage is proximately caused by continued registration of Respondent’s product

⁴³ E-mail correspondence, Witten Decl., 26 TTABVUE 218, ¶ 11, and Exh. 10, 26 TTABVUE 139-57.

design mark. See *McGowen Precision Barrels, LLC v. Proof Rsch, Inc.*, 2021 USPQ2d 559, at *15-17 (TTAB 2021) (entitlement to a statutory cause of action established by the petitioner's position as a competitor to the respondent, and as a defendant in a civil action brought by the respondent alleging trademark infringement); *Domino's Pizza Inc. v. Little Caesar Enters. Inc.*, 7 USPQ2d 1359, 1363-64 (TTAB 1988) (same, in the context of an opposition proceeding).

VI. Functionality: Applicable Law and Analysis

Generally, for matter claimed as trade dress to be capable of protection as a "mark," it must be distinctive and not functional. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1084 (1992).⁴⁴ Petitioner has not pled that the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device as shown in the '245 Registration lacks acquired distinctiveness, and the parties have not argued that question in their briefs. The sole issue to be decided in this proceeding pertaining to Respondent's trademark rights is functionality.

The Trademark Act does not exist to reward manufacturers for their innovations. "It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time ..., after which competitors are free to use the innovation." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995). "[T]rademark ... law can[not] properly make an 'end run' around the strict requirements of utility

⁴⁴ "The trade dress of a product is essentially its total image and overall appearance ... and may include features such as size, shape, [and] texture" *Two Pesos*, 23 USPQ2d at 1082, n.1 (cleaned up).

patent law by giving equivalent rights to exclude.” J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:64 (5th ed., Sept. 2023 update). Thus, a product feature that is functional “is incapable of registration on either the Principal or Supplemental Register.” *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1837 (TTAB 2013). Accordingly, Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), prohibits registration of “a mark which ... comprises any matter that, as a whole, is functional.”

There are two types of functionality recognized by controlling case law. One formulation states that “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982) (setting forth the *Inwood* test). This we refer to as “utilitarian functionality.” The other theory of functionality posits “that, if a design’s ‘aesthetic value’ lies in its ability to ‘confe[r] 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,’ ... [under this theory], ‘is whether the recognition of trademark rights would significantly hinder competition.” *Qualitex*, 34 USPQ2d at 1165 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, Comment c, pp. 175-176 (1993)). This we refer to as “aesthetic functionality.” It is clear from our reading of the pleadings, evidence and briefing in this case that Petitioner’s functionality claim under Trademark Act Section 2(e)(5) is grounded on functionality based on utilitarian

considerations and not aesthetic functionality. Neither Petitioner nor Respondent argue otherwise.

The Court of Customs and Patent Appeals, in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982), suggested four factors to consider when evaluating utilitarian functionality:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the registered subject matter;
- (2) advertising by the registrant that touts the utilitarian advantages of the subject matter;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the subject matter results from a comparatively simple or inexpensive method of manufacture.

See also, In re Change Wind, 123 USPQ2d at 1456 (“*Morton-Norwich* identifies four nonexclusive categories of evidence which may be helpful in determining whether a particular design is functional[.]”).

The U.S. Supreme Court has stated that if functionality is established under the *Inwood* test (essential to the use or purpose of the article or affecting the cost or quality of the article), a full analysis of all types of *Morton-Norwich* evidence is not necessary. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006-07 (2001) (“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. ... There [also] is no need, furthermore, to engage ... in speculation about other design possibilities, ... which might serve the same purpose. ... Other designs need not be attempted.”).

The U.S. Court of Appeals for the Federal Circuit later had occasion to comment on the Supreme Court's observations in *TrafFix*:

We do not understand the Supreme Court's decision in *TrafFix* to have altered the *Morton-Norwich* analysis. ... [T]he *Morton-Norwich* factors aid in the determination of whether a particular feature is functional, ... [one] factor focus[ing] on the availability of "other alternatives." (citation omitted). ... Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather ..., once a product feature is found functional based on other considerations [such as if it "affects the cost or quality of the device,"] there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

Valu Eng'g, Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002).

Functionality is a question of fact and depends on the totality of the evidence in each particular case. *Valu Eng'g*, 61 USPQ2d at 1424. We consider the *Morton-Norwich* factors to the extent raised in the arguments and based on the evidence made of record. All four *Morton-Norwich* factors need not be considered or proven in every case, nor do all four factors have to weigh in favor of functionality to support a cancellation based upon such a claim. *Poly-America*, 124 USPQ2d at 1514. "[T]he decisive consideration is whether the overall design of ... [Respondent's device as reflected in the design mark shown in the '245 Registration] is so superior in ... function or economy of manufacture that recognition of that design as a trademark would hinder competition in the ... trade." *In re Teledyne Indus., Inc.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982).

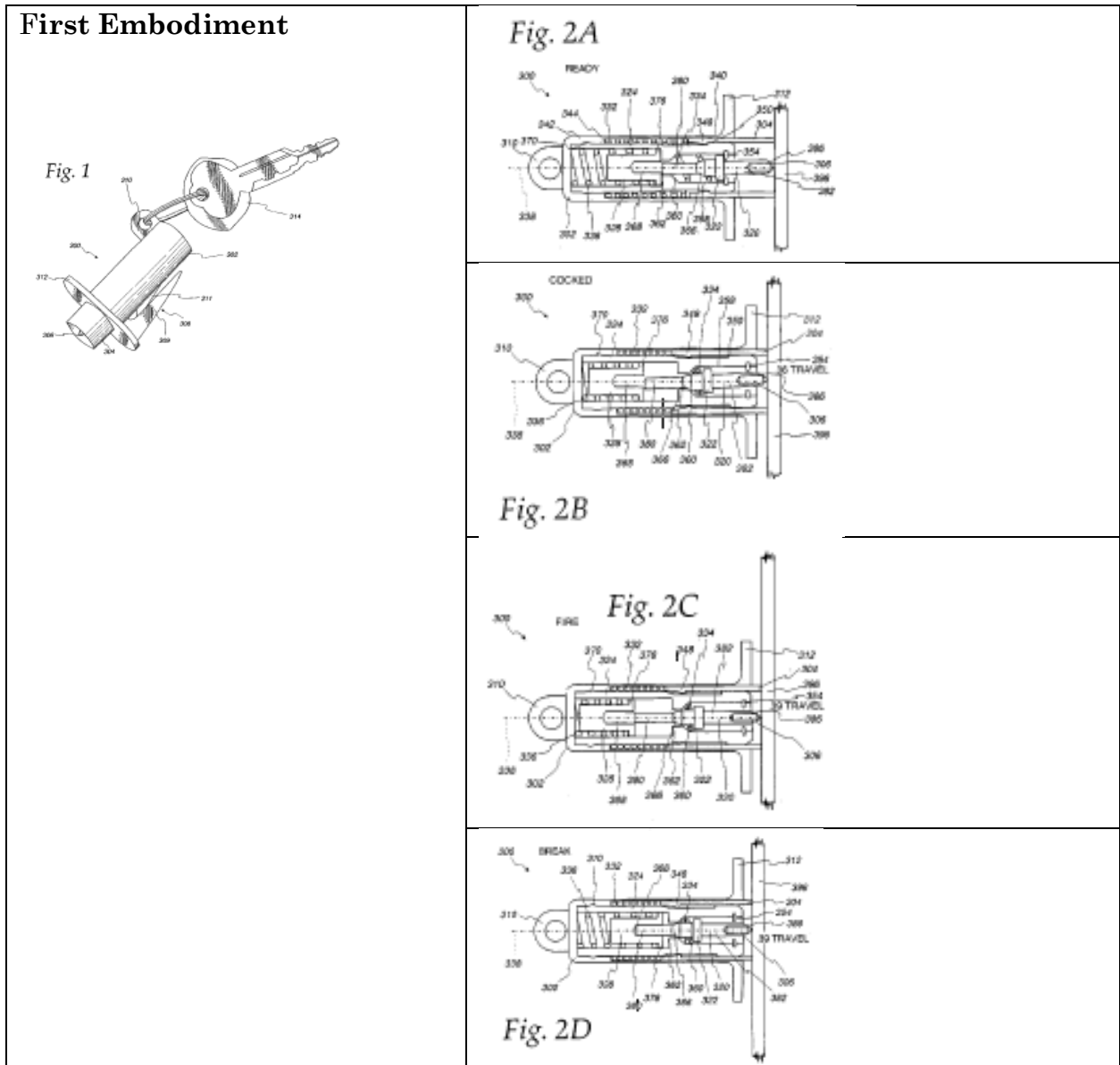
A. The EU '787 Patent Discloses the Utilitarian Advantages of the Design Mark shown in the '245 Registration

The vast majority of the functionality arguments made in Petitioner's ACR Briefs rely on the disclosures and claims of the EU '787 Patent, and the testimony of its listed co-inventors, Kolacz and Steingass. The application for the EU '787 Patent⁴⁵ was filed on March 22, 2002. Per Art. 63(1) of the European Patent Convention, "[t]he term of the European patent shall be 20 years from the date of filing of the application."⁴⁶ So, presuming all interim maintenance fees were paid during its term, the EU '787 Patent would have expired, at the latest, on March 22, 2022. The fact that this patent is expired does not affect our analysis. *TrafFix*, 58 USPQ2d 1001, 1005 ("The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim."). The fact that this patent was issued in Europe, rather than the United States, also does not affect our analysis. *See Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (holding that the applicant's engine configuration was unregistrable as functional, based in part on a Japanese utility model application also filed by the applicant).

The EU '787 Patent discloses two embodiments, the first of which is shown at Figs. 1 and 2A-2D, with its parts (or objects, hereinafter "Obj.") labeled with numbers in the 300 series:

⁴⁵ EU '787 Patent, Witten Decl., 26 TTABVUE 85-103, Exh. 4.

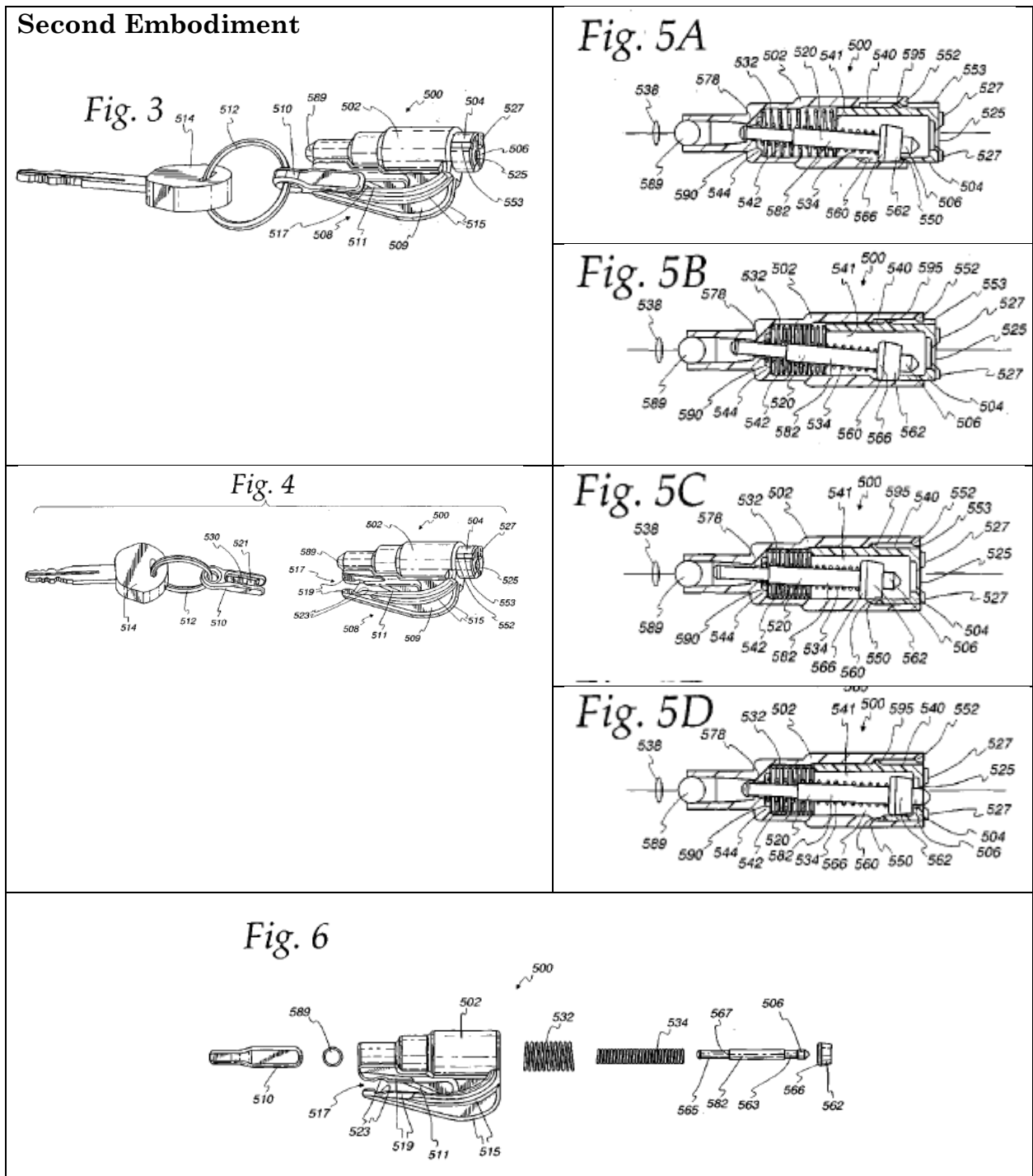
⁴⁶ Convention on the Grant of European Patents (European Patent Convention) art. 63(1), Oct. 5, 1973, 1065 U.N.T.S. 255, 274.



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The Second Embodiment of the EU '787 Patent is disclosed at Figs. 3, 4, 5A-5D and 6, with its parts (or objects) labeled with numbers in the 500 series:

⁴⁷ The First Embodiment of the EU '787 Patent is also the subject of the US '628 Patent. Steingass is listed as the sole inventor on the United States Patent, whereas Steingass and Kolacz are listed as co-inventors on the European Patent. See Witten Decl., 26 TTABVUE 76-103, Exhs. 3-4; Steingass Tr., 28 TTABVUE 145-46.



Collectively, the drawings of Fig. 5 show the operation of the glass breaking device, in its ready position (Fig. 5A), cocked position (Fig. 5B), fire position (Fig. 5C), and break position (Fig. 5D).⁴⁸

In March 2001, in response to the sudden death of two of their employees who had lost their lives in an automobile accident when their vehicle was submerged under water, Tokyo Electronics Corporation (“Tokyo Electronics”) approached Task Force Tips, Inc. (“TFT”) to provide a life-saving device so this calamity would not happen again – that is, to prevent people from drowning in a submerged automobile accident. The First Embodiment of the device was completed under a very short time-frame; a matter of several days.⁴⁹ Steingass and Kolacz were the TFT development team assigned to the project, with Kolacz working under Steingass’ direction.⁵⁰

The internal parts of the First Embodiment (Figs. 1-2) had a hammer (Obj. 328) to provide the impact energy to the spike shaft and spike (Objs. 320 and 306). The hammer was made as large as reasonably possible to maximize its weight. This arrangement of parts gave a uniform (cylindrical) outer diameter for the length of the tool. A surface was added (finger platform (Obj. 312)) at the end of the tool so a user had something to push against. In the First Embodiment, the spike contacts the glass and cocks the hammer (breaking the glass) as the body of the tool is pushed toward the glass.⁵¹

⁴⁸ EU ’787 Patent, par. 86; Steingass Tr., 28 TTABVUE 177-181.

⁴⁹ Steingass Tr., 28 TTABVUE 147-51.

⁵⁰ Steingass Tr., 28 TTABVUE 148-49.

⁵¹ Kolacz Decl., 26 TTABVUE 105, ¶¶ 5-6.

Although Tokyo Electronics loved the First Embodiment of the device as a proof of concept, they thought it was ugly. Put on a keychain, the device was unacceptable to place in a woman's purse or a man's pocket, particularly with the "wings" (finger platform) sticking out and liable to catch on other items in the purse/pocket. Also, the blade on the cutting portion of the device was fully exposed, and would be a hazard should a small child teeth on it.⁵² Tokyo Electronics also did not like how fat the cylindrical design was all the way down the housing.⁵³ Consequently, TFT started work on the Second Embodiment roughly a couple of weeks after meeting with their client and receiving feedback.⁵⁴

In the Second Embodiment, the mechanism is cocked and released without the spike (Obj. 506) touching the glass. The spike itself provides the weight for the impact energy. Since no separate hammer is needed, the diameter at that end of the tool could be much smaller.⁵⁵

The outer casing of the Second Embodiment (Obj. 502) follows the sizes of the internal parts, allowing the device to perform according to the invention claimed in the EU '787 Patent. While the First Embodiment (as shown above) gave a smooth outer diameter to the outer casing, the Second Embodiment gave steps or ridges. The outer casing of the Second Embodiment also naturally provides surfaces to push against (the steps). No other pushing surface was needed or desirable (since the goal

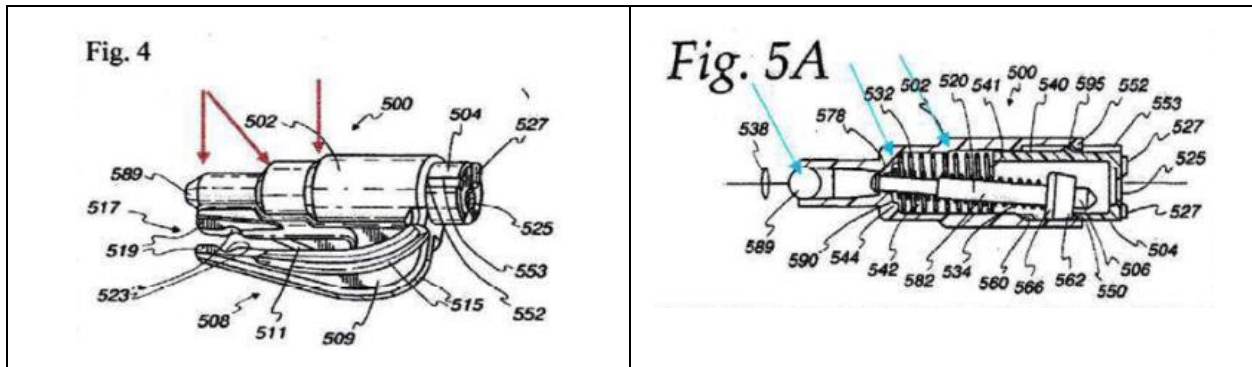
⁵² Steingass Tr., 28 TTABVUE 154-58.

⁵³ Steingass Tr., 28 TTABVUE 223.

⁵⁴ Steingass Tr., 28 TTABVUE 154.

⁵⁵ Kolacz Decl., 26 TTABVUE 106, ¶ 9.

was for a compact unit). Therefore, in the Second Embodiment TFT was able to eliminate the finger platform (Obj. 312) of the first embodiment:

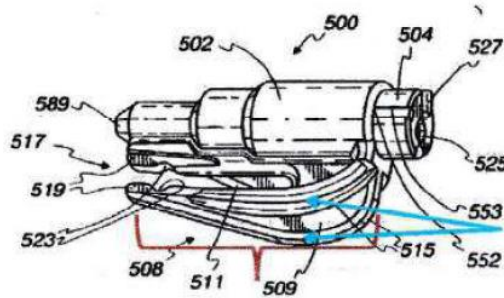


Red arrows have been added to Fig. 4 of the EU '787 Patent show the outer steps are dictated by the required internal diameters (blue arrows added to Fig. 5A of the EU '787 Patent at the left end of each step).⁵⁶

What Respondent called the “finger” portion of the device during prosecution of the Application underlying the '245 Registration, Kolacz calls the “hook” – that is, the seat belt cutting portion of the device. As with any cutter device, safety is important. Therefore, the blade is recessed into the hook to prevent cuts. In addition, the long opening of the hook before the blade keeps more of the seatbelt in the hook and prevents it from slipping out.⁵⁷ The back of the hook, the part at the bottom of Fig. 4 of the EU '787 Patent seen here bracketed red:

⁵⁶ Kolacz Decl., 26 TTABVUE 106-07, ¶¶ 10-11.

⁵⁷ Kolacz Decl., 26 TTABVUE 107, ¶¶ 12-13.



had wings (pointed at with blue arrows) added to it that are broad in the Second Embodiment to keep objects away from the blade, thereby improving its function of protecting against cutting skin or clothing.⁵⁸

The depth and breadth of the hook and the wings also protect the blade against nicking. The longer hook added greater flexibility to the structure of the hook to remove the key ring holder from the notch. The design of the hook in the Second Embodiment is more curved than the First Embodiment. This was to prevent the outside of the hook from snagging on clothing or anything else, like upholstery.⁵⁹

Kolacz testified that every significantly visible portion of the Second Embodiment of the EU '787 Patent, the stepped or ridged outer casing (housing), as well as the configuration of the seat belt cutting device (hook) attached to the housing, is functional.⁶⁰ By “functional,” Kolacz meant that each of these identified features works for its intended purpose: (1) a stepped outer contour that would contain the inner parts, be moldable and produce-able, following along with what the internal parts were doing, to fit on a keychain and be easy to carry, and to provide surface

⁵⁸ Kolacz Decl., 26 TTABVUE 107, ¶ 14.

⁵⁹ Kolacz Decl., 26 TTABVUE 107-08, ¶¶ 15-17.

⁶⁰ Kolacz Decl., 26 TTABVUE 106-08, ¶¶ 10-17.

area allowing the user to push on the glass-breaking tool to activate it, particularly if the surface of the device became wet;⁶¹ and (2) a blade for cutting, surrounded by a hook with wings (or flanges) that come to a point and taper off, which provides a wedging action that allows for easy insertion of the seat belt into and toward the blade, and designed so as to provide side-to-side stiffness and rigidity of the hook.⁶²

We find Kolacz's testimony consistent with the discussion of the Second Embodiment in the following excerpts from the Specification of the EU '787 Patent:

| | |
|--|---|
| <p>[0063] An alternate embodiment of a glass breaker 500 in accordance with the present invention is disclosed in Figs. 3 through 6. Referring to Figs 3 and 4, the glass breaker 500 includes a housing 502, a safety sheath 504, a glass breaking spike 506, a seat belt cutter 508, a key chain loop 510 for securing the glass breaker 500 to a key ring 512 and a key 514.</p> <p>[0064] The housing 502 is illustrated in its preferred approximate size and configuration, which generally has several coaxial cylindrical tiers. The housing 502, as manufactured, is open at each end. The right end as viewed is closed off by the safety sheath 504. The left end as viewed is closed by a ball 589 that is press-fit into the housing 502 to protect the inner mechanism from dirt and moisture.</p> | <p>[0066] The housing 502 also preferably includes one or more other tools that are appropriate for use with a glass breaker or other convenience-type tool. As illustrated, the housing 502 includes an integral seat belt cutter 508. This seat belt cutter 508 is used to cut seat belts and shoulder harnesses in vehicles to gain access to children or injured motorists and passengers. The cutter 508 is defined by a hook 509 formed in the housing 502. The hook 509 is relatively robust where it connects to, or is otherwise formed integrally with, the housing 502. At the opposite end, the hook 509 tapers to nearly a point so that it can readily hook into the material to be cut without being hung up on other materials. The hook 509 is preferably molded with one or more flanges 515, as illustrated, to provide rigidity.</p> <p>[0067] Disposed in the cutter 508 is a cutting edge 511 such as a razor blade, preferably a blade made of stainless steel. The cutting edge 511 is preferably disposed at an angle to the hook 509, as illustrated, to form a deep v-shape in which the seat belt will be secured and efficiently cut. The cutting edge 511 can be molded into, press-fit, or otherwise embedded in the housing 502 and hook 509 using a suitable adhesive. The blade can be permanently attached to the tool 500, or secured in a way to be field replaceable by being, for example, sandwiched between screwed together halves of the tool 500.</p> |
|--|---|

⁶¹ Kolacz Tr., 28 TTABVUE 57-62, 67-68.

⁶² Kolacz Tr., 28 TTABVUE 68-70.

| | |
|--|---|
| <p>[0081] In addition to the features described above, the cross-sectional views illustrate that the housing 502 has three internal diameters, a large internal diameter 540, an intermediate internal diameter 541, and a small internal diameter 542. The large 540 and intermediate internal 541 diameter portions accommodate movement of the safety sheath 504 while the small internal diameter 542 portion accommodates the left end of the spike 506. In addition, the intermediate internal diameter 541 portion houses a safety sheath compression spring 532 which biases the safety sheath 504 outwardly (to the right, as viewed) from the housing 502. A step 544 at the left end of the small diameter 542 housing portion serves as a bearing surface for the safety sheath spring 532 to bias the spike 506 outwardly (to the right as shown).</p> | <p>[0089] In the cocked position (Fig. 5B), a user (not illustrated) has exerted finger pressure against the housing's outer surface 512 of the housing 502 to move the housing 502 toward the glass.</p> <p>[0090] Also in response to the user pressing on the housing's outer surface 512, the safety sheath spring 532 is compressed so that the safety sheath 504 can remain in contact with the glass, but also slide into the housing 502, as illustrated.</p> <p>[0092] In the fire position (Fig. 5C), the user has pushed the housing 502 its entire distance of travel toward the pane of glass.</p> <p>[0095] The result of the spike spring 536 expanding, is that the spike 506 impacts and breaks the glass (Fig. 5D).</p> |
| <p>[0096] All of the above-described movements can take place as a result of a single pushing movement by the user, and they all occur in a short time. Thus, the glass breaker 500 is useful in emergencies and can be used with little thought as to its operation.</p> <p>[0098] The materials specified above for use in the multipurpose tool provide sufficient strength and rigidity for most situations, while concurrently providing a lightweight tool that is easily manufactured and carried.</p> | |

The above discussion from the EU '787 Patent supports Kolacz's explanation regarding the placement, configuration and purposes of the stepped or ridged housing and the "hook" cutting device of the Second Embodiment. It is this same device that is shown in the '245 Registration. The EU '787 Patent ends with twelve numbered claims. In our view, at the least, the following claims in the EU '787 Patent cover the Second Embodiment of the invention:

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| <p>1. A glass breaking apparatus comprising:</p> <ul style="list-style-type: none">a housing (302);a safety sheath (304) slidably disposed in the housing;a spike (306) disposed at least partially in the housing;a safety sheath spring (332) in biasing engagement with the housing to bias the safety sheath toward a ready position; anda spike spring (334) in biasing engagement with the housing to bias the spike toward a break position; <p>wherein the housing is moved toward a glass pane to compress the safety sheath spring and the spike spring until the spike is disengaged from the safety sheath to release the spike to the urging of the spike spring, and urge the spike into breaking impact with the glass.</p> | <p>4. The glass breaking apparatus of claim 1, and further comprising:</p> <ul style="list-style-type: none">a seat belt cutting tool joined to the housing. <p>5. The glass breaking apparatus of claim 1, and further comprising:</p> <ul style="list-style-type: none">a seat belt cutter tool joined to the housing and defining a slot with the housing; anda key chain loop that is removably disposed in the slot. |
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These claims cover the Second Embodiment disclosed in the EU '787 Patent and the design elements of the same device shown in the '245 Registration – particularly the housing and the seat belt cutting tool or (as Kolacz described it) “hook.”⁶³ Even if the claims of the EU '787 Patent do not cover the design mark of the '245 Registration, this would not preclude a finding of functionality based on the drawings of the Second Embodiment and the textual discussion thereof set out above. *See In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (There is no requirement “that a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant’s assertion that an applied-

⁶³ Even though the elements of Claim 1 (and by extension Claims 4 and 5, which depend therefrom) contain Object Numbers associated with the drawings in the First Embodiment, the scope of the claims is not limited to the First Embodiment. *See* European Patent Convention Rule 43(7), Guidelines for Examination in the European Patent Office. Part F, Ch. IV, Section 4.18, and European Patent Office Technical Board of Appeal, Case No. T 0237/84 (Reference Signs) (July 31, 1986).

for mark is not de jure functional. Indeed, ... statements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality."); *Poly-America*, 124 USPQ2d at 1519 ("The issue is whether anything in the patent, its specification, or statements made in prosecution disclose the functionality of the marks. ... '[R]eadability of patent claims on structure is not [the] test of functionality for trademark purposes.") (quoting *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985)).

During his deposition, Steingass did not completely agree with Kolacz that the elements of the design of the GLASS-BREAKING/SEAT-BELT CUTTING Device of the '245 Registration in which Respondent claims trademark rights are necessarily functional.⁶⁴ Steingass explains that, in order to break glass using the device, it takes energy. The energy comes from pushing the device against a pane of glass. The "movement" discussed in the patent is the movement of the device toward the glass pane. Moving the device toward the glass pane, energy is stored by compressing a spring; the tool moves from the cocked position to the break position under the force of the spring. The person operating the device provides the energy to bring the device

⁶⁴ During Steingass' deposition and in Petitioner's ACR Brief, Petitioner went to great lengths to show that Steingass' testimony was biased in Respondent's favor, whether because Steingass and Respondent had a friendly relationship, Steingass was being coached during telephone calls with Respondent, or because Steingass was upset that other glass-breaking/seat-belt cutting devices were on the market that looked much like the configuration of Respondent's design but that were operationally inferior. Steingass Tr., 28 TTABVUE 199-201, 231, 233-48; Petitioner's ACR Brief, 28 TTABVUE 33-34. We do not believe that Steingass told untruths during his testimony, or shaded his testimony in Respondent's favor, for any of these reasons.

to the cocked position. Once it fires, there is just a fraction of a second; the mechanism moves against the glass with great speed and bursts the glass.⁶⁵

With his explanation above as background, Steingass did not believe that the stepped or ridged housing of the device was necessary for the user to push it against the glass; other housing shapes could achieve this purpose.⁶⁶ Further, although the user could push against the stepped or ridged housing to hold the device up to the glass (so the internal mechanism can break it), the user could hold onto, and push against, other parts of the device, including: the hook, one's keys (if attached), the key ring, the ridged embossments on the safety sheath, or the back (cylindrically smaller) end of the device.⁶⁷

Steingass did concede, however, that the stepped or ridged housing of the Second Embodiment in the EU '787 Patent looked sleeker than the wholly cylindrical First Embodiment; in a configuration that would better nestle with a set of keys on the attached keyring.⁶⁸ Not only was the Second Embodiment pleasing to the eye, it was also simple to make and in a configuration for which it was easy to cut a mold.⁶⁹ The housing or casing of the Second Embodiment is such that, while not mimicking the

⁶⁵ Steingass Tr., 28 TTABVUE 175-177.

⁶⁶ Steingass Tr., 28 TTABVUE 185-87, 198.

⁶⁷ Steingass Tr., 28 TTABVUE 187-95, 198-99, 201-02. The safety sheath and ridged embossments are Objs. 504 and 527, respectively, in Figs. 3-4 of the EU '787 Patent.

⁶⁸ Steingass Tr., 28 TTABVUE 222-24.

⁶⁹ Steingass Tr., 28 TTABVUE 224.

interior parts of the device exactly, it follows the interior parts of the device in a somewhat similar manner.⁷⁰

Also according to Steingass, the “hook” (or cutting tool) portion of the device is robustly connected to the housing to prevent it from breaking off or bending upon the cutting edge being forced through the seat belt when the user self-rescues from a seat belt entrapment.⁷¹ The flanges (or “wings”) on the hook provide rigidity.⁷² The hook tapers to nearly a point so that it can readily hook into the seat belt material to be cut without snagging on other materials.⁷³ The deep V-shape in the hook, in conjunction with the cutting edge, is purposely designed so it can cut a seat belt securely and efficiently.⁷⁴

With all of these functional features of Respondent’s GLASS-BREAKING/SEAT-BELT CUTTING Device depicted, discussed and claimed in the EU ’787 Patent, for Respondent to maintain trademark protection for the device he “must carry the heavy burden of showing that the feature[s] of the device are] ... not functional, for instance by showing that ... [they are] merely ... ornamental, incidental, or arbitrary aspect[s] of the device[,]” *TrafFix*, 58 USPQ2d at 1005, “perhaps [by] prov[ing] that those aspects do not serve a purpose within the terms of the utility patent.” *Id.* at 1007. To

⁷⁰ Steingass Tr., 28 TTABVUE 227-230.

⁷¹ Steingass Tr., 28 TTABVUE 168-70.

⁷² Steingass Tr., 28 TTABVUE 170-71.

⁷³ Steingass Tr., 28 TTABVUE 171-72.

⁷⁴ Steingass Tr., 28 TTABVUE 172-73.

meet this heavy burden, all Respondent says is that “Steingass testified he and ... Kolacz chose the shape [of the device] to look good to their company’s customer.”⁷⁵ That testimony alone is not enough to meet this heavy burden, and moreover that is not the whole story. In response to Petitioner’s pre-deposition written questions concerning the change in configuration of the outer part of the housing from the First to Second Embodiments, which Steingass confirmed and adhered to during his deposition, Steingass said, “I was told by our launch customer that [we] would need to make our tool safer, look better, and work better if we were to get the order, so we improved the design.”⁷⁶ Thus, two of the three reasons for the “improved design,” the Second Embodiment, comprise functional considerations.

B. Respondent’s Advertising and Other Public Statements Touting Utilitarian Advantages

“If a seller advertises the utilitarian advantages of a particular feature of its product, this constitutes strong evidence of functionality.” *Kohler*, 125 USPQ2d 1468, 1502 (TTAB 2017) (quoting *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1924 (TTAB 2011)). In evaluating whether the design of Respondent’s GLASS-BREAKING/SEAT-BELT CUTTING Device has functional utility from the standpoint of performance, “we need only believe ... [Respondent’s] own statements.” *In re Bose*, 227 USPQ at 6; *see also New England Butt Co. v. U.S. Int’l Trade Com.*, 756 F.2d 874, 225 USPQ 260, 263 (Fed. Cir. 1985) (finding that

⁷⁵ Respondent’s ACR Brief, 28 TTABVUE 11-12.

⁷⁶ Steingass Tr., 27 TTABVUE 143, 231, 299, Exh. 5.

advertising brochures and catalogs which promote the utilitarian features of the claimed design support a finding of functionality).

We begin with the packaging for Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device used by his company, Resqme:⁷⁷



Nearly all of the graphical and textual matter on Respondent's product packaging (other than the RESQME mark and the "Made in the USA" insignia) pertains to the functional operations of the device: a seat belt cutter in an elongated and winged configuration with a window breaker in a stepped or ridged housing affixed to a keychain, used for the purpose of escaping from a car in an emergency.

Respondent's online advertising fares no better. On the webpage for Respondent's company titled "The resqme®: a unique beginning,"⁷⁸ it says:

⁷⁷ Witten Decl., 26 TTABVUE 214-16, Exh. 14.

⁷⁸ Witten Decl., 26 TTABVUE 43-45, Exh. 1.

The idea of the resqme® (<https://resqme.com/product/resqme/>) began after introducing and selling the LifeHammer®. Straightaway, I noticed people having trouble finding an accessible location to store a tool of that size in their vehicle. Eventually, it would end up in the glove box, where most passengers cannot reach, especially during a stressful emergency. Thus, I began imagining **a smaller tool that could easily attach to a keychain while maintaining the valuable seatbelt cutting and window breaking functions.**

Unfortunately, in 2001, 3 employees of Tokyo Electronic lost their lives in a tragic Houston flood. The company reached out to me looking to gift their 15,000 employees the LifeHammer®. With this gesture, they hoped to honor the innocent lives lost, and avoid any future losses. However, after reviewing the product, they began inquiring about **a smaller tool**, which did not exist yet.

Coming to life:

Hence, I shared my idea for creating **a keychain-accessible tool with the same functions**, and they loved it. They quickly shared my idea with Task Force Tips, a reputable fire-safety manufacturer. With the amazing help of mechanical engineer and ex-volunteer fire fighter, Bob Steingass, the resqme® car escape tool (<https://resqme.com/product/resqme/>) was designed and created. Task Force Tips manufactured 15,000 units for Tokyo Electronic as a gift for each of their employees during the holidays.

Within a couple hours of receiving their gift, Tokyo Electronic employees all received an email. It read “You have just received **a safety window breaker and seat belt cutter**, PLEASE DO NOT TEST THE DEVICE ON YOUR DESKTOP SCREEN”! Excitedly, employees started testing out their new tools on their monitors, and sure enough, the glass was shattering! (Emphasis Added).

* * *

Laurent Colasse, Founder and President of resqme, Inc.

Thus, Respondent’s origin story for the device shown in the ’245 Registration wholly touts its functional features.

On the webpage for Respondent’s company titled “Step by Step Guide for using the resqme®,”⁷⁹ it says:

⁷⁹ Colasse Decl., 29 TTABVUE 72-82, Exh. L.

What is the resqme® (<https://resqme.com/product/resqme/>)?

The resqme® (<https://resqme.com/product/resqme/>) is a **car escape tool designed to help drivers and passengers escape car entrapment emergencies. This small, easy-to-carry tool has two functions that could save your life: cutting jammed seat belts and breaking tempered glass windows.** Both the seat belt-cutting blade and window-breaking spring-loaded spike are designed to withstand several uses.



How do you use the resqme® (<https://resqme.com/product/resqme/>)?

...

1. Grab your resqme® (<https://resqme.com/product/resqme/>)!

With several accessible locations to store your tool, you can ensure it will always be within reach! **You can use the provided key-ring to attach the resqme® to your keychain** to access it at all times. ...



2. Remove the blade cover®

Place your finger in the key-ring attached to the black blade cover, and quickly pull to reveal the blade.



3. Cut a jammed seatbelt

Place the resqme® between your index finger and thumb to grip the tool firmly. **Position the seat belt near the blade, and cut at a 45° angle for best results. With one quick pull of the tool, you will be free to move and get to safety.**



4. Break a tempered glass window

During many emergency situations, car mechanics might not operate properly, so you will need to escape from a window opening. **To quickly shatter a tempered glass window, place the black head of the resqme® against the bottom corner of the window and push. With a bit of force, the spring-loaded spike will be activated, and the glass will break into small harmless pieces. (Emphasis added).**



Respondent states that the Resqme device promoted and sold on his company's website "conforms to the configuration of the ['245] Registration."⁸⁰ As noted above, the Declaration Respondent filed in support of the Application that matured to the '245 Registration states that "[t]he device was the subject of European Patent No. 1372787B1 ... as can be evidenced by comparison to the drawings of that patent ... [to] the particular rendition of the present trade dress design" (Emphasis added).⁸¹ The explanation and demonstration on the website of Respondent's company as to how the Resqme device was conceived and operates is totally consistent with the disclosures of the EU '737 Patent and Kolacz's explanation of how the device works per its corresponding design considerations (particularly, the utility of the stepped or ridged housing and configuration of the hook), most of which is confirmed by Steingass' testimony. To the extent Steingass' testimony is to the contrary, we find that it departs from the totality of the other evidence of record.

C. Whether the Subject Matter Results from a Comparatively Simple or Inexpensive Method of Manufacture

Where "[R]espondent's design, due to its structural efficiencies, is less expensive to produce than other less efficient designs that may require more ... or ... [other] materials[,] ... [t]his factor weighs in favor" of a finding of functionality. *Kistner*, 97 USPQ2d at 1930. Similarly, where "patented improvements ... [have] simplified and reduced the cost of the design[,]" this also is a factor weighing in favor of a functionality finding. *New England Butt*, 225 USPQ at 263.

⁸⁰ Colasse Decl., 29 TTABVUE 47, ¶ 4.

⁸¹ Colasse File History Decl., Application of January 11, 2013, at 8.

There is very limited evidence in the record regarding the manufacture of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device. The parties do not devote arguments in their ACR Briefs to this *Morton-Norwich* factor. What little evidence there is on this factor comes from the testimony of the named inventors in the EU '787 Patent. According to Kolacz, the design of the Second Embodiment of the EU '787 Patent led to a stepped outer contour, using a moulding process that would avoid thick wall sections or big transitions from thick to thin. In the interest in keeping the wall uniform, it followed along with what the internal parts were doing. The casing or housing thus was shaped in order to contain the parts and be moldable, produce-able.⁸² According to Steingass, not only was the Second Embodiment more pleasing to the eye than the First Embodiment, it was also simple to make and in a configuration for which was easy to cut a mold.⁸³

Thus, what little evidence there is in the record regarding the design and efficiencies in the manufacture of the device supports a finding, under the fourth *Morton-Norwich* factor, that the overall configuration of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device is functional.

D. The Availability of Alternative Designs

Attached to the declaration of Duprat, an employee from Respondent's company, are page captures from 22 third-parties promoting car emergency escape tools for sale, in a variety of different configurations.⁸⁴ Three of these designs originate from

⁸² Kolacz Tr., 28 TTABVUE 57-58.

⁸³ Steingass Tr., 28 TTABVUE 224.

⁸⁴ Duprat Decl., 29 TTABVUE 84-86, 88-110, ¶¶ 3-25, Exh. M.

the same company (SWISS+TECH). Respondent also made of record and points to a new car emergency escape tool design offered for sale by Petitioner that does not include a ridged or stepped housing configuration.⁸⁵

Respondent argues that these third-party car emergency escape tool designs, and Petitioner's new tool design, comprise evidence that numerous alternative designs are available; thus undercutting Petitioner's assertion that the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device is functional.⁸⁶ Petitioner goes to great lengths to distinguish these third-party tools as not being acceptable "alternative designs."⁸⁷

We have two problems with Respondent's alternative design evidence. First, since we have found the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device to be utilitarian functional under the other *Morton-Norwich* factors, we need not consider the existence or acceptability of alternative designs. *TrafFix*, 58 USPQ2d at 1006-07; *In re Becton, Dickinson*, 102 USPQ2d at 1378; *Valu Eng'g*, 61 USPQ2d at 1427.

⁸⁵ Colasse Decl., 29 TTABVUE 49, 68-71, ¶¶ 15-17, Exhs. J-K.

⁸⁶ Respondent's ACR Brief, 28 TTABVUE 14-15.

⁸⁷ Petitioner's Reply ACR Brief, 29 TTABVUE 14-20. Petitioner waived its various objections to the admissibility of Respondent's alternative designs evidence because Petitioner did not assert these objections until its reply brief. *See, e.g., JNF LLC v. Harwood Int'l Inc.*, 2022 USPQ2d 862, at *24 n.59 (TTAB 2022) (Board did not consider petitioner's objection raised for the first time in its reply brief questioning the reliability of the Google Street View evidence); *Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1207 n.28 (TTAB 2018) (testimony objections waived when not asserted in or with opening brief), *judgment rev'd and vacated by consent decree*, No. 1:18-cv-00599 (W.D.N.Y. June 8, 2022).

Second, Respondent has not supplied evidence, nor has it provided analysis, demonstrating that the designs of the competitors' products or Petitioner's new product made of record are equivalent in desired mechanical properties to those of Respondent's design. *See Valu Eng'g*, 61 USPQ2d at 1427 (discussing that the law of functionality considers in part "[t]he existence of **actual or potential alternative designs that work equally well** [which] strongly suggests that the particular design used by plaintiff is not needed by competitors to effectively compete on the merits." (emphasis added)) (citing J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7:75, 7-180-1 (4th ed. 2001)).

In view of the dearth of probative evidence and analysis, we find the presence or absence of alternative designs to be a neutral factor regarding our ultimate determination whether the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device is functional, which in any event we need not consider under controlling case law.

VII. Conclusion: Functionality

The EU '787 Patent discloses the utilitarian advantages of the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device as shown in Respondent's '245 Registration. The packaging and online advertising of Respondent's company for the Resqme product incorporating the design shown in the '245 Registration touts the utilitarian advantages of the design. Although not totally in sync, testimony from the named inventors on the EU '787 Patent demonstrates that the elements of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device in which Respondent claims rights were designed based on functional

considerations as to (1) user operation of the device, and (2) ease of manufacture. Facts pertaining to the availability of alternative designs comprise a neutral factor here, in view of controlling case law and due to the dearth of relevant evidence and analysis.

In sum, based upon our analysis of the *Morton-Norwich* factors for which there has been evidence and argument, we find that the design of Respondent's GLASS-BREAKING/SEAT-BELT CUTTING Device, as shown in Respondent's '245 Registration, is functional based on utilitarian considerations.

Decision:

The Petition to Cancel Trademark Registration No. 4461245 is granted. The registration will be canceled in due course.