

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: November 18, 2004
csl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Baby Bjorn AB

Serial No. 75751554

Daniel Zendel, Steven M. Perez and Mary A. Moy of Ladas & Parry for Baby Bjorn AB.

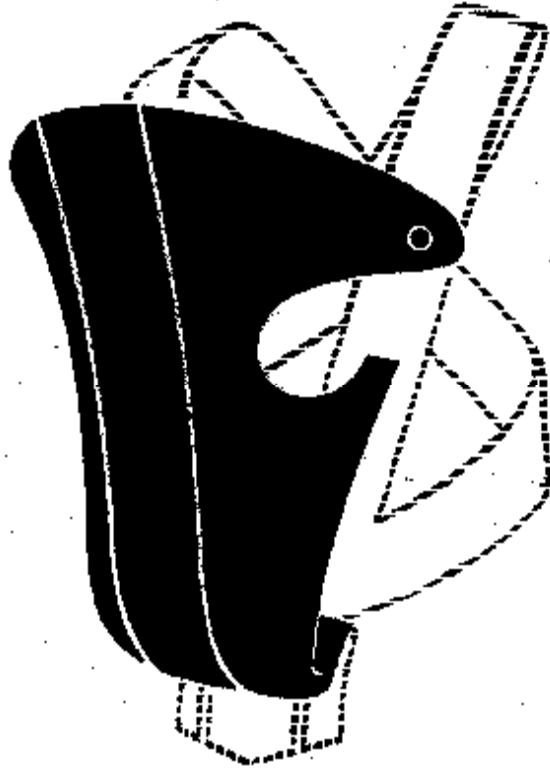
Nicholas K.D. Altree, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Simms, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Baby Bjorn AB (applicant), a Swedish corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the amended mark shown below for soft baby carriers worn on the body.¹

¹ Serial No. 75751554, filed July 15, 1999, based upon an allegation of use in commerce since at least July 4, 1991, and on a claim of priority under Section 44(d) of the Act, 15 USC §1126(d), based upon ownership of Swedish application 99-00356, now Reg. No. 337,347, filed January 20, 1999. During the course of prosecution, on February 2, 2001, applicant claimed acquired distinctiveness of its asserted mark.



With a request for reconsideration, applicant amended the description of its mark as follows:

The mark comprises the configuration of a flared, kite-shaped outside front panel of a baby carrier and two vertical stripes placed thereon. The portions of the drawing shown in dotted lines are not part of the mark but are merely intended to show the position of the mark.

Essentially, applicant claims that the source-identifying features of its design consist of the arbitrary shape of

No issue has been raised as to whether applicant's amended mark is a substantially exact representation of the mark in the foreign registration, which is of the same image except that the straps are shown in black rather than in dotted lines. See Trademark Rule 2.51(a)(3) and (b)(3), and TMEP §§1011.01, 1011.03

Serial No. 75751554

the front flap of its baby carrier as well as the vertical stripes on the front of the carrier. In its brief, 10, applicant states that its mark consists of "the combination of arbitrary curves and lines comprising its distinctive one-piece, kite-shaped flap design and distinctive front-panel stripes," and, at 18, the "combination of a flared, kite-shaped panel and vertical stripes."

The Examining Attorney has refused registration on the basis that applicant's proposed mark is functional under Section 2(e)(5) of the Act, 15 USC §1052(e)(5), and, assuming that the configuration is nonfunctional, on the basis that applicant's product design has not acquired distinctiveness under Section 2(f) of the Act, 15 USC §1052(f), and is therefore merely a non-distinctive configuration which is not a mark. See Sections 1, 2 and 45 of the Act, 15 USC §§1051, 1052 and 1127.

The Law of Functionality

The Trademark Act has been amended to provide that an application may be refused registration if it "comprises any matter that, as a whole, is functional." 15 USC §1052(e)(5). The Supreme Court has recently discussed the issue of functionality:

and 807.14. For purposes of this decision, we shall assume that these marks are substantially exact.

[W]e have said "[i]n general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.'" *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n. 10 (1982)). Expanding upon the meaning of this phrase, we have observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." 514 U.S., at 165.

TraFFix Devices Inc. v. Marketing Displays Inc., 523 U.S. 23, 58 USPQ2d 1001, 1006 (2001). Also, in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64, the Supreme Court observed:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. 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. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

That is to say, the Lanham Act does not exist to reward manufacturers for their innovation in creating a particular

Serial No. 75751554

device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

The Federal Circuit looks at four factors in determining the issue of functionality:

- (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 the product.

See *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982).

Concerning the first factor, the existence of a utility patent, one must first look at the question of whether there is a prior utility patent that is relevant to the issue of functionality of applicant's design. The

Supreme Court has indicated that a utility patent can be a critical factor in a functionality determination.

A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features, the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection.

TrafFix, 58 USPQ2d at 1005.

As to the third factor, the existence of alternative designs, the Federal Circuit has noted that the fact that other designs are available does not mean that applicant's design is not functional:

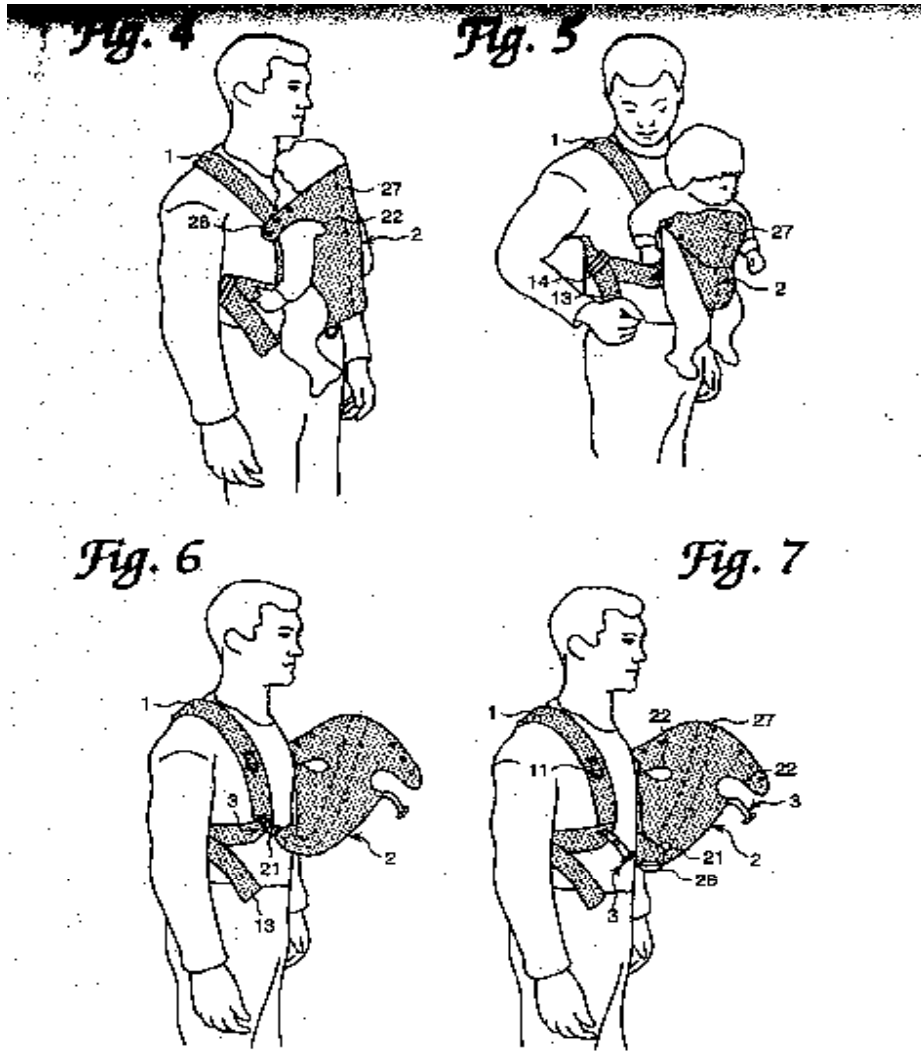
We did not in the past under the third factor require that the opposing party establish that there was a "competitive necessity" for the product feature. Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations 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 Engineering, 61 USPQ2d at 1427 (footnote omitted).

The question is not whether there are alternative designs that perform the same basic function, but whether these designs work "equally well." *Valu Engineering*, 61 USPQ2d at 1427, quoting, 1 McCarthy on Trademarks and Unfair Competition, §7:75, 7-180-1 (4th ed. 2001). The Supreme Court found that it was improper to engage in "speculation about other design possibilities, such as using three or four springs which might serve the same purpose ... [or] to explore designs to hide the springs." *TrafFix*, 58 USPQ2d at 1007. The presence of other designs does not indicate, therefore, that applicant's design is not de jure functional.

The Patents and Advertising of Record

The record includes two patents held by applicant. Patent number 5,490,620, dated February 13, 1996, is the more relevant of the two. It covers a child-supporting shoulder harness. In the detailed description of the preferred embodiments, it is indicated that the supporting flap (2) in the drawing below has a neck-supporting part (27) in the region above the point at which the fastening devices are attached to the straps.



It also indicates that the side edges of the flap are provided with recesses (22) through which the arms of the child extend in a region immediately above the fastening devices. Further, the patent states that, if the harness is placed in another configuration, used when the child is placed in the harness in a forward-facing position, the neck-support part can be folded down onto the lower part of the supporting flap. However, the patent states that "it

Serial No. 75751554

is normally desirable for the supporting flap ... to have a given degree of stiffness so as to hold the neck-supporting part 27 upright." In the patent, the applicant states that he claims, among other things, a flap which includes "a neck-support part ... which extends up beyond the level of the fastening connections (3, 11) of said flap; in that the neck-support part is provided along its side (28) with fastener elements (23) for releasably fastening said neck-support part to the two looped straps (1) so as to stabilize said neck-support part (27)... ... A harness according to [the previous claim], characterized in that the neck-support part (27) can be folded down... 13. A harness according to [a previous claim], characterized in that the child-supporting flap (2) has lateral recesses (22) for accommodating arms of the child."

Applicant's other patent (the '821 patent) relates to clasp mechanisms used to attach and adjust the baby carrier.

Exhibit E submitted with applicant's Request for Reconsideration shows ads and product reviews touting applicant's baby carriers. The ads indicate that applicant's baby harness provides "safe and snug head support," and "strong support for your baby's neck and back," and "[I]t features safe and comfy head support."

Another ad indicates that one may "[p]lace baby facing you when very young and use the head support." Instructions for using applicant's baby carrier are of record, one part of which is reproduced below:



... Putting the baby in the carrier

8. Adjust the head support needed for the child, by snapping it in place. Inner buttons for newborns.
9. Secure the two leg straps for infants ages 2 months and under to reduce the size of the leg openings. Discontinue the use of the leg straps when it becomes too tight on the child's leg.
10. Finally pull the end of both side-straps, one at time, while lifting the baby with the other hand. Pull tight until the child is close to your body and high upon your chest for maximum safety and comfort.

Arguments

It is the Examining Attorney's position that the evidence of record, including applicant's utility patents and advertising, demonstrates that the portion of applicant's baby carrier sought to be protected by its application is de jure functional and unregistrable. The Examining Attorney maintains that applicant's product has this shape because it works better in this shape. The Examining Attorney points to some of the statements from

applicant's '620 patent noted above as well as claims made in applicant's advertising such as "safe and snug head support" and "high and padded neck rest." The Examining Attorney contends that advertising calling attention to functional details of applicant's product does not establish that consumers recognize the configuration (or a part thereof) as an indicator of source. Applicant's utility patents, he argues, are strong evidence that applicant's features are functional, and applicant has a heavy burden to show that the features in its patents are not functional, for example, that they are ornamental, incidental or arbitrary. It is the Examining Attorney's position that the vertical stripes shown in the drawing are "probably" the result of reinforcement stitching.

Assuming that applicant's design is determined not to be functional as a whole, the Examining Attorney contends that applicant's design has not acquired distinctiveness, and that it shares some of the same properties embodied in baby carriers of others, such as a supporting pouch, head support and openings for the arms and legs. While the Examining Attorney concedes that it is possible that the two vertical stripes, if not functional, may be protectable, the Examining Attorney points out that applicant's drawing is not limited to the two vertical

Serial No. 75751554

stripes but includes the overall shape of the pouch or flap as well.

Applicant, on the other hand, contends that all baby carriers have certain features, such as flaps, straps and fastener elements. It is applicant's position, however, that its patents do not disclose any utilitarian advantages relating to the design features for which applicant seeks trademark registration, but rather applicant's configuration embodies a nonfunctional design which has acquired distinctiveness. That is to say, the pouch or flap herein sought to be protected has a shape which is neither described nor dictated by the claims of its patents, applicant argues.

Because the drawing of applicant's mark has been amended to delete any claim to the straps, buckles or clasps covered in the '821 patent, that patent is irrelevant, applicant maintains. The '620 patent concerns the ease with which a child may be removed from its baby carrier, applicant contends. It is applicant's position that the shape or use of the flap design is not the subject matter of or central advance claimed in that patent. According to applicant, neither patent reveals any particular utilitarian advantages to the shape of this support flap. In sum, applicant acknowledges that it is

not seeking or entitled to "exclusive rights to the use of a fabric support flap for baby carriers. Applicant instead seeks registration of a particular flap shape comprising a specific combination of curves, lines and stripes." Reply brief, 4.

Furthermore, applicant points out that there is no mention in the '620 patent of any functional advantages of the stitching shown in applicant's proposed mark. With respect to this stitching, applicant argues that its function is to add "a characteristic, eye-catching element." Request for Reconsideration, 9.

Applicant also points to the alternative competitive configurations of other baby carriers as evidence that applicant's design is not essential to the use or purpose of its product. Some of these alternative designs are shown below.



Serial No. 75751554





With respect to any advertising claims made by applicant, applicant maintains that statements concerning strap comfort, the ease of baby removal and adjustability are irrelevant in view of applicant's amended drawing and description, which no longer claim those features as part of the mark.

Assuming that applicant's asserted mark is not found functional, applicant maintains that the design aspects of its mark have acquired distinctiveness. Applicant points to its cumulative sales in the U.S. over 12 years of more than one million units and advertising expenditures approaching \$2 million. For example, in 2002, applicant spent \$428,000 in advertising all of its products, about 90 percent of which was for its baby carrier. In addition, its marketing materials have included photographs showing

Serial No. 75751554

the flap configuration. It is applicant's position that the flared front panel of its baby carrier as well as the dual vertical stripes are extremely well-known in the baby care industry and that the public has come to recognize these design features as indicating source. Further, no similar marks have been registered by third parties, according to applicant. Applicant also points to what it characterizes as an unsolicited consumer review:

This now famous carrier has been touted in all the magazines of must haves. Easily recognizable as a brand name from afar the Bjorn certainly looks attractive and comes in different color patterns.

Exhibit C, from epinions.com Web site, attached to applicant's Request for Reconsideration. Applicant's Request for Reconsideration also contains a number of photographs of celebrities wearing applicant's baby carriers.

Functionality Discussion and Analysis

Upon careful consideration of this record, including applicant's more relevant patent and applicant's advertising, we conclude that the flap design sought to be registered is functional as a whole. The curved top of the flap is clearly designed for and promoted as providing support for the baby's head. In addition, the openings near the top of the flap are intended to be used as arm

Serial No. 75751554

openings for the baby. These openings are clearly functional. Because the flap narrows near the bottom, the baby's legs may easily be placed on either side of the flap.

While it is true that the Examining Attorney has only speculated about the purpose of the vertical stitching or stripes, shown in white in applicant's drawing, applicant has not sought registration of only these two stripes as its trademark. Rather, applicant claims that the entire flap configuration, as well as the two stripes shown thereon, is its trademark. Because applicant is seeking registration of the entire flap design, which we find to be de jure functional, registration on this application cannot be permitted even if the stripes are ornamental, incidental or arbitrary.

With respect to the existence of alternative designs of baby carriers, as noted above, the existence of such alternatives does not mean that applicant's product design is nonfunctional. In view of the evidence establishing the functionality of applicant's flap design, these alternative designs do not show that applicant's flap design is not functional.

Acquired Distinctiveness

While we have affirmed the functionality refusal, applicant has also sought registration on the basis that its design has acquired distinctiveness. Because applicant's design is functional, any evidence of distinctiveness is of no avail to applicant in support of registration. See *TrafFix*, 58 USPQ2d at 1007 ("Functionality having been established, whether MDI's dual-spring design has acquired secondary meaning need not be considered"). Therefore, even if there were evidence sufficient to demonstrate acquired distinctiveness, it would not permit the registration of a functional design. However, for the sake of completeness, should applicant appeal and ultimately prevail on the issue of functionality, we will discuss applicant's contention that its design has acquired distinctiveness.

At the outset, we observe that a product configuration is not inherently distinctive, and is entitled to registration on the Principal Register only upon a showing of acquired distinctiveness under Section 2(f). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). Further, the burden of establishing acquired distinctiveness is upon the applicant, who must establish acquired distinctiveness by a

Serial No. 75751554

preponderance of the evidence. *Yamaha International Corporation v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Acquired distinctiveness or secondary meaning occurs when "in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, *supra*.

As noted above, applicant has pointed to its sales in the U.S. for over 12 years of over one million units and advertising expenditures of about \$2 million. In 2002, applicant spent about \$400,000 in advertising for its baby carrier.

The claim that applicant has been using a design for a long period of substantial and exclusive use does not, by itself, demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001)(66 years of use). In addition, the mere fact that applicant has sold over 200,000 units in a recent year is not in and of itself persuasive since we have no evidence of the percentage of the market this number of baby carriers represents. *Id.* ("As for the sales of 10,000 in a two-year period, again there is no evidence to show whether this is a large number of sales of guitars

Serial No. 75751554

vis-à-vis the sales of other companies"). Even if these sales figures were significant, it would not establish that the applicant's design was the basis for the success. *M-5 Steel Mfg. Co. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1098 (TTAB 2001)("[W]hile applicant's sales may demonstrate popularity or commercial success for its roof vents, such evidence alone does not demonstrate that the vents' designs which applicant seeks to register have become distinctive of its goods and thus function as source indicators"). That is, mere sales volume alone does not establish recognition of a mark and may be readily attributable to the desire of purchasers to acquire the product.

Also, applicant's ads do not contain any indication "that [applicant] has promoted the asserted product designs as trademarks, and we have no evidence that consumers have come to recognize applicant's designs as indications of origin." *M-5 Steel v. O'Hagin's*, *supra*, at 1098. It is not clear if prospective purchasers would even recognize applicant's flap design as a trademark, especially since we observe no "look-for" advertising calling attention to those features of applicant's baby carrier which it maintains is its mark. One unsolicited consumer comment that applicant's product is "easily recognizable as a brand name from afar" is not sufficient to show that applicant's

Serial No. 75751554

front flap of its baby carrier has become distinctive and is a trademark.

We cannot say that applicant's showing of acquired distinctiveness is sufficient to demonstrate that, even if the product design is not considered functional, the design of the flap has acquired distinctiveness.

Decision: The refusal to register applicant's design on the Principal Register on the basis that it is de jure functional is affirmed. If the mark is not functional, the refusal to register the mark on the ground that it has not acquired distinctiveness is also affirmed.