

THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB

Hearing:
April 1, 2010

Mailed:
July 27, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Becton, Dickinson and Company

Serial No. 77254637

Mark D. Engelmann of Fross Zelnick Lehrman & Zissu, P.C.
for Becton, Dickinson and Company.¹

Jennifer M. Hetu, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Mermelstein, Wellington, and Ritchie,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On August 14, 2007, Becton, Dickinson and Company,
applicant, applied to register the configuration mark shown
below on the Principal Register for goods identified as
"closures for medical collection tubes" in International
Class 10.²

¹ Charles T.J. Weigell (of the same law firm) appeared on behalf
of applicant at oral hearing.

² Application Serial No. 77254637, based on an allegation of
first use anywhere and in commerce on September 30, 1989.

Serial No. 77254637



The required description of the mark (as amended) reads as follows:

The mark consists of the configuration of a closure cap that has an overall streamlined exterior wherein the top of cap is slimmer than at the bottom and the cap features vertically elongated ribs set out in combination sets of numerous slim ribs bordered by fatter ribs around most of the cap circumference, where a smooth area separates sets of ribs. The slim ribs taper at their top to form triangular shapes which intersect and blend together at a point where a smooth surface area rings the top of the cap above the ribs, thus extending the cap's vertical profile. At the bottom, a flanged lip rings the cap and protrudes from the sides in two circumferential segments with the bottom-most segment having a slightly curved contour. The matter in dotted lines is not claimed as a feature of the mark, but shows the tube on which the closure is positioned.

Serial No. 77254637

(The proposed mark is hereinafter frequently referred to as the "closure cap configuration mark.")

The application includes a claim that the closure cap configuration mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

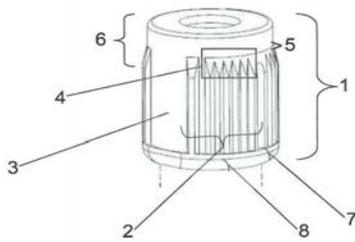
The trademark examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), on the ground that applicant's proposed mark is functional. The examining attorney also refused registration on the alternative ground that, if the mark is not functional, the mark nonetheless consists of a non-distinctive configuration of the goods that does not function as a mark under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052 and 1127, and has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f).

Applicant concurrently appealed and filed a request for reconsideration that included a proposed amended description of the mark in the application. The examining attorney accepted the amendment (so that it reads as recited above), but rejected the request for reconsideration to the extent that she maintained the refusals to registration. Both Applicant and the Examining Attorney filed briefs, including applicant's supplemental

reply brief filed after the request for reconsideration was denied. Applicant and the examining attorney took part in an oral hearing on April 10, 2010.

The Mark and the Goods

Before discussing the merits of the grounds for refusal, we believe it is important to discuss what exactly applicant is seeking to register as well as the nature of the goods. As to the proposed mark itself, there is no dispute that it represents a configuration of the goods, i.e., a closure cap for collection tubes. Applicant places emphasis on certain features of the mark. In its supplemental reply brief, applicant provided the following illustration of what it believed are the key features of the closure cap configuration mark, "as guided by [the] amended description":³



³ Supplemental Reply Brief, pp. 3-4, filed October 28, 2009. Applicant describes the features as: (1) "an overall streamlined exterior"; (2) "vertically elongated ribs set out in combination..."; (3) "a smooth area separates sets of ribs"; (4) "slim ribs taper at their top..."; (5) "...a smooth surface area rings the top of the cap"; (6) "extending the cap's vertical profile"; (7) "...a flanged lip rings the cap"; and (8) "...having a slightly curved contour." *Id.*

Serial No. 77254637

Although the above-numbered features are described in a precise and helpful manner in the application, this does not mean that they are the only elements of the mark nor does it mean that they necessarily embody the overall significance of the mark. Rather, the proposed mark is as described in the application's description of the mark, as well as that which is shown in the drawing page, except for the dotted line portion which only represents where the closure is positioned on the collection tubes. Upon inspection of the drawing, we see other features of the closure cap configuration mark such as the circular opening on the top of the cap as well as the ridges themselves. Had applicant not sought to register these components, in addition to those identified in the description, it should have depicted those features in dotted lines to indicate that they were not being claimed as part of the mark. Trademark Rule 2.52(b)(4); see TMEP § 1202.02(c)(i) ("Drawings of three-dimensional, configuration, and trade dress marks may not contain elements that are not a part of the mark. If the mark comprises the design of only a portion of a product or container, broken or dotted lines must be used in the drawing to indicate that portion of the product that is not part of the mark.") Accordingly, when considering the merits of the refusal to register, we must

consider all elements, including those described in the application as well as those shown in the drawing page.

As to the nature of the proposed mark, the record establishes that it is a configuration of applicant's collection tube closure caps that are sold under the brand HEMOGARD. The proposed mark essentially represents the outer shell portion of the HEMOGARD closure caps. Within the outer shell is a stopper that plugs (and seals) the collection tube when the closure cap is positioned on the tube. The stopper is not shown in applicant's proposed mark and thus is not considered to be a feature of it.

Functionality

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 Prods. Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). Functional matter cannot receive trademark protection. At its core, the functionality doctrine serves as a balance between trademark and patent law. As the Supreme Court explained in *Qualitex*:

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, 35 U.S.C. §§154, 173, 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).

34 USPQ2d at 1163.

The examining attorney argues that the closure cap configuration mark represents a design with features that are utilitarian. In particular, she argues "the shield design of the cap makes opening a medical collection tube safer, ridges on the cap allow for an improved grip, and the hooded feature of the cap prevents the user's glove from getting caught when closing the collection tube." Brief, (unnumbered) p. 3. The examining attorney relies greatly on applicant's brochures touting features of the HEMOGARD brand closure caps. And, in response to declarations submitted by applicant purportedly showing that the proposed mark's design features were not dictated by utilitarian purpose, the examining attorney counters that "[d]espite the motivating factor behind including such design features, [they] are utilitarian in nature." Brief, (unnumbered) p. 6.

Applicant, on the other hand, argues that the examining attorney "relies on an improper application of law of functionality and an incomplete consideration of the record." Reply Brief, p. 1. Specifically, applicant cites several cases and argues that its proposed mark cannot be deemed functional merely because the goods that embody the mark serve a utilitarian purpose. Applicant also disputes the examining attorney's reliance on applicant's advertising because, applicant asserts, those advertisements do not highlight the features of the proposed mark but instead reference "closure caps in general." *Id.* at p. 2. Ultimately, applicant concludes, "when considered as a whole, [the proposed mark] has an appearance that is not defined by its utilitarian purpose." Supp. Reply Brief, p. 3.

In making our determination as whether a proposed mark is functional, the following four factors are considered:

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

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). See also, *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002). Upon consideration of these factors, our determination of functionality is ultimately a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Engineering*, 278 F.3d at 1273, 61 USPQ2d 1424; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); see also, TMEP §1202.02(a)(iv).

Furthermore, and particularly relevant to this proceeding, to be held functional, it is not necessary that all features of a product or packaging configuration mark be functional; that is, should the proposed mark contain arbitrary or otherwise nonfunctional features, this will not affect the determination where the evidence shows the overall design to be functional. See *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1024-27, 224 USPQ 625, 628-30 (Fed. Cir. 1985); *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 368 (TTAB 1985).

With the above principles in mind and based on the record before us, we conclude that the closure cap configuration mark, considered in its entirety, is functional.

As to the factor involving the existence of any utility patent that discloses utilitarian advantages of the closure cap configuration mark, the record reveals that applicant is the owner of three utility patents involving closure caps for collection tubes.⁴ Applicant argues that none of these patents, however, "claim any of the surface features depicted in the drawing of the Mark." Response to Office Action (dated April 18, 2008). The examining attorney does not argue the relevance of these utility patents in her appeal brief. Nevertheless, a review of the patents indicates that several features of the closure cap configuration mark are indeed guided by utilitarian concerns. In particular, patent No. 4741446 ("Computer Generated Stopper," hereinafter, "patent '446"),⁵ contains the following drawing:

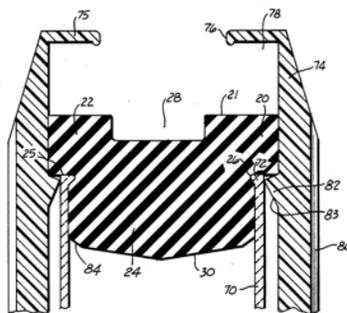


Fig. 3

⁴ Patents Nos. 4741446 (issued May 3, 1988), 6602206 (issued August 5, 2003), and 4991104 (issued February 5, 1991). Copies thereof attached to applicant's Response to Office Action (dated April 18, 2008).

Referencing this illustration, the patent provides the following description of utilitarian advantages:

Extending over the top of stopper 20 is a plastic cap assembly 74 which may be comprised of a flexible thermoplastic resin, and which includes a radially extending top 75 for extending over the top surface 21 of stopper 20. This radially extending top surface 75 defines an opening 76 through which a needle may pass to be inserted into and through stopper 20. This "overhang" 75 of the plastic cap of the assembly of the invention serves to define a compartment or area 78 for receiving and containing any blood droplets or blood aerosol which may develop during the insertion and removal of needles through stopper 20. Also, the top finger well 28 of stopper 20 serves to enhance this containing function of the assembly shown.

As can be seen in FIG. 3, the bottom surface 30 of stopper 20 may have an annular tapered end edge portion 84 for ease of insertion of the lower portion 24 of stopper 20 into the top of tube 70. Formed on the outer surface of the cap 74 are a plurality of circumferentially spaced ribs 80 which serve to provide a gripping surface for the assembly for removing the assembly from tube 70.⁶

Claim 4 of the '446 patent, describes a "closure assembly for evacuated tubes for receiving samples of body fluids characterized by...":

- (f) a flexible cap body for mounting on said stopper body;
- (g) said cap body having an open end and a substantially closed end;
- (h) said open end for receiving said stopper body;
- (i) said closed end having a needle receiving bore in the top surface thereof;...

⁵ Issued May 3, 1988 to applicant (as assignee).

⁶ We note that the patent does not show or illustrate the same pattern as that depicted in the proposed mark.

We find the above-detailed description with illustration, along with the claims, in patent '446 to be relevant in our analysis because it explains the utilitarian nature of at least two prominent features of applicant's closure cap configuration mark. First, the drawing depicts two concentric circles prominently and clearly located at the top of the closure cap configuration mark. As explained in patent '446, this is the "radially extending top of the closure cap" (identified as "75" in patent '446) and contains an opening (identified as "76" in patent '446), through which a needle may pass to be inserted into and through the stopper (located inside the closure cap's shell). Thus, the circular opening represents an opening in the closure cap to allow for needle to puncture the cap and access the specimen contained in the collection tube. Second, patent '446 describes the function of the ribs, namely, that "a plurality of circumferentially spaced ribs...serve to provide a gripping surface" for inserting (or removing) the caps to (or from) the collection tubes. We find the first Morton-Norwich factor to weigh in favor of finding the mark to be functional.

We turn now to the second Morton-Norwich factor regarding any advertising materials in which applicant

touts the design's utilitarian advantages. The examining attorney has effectively pointed out passages in applicant's advertising that extol the utilitarian advantages of several design features of the proposed mark. For example, one advertisement states, in part:⁷

With the new HEMOGARD Closure, the rubber stopper that seals the tube is covered by a plastic shield - an important design innovation that keeps blood safely contained within the closure and allows Hematology Lab professionals to handle specimens with a new feeling of confidence.

...

Enhanced handling features - inherent in the design

Ridges on the outer surface of the HEMOGARD[®] Closure permit a more secure grip. The special closure design encourages safer opening of the tube by discouraging use of the "thumb roll" technique, which can result in blood splattering. And, the "hooded" feature of the closure reduces the possibility of pinching gloves between stopper and tube when reclosing.

(Bold and underlining in original.)

The features being touted by applicant in its advertisements are clearly depicted in the mark, as shown on the drawing page. That is, the "ribs" or "ridges" on the side of the cap are clearly designed to allow for a more secure grip. Another design feature of applicant's

⁷ Attached as "Exhibit A" to Office Action dated May 16, 2008 (and originally submitted with applicant's April 18, 2008, response to Office Action).

Serial No. 77254637

proposed mark, as extolled in the advertisement, is that it discourages use of a "thumb roll" - that is, the flanged lip at the bottom of the closure cap configuration mark inhibits the ability of the handler of the collection tubes from popping off ("thumb roll") the cap with the thumb. This reduces the risk of potentially dangerous splattering of specimen fluids. Finally, there is what applicant calls the "hooded" feature of the proposed mark that helps reduce "the possibility of pinching gloves between the stopper and tube when reclosing." We find the second Morton-Norwich factor to also weigh in favor of finding the mark to be functional.

There is little argument or evidence to establish as to whether the closure cap configuration mark is a design resulting from a comparatively simple or inexpensive method of manufacture. In its brief, applicant does state that there is "no comparative economy of manufacture reflected in Applicant's closure design, and the design does not result from a simpler or cheaper method of manufacture." Brief, p. 12. Applicant relies on the declarations of Messrs. Jaeger and Newby who each make the following identical averment, "[n]one of these design features...lower its cost of manufacture." The examining attorney does not argue to the contrary and there is no

evidence suggesting that the proposed mark derives from a less expensive method of manufacture of the closure caps. Thus, we cannot and do not weigh this third Morton-Norwich factor in favor of finding that applicant's proposed mark is functional.

As to the final Morton-Norwich factor, applicant has submitted evidence of what it argues are "alternative designs for specimen cap closures for blood collection tubes that vary considerably from Applicant's mark in their shapes, sizes, and features." Brief, p. 11 (referencing Exhibits B and D, respectively, of its Request for Reconsideration and Response to Office Action, filed April 18, 2009). The evidence is comprised of printouts from websites and reveals three third-party collection tube products. One website identifies the product as a "Micro Vacuum Blood Collection Tube" and contains a side-view photograph of a cap on a collection tube. The cap contains evenly and circumferentially placed ribs on the side of the cap, but for one larger and more rounded rib. There is also what appears to be a lip or rounded portion at the bottom of the cap, similar in appearance to that depicted in applicant's proposed mark.

A second website shows a product called SAF-T-FILL, used for capillary blood collection. It is a "single-use

only" product, pre-assembled with a straw for collecting blood. Essentially, the SAF-T-FILL product is "used to collect blood samples from finger and heel sticks [punctures into the skin]." Thus it is clear that this product is different than applicant's collection tube cap and involves different design needs than applicant's collection tube cap. Accordingly, it lacks relevance for purposes of showing an alternative design that performs the same function as the goods represented by applicant's collection tube closure cap.

Finally, the third website shows a collection tube cap made by Greiner Bio-One GmbH and is advertised under the mark VACUETTE.⁸ In its brief, applicant argues that "the differences are clear" between the VACUETTE closure cap design and its own closure cap (represented by applicant's VACUTAINER closure cap). Brief, p. 11. Applicant attempts to describe some of the differences; however, a review of applicant's closure cap configuration mark vis-à-vis the VACUETTE closure cap reveals many more similarities than discernable contrasting features. For example, both closure caps contain series of circumferential ribs on the

⁸ Actual examples of applicant's VACUTAINER closure cap and the VACUETTE closure cap were submitted at oral hearing; the examining attorney did not object to the introduction of these caps as evidence.

Serial No. 77254637

sides that are bookended by a larger more pronounced rib. A smooth area on the side of both closure caps separates the series of ribs. Applicant argues that the ribs are shaped differently and placed in a different pattern, but such slight differences are barely discernable to the eye. Furthermore, both closure caps contain the same design of an opening on the top of the cap (represented in applicant's drawing as two concentric circles); said opening allows for the insertion of a needle through the stopper to access the specimen in the collection tube. Both the VACUETTE closure cap and applicant's drawing contain an accentuated bottom lip portion of the cap. Applicant again argues that the lip on its closure cap is "more pronounced," but a visual inspection of the two reveals very little discernable difference. Applicant argues that its closure cap "has a longer more streamlined profile" than the VACUETTE closure cap and, indeed, when placed side-by-side, applicant's closure cap is taller and appears to be slightly narrower at the top. Nevertheless, when comparing the two closure caps, there are far more similarities than distinguishable characteristics and one would be hard pressed to characterize the VACUETTE closure cap as an alternative design.

Ultimately, the record does not establish that there are alternative designs for collection tube closure caps. Rather, the evidence tends to show that collection tube closure caps are likely to have ribs or ridges on the side (to allow for a better grip) as well as an opening on the top of the cap (for insertion of a needle to access the specimen through the stopper). These features, as previously explained, are clearly utilitarian. Any variation thereof, e.g. the spacing or shape of the ridges, size of the lip, at least with respect to applicant's closure cap configuration mark, appears to only be incidental to the overall adoption of those features. We find the fourth and final Morton-Norwich factor to weigh in favor of finding the mark to be functional.

Applicant places great emphasis on the facts and actual decision in *Morton-Norwich*. In that case, the Federal Circuit contemplated the mark's overall importance and ultimately concluded that the configuration of the spray bottle, based largely on the bottle's neck design, was not functional.

What is sought to be registered, however, is no single design feature or component but the overall composite design comprising both bottle and spray top. While that design must be accommodated to the functions performed, we see no evidence that it was dictated by them and resulted in a functionally or economically superior design of such a container.

Morton-Norwich, 671 F.2d at 1342.

Unlike in *Morton-Norwich*, the overall design of applicant's proposed mark is dictated by utilitarian concerns. While there may be some incidental design features of the mark that are not entirely functional (such as the length of the cap or the exact spacing of the ribs), they are hardly noticeable and the "overall composite design" engendered by applicant's proposed mark is functional.

In sum, based on all of the record evidence and arguments in relation to the *Morton-Norwich* factors, we find that the examining attorney has met her burden in establishing a prima facie case that the closure cap configuration mark is functional and, thus, is not registrable.

Because we have affirmed the functionality refusal, it is unnecessary to reach a decision as to whether the closure cap configuration mark has acquired distinctiveness; in other words, even if there were evidence sufficient to demonstrate acquired distinctiveness, it would not permit the registration of a functional design. See, e.g., *TrafFix*, 58 USPQ2d at 1007 ("Functionality having been established, whether [the mark]

has acquired secondary meaning need not be considered"). Nevertheless, for the sake of completeness and should applicant ultimately prevail on the issue of functionality, we will address the examining attorney's refusal to accept applicant's Section 2(f) acquired distinctiveness showing.

Acquired Distinctiveness

A product design, "like color, is not inherently distinctive." *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). Applicant admits as much by seeking registration under Section 2(f). *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007) (application under § 2(f) is a concession that the mark is not distinctive). Thus, the issue is not whether the proposed mark is inherently distinctive, but whether the design has acquired distinctiveness, *i.e.*, whether the relevant consumers view the configuration of applicant's goods as a trademark. And, on this issue, it is applicant's burden to prove that the proposed mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant").

It is noted that the lesser the degree of inherent distinctiveness of a mark, the heavier the burden for

applicant to prove that its proposed mark has acquired distinctiveness.

[T]he statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence. As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (citations omitted). Applicant has a heavy burden in this case inasmuch as there is no evidence to suggest that the configuration of collection tube closure caps (or any other types of caps) are frequently - or ever - used as source identifiers in the relevant industry. Moreover, the design features of applicant's closure cap that it claims to have acquired distinctiveness consist primarily of attributes that can be frequently found on closure caps. To wit, the closure cap of applicant's competitor (the "Greiner" cap) has several uncannily similar features. And, even if the features of applicant's proposed mark are ultimately not found to be "functional" under Trademark Act § 2(e)(5),

they do perform a function and thus consumers may be more inclined to only perceive that feature as utilitarian in nature and not as a source identifier.

In support of its argument that the closure cap configuration mark has acquired distinctiveness, applicant relies on the declaration of its Vice President and Chief Intellectual Property Counsel, David W. Hight, with attached exhibits;⁹ In his declaration, Mr. Hight avers, *inter alia*, that applicant has made "substantially exclusive and continuous" use of the closure cap configuration mark since 1989; that sales of products featuring the closure cap configuration mark for the past five years "exceed eighty million dollars (\$80,000,000) and sales have grown more than 40% during this time"; that applicant's annual advertising and promotion expenditures for the same products have been substantial (exceeding \$1,500,000 per year for the past five years); that applicant "seeks to feature and exhibit [its proposed mark] prominently in its [advertising]"; and that "the closure cap was awarded the Industrial Designers Society of America bronze medal in 1990." The exhibits to the Hight declaration include samples of applicant's advertisements,

⁹ Submitted with applicant's Response to Office Action (dated April 18, 2008).

Serial No. 77254637

as well as what Mr. Highet describes as a “page exhibiting Applicant’s Design from the Society’s Designing for Humanity book detailing past award recipients.” Applicant also submitted eleven signed declarations from customers and users of applicant’s HEMOGARD closure caps.¹⁰

Upon careful consideration of all of the submissions by applicant, in addition to the arguments set forth on appeal, we agree with the examining attorney that the evidence “does not establish that the public views the product configuration as identifying the source of the product rather than the product itself.” Brief, (unnumbered) p. 15. In particular, we agree that applicant’s mere use of a design, even for a long period, by itself, does not demonstrate that the mark has acquired distinctiveness. *See In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use and also of a product configuration). Moreover, although applicant’s evidence regarding sales and number of units sold is impressive, certainly in numbers, the persuasive value of this evidence is diminished by the lack of evidence showing applicant’s market share or information to place the sales numbers in context. *Id.* (“As for the sales of 10,000 [guitars] in a two-year period, again there is no evidence

¹⁰ Attached to its Request for Reconsideration.

Serial No. 77254637

to show whether this is a large number of sales of guitars vis-à-vis the sales of other companies"). And, even acknowledging that applicant's success in selling many closure caps, this would not establish that the applicant's design was the basis for the success. *M-5 Steel Mfg., Inc. 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"). In other words, and as often stated, a successful product and advertising campaign do not necessarily translate into a product design acquiring secondary meaning. See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark); *Braun Inc. v. Dynamics Corp.*, 975 F.2d 815, 827, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) ("[L]arge consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun."); *In re Bongrain*

Serial No. 77254637

Int'l (American) Corp., 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin).

It is even more difficult to extrapolate from evidence of substantial sales and advertising numbers that a product configuration mark has acquired distinctiveness when the record is devoid of "look for" advertisements. The Board and other courts have long taken notice of the importance of such advertisements in regard to configuration or product design marks. See *Duraco Prods. Inc. v. Joy Plastic Enter., Ltd.*, 40 F.3d 1431, 1451, 32 USPQ2d 1724, 1741 (3d Cir. 1994) (advertising expenditures "measured primarily with regard to those advertisements which highlight the supposedly distinctive, identifying feature" of the product configuration); see also, *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662, 36 USPQ2d 1065, 1071-72 (7th Cir. 1995) (advertising "look for the oval head" for cable ties encourages consumers to identify the claimed trade dress with the particular producer); *First Brands Corp. v. Fred Meyer Inc.*, 809 F.2d 1378, 1383, 1 USPQ2d 1779, 1782 (9th Cir. 1987) ("[A]dvertising campaign has not stressed the color and shape of the antifreeze jug so as to support an inference of secondary meaning.");

Serial No. 77254637

Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342, 1345 n. 8, 196 USPQ 289, 291 n. 8 (CCPA 1977) (advertising emphasizing design portion of the mark to potential customers is persuasive evidence of acquired distinctiveness).

Applicant asserts that its advertisements "feature" or "prominently" display the proposed mark, but the examining attorney is correct in her rebuttal that none of these advertisements display the closure caps in such a manner whereby consumers would regard the closure cap configuration as a source indicator. However, as already mentioned, product configurations are generally not viewed as trademarks (*i.e.*, they are not inherently distinctive), and thus the product itself (or a picture of it) - without more - will rarely, if ever, be sufficient evidence of acquired distinctiveness. In applicant's advertisements, any mention of applicant's closure cap design or specific features that applicant argues constitute the applied-for mark is made in the context of touting the closure cap's utilitarian advantage. That advantage is presented in terms of permitting the safe handling of blood specimens. For example, one advertisement titled "INTRODUCING VACUTAINER BRAND TUBES WITH HEMOGARD CLOSURE" offers the following description (with a photograph of the closure and

tube alongside) :

Exposure of laboratory professional to contaminated blood specimens has become a well-documented safety concern. VACUTAINER Brand Tubes with HEMOGARD Closure were specifically created to address this concern. The quality and reliability of the VACUTAINER Brand System are maintained, but with an important innovation: A plastic shield that protects personnel from exposure when handling blood specimens.

And, as the examining attorney points out, several other advertisements contain close-up depictions of the closure caps, but in a "cut away" or tilted view that results in the outside of the closure cap not even being shown, i.e., the applied-for mark cannot be seen. Accordingly, we cannot conclude that applicant's advertisements amount to an attempt to have consumers recognize the closure cap configuration as indicating the source of the closure caps.

As to the "Industrial Designers Society of America bronze medal" award from 1990, we have little, if any, evidence what this award was based upon or what level of recognition and exposure this award necessarily means. More importantly, there is no indication that the specific design features that applicant claims as the proposed mark were considered with respect to this award. Without such information, it is difficult to accord any significant probative value to this award in connection with the proposed mark acquiring distinctiveness.

Finally, as to the eleven declarations submitted by applicant to show that the closure cap configuration mark has acquired distinctiveness, these are insufficient by themselves or in conjunction with the totality of the record, to demonstrate that the proposed mark has acquired distinctiveness. The declarants each state that they recognize the closure cap configuration, as engendered by the HEMOGARD closure cap, and associate the design with applicant. However, nearly all of the declarations are identical in their relevant substantive paragraphs and thus do not appear to have been prepared in the signer's own words. Moreover, the declarations represent a relatively small sample of the relevant consumers and there is no evidence to suggest that this was a random selection of possible declarants. The eleven declarations have been considered; however, their evidentiary value is simply insufficient given the relatively high burden applicant has in establishing that the proposed mark has acquired distinctiveness.

Upon review of all of the evidence and arguments in this case, we affirm the examining attorney's alternative refusal that, should the mark ultimately be shown to not be functional, applicant has not met its burden in establishing that its mark has acquired distinctiveness.

Serial No. 77254637

Decision: We affirm the refusal to register the asserted mark under Trademark Act Section 2(e)(5) on the ground of functionality. In the event that applicant's proposed mark should be determined to not be functional in any appeal of this decision, we further find the mark has not acquired distinctiveness and is not entitled to registration under Section 2(f).