

**THIS DISPOSITION
IS NOT A PRECEDENT
OF THE TTAB**

Oral Hearing:
December 6, 2011

Mailed:
September 29, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Navy Exchange Service Command

Serial Nos. 77160754, 77160783, 77324266 and 77324270

Melanie Fix and Geoffrey McNutt for the Navy Exchange
Service Command.

Kathleen H. Lorenzo¹, Trademark Examining Attorney, Law
Office 109 (Gwen Stokels, Acting Managing Attorney).

Before Quinn, Taylor and Kuczma, Administrative Trademark
Judges.

Opinion by Taylor, Administrative Trademark Judge:

This appeal involves four applications filed on the Principal Register by the Navy Exchange Service Command ("NEXCOM" or "applicant"), a component of the Navy, to register marks consisting of or including the Navy's four-color pixilated pattern mark.

¹ Ms. Lorenzo represented the Office at the oral hearing with respect to all four applications and, additionally, is the examining attorney that was responsible through briefing for application Serial Nos. 77160754 and 77160783. Wendy Goodman is the examining attorney that was responsible for Application Serial Nos. 77324266 and 77324270 through briefing.

Serial No. 77160754, 77160783, 77324266, etc.

Application Serial No. 77160754,² for the mark shown below, includes the following description, as amended (more fully discussed, *infra*):

The mark consists of a bald eagle perched, with wings spread, on an anchor in front of a schooner ship with USN, the literal element of the mark, below the design, all of which appear in the color deck grey and set against a light grey portion of the background that consists of irregular block-shaped pixels that consist of a four-color pattern of black, deck grey, light grey and navy blue, the pattern being applied to all or part of the surface of the goods.

Applicant also submitted a statement in the application that "The color(s) black, deck grey, light grey and navy blue is/are claimed as a feature of the mark."



² Application filed April 19, 2007, asserting a bona fide intention to use the mark in commerce. Applicant subsequently filed a statement of use claiming December 15, 2008, as the date of first use of the mark anywhere and in commerce.

Although the prosecution history of the application indicates that the examining attorney accepted, as sufficient, applicant's claim of acquired distinctiveness under Section 2(f) of the Act, the automated records of the USPTO were never updated. These records will be amended to reflect the Section 2(f) claim.

Serial No. 77160754, 77160783, 77324266, etc.

Application No. 77160783,³ for the mark shown below, includes the following description, as amended (more fully discussed, *infra*):

The mark consists of irregular block-shaped pixels that consist of a four-color pattern of black, deck grey, light grey and navy blue, the pattern being applied to all or part of the surface of the goods.

Applicant also submitted a statement in the application that "The color(s) black, deck grey, light grey and navy blue is/are claimed as a feature of the mark."



Both applications cover goods identified as "uniforms, caps, blouses, trousers, parkas, all sold to authorized patrons of the military exchanges pursuant to Armed Services Exchange Regulations" in International Class 25.

³ Application filed on April 19, 2007, claiming a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b). Applicant subsequently filed a statement of use claiming December 15, 2008, as the date of first use of the mark anywhere and in commerce.

Although the prosecution history of the application indicates that the examining attorney accepted, as sufficient, applicant's claim of acquired distinctiveness under Section 2(f) of the Act, the automated records of the USPTO were never updated. These records will be amended to reflect the Section 2(f) claim.

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Application Serial No. 77324266,⁴ for the mark shown below, includes the following description, as amended (more fully discussed, *infra*):

The mark consists of irregular block-shaped pixels in a four-color pattern of black, deck grey, light grey and navy blue, which pattern repeats and covers the entire surface of the goods.



Applicant also submitted a statement in the application that "The color(s) black, deck grey, light grey and navy blue is/are claimed as a feature of the mark."

Application Serial No. 77324270,⁵ includes the following description, as amended (more fully discussed, *infra*):

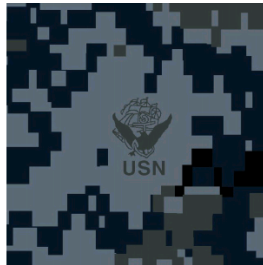
⁴ Application filed on November 8, 2008, with a claim of a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b). Applicant subsequently filed a statement of use, claiming December 15, 2007 as the date of first use of the mark anywhere and in commerce. Thereafter, applicant claimed acquired distinctiveness pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f), which claim was accepted by the examining attorney.

⁵ Application filed November 8, 2007, asserting a bona fide intention to use the mark in commerce. Applicant subsequently filed a statement of use claiming December 15, 2008, as the date of first use anywhere and in commerce. Thereafter, applicant claimed acquired distinctiveness pursuant to Trademark Act

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The mark consists of a bald eagle perched, with wings spread, on an anchor in front of a schooner ship with 'USN', the literal element of the mark, below the design. The outline of the ship and anchor appears in Deck Grey, set against a Light Grey portion of irregular block-shaped pixels in a four-color pattern that repeats and covers the entire surface of the goods. The bald eagle has Deck Grey wings, chest, and head, and Light Grey eyes. The color deck grey appears in the wording 'USN' and in the design of the schooner ship, anchor, and bald eagle set against a light grey portion of the irregular block-shaped pixels that consists of a four-color pattern of black, deck grey, light grey, and navy blue, the pattern being applied to all or part of the surface of the goods.

Applicant also submitted a statement in the application that "The color(s) black, deck grey, light grey and navy blue is/are claimed as a feature of the mark."



The previous two applications cover goods that are identified as "Cotton, nylon blends, and nylon fabrics which will all be used in the manufacture of merchandise, including but not limited to clothing, to be sold to

Section 2(f), 15 U.S.C. § 1052(f), which claim was accepted by the examining attorney.

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authorized patrons of the military exchanges pursuant to Armed Services Regulations" in International Class 24.

As detailed below, all four applications are on appeal on the ground that the pixilated pattern is functional as a matter of law under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(2). Additionally, application Serial Nos. 77160754 and 77160783 are also on appeal based on requirements for more accurate descriptions of the marks.

At the request of applicant, because the marks, facts and issues in each appeal were substantially the same, the appeals were consolidated for an oral hearing held December 6, 2011.⁶ We will issue a single opinion for all four applications, but will take into account the differences in the facts and issues in each application.

APPLICATION SERIAL NUMBERS 77160754, 77160783, 77324266 and 77324270

Prosecution Histories

We turn then to the merits of the appeals in Application Serial Nos. 77160754, 77160783, 77324266 and 77324270. We note that the prosecution histories with

⁶ The December 6, 2011, oral hearing included a fifth proceeding involving an appeal filed in Application Serial No. 77160763 for a mark that includes the same four-color pixilated pattern at issue in this decision. However, for the reasons explained in a concurrently issued remand order in Application Serial No. 77160763, that proceeding is not ready for final decision.

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respect to application Serial Nos. 77160754 and 77160783 are virtually identical.⁷ Both applications were originally filed based on applicant's intent to use the marks in commerce. After publication, with no opposition having been filed, a notice of allowance issued in each case. Upon review of the statement of use filed in each application, the examining attorney refused registration of each mark on the grounds that it is functional under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(2), and that it is a decorative or ornamental feature of the goods under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051-1052, 1127. The examining attorney also required new drawings depicting placement of the marks and amended descriptions explaining what is and is not a part of the mark. Applicant argued in response that its marks were not functional or ornamental but, even if they are considered ornamental, they had acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Applicant provided evidence to support its Section 2(f) claims. In a

⁷ We particularly point out that both applications, for marks for clothing items for patrons of military exchanges, were handled by the same examining attorney (Ms. Lorenzo) on virtually identical records and briefs.

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subsequent Office Action issued in each case, the examining attorney issued a requirement for a more accurate description of the mark that refers to the "repeating pattern" in the marks. Applicant ultimately satisfied the requirements for new drawings and overcame the ornamental refusals by amending the identifications of goods and claiming in each case acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1152(f).

The examining attorney made final the functional refusals under Section 2(e)(5) and maintained the requirements for more accurate descriptions of the marks, and these are the issues on appeal.

While the virtually identical prosecution histories of application Serial Nos. 77324266 and 77324270⁸ are very similar to those of the two applications discussed above, they do contain some differences which are set forth below.⁹ Once again, both applications were originally filed based on applicant's intent to use the marks in commerce. After publication, with no opposition having

⁸ These two applications for fabrics were handled by the same examining attorney (Ms. Goodman) on virtually identical records and briefs.

⁹ Although the prosecution histories are a bit different, the records and briefs of all four proceedings are virtually identical. Accordingly, unless otherwise indicated, specific arguments and exhibits are taken from the record in Application Serial No. 77160754.

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been filed, a notice of allowance issued in each case. Upon review of the Statement of Use filed in each application, the examining attorney refused registration of each mark on the grounds that it is functional under Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(2), and that it is a decorative or ornamental feature of the goods under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051-1052, 1127. Applicant responded to the refusal, arguing that its marks are neither functional nor ornamental. Applicant further asserted in its responses that even if the marks are considered ornamental, they had acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and applicant provided evidence to support its Section 2(f) claims. In a subsequent Office Action issued in each case, the examining attorney rejected applicant's claim of acquired distinctiveness, maintained the functional and ornamental refusals, and raised as new issues a requirement for a more accurate description of the mark that refers to the repeating pattern, and for a substitute specimen showing use of the applied-for mark as applied to the actual goods. Applicant, in each application, ultimately satisfied the requirement for a substitute specimen and a more accurate description of the goods, and overcame the ornamental refusal by amending the

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identification of goods which led to acceptance of its Section 2(f) claims.

In each case, only the functional refusal under Section 2(e)(5) was made final.

Applicant's Marks

As noted, applicant seeks to register four marks comprising or containing an irregular block-shaped, multi-colored pixilated pattern design; two are comprised solely of the pixilated pattern (Serial Nos. 77160783 and 77324266) while the other two are comprised of a logo consisting of an anchor/U.S.S. Constitution/eagle ("ACE logo") placed above the letters "USN" set against an irregular block-shaped, multi-colored pixilated pattern design (Serial Nos. 77160754 and 77324270). The Section 2(e)(5) refusal in each application is directed solely to the pixilated pattern design. In that regard, the examining attorney contends that the additional matter in each mark that is the subject of application Serial Nos. 77160754 and 77324270, respectively, is "a small design," and the "non-functional" features do not change the overriding functional purpose of the mark as a whole.¹⁰

¹⁰ In support of this position, the examining attorneys cite to *Textron, Inc. v. U.S. Int'l Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985) and *In re Vico Products Mfg. Co., Inc.* 229 USPQ364, 368 (TTAB 1985) ("Where the evidence

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Although applicant points out that the examining attorneys ignored the ACE logo and the letters USN in those marks, applicant focuses its arguments solely on the multi-color pixilated pattern. Accordingly, we limit our discussion to the pixilated design in those applications. Additionally, because the description in each application describes the mark in whole, or in part, as consisting of irregular block-shaped pixels in a four-color pattern consisting of black, deck grey, light grey, and navy blue, we will hereafter refer to this trade dress that is the whole of, or comprises a part of, the mark in each application, collectively as the "color pattern marks."¹¹

Functionality

The examining attorneys maintain that applicant's color pattern marks are functional because they mask stains

shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features will not change the result.").

¹¹ Applicant takes issue with the examining attorneys' characterization of its marks as single color marks, instead of marks that consist of several different colors arranged in a pattern design and, by such characterization, and ignoring cases holding that a combination of colors or other trade dress elements is protectable. As just stated, applicant's marks, as described in the applications, are multi-colored pixilated pattern marks and we treat them as such, and apply the appropriate functionality analysis.

We nonetheless disagree with applicant and find the cases cited by the examining attorneys involving single color marks generally instructive as to how the Federal Circuit and the Board have applied the functionality analysis to different types of color design features.

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and wear-and-tear, and thereby, the color pattern design is essential to applicant's requirements for a neat and clean Navy uniform.¹²

Applicant, in urging reversal of the refusals, contends that the examining attorneys failed to offer sufficient evidentiary support to demonstrate a *prima facie* case that its applied-for marks are functional. Applicant specifically contends that there is no evidence to support a showing that the colors black/deck grey/light grey, and/or navy blue serve a functional purpose. Applicant further argues that to the extent that the color pattern in applicant's mark provides an advantage of hiding stains or wear and tear, this attribute is merely an incidental feature inherent to any patterned material. Lastly, applicant cites the definition of "essential,"¹³ arguing that its applied-for marks are neither absolutely necessary nor indispensable to the purpose of its goods, and that

¹² During prosecution of the applications, the examining attorneys argued that applicant's color pattern design served a traditional camouflage function, i.e., that it was intended for concealment. They indicated in their briefs that they had been assured by applicant that the color pattern is not intended to serve, and would not effectively serve, as camouflage. They accordingly stated that they would make no further argument on this basis and, we accordingly, consider that argument withdrawn.

¹³ "Essential" is defined at Dictionary.com as "absolutely necessary; indispensable." Response to Office Action, September 19, 2010, at Exh. A.

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"the plethora of alternative patterns available and the absence of a competitive need to adopt any particular color or design - including those colors and designs reflected in applicant's Mark[s] - confirm that Applicant's Mark[s are] not functional and [are] entitled to registration." Br., p. 11.

Section 2(e)(5) of the Trademark Act prohibits the registration of a mark that comprises any matter that, as a whole, is functional. 15 U.S.C. § 1052(e)(5). In general terms, the design or trade dress of a product 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. *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) citing *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982). In *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), the Court of Customs and Patent Appeals (the predecessor to our primary reviewing court) set forth four factors to be considered in determining whether a product design is functional:

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- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising material in which the originator of the design touts the utilitarian advantages of the design;
- (3) the availability to competitors of alternative designs; and
- (4) facts indicating that the design results in a relatively simple or cheap method of manufacturing the product.

The examining attorney acknowledges that determining functionality normally involves consideration of one or more of the *Morton-Norwich* factors, and correctly points out that it is not necessary to consider all the factors in every case, *TrafFix Devices*, 58 USPQ2d at 1006, or that all four factors weigh in favor of functionality. See *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2001). However, there appears to be some dispute between the examining attorneys and applicant as to whether, post *TrafFix*, the *Morton-Norwich* factor of the availability of alternative designs and their effect on competition, still plays a role in the functionality analysis.

In this regard, the Court of Appeals for the Federal Circuit, our primary reviewing court, explained that the

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Supreme Court's decision in *TraFFix* did not alter the *Morton-Norwich* analysis. The Court specifically stated:

Nothing in *TraFFix* suggests that consideration of alternative designs is not properly a 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 1428.

We thus consider whether applicant's color pattern marks are *de jure* functional by looking to the *Morton-Norwich* factors.

With regard to the first factor, the record does not contain any utility patents referencing utilitarian advantages of applicant's color pattern marks.

We next consider the second factor, applicant's advertising. In determining whether an applicant's advertising or promotional materials tout the utilitarian advantages of a product design, the advertising should clearly emphasize specific utilitarian features of the design claimed as a mark. *Goodyear Tire and Rubber Co. v.*

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Interco Tire Corp., 49 USPQ2d 1705, 1716-1717 (TTAB 1998), quoting *In re Witco Corp.*, 14 USPQ2d 1557, 1559-1561 (TTAB 1989) (the specific statements should focus directly on the advantages of the product design).

The examining attorneys point to statements made in U.S. Navy regulations and policies, press releases, and articles from the Navy's website which they assert show the importance of the "uniform display" to the U.S. Navy. The examining attorneys contend that these statements exemplify applicant's commitment to meet the "qualitative factors" for uniform development set out in Navy regulations and that applicant's color pattern marks meet the requirements of ease of maintenance, cleaning, upkeep, and tailoring, as well as the amount of space required for storage, purchase price and maintenance costs, durability and how well the uniform displays a crisp image. Those statements are set forth below. See Br. at unnumbered p. 8.

1. The *Navy Working Uniform (NWU) Concepts Frequently Asked Questions*, Task Force Uniform Public Affairs Press Release essentially states, in pertinent part:¹⁴

- A multicolored pattern was chosen because solid colors show heavy wear and wrinkles more predominantly, and often a small

¹⁴ Response to Office Action, September 19, 2009, at p. 7.

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stain or spot of paint renders a solid colored uniform not wearable.

- The specific Navy-related colors, including "deck gray" and "navy coverall blue" were thought appropriate to further identify the uniforms to their Navy source since they are colors associated with a maritime environment.
- The camouflage pattern will permit mending of small rips in uniform fabric, saving Sailors considerably in replacement costs.

2. Article 1501.5 of the United States Navy Uniform Regulations - Uniform Review and Development states:¹⁵

The Chief of Naval Operations charged the Navy Uniform Board to continually review Navy uniform matters and use the following specific qualitative factors, applicable to all uniforms to evaluate suitability of current uniforms and those proposed for replacement.

- a. Versatility. Flexibility and adaptability in terms of:
 - (1) Number of personnel wearing uniforms
 - (2) Varied Climates
- b. Safety. The ability to protect and not present a hazard to personnel.
- c. Ease of Maintenance. Laundering, cleaning, upkeep, and tailoring requirements.
- d. Storage. Amount of space required for storage.
- e. Cost. Purchase price and maintenance costs.
- f. Durability. Ability to present a neat appearance over a long period of time ...
- i. Military Appearance. How well the uniform displays a smart, crisp image.

¹⁵ Final Office Action, October 22, 2010, at pp. 9-11.

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3. Article 1101.3 of the Uniform Regulations of the U.S. Navy highlights the Navy's emphasis on the importance of the display of the uniform:¹⁶

Navy uniforms are distinctive visual evidence of the authority and responsibility vested in their wearer by the United States ... Navy personnel must present a proud and professional appearance that will reflect positively on the individual, the Navy and the United States.

4. An excerpt for the recruiting website of the U.S. Navy, www.usnavy.com, describes the Navy uniform policy in great detail, emphasizing the importance of properly maintained uniforms. It specifically states:¹⁷

Commanding officers of the US Navy inspect the clothing of E1/E2/E3 personnel at regular intervals and those of E4/E5/E6 is [sic] subject to individual inspection.

...

All naval personnel of the US Navy need to maintain neat and clean Navy uniforms and wear their respective badges, decorations, ribbons and insignias as the case may be.

5. In an excerpt from an article appearing on the official website of the U.S. Navy, entitled New Navy Working Uniform and Service Uniform Concepts Approved,¹⁸ Chief of Naval Operations Adm. Mike Mullen noted, with respect to the New Navy Working Uniform: "Durability, safety, ease of wear and cleaning were all factors that weighed heavily on my

¹⁶ *Id* at p. 14.

¹⁷ *Id* at pp. 7-8.

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mind... Additionally, Master Chief Petty Officer of the Navy, Terry Scott, stated: "[W]e've created a uniform that's also easier to maintain, is longer lasting, helps reduce the size of the sea bag, while at the same time recognizing the tradition and heritage of serving in the Navy."

While these statements clearly reflect the Navy's requirement that its personnel present a "proud and professional" appearance, and its desire for a durable, cost effective and easily maintained uniform, only one refers in any manner to the design of applicant's mark. That statement, indicating that a multicolor pattern was chosen because it is less likely to show wrinkles, stains and heavy wear than a solid, does not convince us that the particular multicolored pattern chosen by applicant is superior to any other pattern that could have been chosen. As pointed out by applicant, the ability to hide stains and wear and tear is an incidental function inherent to most patterned material.¹⁹

¹⁸ *Id.* at 5.

¹⁹ Applicant supports this statement with claims on various "civilian" websites that patterns hide stains. For example, patterned clothing hide stains on:
new mother's clothes
(<http://pregnancy.about.com/od/postpartum/a/postbabyclothes.htm>)
children's clothes
(<http://defrazlemom.wordpress.com/2007/08/01/21>), and

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Furthermore, many of the Navy's requirements for its uniform have nothing to do with fabric design. Instead, requirements such as durability, cost, ease of maintenance and storage space stem from the permanent press 50/50 nylon and cotton blend fabric, the wash and wear nature of the fabric and the Navy's conscious decision to replace several styles of uniforms with one multi-seasonal uniform. See the press releases entitled Navy Working Uniform (NWU) Concepts Frequently Asked Questions and New Navy Working Uniform and Service Uniform Concepts Approved.²⁰

Quite simply, there is nothing in applicant's statements that persuade us that applicant's applied-for color pattern design is essential to the Navy's requirement for a neat and clean uniform.

The third factor, the availability of alternative designs, is relevant to show that the design sought to be registered will not hinder competition.²¹ *In re Morton-Norwich Products, Inc.*, 213 USPQ at 16. Where the evidence indicates that the applicant's design is the best or one of a few superior designs available, then this evidence will strongly support a finding of functionality. *In re Bose*

chef's pants (<http://ask.metafilter.com/98625...>). See Response to Office Action, September 19, 2010, Exh. E.

²⁰ Final Office Action issued October 22, 2010.

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Corp., 772 F.2d 866, 27 USPQ 1, 5 (Fed. Cir. 1985) (the availability of alternative designs does not detract from the functional character of the product design where the subject matter sought to be registered is "the preferred or a superior design"). With particular regard to the alternative designs, the question is not whether they perform the same basic function, but whether these designs work "equally well." *Valu Engineering*, 61 USPQ2d at 1427, quoting, J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §7:75, 7-180-1 (4th ed. 2001).

Applicant has submitted numerous alternative designs of camouflage patterns that contain various colors and patterns, a random sampling of which are shown below.

Camouflage Uniforms of the World -United States Uniforms²²



Coat, Hot weather, Camouflage



MARPAT (Woodland)

²¹ The examining attorneys did not address this factor.

²² Retrieved from the website of Henrik Clausen, at <http://camo.nenrikc.dk/all.asp> on September 1, 2009. Applicant's response of September 19, 2009, Exh. C. Applicant submitted images of camouflage patterns for military uniforms throughout the world. We have focused on the patterns used in the United States, of which 16 were listed.

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ACU - Army Combat Uniform -jacket

MARPAT (Desert)

Random Designs in Various Camouflage Patterns²³



²³ Applicant's Response of September 19, 2009, Exh. C. Applicant made of record a total of 40 random patterns. Although applicant did not indicate a particular source of or use for these patterns, they nonetheless are probative to show that there is a wide variety of color combinations and patterns that could hide stains and mask wear and tear.

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Applicant's mark shown on the actual goods



Uniform blouse²⁴



Fabric bolt²⁵

Applicant has persuasively shown there are many alternative "camouflage" patterns that are different from applicant's pattern but, due to their coloration and pattern, could similarly mask stains and hide wear and tear.²⁶ We therefore conclude that the availability of alternative designs that appear to work "equally well," does not support the examining attorneys' argument that applicant's marks are functional. Put another way, because there are alternative color pattern designs that perform the same functions as well as applicant's pattern, there is

²⁴ Application Serial No. 77160754, specimen.

²⁵ Application Serial No. 77324266, specimen.

²⁶ In making this finding, we did not rely on the third-party registrations submitted by applicant for marks with patterns or for other uniforms, including sports uniforms. As pointed out by the examining attorneys, prior decisions are not binding on the Board and we make no presumptions as to why these color/patterns were chosen.

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no competitive need to adopt applicant's color pattern. See *Qualitex v. Jacobson*, 34 USPQ2d at 1164 (Although the Court recognized the importance to use *some* color on press pads to avoid noticeable stains, the [lower] court found "no competitive need in the press pad industry for the green-gold color, since other colors are equally usable").

With respect to the final factor, as indicated above, a product feature or design is functional if it affects the cost or quality of the product. Applicant has made of record the declaration of Arthur J. Mitchell, Jr., CFO of Rothtec Engraving Company, a subcontractor of Santee Printworks, a contractor hired to create the screens for printing the Navy digital pattern and embedded logo (color pattern) on fabric. Mr. Mitchell, in his declaration, states that: "Printing the Navy color digital pattern, which the subject of [the four] trademark application[s] is no less expensive of a process than would be involved for any other digital or camouflage pattern in any other colors."²⁷ Mitchell decl., para. 2. Mr. Mitchell further states that: "Printing an embedded logo in the digital design is no less expensive of a process than would be

²⁷ Applicant's Response of September 19, 2009, Exh. I.

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involved for any other additional logo in the design.”²⁸

Id. at para. 3. While this evidence shows that applicant’s color pattern does not result from a cheaper method of manufacturing, this fact does not favor applicant or the examining attorneys in the functionality analysis. See *In re N.V. Organon*, 79 USPQ2d 1639, 1646 (TTAB 2006) (“While evidence that a product feature makes the product cheaper to manufacture may be probative in showing functionality, evidence that it does not affect its cost is not necessarily proof of non-functionality”).

After carefully considering all the arguments and evidence submitted by applicant and the examining attorney, including those not specifically discussed, we cannot conclude that the examining attorneys have met their burden of establishing *prima facie* cases of functionality. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984). See also *In re Howard Leight Industries LLC*, 80 USPQ2d 1507, 1509 n.7 (TTAB 2006) (“In ex parte proceedings before the Board, ... the Office has the initial burden of establishing a *prima facie* case of functionality.”). While the color pattern design in applicant’s marks may perform the incidental function of masking stains and wear and tear

²⁸ *Id.*

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on the fabric and clothing items identified in the applications, it need not be devoid of any function in order to be registrable as a trademark. See *In re Morton Norton Products, supra* (the mere fact that a product configuration has utility, or aspects of a product are functional, does not render the configuration unregistrable). The examining attorneys quite simply have not shown how applicant's particular color pattern is functional or how it would hinder competition.

In view thereof, the refusals to register in each case pursuant to Section 2(e)(5) are reversed.

APPLICATION SERIAL NUMBERS 77160754 and 77160783

More Accurate Description Requirement

We consider now the requirement for complete and accurate descriptions of the marks made only in Application Serial Nos. 77160754 and 77160783. The descriptions initially read in the respective applications as follows:

The mark consists of a bald eagle perched, with wings spread, on an anchor in front of a schooner ship with USN, the literal element of the mark, below the design, all of which appear in the color deck grey and set against a light grey portion of the background that consists of irregular block-shaped pixels that consist of a four-color pattern of black, deck grey, light grey and navy blue. [Application Serial No. 77160754]

and

The mark consists of irregular block-shaped pixels that consist of a four-color pattern of black, deck

Serial No. 77160754, 77160783, 77324266, etc.

grey, light grey and navy blue. [Application Serial No. 77160783]

The examining attorney did not accept applicant's originally-submitted descriptions of its marks, arguing that they are incomplete because they do not describe all of the significant aspects of the applied-for marks. During prosecution of the application, the examining attorney suggested to applicant possible acceptable descriptions which include language that "the mark is a repeating pattern applied to the entire surface of the goods."

Applicant declined to amend the descriptions to include wording that indicates the pattern is a repeating one, arguing that the description in each application is neither inaccurate nor inconsistent with the mark shown on the drawing, that nothing in the authority cited by the examining attorney requires that a mark description identify a design as being "repeating" and that the description submitted meets the requirements for registration. Applicant further explains that it "does not wish to have its mark described as containing a repeating logo when the logo may not repeat in all the goods sold or to be sold by Applicant." Br. p. 15. Nonetheless, in responses filed on May 12, 2010, in each application,

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applicant indicated that it would agree to the following proposed descriptions of the marks, which applicant cited in its briefs as being at issue in the appeals:

The mark consists of a bald eagle perched, with wings spread, on an anchor in front of a schooner ship with USN, the literal element of the mark, below the design, all of which appear in the color deck grey and set against a light grey portion of the background that consists of irregular block-shaped pixels that consist of a four-color pattern of black, deck grey, light grey and navy blue, the pattern being applied to all or part of the surface of the goods. [Registration No. 77160754]

and

The mark consists of irregular block-shaped pixels that consist of a four-color pattern of black, deck grey, light grey and navy blue, the pattern being applied to all or part of the surface of the goods. [Application Serial No. 77160783]

Although the examining attorney did not formally accept the proffered amendment to the description of the mark in either application, she addressed the proposed amendments in her briefs. She particularly stated that she had considered the proposed amended descriptions, but found each incomplete because "it still failed to describe an important feature of the mark, namely, that the pattern is a repetitive design." Examining Attorney's br., unnumbered p. 15. She went on to explain that, as currently described, "the mark on the goods could appear simply as a very large, single set of squares in black, blue and gray, splayed across an entire uniform. This would present a

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different commercial impression than that provided by the mark as applied to the goods in the specimen." Examining Attorney's br., unnumbered p. 16.

Because both applicant and the examining attorney addressed the proposed descriptions in their briefs, we consider them to have been accepted as applicant's operative description of the mark in each case.²⁹

Trademark Rule 2.37 provides that "a description of the mark must be included if the mark is not in standard characters." Section 808.01 of the Trademark Manual of Examining Procedure ("TMEP") further provides guidelines for requiring a description of a mark if "the mark contains a design element" and if "the mark includes color." TMEP § 808.02 (8th ed. 2011) states that "the description should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission. The description should describe all significant aspects of the mark, including both literal elements and design elements. Insignificant features need not be included in a description."

²⁹ The Office records of each application will be updated to reflect the amended descriptions.

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Under this guidance, we find the amended descriptions comply with Rule 2.37 and the corresponding guidelines provided in the TMEP. While perhaps not as specific as they could be in terms of the repeating nature of the marks, the amended descriptions are sufficient under the rule. We find so primarily because applicant's inclusion of the term "pattern"³⁰ in the descriptions, essentially subsumes the "repeating" language required by the examining attorney. Although applicant's marks theoretically may appear in whole, or in part in the context of the "background" in the '754 application, as a large, single set of squares in black, blue and gray, splayed across an entire uniform, given the nature of the pattern and goods upon which it will be applied, we find it unlikely that the description would convey such a singular commercial impression.

³⁰ We take judicial notice of the definition of "pattern" taken from the online edition of the Encarta® World English Dictionary: [North American Edition] (2009):

1. regular form: a regular or repetitive form, order, or arrangement ...
2. design: a repeated decorative design, e.g., on fabric

<http://www.bing.com/Dictionary/search?q=pattern&qs=n&form=QB>, retrieved September 5, 2012. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed

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We thus find that applicant's descriptions of the marks, as amended by the May 12, 2010, responses provide accurate characterizations of the marks. In view of the forgoing, the examining attorney's requirement for acceptable descriptions of the marks is reversed.

Decision: The functionality refusals pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5), in Application Serial Nos. 77160754, 77160783, 77324266 and 77324270 are reversed; and the requirements for a more accurate description of the mark made in Application Serial Nos. 77160754 and 77324270 are reversed.

editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).