

This Opinion is not a
Precedent of the TTAB

Mailed: April 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re National Presto Industries, Inc.
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Serial No. 85870582
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Tye Biasco of Patterson Thuente Pedersen, P.A.,
for National Presto Industries, Inc.

Curtis W. French, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

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Before Adlin, Masiello and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

National Presto Industries, Inc. (“Applicant”) seeks registration on the Principal Register of the following product design mark for “electric popcorn poppers” in International Class 11:¹

¹ Application Serial No. 85870582, filed on March 8, 2013, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging dates of first use anywhere and in commerce as of April 30, 2002.



The Application includes a description of the mark as follows:

The mark consists of three dimensional hot air popcorn popper having a generally cylindrical frustum base with a skirt on the bottom portion of the base and a fitted translucent cover with a back wall curved toward a rectangular discharge expanding in width from the back wall toward the discharge. The chute cover is a flat top and curved downward and away from the opening of the base of the device. The lines of the hot air popcorn popper are intended to indicate the three dimensional shape of the hot air popcorn popper and do not indicate color or texture. The broken lines depict a measuring cup/butter melter and accents on the base and are not part of the mark.

The Trademark Examining Attorney refused registration of Applicant's proposed mark on the grounds that it is a functional and non-distinctive product design that has not acquired distinctiveness. 15 U.S.C. §§ 1051, 1052(e)(5),(f), 1127.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusals to register.

I. Functionality

Section 2(e)(5) of the Act precludes registration of “any matter that, as a whole, is functional.” *In re Van Valkenburgh*, 97 USPQ2d 1757, 1758 (TTAB 2011). 15 U.S.C. §1052(e)(5). “Congress explicitly recognized the functionality doctrine in a 1998 amendment to the Lanham Act by making ‘functionality’ a ground for *ex parte* rejection of a mark.” *Valu Eng., Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002).²

The underlying purpose of the functionality doctrine is to promote fair competition by maintaining a proper balance between trademark law and patent law. As the Supreme Court explained:

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).

Qualitex Co. v. Jacobson Prod. Co., 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995). *See also TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1005 (2001) (adhering to “the well-established rule that trade dress protection may not be

² Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069, effective October 30, 1998. *See generally* TMEP 1202.02(a)(i) (“These amendments codified case law and the longstanding USPTO practice of refusing registration of functional matter.”).

claimed for product features that are functional.”); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1086 (1992); *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 114 USPQ2d 1953, 1957 (Fed. Cir. 2015) (“The protection for source identification, however, must be balanced against a fundamental right to compete through imitation of a competitor's product. This right can only be temporarily denied by the patent or copyright laws. ... In contrast, trademark law allows for a perpetual monopoly and its use in the protection of physical details and design of a product must be limited to those that are nonfunctional.”) (citations and internal punctuation omitted) *cert. granted in part*, No. 15-777, 2016 WL 1078934 (U.S. March 21, 2016). *See generally In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994); *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 224 USPQ 625, 628 (Fed. Cir. 1985).

In general terms, a product feature is functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4n.10 (1982). The exclusive right to use a functional feature would put competitors at a significant non-reputation-related disadvantage. *TrafFix Devices*, 58 USPQ2d at 1006. “The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important non-reputation-related product features.” *Qualitex*, 34 USPQ2d at 1165. *See also ERBE Elektromedizin*

GmbH v. Canady Technology LLC, 629 F.3d 1278, 97 USPQ2d 1048, 1056 (Fed. Cir. 2010).

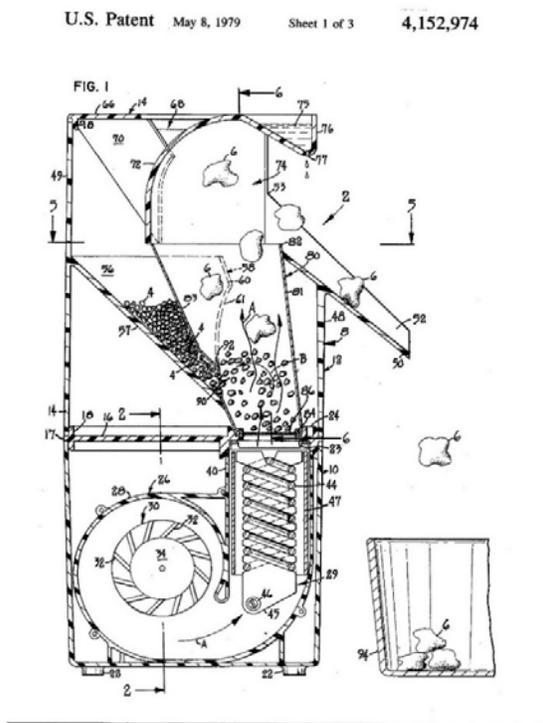
In *Morton-Norwich*, the Federal Circuit's predecessor court sought to "strike a balance between the 'right to copy' and the right to protect one's method of trade identification" *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15 (CCPA 1982). As a guide to analysis, it enunciated the following four factors, which help determine whether matter is functional:

- (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.

Id. at 15-16. *Accord In re Becton, Dickinson*, 102 USPQ2d at 1377; *Valu Eng.*, 61 USPQ2d at 1426. The "*Morton-Norwich* factors" are "legitimate source[s] of evidence to determine whether a feature is functional." *Valu Eng'g*, 61 USPQ2d at 1427. However, the Supreme Court has made it clear that the standard for functionality is set forth in *Inwood*, *i.e.*, whether a feature is "essential to the use or purpose of the device or... affects the cost or quality of the device," and that if functionality is properly established under *Inwood*, further inquiry into facts that might be revealed by a *Morton-Norwich* analysis will not change the result. *TrafFix*, 58 USPQ2d at 1006 ("Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.").

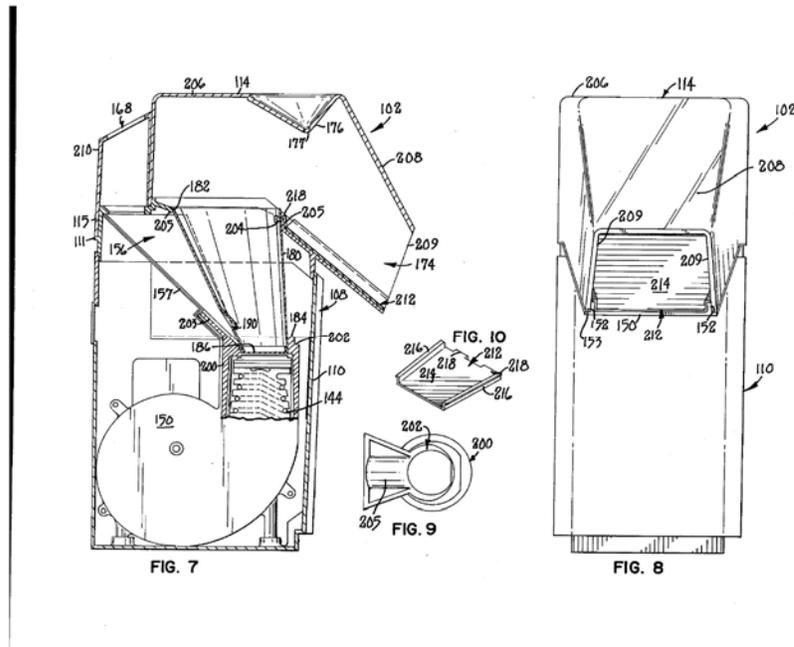
1. *The Existence of Patents.*

The first *Morton-Norwich* factor is whether a utility patent discloses the utilitarian advantages of the design. *In re Mars, Inc.*, 105 USPQ2d 1859, 1861 (TTAB 2013). A utility patent is strong evidence that the features it claims are functional. *TrafFix Devices*, 58 USPQ2d at 1005 Here, the Examining Attorney requested that Applicant provide all copies of patents (current or expired) showing any of the features of the configuration in the Application,³ and Applicant complied. The Examining Attorney cites Applicant's U.S. Patent No. 4,152,974 for a "hot air corn popper,"⁴ depicted as follows:



³ Nov. 25, 2013 Office Action.

⁴ U.S. Patent No. 4,152,974, issued on May 8, 1979, listing Applicant as the assignee. Applicant's Response to Office Action of May 27, 2014, p. 51-61.



U.S. Patent May 8, 1979 Sheet 3 of 3 4,152,974

The abstract in the '974 utility patent describes the invention as follows:

A hot air corn popper comprises a body having a lower body portion closed by a removable cover. A hollow stainless steel popping vessel is removably held in the lower body portion and has a bottom end closed by a perforated grill. A gravity flow feed hopper formed in the lower body portion provides an automatic flow of unpopped kernels into the popping vessel where they are contained on top of the grill. An upwardly directed hot air flow produced in the lower body portion is directed through the popping vessel. The air flow pops the unpopped kernels and carries the popped kernels out of the popping vessel and the body to a storage receptacle.⁵

These features are claimed in the twenty claims of the '974 utility patent.⁶

Dependent claim 15 claims, in pertinent part, "A hot air corn popper as recited in claim 14, in which the lower body portion further includes an outwardly extending

⁵ See Response to Office Action, May 27, 2014, p. 51.

⁶ *Id.* at pp. 58-60.

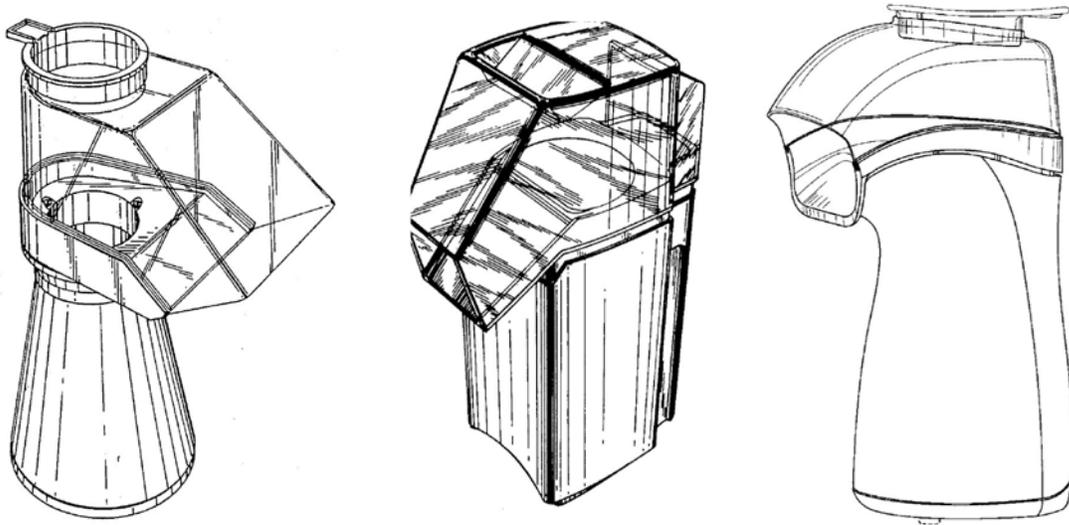
inclined chute located beneath the lid and cooperating with the discharge opening of the lid....”⁷

Applicant argues that the Examining Attorney’s reliance on the ‘974 utility patent is misplaced, as it broadly claims a means of popping corn kernels with hot air, and does not cover particular external design features: “Nothing in the claims of the ‘974 Patent discloses a ‘fitted translucent cover with a back wall curved toward a rectangular discharge expanding in width from the back wall toward the discharge. ... In fact, the cover of the ‘974 Patent is readily distinguishable from the applied-for mark (e.g., cylinder base v. conical frustum base; rectangular cover v. widening cover; indented bottom v. skirt; angled top of cover v. curved top of cover; narrowing discharge chute v. widening discharge chute).”⁸ To illustrate this point, Applicant points to several design patents it has owned for hot air corn poppers, such as Design Patents D279,070, D256,019, and D642,006, each of which depicts a somewhat different shape:⁹

⁷ *Id.* at p. 59.

⁸ Applicant’s brief, pp. 7-8, 7 TTABVUE 8-9.

⁹ D279,070 issued on June 4, 1985 for a term of 14 years; D256,019 issued on July 22, 1980 for a term of 14 years; and D642,006 issued on July 26, 2011 for a term of 14 years. Copies of these design patents are attached to Applicant’s May 27, 2014 Response to Office Action at pp. 25-30 and 43-50.



While Applicant does not cite a design patent claiming its proposed mark, it is, as Applicant observes, similar to the '070 Design Patent pictured immediately above on the left (having a translucent cover, a curved back wall widening to a rectangular discharge chute, and a conical base).¹⁰

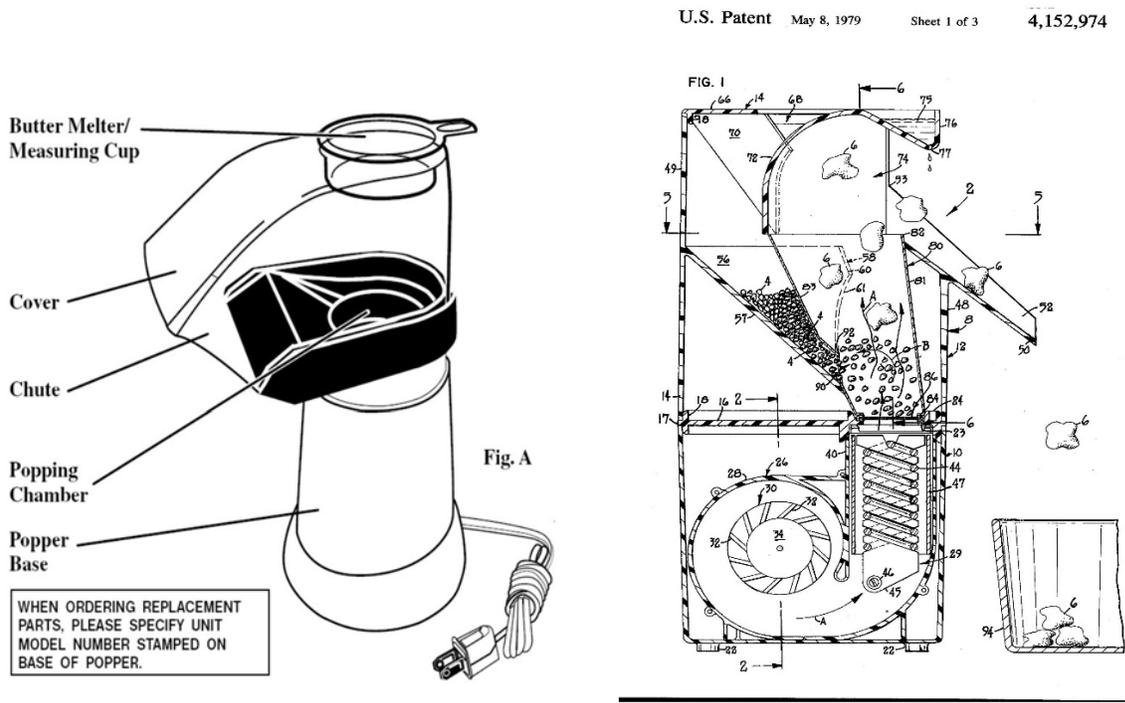
While a design patent may be some evidence of non-functionality, that evidence is not, standing alone, dispositive of the issue; it may be outweighed by other evidence supporting a functionality determination—evidence such as the aforementioned utility patent. *See In re Becton, Dickinson*, 102 USPQ2d at 1377; *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984); *Kistner Concrete Prod. Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1924 (TTAB 2011) (utility patents weighed against design patents). *See generally* TMEP 1202.02(a)(v)(A).

Where, as here, the record reveals both utility and design patents, “The utility patent is helpful in shedding light on the utilitarian aspects of applicant's

¹⁰ Applicant's brief, p. 8, 7 TTABVUE 9.

configuration design.” *In re Caterpillar, Inc.*, 43 USPQ2d 1335, 1338 (TTAB 1997) (utility patent and design patent). The critical question is “the degree of utility present in the overall design of the mark.” *In re Becton, Dickinson*, 102 USPQ2d at 1376.

Here, the product’s form is dictated by its function. If we compare the operating instructions for Applicant’s subject hot air corn popper (shown below, on the left),¹¹ with one of the embodiments of Applicant’s ‘974 utility patent (shown below, on the right), we see how the popper’s utilitarian features dictate its design.



According to the utility patent, it “provide[s] a hot air corn popping apparatus which is simple, efficient, and quite suited for home consumer use.”¹² Its electric

¹¹ See Response to Office Action, May 27, 2014, p. 22.

¹² ‘974 utility patent detailed description, Response to Office Action, May 27, 2014, p. 55.

motor, “actuated by ... normal household voltage,” wafts a stream of hot air from the popper base upward through the “[p]opping vessel[,] in the form of an oval truncated cone having an open upper end and a lower end.” The popper is topped with “a removable transparent upper lid or cover,” which “has a substantially rectangular body portion” and a “downwardly extending spout” that deflects the popcorn down an inclined chute into a waiting bowl.¹³

Applicant’s proposed mark claims the entire configuration as a mark, except for the butter melter and accents on the base. But all the proposed mark does is combine the popper’s fundamentally functional features with minor variations that do not detract from—and may even add to—its overall functionality. The popper’s translucent cover deflects the popped popcorn into the bowl, and enables the home user to watch the corn as it pops and to see when the popper has finished popping the kernels. The widening discharge chute apparently reduces the risk that popped corn would jam as it is discharged from the popper. And the popper’s generally cylindrical base with a skirt on the bottom, increases its stability.

Even if some variations in design are possible, as indicated by the design patents, the language of Section 2(e)(5) precludes registration of “any matter that, *as a whole*, is functional.” 15 U.S.C. § 1052(e)(5) (emphasis added). “[A] mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.” *In re Becton, Dickinson*, 102 USPQ2d at 1376. Applicant’s configuration, even with its insignificant variations, is,

¹³ See generally ‘974 utility patent, Response to Office Action, May 27, 2014, pp. 51-61.

taken as a whole, functional. Accordingly, this factor supports a finding of functionality.

2. Advertisements Touting the Utilitarian Advantages of the Design.

The second *Morton-Norwich* factor focuses on whether advertising materials tout the utilitarian advantages of a product's design features. *Kistner Concrete*, 97 USPQ2d at 1924-28. Advertising extolling the utilitarian advantages of the features supports a finding of functionality, *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1836 (TTAB 2013), and an applicant's own advertising touting such advantages is strong evidence supporting a functionality refusal." *In re Van Valkenburgh*, 97 USPQ2d at 1761.

Applicant's advertising displays its popper design configuration bearing the word marks "PRESTO POPLITE" or "Orville Redenbacher's Gourmet Popping Corn Hot Air Popper by PRESTO" (Applicant is licensed to use the ORVILLE REDENBACHER'S trademark on its popper):¹⁴

¹⁴ Response to Office Action, May 27, 2014, pp. 2, 6. Applicant's appeal brief, p. 13, 7 TTABVUE 14.

PRESTO
PopLite[®]
hot air
corn popper



Pops with hot air, not oil, for a healthy, low-calorie treat.

- This popper offers a faster, healthier, and more economical choice than microwave bag popcorn.
- Use regular or gourmet popcorn with terrific results — virtually no unpopped kernels.
- Up to 18 cups of gourmet popcorn are popped in less than 2 1/2 minutes.
- Butter melter doubles as a handy measuring cup.
- Chute directs popcorn right into your bowl.
- Base and cover simply wipe clean.
- 1-year limited warranty.



Pops with hot air, not oil, for a healthy, low-fat treat.

- Created by Presto and Orville Redenbacher's®.
- Pops up to 18 cups of gourmet popcorn in less than 2 1/2 minutes with virtually no unpopped kernels.
- Butter melter doubles as a handy measuring cup.
- Chute directs popcorn right into your bowl.
- Base and cover simply wipe clean.
- 1-year limited warranty.

Both ads display the involved countertop popper, which propels the popped kernels upward into a transparent cover, whence the “chute directs popcorn right into your bowl.” These advertisements confirm the functional purpose of the chute and its shape.

In its reply brief, Applicant “concedes that a discharge chute of a hot air popcorn popper is functional,” but maintains that this is only one part of the overall design.¹⁵ Yet it is one of the most important parts of a design comprising only a few claimed features, the rest of which function in a supporting role, providing a stable cylindrical base that places the discharge chute a few inches above a waiting bowl as pictured in the advertisements. This factor therefore weighs in favor of functionality.

3. Alternative Designs Available to Competitors

The third *Morton-Norwich* factor focuses on whether competitors would have functionally equivalent designs available to them if applicant were accorded the exclusive rights flowing from registration of its design. *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1704 (TTAB 2009).

Applicant argues that there are numerous designs that are functionally equivalent to, yet different from, its applied-for design,¹⁶ e.g.:

¹⁵ Applicant’s reply brief, pp. 3-4, 10 TTABVUE 4-5.

¹⁶ Applicant’s brief, p. 11, 7 TTABVUE 12. Response to Office Action Nov. 1, 2013, p. 6.

Examples of Various Hot Air Popcorn Popper Trade Dress



However, the four competitors' alternative designs, shown above, all follow the same functional pattern—directing a stream of hot air upward, carrying popped kernels of corn up to a transparent or translucent cover that redirects them to a waiting receptacle. Their commonalities, which are covered by the drawing and description of Applicant's proposed mark, outweigh their differences. Applicant's particular design is one of many functionally and visually similar designs used in the industry. See *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (metal spray nozzles offered by applicant's competitors are visually and functionally similar). See also *Valu Eng'g, Inc.* 61 USPQ2d at 1427 ("[W]e conclude that the [*TrafFix*] 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."). There is no reason to accord to Applicant the exclusive right to this fundamentally functional design.

Here, Applicant owned the '974 utility patent, now expired.¹⁷ If Applicant were granted a trademark registration, that would accord it the exclusive right to use this configuration in perpetuity, as long as it continued to use the "mark" in commerce. *Qualitex*, 34 USPQ2d at 1163. Its monopoly would be far-reaching, as it would encompass not only the described configuration, but all designs confusingly similar thereto. 15 U.S.C. §§ 1052(d), 1114. Many functionally equivalent designs, which necessarily would share many of the functional features of Applicant's design, would at least arguably resemble Applicant's design to some extent. Competitors "would not know if the features which they are using in their products, whose overall configurations are not dissimilar from that of the applicant, subject them to a suit for trademark infringement." *In re R.M. Smith, Inc.*, 219 USPQ 629, 634 (TTAB 1983), *aff'd*, 222 USPQ 1 (Fed. Cir. 1984) *quoted in In Re Udor U.S.A., Inc*, 89 USPQ2d at 1986. *See also In re Vertex Grp.*, 89 USPQ2d at 1704.

Consequently, while alternative designs are no doubt available, registration of Applicant's design would constitute a hindrance to competition. *See TrafFix Devices*, 58 USPQ2d at 1006.

¹⁷ U.S. Patent No. 4,152,974, filed on June 16, 1978, issued on May 8, 1979, for a term of 17 years from the date of filing.

4. *Cost of manufacture.*

The Examining Attorney has not contended, and none of the evidence of record demonstrates, that Applicant's design is simpler or cheaper to manufacture than other designs. This factor is therefore neutral.

Conclusion on Functionality

Upon consideration of all of the evidence of record, we find that Applicant's proposed product configuration is dictated as a whole by utilitarian concerns. These factors include Applicant's utility patent, which explains the utilitarian function of Applicant's design features, its advertising touting the functional configuration of the cover and discharge chute, and the fact that competitors use designs that substantially resemble Applicant's design. Granting a trademark registration to Applicant's product configuration would run afoul of the ban on registering functional marks, and skew the delicate balance between trademark and patent law. *Qualitex, supra*. Taken as a whole, then, we find that Applicant's applied-for matter is functional within the meaning of Section 2(e)(5) of the Trademark Act.

II. Nondistinctiveness.

We next address the Examining Attorney's alternative ground for refusal, that Applicant's mark is a nondistinctive product configuration that has not acquired distinctiveness. In order to be registered as a trademark, a trade dress must be capable of indicating the source of an applicant's goods and distinguishing them, as to source, from those of others. *Two Pesos*, 23 USPQ2d at 1083. 15 U.S.C. §§ 1052, 1127. "Trade dress is inherently distinctive when its 'intrinsic nature serves to identify a particular source of a product,' and, in contrast, acquires distinctiveness

when the public comes to associate the product with its source.” *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006) (quoting *Two Pesos*, 23 USPQ2d at 1083). The Supreme Court has held that product configurations are not inherently distinctive, *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000), because consumers are not predisposed to equate such configurations with particular sources: “even the most unusual of product designs-- such as a cocktail shaker shaped like a penguin--is intended not to identify the source, but to render the product itself more useful or more appealing.” *Id.* at 1069. “If the mark is not inherently distinctive, it is unfair to others in the industry to allow what is in essence in the public domain to be registered and appropriated, absent a showing of secondary meaning.” *In Re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1685 (Fed. Cir. 2010). Hence, product designs may be registered as marks only upon a showing of acquired distinctiveness. *E.g.*, *In re Slokevage*, 78 USPQ2d at 1398-99; *AS Holdings v. H & C Milcor*, 107 USPQ2d at 1837; *In Re Udor U.S.A.*, 89 USPQ2d at 1986.

In view of these policy considerations, Applicant faces a heavy burden in establishing that its product design has acquired distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004, 1008 (Fed. Cir. 1988); *In re Van Valkenburgh*, 97 USPQ2d at 1765; *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1283-84 (TTAB 2000). Applicant must show that the primary significance of the product configuration in the minds of consumers is not the product, but the producer. *Inwood Laboratories*, 214 USPQ at 4n.11 (1982); *In Re MGA Entm't*,

Inc., 84 USPQ2d 1743, 1747 (TTAB 2007); *In Re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d 1177, 1181 (TTAB 2014).

In its request for reconsideration, Applicant expressly claimed that its product design had acquired distinctiveness under 15 U.S.C. §1052(f):

By this response, Applicant now claims the mark has become distinctive of the goods and/or services through applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.¹⁸

In support of this claim, Applicant relies upon the declaration of Douglas J. Frederick, its Secretary and General Counsel, submitted with its November 1, 2013 Response to Office Action.¹⁹ The declaration avers, in pertinent part, that:

2. The Mark has been used as the product design and trade dress for different models of Applicant's hot air popcorn poppers since at least November, 2002.
3. At least \$77,076,499 worth of popcorn poppers (at wholesale value) bearing the product design and trade dress of The Mark have been sold by National Presto as of the date of October 21, 2013.
4. The Mark appears in Applicant's instruction manuals, on its website, and on its product packaging.
5. Through advertising allowances provided to retailers, Applicant has spent more than Six Million Dollars advertising its Poplite and Orville Redenbacher Hot Air Popcorn Poppers, which utilize The Mark. As a result, The Mark is widely associated with National Presto's product among consumers.
6. Numerous pieces of advertising National Presto's Poplite and Orville Redenbacher Hot Air Popcorn Poppers, which utilize The Mark, have been distributed and numerous catalogs containing information regarding the referenced Poplite and Orville Redenbacher Hot Air Popcorn Poppers have been distributed.

¹⁸ Applicant's request for reconsideration, July 30, 2015, 4 TTABVUE 6 (emphasis in original).

¹⁹ Frederick Declaration, Response to Office Action, Nov. 1, 2013, pp. 8-10.

7. National Presto's customer service department receives e-mails and telephone calls from person both inside and outside the state of Wisconsin who associate The Mark with National Presto's hot air popcorn poppers. ...
14. Throughout the years, more than 100,000 copies of product catalogs that have utilized the Mark have been printed and distributed.²⁰

Applicant's length of use of the product design, extending over thirteen years, is insufficient, in itself, to persuade us that the product design has acquired distinctiveness in the public mind as an indicator of source. *See In re Ennco Display Systems*, 56 USPQ2d at 1286 (seven to seventeen years' use for eyeglass/spectacle frame display holders insufficient); *In re Howard Leight Ind. LLC*, 80 USPQ2d 1507, 1517 (TTAB 2006)(fifteen years' use of earplug configuration insufficient); *In re Van Valkenburgh*, 97 USPQ2d at 1766 (sixteen years' use of motorcycle stand insufficient); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001) (sixty-six years' use of guitar configuration insufficient). As with the product designs in these cited cases, Applicant's difficulty inheres in the very nature of its product shape, which the public tends to view as intrinsically useful, rather than an indication of source. *Wal-Mart*, 54 USPQ2d at 1069.

Further, the probative value of long and continuous use is vitiated where the applicant's use is not substantially exclusive. 15 U.S.C. § 1052(f). *Saint-Gobain Corp v. 3M Co.*, 90 USPQ2d 1425, 1440 (TTAB 2007). "When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be

²⁰ *Id.*

successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.” *Id.* (quoting *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984)). *In Re Udor U.S.A.*, 89 USPQ2d at 1986-87. The record is replete with substantially similar poppers using the same basic form to perform the same function. Applicant points to minor differences in the shape of the poppers’ bases, covers, and discharge chutes,²¹ but “in order to be relevant to the question of whether applicant's mark has acquired distinctiveness, the third-party uses do not have to be identical to applicant's mark.” *Saint-Gobain v. 3M*, 90 USPQ2d at 1440. As noted above, the poppers’ commonalities outweigh their differences. So while Applicant has shown over thirteen years’ use of its product configuration, “the probative value of this factor is greatly diminished inasmuch as this use was not substantially exclusive given the third-party uses.” *Stuart Spector Designs, Ltd. v. Fender Musical Instr. Corp.*, 94 USPQ2d 1549, 1572 (TTAB 2009).

Applicant complains that one of its competitors’ designs cited by the Examining Attorney is not evidence that its design is nondistinctive; it is, rather, a “knock-off” of Applicant’s applied-for mark:²²

²¹ Applicant’s brief, pp. 14-16, 7 TTABVUE 15-17; Response to Office Action, Dec. 22, 2014.

²² Applicant’s brief, p. 3, 7 TTABVUE 4; Applicant’s reply brief, p. 3n.3, 10 TTABVUE 4. See Office Action, May 1, 2013, p. 8.



But “Copying is only evidence of secondary meaning if the defendant's intent in copying is to confuse consumers and pass off his product as the plaintiff's.” *Id.* at 1575 (quoting *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 USPQ2d 1065, 1072 (7th Cir. 1995)). There is no evidence of that in the record, as the competitor uses its own word and design mark on the popper. “In any event, it is more common that competitors copy product designs for desirable qualities or features.” *In re Ennco Display Systems*, 56 USPQ2d at 1286. Thus, the probative value of this “knock-off” is neutral; it does not show distinctiveness or nondistinctiveness of Applicant’s design.

Applicant also points to over \$77 million in sales, but these sales figures merely demonstrate the popularity of the product as a product; they do not demonstrate that the purchasing public recognizes the product design as a source indicator. *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121, 1131 (Fed. Cir. 1992) (“Similarly, the fact that there was an apparently large consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun.”); *Stuart Spector Designs*, 94 USPQ2d at 1572 (“...mere figures

demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source.”).

Applicant also points to over \$6 million in advertising, but that advertising identified Applicant’s products as “PRESTO Poplite” and “Orville Redenbacher Hot Air Popcorn Poppers by PRESTO,”²³ as shown below:



There is nothing about these advertisements that promotes the *configuration* of Applicant’s product as an indicator of source. “It is well-settled that, where, as here, a party’s advertising and sales data is based on materials and packaging in which the

²³ Frederick declaration, ¶¶ 5-6, Response to Office Action, Nov. 1, 2013, pp. 8-10.

mark at issue is almost always displayed with another mark, such data does not prove that the mark at issue possesses the requisite degree of consumer recognition.” *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1245 (TTAB 2015) (citing *In re Bongrain Int’l*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990)). See also *In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967) (promotion of a bottle design bearing other trademarks insufficient to show that the public views the bottle design alone as a trademark); *In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (advertising of soccer ball design with word marks “provide[s] no indication of a nexus between [the] design per se and a single source.”) cited in *In Re Koninklijke Philips Elecs. N.V.*, 112 USPQ2d at 1180-81.

At bottom, the critical question is not the length of Applicant’s use, the dollar amount of its sales, or the extent of its advertising; it is the effectiveness of these efforts in “creating a consumer association between the product configuration and the producer.” *In re Ennco Display Systems*, 56 USPQ2d at 1285. The record in this case does not reveal that the claimed product features have acquired distinctiveness under Section 2(f) of the Trademark Act.

Decision: The refusal to register Applicant’s product design is affirmed on the ground of functionality, and on the ground that it is a nondistinctive product configuration that has not acquired distinctiveness.