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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85945749
Applicant	Orbit Irrigation Products, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: Orbit Irrigation Products, Inc.

Application No.: 85/945749, 85/945766, 85/945775, 85/945777, 85/945781,
85/945783 (consolidated)

Filed: May 30, 2013

Mark: Sprinkler Head Configuration

APPLICANT'S REPLY BRIEF

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INTRODUCTION

Applicant, Orbit Irrigation Products, Inc., has applied for federal trademark registration for six of its sprinkler head configurations; which applications have been consolidated in the proceeding. Applicant's marks comprise the color green and another color in a specific configuration on the top portion of a sprinkler head. Applicant has used its marks for over twenty years and has sold tens of millions of sprinkler heads having the applied-for configurations. Applicant has substantial trademark rights in its sprinkler head configurations.

The examining attorney has refused Applicant's marks on two grounds: the marks lack distinctiveness and that Applicant's 2(f) claim is not properly supported; and that the marks are functional because they provide camouflage in grass. However, as has been discussed in Applicant's office action responses and Applicant's appeal brief, the refusals are improper. First, the examining attorney has improperly discounted evidence of acquired distinctiveness submitted in support of Applicant's 2(f) claim. Applicant has provided adequate evidence to support its 2(f) claim, which is not rebutted by the record evidence. Second, the examining attorney incorrectly concludes that Applicant's marks are functional because they provide camouflage – they do not. Therefore, they cannot provide the functional advantage alleged by the examining attorney. Consequently, the refusal of Applicant's marks should be reversed.

ARGUMENT

I. Applicant's Section 2(f) Claims Is Sufficiently Supported

The examining attorney has discounted Applicant's evidence of acquired distinctiveness, including evidence that Applicant has used its sprinkler head configuration for over 20-years, has sold tens of millions of sprinkler heads with the applied-for configurations, and has spent over \$3.5 million annually advertising Applicant's goods using the applied-for configurations. The examining attorney also argues that declarations from Applicant's distributors and Applicant's "look to" advertising inviting consumers to "Trust the Green Top" are unpersuasive. As basis for rejecting Applicant's 2(f) claim, the examining attorney focuses primarily upon the contention that Applicant is not the exclusive user of the applied-for mark. However, this is unsupported by the record evidence.

The examining attorney contends that because there are third party lawn sprinklers that include the color green, Applicant's color configuration marks lack exclusivity and its marks cannot have acquired distinctiveness. However, as has been discussed in Applicant's responses and appeal brief, the green lawn sprinklers in the record evidence are far different from Applicant's goods and sprinkler head configuration. Applicant's sprinkler head configurations are different and distinct from any of the sprinklers relied on by the examining attorney. They have different sprinkler shapes, functions, applications, and/or color designs. Therefore, Applicant is the exclusive user of its sprinkler head configuration marks.

The examining attorney relies in part on evidence submitted with the First Office Action, which the examining attorney purports shows a sprinkler that is similar to the applied-for mark. However, the evidence in the First Office Action is improper. Applicant previously objected to this evidence in its Response to the First Office Action because the evidence, which consists primarily of internet evidence, is dated 8/6/2010, nearly three years before Applicant filed the applications that are the subject of this appeal. Applicant has been unable to find this evidence online. Moreover, this evidence is conspicuously absent from the searches performed in connection with the Second and Final Office Actions. Therefore, because the evidence no longer exists, it cannot be properly relied upon. See TBMP § 704.08(b) (“Due to the transitory nature of the Internet, the party proffering information obtained from the Internet runs the risk that the website owner may change the information contained therein.”)

The examining attorney also relies upon evidence attached to the Second and Final Office Actions. However, while that evidence may show green sprinklers, it does not show third party use of the applied-for mark. In fact, of the products referenced in the examining attorney’s brief, only one bears any similarity to the design and configuration of Applicant’s marks - the Ace H2O-6. However, this does not support the refusal because the H2O-6 product is actually Applicant’s product, and its configuration is the subject of App. No. 85/945783.

In conclusion, Applicant has provided ample evidence to support its Section 2(f) claim. Applicant is the sole and exclusive user of the applied-for marks and the

examining attorney's reliance on dissimilar third party products and designs is misplaced. Consequently, this refusal should be reversed.

Supplemental Register

The examining attorney has suggested that, absent the other grounds for refusal, the applied for marks could be appropriately placed upon the Supplemental Register. While Applicant disputes the refusal of its Section 2(f) claim, in the alternative, Applicant agrees to amend its application to the Supplemental Register. Therefore, if the Board affirms this grounds for refusal, and provided that there are no other impediments to the marks being allowed, Applicant requests that the Board return the applications to the examining attorney so that Applicant may amend the applications to the Supplemental Register.

II. Applicant's Marks Are Not Functional

The examining attorney argues that the applied-for marks are functional because "[t]he color green is the only color compatible with green grass." The record evidence, including evidence submitted by the examining attorney, clearly contradicts this statement. Included in the evidence are several examples of lawn sprinkler heads that are completely black, clearly demonstrating that colors other than green are commercially compatible with grass. Notwithstanding this contradiction, Applicant understands the examining attorney's position as follows: 1) Grass and other landscaping is green; 2) It may be desirable to hide or camouflage sprinklers and other yard equipment; 3) Green sprinklers and green yard equipment are camouflaged in grass; 4) The use of green to

camouflage provides a functional advantage; 5) Applicant's configuration marks, which include the color green, are therefore functional.

The examining attorney refuses to consider two important factors, however. 1) The applied-for marks are not exclusively green; and 2) Applicant's goods are intended for use in a manner such that it is impossible for the green portion of the applied-for marks to provide functional advantage. Even if the color green does provide a functional advantage by allowing certain sprinklers and products to be camouflaged in green landscapes (which Applicant does not concede and the record evidence does not establish), the applied-for marks do not function to camouflage Applicant's associated goods. As previously provided, the images below show an example of one of products associated with the applied-for marks (corresponding to App. No. 85/945775). This is a non-telescoping product, meaning that its shape and configuration is static whether active or inactive. The images below show the products in both the active (distributing water) and inactive states.



In neither state can a plausible argument be made that the color green in any way provides the benefit of camouflage. Perhaps if the entire product were green, the examining attorney's position would have some merit – however the applied-for mark is very clearly only partially green. Even a cursory review of the product shows that the applied-for mark cannot offer the benefit of camouflage and does not offer a functional advantage.

The applied-for marks are similar in some respects similar to the Reg. No. 3361596 for a “red lacquered outsole on footwear that contrasts with the color of the adjoining (“upper”) portion of the shoe.” The Second Circuit considered the validity this mark and determined it was entitled to trademark protection, but “limit[ed] the trademark to uses in which the red outsole contrasts with the remainder of the shoe.” *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 213 (2d Cir. N.Y. 2012). The Second Circuit determined that a red sole attached to a red upper was not protectable – this would have anticompetitive implications because third parties need to be able to produce completely red shoes. *Id.* However, a red sole attached to a different color upper was capable of acting as an identifier of source and was not unfair to consumers or competitors. *Id.* While the *Louboutin* case primarily addressed the question of secondary meaning, the same rationale is applicable here. Applicant's mark consists of the color green and another color directly adjacent to green, both colors on the top portion of the goods. Applicant's marks are therefore not for a wholly green sprinkler, or even for a sprinkler head top that is wholly green. The examining attorney's analysis is flawed because it focuses primarily on the color green, which is only a portion of Applicant's marks. Even if an individual element of an applied-for design may be

functional, the overall mark may still be nonfunctional. *See* 15 U.S.C. §1052(e)(5); *In re Teledyne*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982). A proper evaluation of the applied-for marks, in their entirety, shows that the marks are not functional and should be allowed.

CONCLUSION

For the foregoing reasons and in view of the record evidence, Applicant's marks are not functional, functions as trademarks, and have achieved acquired distinctiveness. Orbit therefore respectfully requests that the grounds for refusal set forth in the Final Office Action be reversed and the applied-for mark be approved for publication.

DATED this 3rd of February, 2016.

Respectfully submitted,

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