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Subject: U.S. TRADEMARK APPLICATION NO. 85945766 - 01042-007.TM - REMAND REQUEST TO TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85945766

MARK:



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01042-007.TM

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MOTION TO REMAND

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S REQUEST FOR REMAND

The trademark examining attorney requests that the Trademark Trial and Appeal Board remand this case to the trademark examining attorney under 37 C.F.R. §2.142(d) for the reason(s) that follow.

DRAWING OF THE MARK

In the July 23, 2013 Office Action, the examining attorney advised applicant that an acceptable drawing of the mark was required along with an acceptable description of the mark. In the December 13, 2013 Response to Office Action, applicant amended the description of the mark but did not provide the new drawing. The current drawing of the mark and the current description of the mark are inconsistent.

The drawing of applicant's applied-for three-dimensional mark is not acceptable because it includes functional elements depicted in solid lines rather than broken or dotted lines. See TMEP §1202.02(c)(i)(A). Elements of a mark that are functional are required to be shown in broken or dotted lines. See 37 C.F.R. §2.52(b)(4); *In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983); TMEP §1202.02(c)(i)(A).

"Functional matter cannot be protected as a trademark." TMEP §1202.02(a)(iii)(A); see 15 U.S.C. §§1052(e)(5), (f), 1091(c), 1064(3), 1115(b)(8). A feature is functional as a matter of law if it is "essential to the use or purpose of the [product]" or "it affects the cost or quality of the [product]." *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); TMEP §1202.02(a)(iii)(A).

In the present case, along with the Section 2(e)(5) refusal with respect to the color green, the following elements are functional: the overall shape of the goods. The shape of the actual sprinkler is functional because the industry reflects that there are few alternative designs available for sprinklers which feature a portion that may go below or on the ground as well as an exposed portion which is above ground and allows the water to flow through. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (C.C.P.A. 1982); TMEP §1202.02(a)(v).

Therefore, applicant must provide (1) a new drawing of the mark showing the functional element(s) in broken or dotted lines, and (2) an amended mark description that references the matter in broken or dotted lines and indicates such matter is not claimed as part of the mark. See TMEP §1202.02(c)(i)(A), (c)(ii). Applicant must provide the amended drawing regardless of whether the remaining portions of the mark are determined to be registrable. TMEP §1202.02(c)(i)(A).

The examining attorney inadvertently failed to maintain the requirement for an acceptable drawing and consistent description of the mark and thus this request for remand is now issued.

Respectfully submitted,

/Ms. Tasneem Hussain/

(Thomas Howell, Managing Attorney)

Trademark Examining Attorney

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