

This Opinion is Not a  
Precedent of the TTAB

Hearing: April 6, 2016

Mailed: May 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Openings d/b/a Total Door*  
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Serial No. 86044043  
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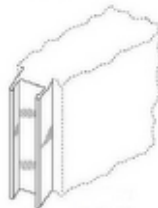
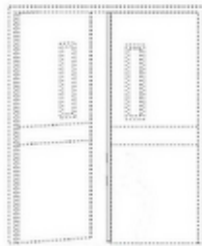
Paul E. Rauch, Ph.D. of Evan Law Group, LLC for Openings d/b/a Total Door.

Christopher Law, Trademark Examining Attorney, Law Office 105, Susan Hayash,  
Managing Attorney.

—  
Before Kuhlke, Adlin and Masiello, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Openings d/b/a Total Door (“Applicant”) seeks a Principal Register registration for  
the proposed mark shown below



for “Metal doors, commercial reinforced steel doors” and “Non-metal doors.”<sup>1</sup> The application includes this description of the mark: “The mark consists of at the top of the drawing a front-facing full depiction of a three-dimensional product configuration consisting of a U-shaped channel that runs the full length of a door. At the bottom of the drawing is a depiction of a cross-section of the three-dimensional product configuration consisting of a U-shaped channel that runs the full length of a door. The door itself is not claimed as a feature of the mark.”

The Examining Attorney refused registration of the proposed mark on the ground that it comprises “matter that, as a whole, is functional,” under Section 2(e)(5) of the Act, and accordingly did not substantively consider Applicant’s evidence of acquired distinctiveness. After the refusal became final, Applicant appealed. Applicant and the Examining Attorney filed briefs and appeared at an oral hearing on April 6, 2016.

### **Relevant Law on Functionality**

A product feature, such as Applicant’s proposed mark, is functional “when it is essential to the use or purpose of the device or when it affects the cost or quality of the device.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citing *Qualitex Co. v. Jacobson Products Co., Inc.* 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995) and *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)).

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<sup>1</sup> Application Serial No. 86044043, filed August 21, 2013 under Sections 1(a) and 2(f) of the Trademark Act, based on first use dates of December 31, 1977 and a claim of acquired distinctiveness.

“To support a functionality rejection in proceedings before the Board, the PTO examining attorney must make a prima facie case of functionality, which if established must be rebutted ...by preponderant evidence.” *In re Becton, Dickinson and Co.*, 675 F.2d 1368, 102 USPQ2d 1372, 1376-77 (Fed. Cir. 2012); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1980 (TTAB 2009). Generally, depending on the types of evidence of record, we consider one or more of the following “*Morton-Norwich* factors” in assessing whether a product design is functional under Section 2(e)(5):

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

*Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002) (citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982)). In considering whether the Examining Attorney has made a prima facie case of functionality, and, if so, whether Applicant has rebutted the case, we keep in mind that “product design almost invariably serves purposes other than source identification.” *TrafFix*, 58 USPQ2d at 1005 (quoting *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 US. 205, 54 USPQ2d 1065, 1069 (2000)).

While the *Morton-Norwich* factors “aid in the determination of whether a particular feature is functional,” *Valu Engineering*, 61 USPQ2d at 1427, if

functionality is established by evidence that the features described in the involved application are essential to the use or purpose of the device, or affect the cost or quality of the device, we need not consider each of the factors. *TrafFix*, 58 USPQ2d at 1006-07; *Valu Engineering*, 61 USPQ2d at 1427 (*TrafFix* “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”); *In re Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) (“a higher cost does not detract from the functionality of that feature ... even at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially, as claimed in the patents, a superior quality wheel”); *In re Howard Leight Industries, LLC*, 80 USPQ2d 1507, 1515-16 (TTAB 2006).

The following oft-cited passage from *Qualitex* explains the policy behind Section 2(e)(5):

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. Sections 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*, 34 USPQ2d at 1163. This policy is directly implicated in this case, because in response to the Examining Attorney’s inquiry under Trademark Rule 2.61(b), Applicant submitted four expired patents related to locking channels for doors, all of which were owned by Leon B. Yulkowski, Applicant’s founder and former president (the “Expired Yulkowski Patents”). Exhibits to Declaration of Leon Yulkowski (“Yulkowski Dec.”) submitted in support of Applicant’s June 13, 2014 Office Action Response. According to Mr. Yulkowski, the Expired Yulkowski Patents “illustrate a locking channel with the configuration of the [involved] Distinctive U-Shaped Channel Mark.” Yulkowski Dec. ¶ 14.

It is settled that prior patents, such as the Expired Yulkowski Patents in this case, have “vital significance in resolving the trade dress claim.” *TrafFix*, 58 USPQ2d at 1005. Indeed

[a] utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption [of 15 U.S.C. § 1125(a)(3)] that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

*Id.* Moreover, utility patent evidence of functionality is entitled to even greater weight where, as here, the patent’s owner seeks a trademark registration for the same configuration claimed in the (expired) patent. *In re Howard Leight*, 80 USPQ2d at

1510 (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7.89 (4<sup>th</sup> ed. 2006)); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997).

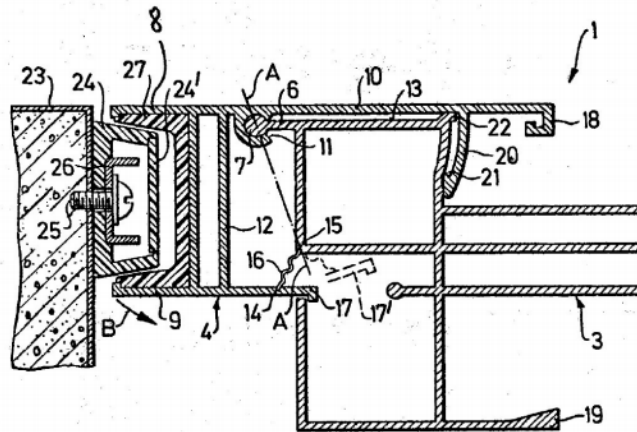
### **Relevant Evidence**

Before turning to the Expired Yulkowski Patents and Applicant's advertising, it is important to point out that virtually all of Applicant's doors feature the proposed mark. Indeed, according to Mr. Yulkowski, "[g]oods sold under the mark that is the subject of this application account for about 99% of Applicant's revenue." Yulkowski Dec. ¶ 5. Applicant's counsel corroborated this claim during the oral hearing.

### **The Expired Yulkowski Patents**

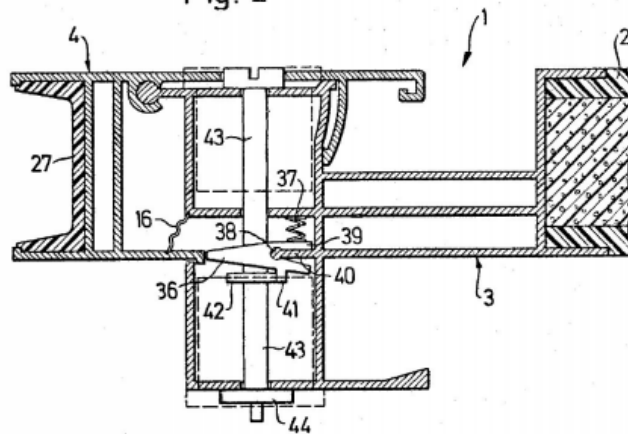
The earliest of the Expired Yulkowski Patents, U.S. Patent No. 3,969,845, states in its summary of the invention that it consists of a "movably connected locking element extending at least a part of the height of the door ... Appropriately, the locking element runs the full height of the door ... The locking element can exhibit on its face side a longitudinally running groove or a longitudinally running projection, which works together with the corresponding groove or projection planned for the door frame, running substantially the full height of the door." Yulkowski Dec. The detailed description of the invention goes on to state that "locking element 4 consists of a box-like bracket which has formed on one side the U-formed groove, formed by means of projections 8 and 9," as shown in the following drawing from the patent:

Fig. 1



*Id.* In other words, this patent describes the “U-shaped channel” claimed in the involved trademark application, referring to it as a “U-formed groove.”<sup>2</sup> In fact, the patent, like the involved trademark application, specifically refers to the “groove” as “U-shaped” in reference to this patent drawing

Fig. 2



<sup>2</sup> The drawing depicts the “U” shape sideways, with projections 8 and 9 forming what would be the vertical sides of the “U” if the drawing was turned 90° clockwise.

stating “[i]n order to provide a good seating of the locking element the door is provided with a U-shaped plastic part **27** in the closing groove formed by projections **8** and **9**.”

*Id.*<sup>3</sup>

Furthermore, the patent claims features for which Applicant now seeks a trademark registration, including:

Claim 1—In combination door and locking mechanism ... the locking mechanism is operably connected to the opposed major longitudinal side of the door, the improvement of: said locking mechanism including a longitudinal engaging element carried by said opposed door side and being hingedly mounted about a pivot axis which is generally parallel to the door hinge axis; a corresponding longitudinal counter-element connected to a door frame and being generally parallel to and engageable with the engaging element; said engaging element and counter-element *extending substantially the entire height of the opposed door side*; said engaging element being *channel-shaped in cross section and including a pair of spaced, longitudinal, substantially parallel projections extending away from the door*; said counter element being comprised of a male-shaped member nesting within said projections when the door is in the closed position ...

Claim 9—the improvement comprising a locking element movably connected to the door for at least a part of its height; a longitudinal engaging element along the edge of the locking element; a corresponding longitudinal counter-element upon said frame interlocking with said engaging element ...

Claim 15—said engaging element and counter-element *extending substantially the entire height of the opposed door side, one of said elements being channel-shaped in cross-section and including a pair of spaced, longitudinal substantially parallel projections, the other of said elements*

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<sup>3</sup> Notwithstanding Applicant’s argument to the contrary, “we are not limited to review of the claims in a patent in determining functionality, but we may also consider the disclosures in the patent.” *In re Dietrich*, 91 USPQ2d at 1627.

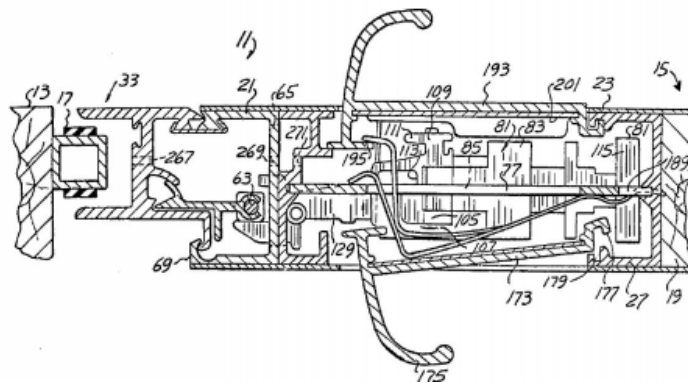


*being comprised of a male-shaped member nesting within said projections when the door is in the closed position ...*

*Id.* (emphasis added). The italicized portions of these claims make clear that this patent claimed features – the “U-shaped channel” which “runs the full length of a door” – for which Applicant now seeks a trademark registration.

The other Expired Yulkowski Patents contain similar information making clear that those patents claimed features now the subject of the involved trademark application. For example, U.S. Patent No. 4,093,284 makes clear that the “longitudinal engaging element” referenced in the patents is the “U-shaped” or “U-formed” “groove” or “channel” discussed in U.S. Patent No. 3,969,845. Indeed, Patent No. 4,093,284 states “[t]he present lock mechanism includes a lock channel **33** of H-shape in cross section, hereafter often referred to as a longitudinal engaging element”:

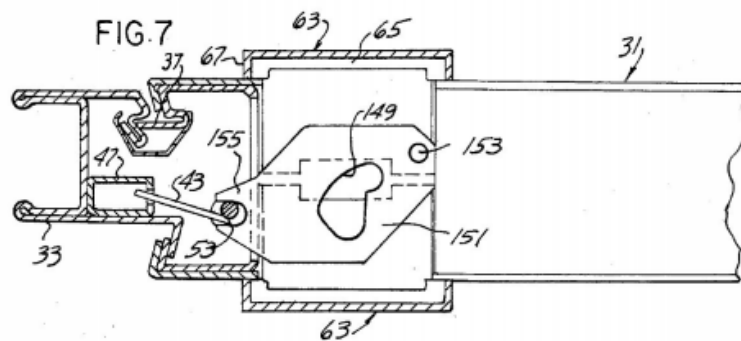
FIG. 2



While this patent refers to the lock channel as “H-shaped,” as the Examining Attorney points out, “[a] user or consumer of applicant’s product would only be able to view the front portion of the channel that runs the full length of the door. As such, users and consumers would view this channel as being U-shaped or U-formed ... users and consumers would only be able to appreciate the H-shape of this channel if

permitted to view a disassembled door or cross-section of the door.” Examining Attorney’s Appeal Brief at 10.

While Applicant attempts to make much of the “anvil-shaped recess” visible in the bottom part of the “U” depicted above, this small recess does not alter the fundamental U shape of the channel. In any event, U.S. Patent No. 4,545,607 depicts a locking channel (33) as more clearly U-shaped:



*Id.*

The patents also identify the functional benefits of the elements of the invention for which Applicant now seeks trademark registration. For example, Patent No. 4,093,284 states the “present channel 33, also referred to as a longitudinal engaging element, extends over at least a substantial part of the door height, or the full door height. This increases its holding effect with respect to the door stop 17 and also closing off any visual space between the door and the corresponding frame 13.” According to Patent No. 3,969,845, Applicant’s invention, significant portions of which are now the subject of its trademark application, performs a number of functions:

The door exhibits no projections on which one can be injured.

The manufacturing cost of the door is minimized because lock cases, knobs and other customary hardware can be eliminated.

Customary carpenter work is eliminated in installation or mounting of the door. The door is completely and economically manufactured in the factory and can be packed in a very small volume for shipping because this door has no or only insignificant projections and, therefore, can be stacked one on top of the other ...

The door is burglar-proof (resistant) since the frame cannot be simply spread apart by force, permitting unauthorized entry because the door is substantially engaged in the closing element over its full height ....

*Id.*

Thus, the Expired Yulkowski Patents assert that Applicant's doors, and more specifically its "U-shaped channel that runs the full length of a door," which is identified in the involved trademark application, perform important functions and are indeed functionally superior in many respects to other doors. Applicant's vigorous argument that the U-shape of the locking channel does not perform a function beyond those performed by any type of locking channel is essentially irrelevant. *See, In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 5-6 (Fed. Cir. 1985) ("The pentagonally shaped cross-section of the enclosure is part and parcel of the functional, i.e. utilitarian, advantage stated by Bose itself to inhere in the *enclosure* as an element of a speaker system. That another type of enclosure would work equally as well does not negate that this enclosure was designed *functionally* to enhance or at least not detract from the rest of the system."); *In re Honeywell, Inc.*, 532 F.2d 180, 189 USPQ 343, 346 (CCPA 1976); *In re Howard Leight Industries*, 80 USPQ2d at 1514; *In re Cabot Corp.*,

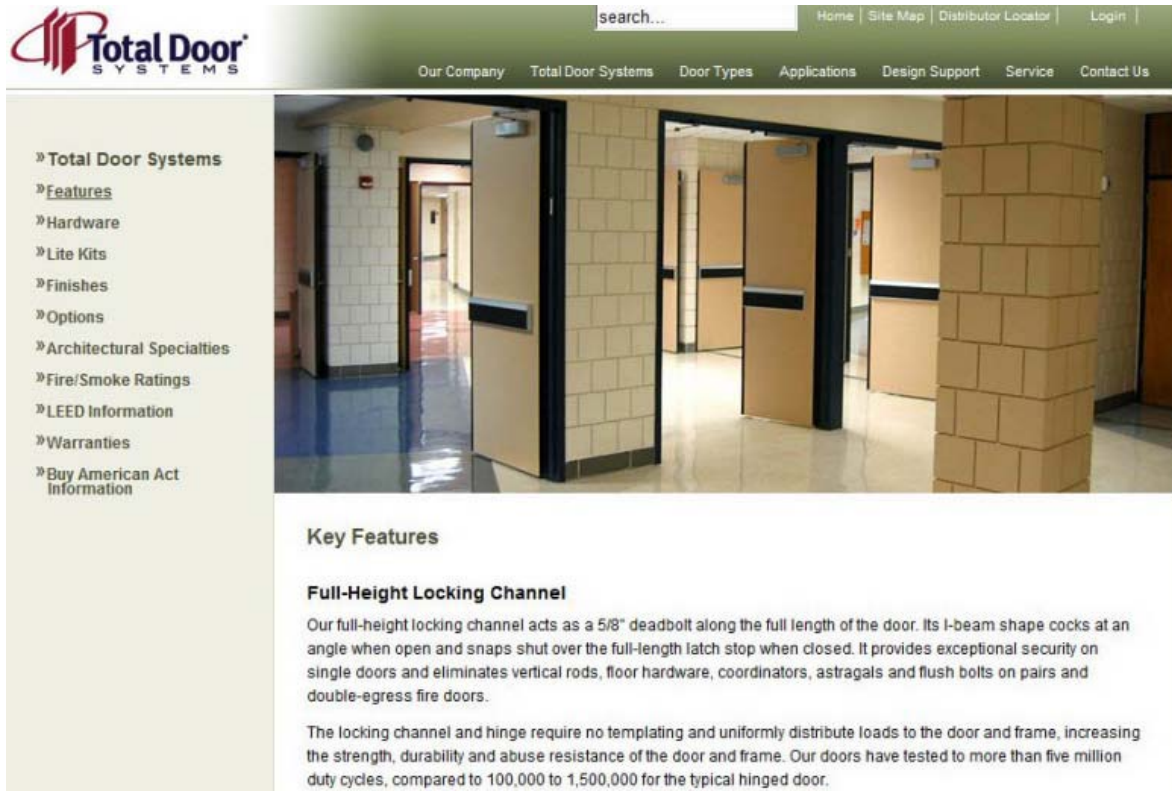
15 USPQ2d 1224, 1228-29 (TTAB 1990) (“We do not believe the law requires us to find that applicant’s package is the *one* superior container and, therefore, to allow its free use by all while permitting all other package configurations to be registered as trademarks.”).

In any event, many and perhaps most of Applicant’s claims of functional superiority relate to the locking channel “running the full length of a door,” which adds strength and security. This alone is enough to establish the functionality of a locking channel “that runs the full length of a door,” which is how Applicant describes its mark in the involved application. Indeed, even if the U-shaped channel was not functional in and of itself, and the evidence reveals that it is, Applicant is not seeking a trademark registration for the U-shaped locking channel alone, but instead for a channel which runs the full length of the door. *See In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748, 1753 (Fed. Cir. 2007) (“Bose is seeking protection of its entire pentagonal-shaped design, not only its curved front edges, as made clear by the picture and description of the design in its application for trademark protection. If Bose were only seeking protection of its curved front edge, it would have made that clear in its application for registration.”).

In short, the Expired Yulkowski Patents weigh heavily in favor of a finding of functionality.

#### Applicant’s Advertising

Applicant touts the very product features for which it now seeks trademark registration. For example:

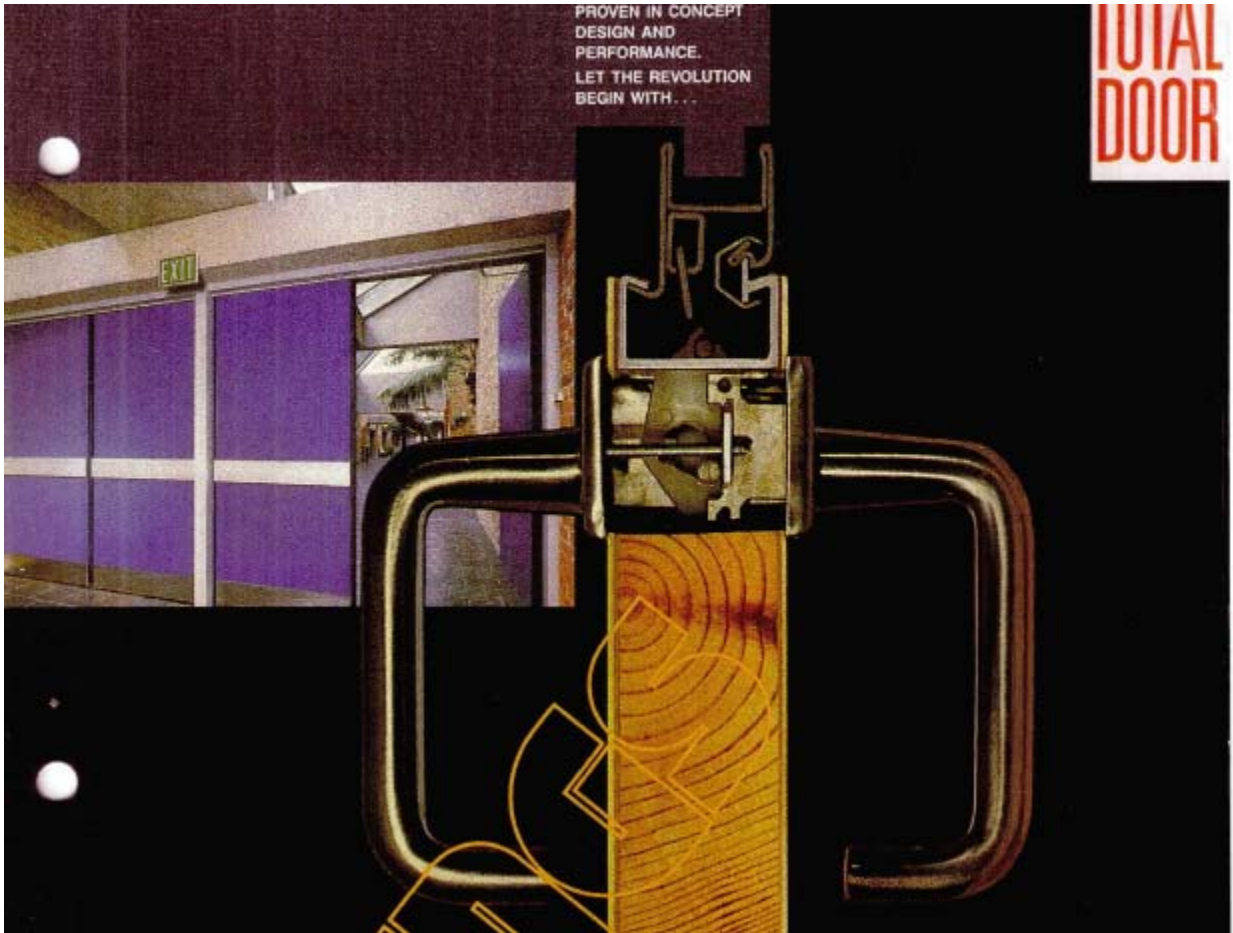


Office Action of December 13, 2013. According to this promotional material from Applicant's website, the full-height locking channel (or as described in the trademark application, the "U-shaped channel that runs the full length of a door") "acts as a 5/8" deadbolt along the full length of the door." It provides "exceptional security on single doors and eliminates vertical rods, floor hardware, coordinators, astragals and flush bolts on pairs and double-egress fire doors." Moreover, the locking channel requires "no templating" and uniformly distributes loads to the door, "increasing the strength, durability and abuse resistance of the door and frame." These are all functional benefits.

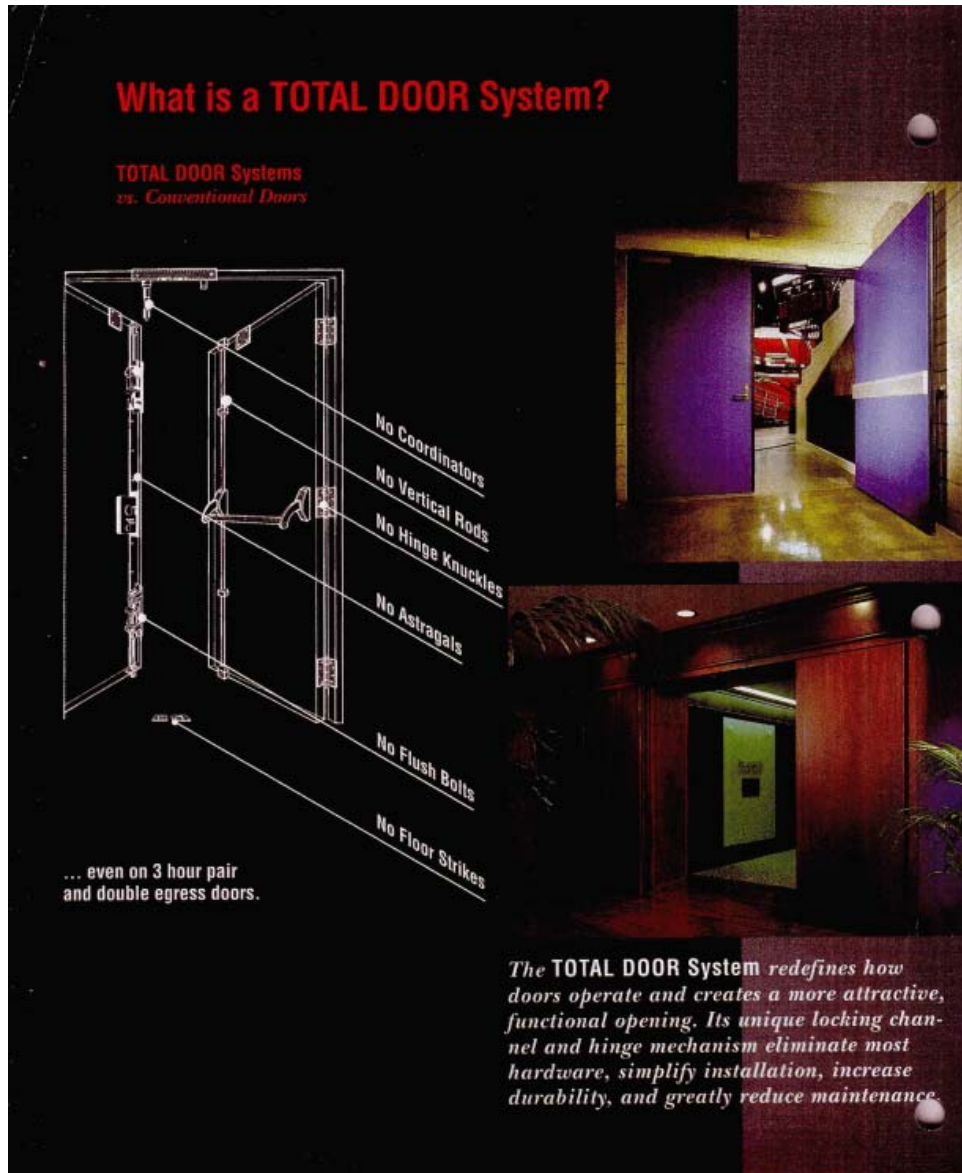
The advertisements which Applicant submitted in response to the Examining Attorney's information request under Trademark Rule 2.61(b) also claim that the proposed mark described in the involved application has functional benefits. For

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example, this print advertisement depicts a cross-section similar to that shown in the drawing of Applicant's proposed mark, and touts its "performance":



Office Action Response of June 13, 2014. And the advertisement shown below explains that the "unique locking channel" of Applicant's doors "creates a more attractive, functional opening" and eliminates most hardware, simplifies installation, increases durability and greatly reduces maintenance:



*Id.* Another advertisement touting “The Total Advantage” mentions not only “unequaled security,” but also durability and “exceptionally quiet operation.” *Id.* This advertisement promotes and depicts Applicant’s “patented hinge and locking channel,” including the channel depicted in the drawing of Applicant’s proposed mark, and, *inter alia*, states that “pocketed TOTAL DOORS seem to disappear into the wall system when open because there are no coordinators, floor strikes, and vertical rods to clutter the opening”:



**How TOTAL DOOR Works**

**Openings' patented hinge and locking channel eliminate most hardware, simplify installation, increase durability, and reduce maintenance.**

*The I-beam shaped continuous locking channel securely locks the door for its full height. It cocks at an angle when opened and snaps shut over the full-length latch stop when closed.*

*The concealed continuous hinge runs the full height of the door. Placement of the pivot points allows the door to open a full 180° and lay tightly against the wall.*

**Pocket Applications**

**Wider Openings and "Disappearing" Doors!**

*Pocketed TOTAL DOORS seem to disappear into the wall system when open because there are no coordinators, floor strikes, and vertical rods to clutter the opening. The application of two-part polyurethane, high pressure laminate and wood veneer faces on even three hour steel doors further allow TOTAL DOORS to blend into their wall environments.*

It goes on to state that “The I-beam shaped continuous locking channel securely locks the door for its full height ... and snaps shut over the full-length latch stop when closed.” *Id.* Finally, the following advertisement sums up many of the functional advantages of, and depicts, Applicant’s proposed mark:





**Integrated Door Assemblies,  
Non-Rated and Rated up to 3 Hours.**

*With the TOTAL DOOR® SYSTEM, you no longer need vertical rods, astragals, coordinators, floor strikes or flush bolts. The TOTAL DOOR® SYSTEM, with its unique full vertical length locking channel and hinge, has the inherent design that provides up to 10 times the normal life. All that plus quieter more secure function. You can expect these advantages and many more with the TOTAL DOOR® SYSTEM.*

TOTAL DOOR® is an architectural grade fire door system. It includes primed or prefinished door panels, factory installed door hardware, frames and field installation.

The continuous locking channel has an I-beam shape that securely locks the door along its full height. It acts as a 5/8" throw deadbolt the full length of the door. It cocks at an angle when open and snaps shut over the full-length latch stop when closed. It provides exceptional security on single doors and eliminates vertical rods, floor hardware, coordinators, astragals and flush bolts on pairs and double egress fire doors.



**TOTAL DOOR® FEATURES**

- The continuous semi-concealed hinge fits easily into any existing frame or to any flat surface without any projecting knuckles. 3-hour rated pairs can be installed in standard rabbetted or cased frames. The hinge eliminates the need for triple step frames on double egress applications. You can even retrofit a TOTAL DOOR® double egress into a standard pair frame. Our exclusive dual pivot point semi-wide throw hinge allows the door to open a full 180 degrees and gives greater clearance width.
- Locking channel and hinge require no templating and uniformly distribute loads to the door and frame increasing the strength, durability and abuse resistance of the door and frame.
- Our standard exit device has a narrow projection (1-15/16") and allows a 32" clear width in a 36" opening. Our new optional Flush Exit Device (Shown Above) offers the least projection in the industry with a mere 1/8" projection in the open position.
- High pressure laminate, IPC, wood veneer and metal door faces are available in all labels including 3 hours, even for pair and double egress fire doors.
- Maximum design flexibility.
- Quiet operation for auditoriums and meeting rooms.
- Abuse resistance and low maintenance. Stands up to heavy use in schools, sports facilities, health care institutions, and institutional settings.
- Meets all fire-ratings including 3 hour, temperature rise and positive pressure.
- ADA compliant. Intertek Testing Services certified.
- 8'4 3/8" wide pairs for 8'0" clear opening.



*Id.*

Because Applicant's promotional materials tout the functionality of the U-shaped locking channel which runs the full length of Applicant's doors, this factor also weighs heavily in favor of a finding of functionality.

Alternative Designs and Simple or Cheap Method of Manufacturing

As stated, and pursuant to *TrafFix*, because the Expired Yulkowski Patents and Applicant's promotional materials establish the functionality of the proposed mark, we need not consider these factors. In any event,

applicant's argument that "the alternative designs are equal to, or even superior" to applicant's design rings hollow in view of its own touting to the contrary in promotional materials. Given the utilitarian advantages of applicant's configuration (one need only believe applicant's own statements in its promotional materials) ... it follows that competition is hindered.

*In re Caterpillar*, 43 USPQ2d at 1441. Furthermore, even if Expired Yulkowski Patent No. 3,969,845 did not reveal that "the manufacturing cost of the door is minimized because lock cases, knobs and other customary hardware can be eliminated," and the cost to manufacture Applicant's doors was higher than for other doors, "even at a higher manufacturing cost, applicant would have a competitive advantage" by excluding competitors from using what is, as claimed in the patents and Applicant's advertisements, a desirable product design for a door. *See In re Dietrich*, 97 USPQ2d at 1637.

### **Conclusion**

The Examining Attorney has established a prima facie case of functionality based on the Expired Yulkowski Patents, Applicant's own advertising and the record in its entirety, which Applicant failed to rebut. Accordingly, we find that the proposed mark is functional under *TrafFix* and *Inwood*.

**Decision:** The refusal to register Applicant's proposed mark on the ground that it comprises "matter that, as a whole, is functional," is affirmed. 15 U.S.C. § 1052(e)(5).