

This Opinion Is Not a
Precedent of the TTAB

Mailed: June 17, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re TrackFin GmbH
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Application Serial No. 86175623
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Holby M. Abern of Neal, Gerber & Eisenberg, LLP.
for TrackFin GmbH.

April A. Hesik, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.
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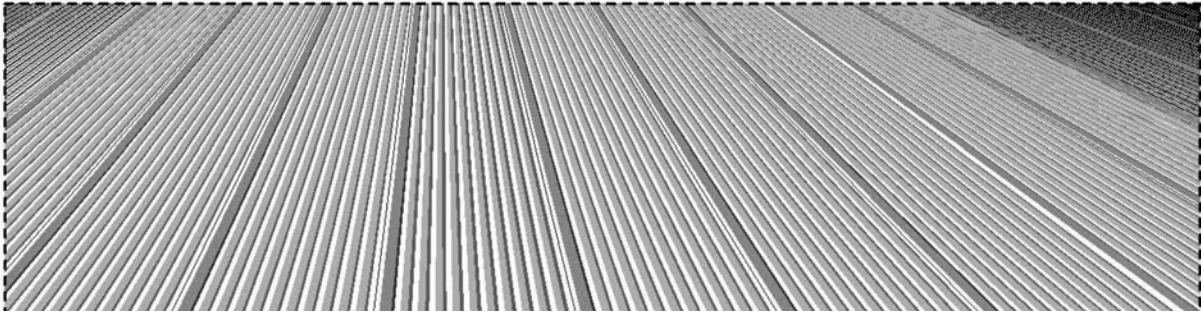
Before Bergsman, Ritchie and Lynch, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

TrackFin GmbH (“Applicant”) seeks registration on the Principal Register, under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), of the design reproduced below for

Machines, namely, snow groomers for maintaining snow pistes, cross country skiing tracks and cross country races, in Class 7; and

Tracked utility vehicles for grooming snow and sand, in Class 12.¹



The description of the mark reads as follows:

The mark consists of a three-dimensional trade dress including a repeating pattern appearing in groomed snow or groomed sand. The pattern includes ten substantially equidistant grooves that each have a substantially pointed bottom, the ten substantially equidistant grooves being offset on both sides by a thicker groove having a substantially flat bottom. The matter shown in broken lines is not part of the mark and serves only to show the position of the mark.

The Examining Attorney refused registration on the following grounds:

The subject matter sought to be registered is a functional feature of the goods pursuant to Trademark Act Section 2(e)(5), 15 U.S.C. § 1052(e)(5);

The subject matter sought to be registered consists of a non-distinctive product design under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052 and 1127;

¹ Application Serial No. 86175623, filed January 27, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based on Applicant's claim of first use anywhere and first use in commerce on January 1, 1993 for the goods in both classes.

On January 24, 2019, Applicant recorded a "change of registered address from the Netherlands (B.V.) to Austria (GmbH)" (i.e., Trackfin B.V., a limited liability company of the Netherlands, to TrackFin GmbH, an Austrian limited liability company) at reel 6535, frame 0318.

The subject matter sought to be registered fails to function as a trademark pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052 and 1127; and

The specimens showing use of the subject matter sought to be registered fail to show the applied-for mark in commerce pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127.

I. Background

Snow Grooming

Snow grooming or piste bashing is the process to manipulate snow for recreational uses, usually using a snow groomer or piste basher vehicle (colloquially sometimes referred to as a “piste beastie”). This can be a tractor, snowmobile, truck or snowcat towing specialized equipment to move and manipulate snow. The process used to maintain ski hills, cross country ski trails and snowmobile trails by grooming (moving, flattening, rototilling, or compacting) the snow on them.

* * *

Process

A groomer will usually go out to pack the snow and improve skiing and snowboarding and snowmobile trail conditions. The resulting pattern on the snow is known as corduroy in ski and snowboard slang, and is widely regarded as a good surface on which to ski or ride.²

“Corduroy” is defined as “the finely ridged surface of the snow after a snowcat has groomed a ski trail.”³ “The function of the corduroy ridges is to provide resistance to

² Snow Grooming, Wikipedia.org attached to the May 8, 2014 Office Action (TSDR 6).

Citations to the examination record refer to the Trademark Office’s online Trademark Status and Document retrieval system (TSDR), by page number, from the downloadable .pdf format.

³ Skiing, About.com attached to the May 8, 2014 Office Action (TSDR 8); *see also* Corduroy, Digital Nomad, National Geographic (digitalnomad.nationalgeographic.com) (TSDR 12) (“The lined furrows are called ‘corduroy’ because the groomed snow and ice looks just like the fabric of the same name.”) attached to the May 8, 2014 Office Action; Ski.com/ski-glossary (TSDR 579) (“Corduroy: Named for the ridges in the snow caused by grooming machines, corduroy

the ski edge so as to minimize lateral ski motion (slippage).”⁴ “Fresh corduroy is generally smooth and predictable, so it is a favorite of skiers who like to ski fast or ‘rip corduroy.’”⁵ Corduroy “is widely regarded as a good surface on which to ski or ride”⁶ because “processed snow is ideal for carving turns.”⁷ In this regard, Applicant states that “the pattern of groomed snow that constitutes Applicant’s Trade Dress is one of many equally feasible, efficient competitive designs.”⁸ A photograph of a representative “corduroy” snow design is reproduced below.⁹



is another word for groomer or groomed slope.”) attached to the January 17, 2018 Office Action.

⁴ Patent Application Publication No. 2013/0264797 [0004] attached to the January 17, 2018 Office Action (TSDR 501).

⁵ Liftopia.com (September 18, 2014) attached to the January 17, 2018 Office Action (TSDR 516).

⁶ Snow Grooming, Like2Do.com attached to the January 17, 2018 Office Action (TSDR 566).

⁷ Bedeviling Gravity (November 2, 2008), SunValleyMag.com attached to the January 17, 2018 Office Action (TSDR 571).

⁸ November 6, 2014 Response to an Office Action (TSDR 16).

⁹ Corduroy, Digital Nomad, National Geographic (digitalnomad.nationalgeographic.com) (TSDR 13) attached to the May 8, 2014 Office Action.

Finally, “[t]here are many other things – besides corduroy – that indicate if a run is groomed well. A well-groomed run is flat, has a good fall line, and does not have thin spots.”¹⁰

Applicant is not claiming rights in the corduroy design per se; rather Applicant is seeking to register a corduroy design consisting of a repeating pattern of ten substantially equidistant grooves that each have a substantially pointed bottom, the ten substantially equidistant grooves being offset on both sides by a thicker groove having a substantially flat bottom. In its November 6, 2014 Response to an Office Action, Applicant presented a side-by-side comparison of Applicant’s snow pattern and the snow pattern created by PistenBully, a competitor, thus, distinguishing Applicant’s purported mark from other snow tracks.¹¹ The comparison is reproduced below:



Applicant’s Trade Dress



PistenBully’s Groomed Snow Design

¹⁰ *Id.* at 573.

¹¹ November 6, 2014 Response to an Office Action (TSDR 17-18).

II. Whether the specimens show use of the subject matter sought to be registered?

A trademark application filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), must include one specimen for each class, showing use of the mark in commerce on or in connection with the goods. Section 45 of the Trademark Act states that a mark is deemed to be in use in commerce

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce.

Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1) provides:

A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods or packaging for the goods.

See also In re Sones, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (“the test for an acceptable ... specimen, is simply that it must in some way evince that the mark is ‘associated’ with the goods and serves as an indicator of source”); *In re Marriott*, 459 F.2d 525, 173 USPQ 799, 800 (CCPA 1972) (“the menu is a display of appellant’s offering directly associated with appellant’s goods. It is from this word or pictorial depiction of the sandwich that the customer makes his selection, and his selection is not indicated on the check by the specific ingredients of its composition but by the mark TEEN TWIST.”).

The TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) (2018) explains that a qualifying “display” will essentially comprise “point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices.” TMPEP § 904.03(g). “[T]he mere inclusion of a phone number, Internet address and/or mailing address on an advertisement describing the product is not in itself sufficient to meet the criteria for a display associated with the goods. There must be an offer to accept orders or instructions on how to place an order.” *Id.* See also *In re Siny Corp.*, 920 F.3d 1331, 2019 USPQ2d 11362**4 (Fed. Cir. 2019) (affirming rejection of “specimen [that] did not cross the line from mere advertising to an acceptable display associated with the goods”); *In re MediaShare Corp.*, 43 USPQ2d 1304, 1306 (TTAB 1997) (fact sheets, catalogs, or brochures submitted as specimens were not displays associated with the goods, in part, because they did not include any information as to how to order the products or the terms and conditions under which the software was available for license).

The specimens of use filed with the application are four photographs, each described only as “photo,” and for which Applicant provided no additional explanation. A representative photographic specimen is reproduced below:



These specimens are not acceptable because they do not show the applied-for mark on the products, packaging for the products, or as displays used in association with the products (i.e., point-of-sale materials).

In its October 20, 2015 Response to an Office Action, Applicant submitted a copy of an Operator's Guide. The cover of the Operator's Guide is reproduced below:¹²



¹² TSDR 49.

Instruction manuals per se, such as an Operator's Guide, can be acceptable specimens. *See In re Ultraflight Inc.*, 221 USPQ 903, 906 (TTAB 1984) ("We believe the instruction manual is as much a part of applicant's goods as are the various parts that are used to build the gliders. Application of the mark to the manual of assembly instructions, then, must be considered affixation to the goods.").

However, the Examining Attorney argues that Applicant's Operator's Guide is not an acceptable specimen because it does not display the subject matter sought to be registered.

[T]he operator's guide, which is a printed booklet, does not depict the mark—that is, the actual tracks left in snow or sand—in connection with the goods. Rather, the specimen presented to the consumer of the goods a two-dimensional printed image of snow tracks, not tracks left in the snow or sand. Furthermore, the picture of groomed snow printed on the operator's guide depicts a series of grooved lines, but does not depict the repeating pattern of thin and thick grooved lines shown in the drawing of the mark. Thus, the image does not depict a substantially exact representation of the mark, which is a requirement for an acceptable specimen.¹³

Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a), provides, in relevant part, that the specimen must show the mark as used on or in connection with the goods or services. TMEP § 807.12 (2018) summarizes the requirements for the mark in the drawing as compared to the mark in the specimen.

For applications under §1 of the Trademark Act, the drawing must always be compared to the specimen of record to determine whether they match. See 37 C.F.R. §2.51(a)-(b) [sic]. The first step is to analyze whether the

¹³ Examining Attorney's Brief (21 TTABVUE 23-24).

mark in the drawing is a substantially exact representation of the mark shown on the specimen.

In this case, the mark sought to be registered is a three-dimensional repeating pattern of ten substantially equidistant grooves appearing in groomed snow or groomed sand, offset on both sides by a thicker groove having a substantially flat bottom. The Operator's Guide does not display a three-dimensional repeating pattern appearing in groomed snow or groomed sand. Thus, the Operator's Guide does not display the applied-for mark.¹⁴

In its October 20, 2015 Response to an Office Action, Applicant also submitted a photograph of its exhibit at a trade show.¹⁵ The most legible photograph of Applicant's trade show exhibit is reproduced below:¹⁶

¹⁴ Applicant does not dispute that the photograph as part of the Operator's Guide is not a repeating pattern of ten substantially equidistant grooves appearing in groomed snow or groomed sand, offset on both sides by a thicker groove having a substantially flat bottom; rather, Applicant contends that it is "a sufficient representation." Applicant's Brief, p. 20 (7 TTABVUE 21). However, Applicant's "sufficient representation" is merely the presentation of a corduroy design which Applicant has acknowledged is used by competitors. *See* the Introduction; *see also* the declaration of Jean-Claude Perreault, Applicant's Vice President of Sales, who testified that over his 10 years of experience working for Applicant, he is unaware of any other company whose vehicles leave the snow track sought to be registered. Jean-Claude Perreault Decl. ¶20, November 6, 2014 Response to Office Action (TSDR 24). Moreover, Applicant argued that because its mark is the repeating pattern of ten substantially equidistant grooves, a repeating pattern of, inter alia, five substantially equidistant grooves would be an alternative design for snow or sand. Applicant's July 17, 2017 Response to an Office Action (TSDR 8). Accordingly, Applicant must show use of the subject matter described in the application and not an allegedly "sufficient representation."

¹⁵ TSDR 118.

¹⁶ Photographs should be clear and legible. Trademark Rule 2.126(a)(2), 37 C.F.R. § 2.126(a)(2) ("Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible."); *see also* TMEP § 904.02(b) *cf. Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013)(citing *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible....")), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014)



In other cases, the Board has found that the prominent display of the trademark on a trade-show booth where product literature is distributed and orders for the goods are taken is a display associated with the goods, *In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986), and that informational fliers or leaflets clearly depicting the mark and presented on the goods at trade show exhibits are acceptable displays associated with the goods. *In re Ancha Elec. Inc.*, 1 USPQ2d 1318 (TTAB 1986).

In *Shipley*, the Board found based on Applicant's declaration, "applicant's trade show booths are more than sites for the distribution of advertising literature; these booths are also sales counters for applicant's products, including the chemicals for use in fabrication of printed circuit boards." 230 USPQ at 693. Accordingly, the Board

(mem.); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

held that “[a] purchaser, upon seeing such literature describing applicant’s chemicals for use in the fabrication of printed circuit boards and being provided with the opportunity to buy these products at the trade show booths would, we think, associate the mark that is prominently displayed on that booth with such goods.” 230 USPQ at 694. *See also Ancha Elec.*, 1 USPQ2d at 1319 (applicant’s declaration supported applicant’s argument that specimens at trade show were point of sale materials).

In this case, John Swartz, a sales representative for Applicant, testified that Applicant’s snow grooming vehicles and related equipment are routinely marketed and sold at trade shows.¹⁷ Although the photograph displays a repeating snow track, the snow track does not appear to show the pattern sought to be registered (i.e., display a repeating pattern of ten substantially equidistant grooves, offset on both sides by a thicker groove having a substantially flat bottom, appearing in groomed snow).¹⁸ Thus, this specimen is not acceptable because it does not display the applied-for mark.¹⁹

¹⁷ Swartz Decl. ¶¶4-5 attached to Applicant’s May 20, 2016 Request for Reconsideration (4 TTABVUE 41).

¹⁸ As explained in note 15, it is incumbent on Applicant to submit evidence that is clear, legible, and displays what Applicant asserts that it displays.

¹⁹ Even if the photograph clearly displayed the subject matter sought to be registered, photographs such as those at the trade show displaying the products and the results of using those products (i.e., photographs of groomed snow) are commonplace. May 8, 2014 Office Action (TSDR 8-9, 17); November 6, 2014 Response to an Office Action (TSDR 17, 18, 32, 34-43); May 20, 2016 Response to an Office Action (TSDR 16, 22, 26, 29, 44, 116, 119); October 30, 2016 Office Action (TSDR 6, 11, 14, 20, 32); January 17, 2018 Office Action (TSDR 562, 571, 613, 618-637, 640-644, 648, 651-653, 658, 670, 675, 682, 687, 694-696, 699-700, 715, 717, 719-721, 736-743). As set forth in the specimen, the photograph of groomed snow would be viewed by prospective customers as no more than an informational depiction of the results of using Applicant’s machinery and not as a trademark for the goods. Thus, the trade show photographs do not show use of the applied-for matter as a mark, as indicated in the Examining Attorney’s failure to function refusal. However, given our determination below

Applicant also submitted video evidence as specimens. Although Applicant failed to provide evidence that the videos are point-of-sale materials, we consider their effectiveness. The videos are identified as “promotional videos.”²⁰ Because the URL for videos is <https://youtu.be/...>, we assume the videos are posted and available for viewing on the Youtube website.²¹ Mr. Swartz, Applicant’s sales representative, testified that materials such as “catalogs, operator’s guides, and pricing sheets are distributed to potential buyers at such trade shows.”²² Because he did not mention the videos at this point-of-sale venue, we lack evidence to treat them as displays used in association with the goods.²³

In addition, the first video only shows the applied-for mark in passing, if it is even noticed at all.²⁴ Through no stretch of the imagination could the first video be considered as displaying a mark. A second video focuses on creating a good snow pack, not the track.²⁵ The video informs the viewer that the tiller creates the pattern that

that the subject matter sought to be registered consists of a non-distinctive trade dress, we need not reach the failure to function refusal.

²⁰ October 20, 2015 Office Action (TSDR 5, 7, 10, 18).

²¹ October 20, 2015 Office Action (TSDR 19).

²² Swartz Decl. ¶¶4-5 attached to Applicant’s May 20, 2016 Request for Reconsideration (4 TTABVUE 41).

²³ We cannot treat the videos submitted with the May 20, 2016 Request for Reconsideration as substitute specimens because they are not supported by a declaration that they were in use as of the filing date of the application. Trademark Rule 2.59(a), 37 C.F.R. § 2.59(a). Nevertheless, we will consider them in connection with determining whether the subject matter sought to be registered has acquired distinctiveness.

²⁴ October 20, 2015 Office Action (Document 25 and 27).

²⁵ Document 26 and 28.

the skier skies on. The most prominent display of the track in the second video does not show the repeating pattern or the repeating pattern could not be perceived.²⁶

Because the specimens are not acceptable, the refusal to register on the ground that the specimens do not show use of the subject matter sought to be registered is affirmed.

III. Whether the subject matter sought to be registered consists of a non-distinctive product design?

The Examining Attorney refused to register the applied-for mark on the grounds that it does not function as a trademark and that it is a product design that has not acquired distinctiveness.²⁷ We find, however, that the applied-for mark is not a product design. The subject matter sought to be registered is not the shape, configuration, or other product design feature of a snow groomer (Class 7) or a tracked utility vehicle for grooming snow and sand (Class 12). The subject matter sought to be registered is the groomed snow or sand; the result of having used the product identified in the description of goods.²⁸

²⁶ Further, like the photograph of Applicant's booth at the trade show, to the extent that the videos display groomed snow, the groomed snow would be viewed by prospective customers as no more than part of Applicant's marketing strategy to show the results of using its equipment and would not be perceived as a trademark for the snow grooming machinery being promoted in the videos. Thus, the videos do not display the subject matter sought to be registered as a trademark because consumers will not perceive it as a source indicator as presented in the videos, as indicated in the Examining Attorney's failure to function refusal. However, given our determination below that the subject matter sought to be registered consists of a non-distinctive trade dress, we need not reach the failure to function refusal.

²⁷ Examining Attorney's Brief (21 TTABVUE 17).

²⁸ The subject matter sought to be registered is not product packaging because it is not a combination or arrangement of design elements that make up the product's packaging, graphics, layout, or color.

Nevertheless, “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes [source indication].” *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995).

But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in [****1163] context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods--*i.e.*, “to indicate” their “source”--much in the way that descriptive words on a product (say, “Trim” on nail clippers or “Car-Freshner” on deodorizer) can come to indicate a product’s origin. See, *e. g.*, *J. Wiss & Sons Co. v. W. E. Bassett Co.*, 59 C. C. P. A. 1269, 1271 (Pat.), 462 F.2d 567, 569 (1972); *Car-Freshner Corp. v. Turtle Wax, Inc.*, 268 F. Supp. 162, 164 (SDNY 1967). In this circumstance, trademark law says that the word (*e. g.*, “Trim”), although not inherently distinctive, has developed “secondary meaning.” See *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n. 11 (1982) (“[S]econdary meaning” is acquired when “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself”). Again, one might ask, if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit a color, under similar circumstances, to do the same?

Id. at 1162-63.²⁹ Thus, we first analyze whether the subject matter sought to be registered has acquired distinctiveness, because if it has not, we need not reach the failure to function refusal.

²⁹ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1070 (2000), holds

To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. The very

Because Applicant amended its application to register the subject matter sought to be registered under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), the Trademark Act “accepts a lack of inherent distinctiveness as an established fact.” *Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018) (“We have long held that ‘the applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.’”); *Yamaha Int’l Corp.*, 6 USPQ2d at 1008; *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983). In this appeal, Applicant has a heavy burden because the repeating pattern of ten substantially equidistant grooves appearing in groomed snow or groomed sand is a nontraditional mark. *See Yamaha*, 6 USPQ2d at 1008 (evidence required to show acquired

closeness will suggest the existence of relatively small utility in adopting an inherent-distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning.

Likewise, in this application, the consumer predisposition to equate the subject matter sought to be registered in this case does not exist and, therefore, evidence of acquired distinctiveness is required.

distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (analogizing color with ornamentation and holding “convincing evidence must be forthcoming to prove that in fact the purchasing public does recognize the design as a trademark which identifies the source of the goods.”) (quoting *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1, 2 (CCPA 1961); *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1052 (TTAB 2013) (finding that peppermint scent mark for “pharmaceutical formulations of nitroglycerin” failed to function as a mark by noting the insufficiency of applicant’s evidence of acquired distinctiveness in light of evidence that the use of peppermint scent by others in the relevant marketplace (i.e., pharmaceuticals) tends to show that such scents are more likely to be perceived as attributes of ingestible products than as indicators of source); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) (product configurations face a heavy burden to establish secondary meaning).

To establish acquired distinctiveness, an applicant must demonstrate that the subject matter sought to be registered is perceived by relevant consumers not just as the result of using the product or a feature of the product, but as identifying the producer or source of the product. *See Wal-Mart Stores*, 54 USPQ2d at 1068 (acquired distinctiveness exists “when, in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself”) (citation and internal quotation marks omitted); *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (“An applicant must show

that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness.”). This may be shown by direct or circumstantial evidence. *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018) (“The Board and courts have recognized that both direct and circumstantial evidence may show secondary meaning.”) (citation omitted); *In re Ennco Display Sys.*, 56 USPQ2d at 1283. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. *Id.* Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, prior registrations, extensive amount of sales and advertising, unsolicited media coverage, and any similar evidence showing wide exposure of the mark to consumers. *Id.*; *see also Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) (listing, as examples of circumstantial evidence, advertising, sales figures, and intentional copying by competitors). In particular, the Court of Appeals for the Federal Circuit set out factors to consider in assessing whether a mark has acquired distinctiveness, stating as follows:

Today we clarify that the considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. Int'l Trade Comm'n, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018); *see also In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1004-05 (TTAB 2018).

A. Association of the subject matter sought to be registered with a particular source by actual purchasers.

Applicant submitted declarations from six persons in the snow grooming industry, each of whom testified to the following (emphasis added):³⁰

Having worked in this industry for X years, I have become familiar with the different design impressions that are created in the freshly groomed snow by the various manufacturers' snow grooming vehicles.

Specifically, I have seen the distinctive [**corduroy, corduroy profile, pattern, superior, "single, oversized raised ridge," or segmented**] design impression that is created by [Applicant's] snow grooming vehicles on a multitude of occasions.

Consequently, upon encountering the distinctive [**corduroy, corduroy profile, pattern, superior, "single, oversized raised ridge," or segmented**] design impression found in the snow that has been freshly groomed, the primary significance to me is that it

³⁰ November 6, 2014 Response to Office Action (TSDR 51-52, 57-61, and 66-73).

We do not consider the declarations of Luc Boulanger, Operation Manager of Mont Sutton in Quebec, Canada (November 6, 2014 Response to Office Action (TSDR 45)), Mike Tanner, Director, Venues, of Winsport, Canada Olympic Park ((November 6, 2014 Response to Office Action (TSDR 48)), Patrick Founier, Manager of Lake Louise Ski Resort in Alberta, Canada (November 6, 2014 Response to Office Action (TSDR 54)), Steven Wall, Vehicle Maintenance Manager of Fernie Alpine Resort in British Columbia, Canada (November 6, 2014 Response to Office Action (TSDR 63)) because they are Canadian citizens working at Canadian ski resorts. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) ("Information concerning applicant's foreign activities, including foreign trademark applications and/or registrations, is not relevant to the issues in an opposition proceeding."); *Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ481, 489 n.7 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff'd, Miller Brewing Co. v. Oland's Breweries*, 548F.2d 349, 192 USPQ 266 (CCPA 1976); *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.).

represents snow that has been freshly groomed by [Applicant's] vehicle.

Subsequently, Applicant submitted three more declarations from people in the snow grooming industry, each of whom testified to the following (emphasis added):³¹

Having worked in this industry for X years, I have become familiar with the different design impressions that are created in the freshly groomed snow by the various manufacturers' snow grooming vehicles.

I have seen the distinctive **snow** design impression that is created by [Applicant's] snow grooming vehicles on a multitude of occasions, and when I see that distinctive design impression in freshly groomed snow, I associate the character and quality of the snow grooming vehicles with [Applicant].

None of the declarations included or referenced a depiction of the applied-for mark. Instead, the nine declarants vaguely described the purportedly distinctive design of the subject matter sought to be registered six different ways. While they refer to a design produced by Applicant's products, the persuasiveness of the declarations is seriously undermined because they lack clarity as to the specific features they recognize. None of the declarants described the purportedly distinctive design as including a repeating pattern, let alone a repeating pattern of ten equidistant grooves, offset on both sides by a thicker groove having a substantially flat bottom, although two declarants referred to a corduroy design. The declarations have little, if any, probative value because it is not clear that the declarants recognize the subject matter sought to be registered as the design impression found in the snow.

³¹ May 20, 2016 Response to Office Action (TSDR 9-14).

Further, in its November 6, 2014 Response to an Office Action, Applicant contends that its customers often feature images of the subject matter sought to be registered and “tout the distinctive quality of Applicant’s Trade Dress as it pertains to Applicant’s BR530 model snow groomer creating Applicant’s distinctive pattern of groomed snow.”³² Contrary to Applicant’s contention, the purportedly representative ski resort webpage refers to the resort’s commitment to quality grooming by providing “a smooth carpet of corduroy.” The resort does not refer to a repeating pattern of ten substantially equidistant grooves that each have a substantially pointed bottom, the ten substantially equidistant grooves being offset on both sides by a thicker groove having a substantially flat bottom. The resort does not differentiate between Applicant’s corduroy pattern and any other pattern of groomed snow. The resort only refers to its “crisp corduroy.” Applicant has failed to show that its customers perceive the subject matter sought to be registered as a source indicator.³³

B. Length, degree, and exclusivity of use.

Applicant has been using its applied-for mark, via tracks left in the snow by its vehicles, for at least 20 years.³⁴ Nevertheless, it is well settled that an applicant’s use of a term or design for a long time does not necessarily establish that the subject matter sought to be registered has acquired distinctiveness as a mark. *See, e.g.,*

³² November 6, 2014 Response to an Office Action (TSDR 14-15).

³³ In Applicant’s brochure for the BR 350, Applicant advertises that its “Posiflex Tiller provides perfect grooming and that the vehicle has extraordinary climbing ability, it operates in the toughest conditions, the cabin is designed for operator comfort, and it is designed for performance and economy. *Id.* at TSDR 40-43. Applicant fails to refer to its purportedly distinctive corduroy pattern.

³⁴ Jean-Claude Perreault Decl. ¶12, November 6, 2014 Response to Office Action (TSDR 22).

Alcatraz Media Inc. v. Chesapeake Marine Tours Inc., 107 USPQ2d 1750, 176 (TTAB 2013), *aff'd mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014) (“Given the highly descriptive nature of registrant’s mark, continuous use alone since 1992 would not be sufficient to establish acquired distinctiveness.”); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007) (“Applicant’s continuous use since 1992 is a fairly lengthy period, but not necessarily conclusive or persuasive on the Section 2(f) showing.”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (use of mark for sixteen years deemed “a substantial period but not necessarily conclusive or persuasive on the Section 2(f) showing”); *In re The Interstate Folding Box Co.*, 167 USPQ 241, 245 (TTAB 1970).

Jean-Claude Perreault, Applicant’s Vice President of Sales, testified that over his 10 years of experience working for Applicant, he is unaware of any other company whose vehicles leave the snow track sought to be registered (i.e., a repeating pattern of ten substantially equidistant grooves that each have a substantially pointed bottom, the ten substantially equidistant grooves being offset on both sides by a thicker groove having a substantially flat bottom).³⁵ However, Applicant acknowledged that “the Examining Attorney identified in her own internet searches other patterns of groomed snow, including those with equally sized and spaced ‘corduroy’ designs by Applicant’s competitors, including at least the following:”³⁶

³⁵ Jean-Claude Perreault Decl. ¶20, November 6, 2014 Response to Office Action (TSDR 24).

³⁶ November 6, 2014 Response to Office Action (TSDR 17).



Due to the similarity of these corduroy snow pattern to the pattern that Applicant seeks to register, we find that the applied-for mark is not substantially exclusive to Applicant's snow grooming vehicles.

C. Amount and manner of advertising.

In the last five years, Applicant has spent in excess of \$500,000 in advertising its snow grooming vehicles and equipment that leave the track design sought to be registered,³⁷ primarily at trade shows and conferences.³⁸ However, Applicant also advertises in trade journals and periodicals "that cater to the snow grooming industry."³⁹ Applicant submitted five representative advertisements which purportedly "prominently feature[] the Subject Mark."⁴⁰ However, we disagree that most of the advertisements prominently feature Applicant's mark, and the advertisement reproduced below is the only advertisement that appears to feature the "Subject Mark."

³⁷ Jean-Claude Perreault Decl. ¶13, November 6, 2014 Response to Office Action (TSDR 22).

³⁸ Jean-Claude Perreault Decl. ¶¶14 and 15, November 6, 2014 Response to Office Action (TSDR 23).

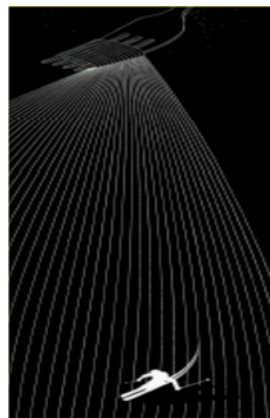
³⁹ Jean-Claude Perreault Decl. ¶17, November 6, 2014 Response to Office Action (TSDR 23).

⁴⁰ Jean-Claude Perreault Decl. ¶17 and Exhibit B, November 6, 2014 Response to Office Action (TSDR 23-24 and 27-31).



While the advertisement displays the subject matter sought to be registered, the advertisement focuses on how Applicant’s snow grooming machine is environmentally friendly and cost efficient; it does not draw the consumers’ attention to the snow track design.

An advertisement for Applicant’s SNOWLICIOUS “professional kitchen installed on a Prinoth snow groomer” features groomed corduroy. An excerpt from the advertisement is reproduced below.⁴¹



⁴¹ May 20, 2016 Request for Reconsideration (TSDR 143).

The advertisement features an alternative corduroy pattern; not the subject matter sought to be registered. We infer from this advertisement that little differentiates the subject matter sought to be registered from other corduroy patterns.

Finally, Applicant has submitted promotional videos used at trade shows that “depict demonstrations of Applicant’s goods - - and which highlight the distinctive snow design impression that is created by Applicant’s vehicles.”⁴² These videos promote the subject matter sought to be registered.

D. Amount of sales and number of customers.

Over the last five years, Applicant has sold in excess of \$365,000,000 worth of snow grooming vehicles in the United States that leave the track design sought to be registered.⁴³ Applicant’s snow grooming vehicles are used in hundreds of ski resorts in the United States.⁴⁴ This evidence demonstrates that Applicant’s snow grooming vehicles are commercially successful products but does not provide any information as to whether consumers perceive the snow track produced by the machines as a trademark. *See Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 (Fed. Cir. 1977) (“[sales volume] is not necessarily indicative of recognition of the mark by purchasers as an indication of source of the goods”).

E. Intentional copying.

There is no evidence of copying.

⁴² *Id.* at TSDR 5.

⁴³ Jean-Claude Perreault Decl. ¶13, November 6, 2014 Response to Office Action (TSDR 22).

⁴⁴ Jean-Claude Perreault Decl. ¶10, November 6, 2014 Response to Office Action (TSDR 22).

F. Unsolicited media coverage of the subject matter sought to be registered.

Applicant asserts that it has been recognized in various media reports and journals which purportedly note that Applicant is an industry leader.⁴⁵ Applicant attached two articles to the Perreault declaration. The articles are barely legible, they do not refer to Applicant as “an industry leader,” and they do not depict the subject matter sought to be registered in any significant way.

In its May 20, 2016 Request for Reconsideration, Applicant submitted “a compilation of third party articles and media between Applicant’s Mark and its applied for goods.”⁴⁶ None of the articles refer to the subject matter sought to be registered. Although, in “Mountain groomers offer a Beastly ride,” Idaho Mountain Express (December 26, 2012) (archives.metexpress.com), the article quotes Jack Seagraves, a snowcat operator, as follows:

“We’re laying down some corduroy now,” he said proudly as he put the Beast in forward gear and began to creep up Lower River Run at about 5 mph. ...

“The goal is to get the corduroy to line up straight when you’re connecting your passes,” he said.⁴⁷

Since we have established that the “corduroy” pattern is neither exclusive to Applicant’s machinery, nor is it the exact description of Applicant’s applied-for mark,

⁴⁵ Jean-Claude Perreault Decl. ¶19 and Exhibit C, November 6, 2014 Response to Office Action (TSDR 23 and 32-38).

⁴⁶ TSDR 1-2 and 16-32. We do not consider the article “The Pride and the Groom” in The Jasper Local (thejasperlocal.com) because it is a publication located in Jasper, Alberta, Canada.

⁴⁷ May 20, 2016 Request for Reconsideration (TSDR 27).

we do not find this article to be availing as to the subject matter sought to be registered.

“Prinoth: Moving Mountains,” an article by Snow Grooming Magazine (snowgroomingmag.com) (August 22, 2014) provides the following information about slope quality:

Additionally, the Posiflex tiller delivers unrivaled slope quality by combining key-features such as: Motor Speed Sensor that allows the operator to respond immediately to an overload, also resulting in better fuel efficiency; Active Posiflex Pressure Tuning that allows control over the pressure exerted on the ground so that any snow condition is managed properly. As featured in SKI Magazine, the proven efficiency of Prinoth’s Posiflex Tiller Technology has been behind vehicles grooming nine out of ten of the best groomed resorts last season.⁴⁸

There is no mention of the subject matter sought to be registered.

Finally, the photographs of the subject matter sought to be registered that appear in the articles are not so closely associated with the products that customers and potential customers will necessarily associate the track pattern with Applicant. Contrary to Applicant’s assertions, these materials do not constitute evidence that the subject matter sought to be registered has garnered unsolicited publicity in the media (i.e. from newspapers, magazines) and renown in the snow grooming field.

G. Conclusion as to lack of acquired distinctiveness

While Applicant’s snow grooming vehicles have been making snow tracks at hundreds of ski resorts in the United States over the past twenty years, Applicant

⁴⁸ *Id.* at TSDR 23.

has failed to prove that consumers perceive the applied-for snow tracks as a trademark for Applicant's snow grooming vehicles. With the exception of the videos submitted with Applicant's May 20, 2016 Request for Reconsideration, Applicant's advertising, marketing and promotional materials fail to focus on, or point to, the applied-for snow track as a trademark (e.g., there is no look for advertising focusing a reader's attention to the snow track). Rather, they depict the snow track as the result of using Applicant's goods. Especially in light of the fact that the subject matter sought to be registered is so similar to the tracks made by competitors' snow grooming vehicles, consumers are not likely to perceive the snow track to be anything other than a non-source-identifying design the grooming vehicle leaves behind.

Applicant has failed to prove that the subject matter sought to be registered has acquired distinctiveness.⁴⁹

IV. Whether the subject matter sought to be registered is a functional feature of the goods?

Trade dress is considered functional, and cannot serve as a trademark, if a feature of that trade dress is "essential to the use or purpose of the article or if it affects the cost or quality of the article." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4 n.10 (1982)). A determination of functionality

⁴⁹ Because the record fails to show that the subject matter sought to be registered has acquired distinctiveness, we have no need to further discuss whether the subject matter sought to be registered functions as a trademark.

normally involves consideration of one or more of the following factors, commonly known as the “*Morton-Norwich* factors”:

- (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.

In re Becton, Dickinson & Co., 675 F.3d 1368, 1374-75, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982).

- A. Whether there are any utility patents that disclose the utilitarian advantages of the design sought to be registered?

Applicant explains that the tiller and mats that create the subject matter sought to be registered when the snow is groomed are not the subject of any utility patents, and neither is the subject matter sought to be registered.⁵⁰ Conceding that there are some patents that display the subject matter sought to be registered or describe the mat assembly in conjunction with other claims, Applicant contends that the claims of those patents are not directed to the subject matter sought to be registered.⁵¹

⁵⁰ Applicant’s Supplemental Brief, p. 8 (19 TTABVUE 9); Applicant’s July 12, 2017 Response to Office Action (TSDR 5).

⁵¹ *Id.*

That is, while Applicant's Mark may be used as an example of a snow pattern illustrated in the drawings of certain U.S. patents and U.S. patent applications (which is completely logical considering how, over time this example snow pattern became the distinctive trade dress of Applicant's snow grooming machines), the claims of these patents (which describe the metes and bounds of the invention of such patents) are not directed to the implement that makes the subject mark in snow or sand. Consequently, the mat assembly / grooming method of Applicant's grooming snow and sand grooming machines are irrelevant to the functionality analysis here and are not germane to this case.⁵²

Applicant concludes that while the tiller and mats of the grooming vehicles function to groom snow evenly, the subject matter sought to be registered is not itself "functional" because it provides no functionality other than what any other pattern of groomed snow would provide.⁵³

The Examining Attorney disagrees and, in her January 17, 2018 and August 15, 2018 Office Actions, she submitted numerous patents and patent applications purportedly to show "features of snow grooming machines and vehicles."⁵⁴ In her brief, the Examining Attorney referred only to three patents and patent applications.⁵⁵

⁵² *Id.* at pp. 8-9 (19 TTABVUE 9-10).

⁵³ Applicant's July 12, 2017 Response to an Office Action (TSDR 7-8).

⁵⁴ Examining Attorney's Brief (21 TTABVUE 8).

⁵⁵ Although the Examining Attorney submitted numerous patents and patent applications, as noted in the body of the decision, she only referred to three; presumably the most probative. "The Board frowns equally upon an applicant or examining attorney submitting hundreds of pages of evidence in the hope that as the Board wades through it we will find something that is probative. When they believe that it is necessary to submit a significant amount of such material, it is incumbent on the applicant and the examining attorney to specify in their briefs those pieces of evidence that they believe are most persuasive of their respective positions, so that the Board can consider that evidence in particular." *In re Max*

1. Patent No. 6810609 for a “Snow Groomer Having an Improved Variable Geometry Tiller Assembly.”⁵⁶

This patent states that: “This invention relates to tillers for use with snow grooming vehicles for ski slopes.” The “Background” discussion further states:⁵⁷

Snow tillers are frequently equipped with a drum formed as a rotating blade and a finishing member that trails behind the rotator. ... The finishing member is usually a flexible mat or mats having grooved finishing elements provided at the rear of the tiller assembly to provide final snow surface conditioning by smoothing or, alternatively, to provide a “corduroy” texture to the surface of the tilled snow.⁵⁸

The invention, in part, allows the tiller to be operated in a floating or releasable locked mode to prevent damage to the tiller and return it to the preselected orientation to provide a consistent snow profile in differing snow conditions on the same hill on the same day and it provides the means to create a variety of snow profiles.⁵⁹ Although the patent mentions the creation of a “corduroy” surface, it does not demonstrate or discuss whether there is any utilitarian advantage to the creation of such corduroy pattern in general, much less Applicant’s design in particular by a snow grooming machine. Thus, the invention does not refer the utilitarian advantages of the snow track design sought to be registered.

Capital Grp. Ltd., 93 USPQ2d 1243, 1246 (TTAB 2010). Although, we considered all the evidence of record, in this decision we refer only to the three patents the Examining Attorney found most probative.

⁵⁶ August 15, 2018 Office Action (TSDR 2-16).

⁵⁷ *Id.* at Field of Invention, Column 1 (TSDR 13).

⁵⁸ *Id.* at Background of the Invention, Column 1 (TSDR 13).

⁵⁹ *Id.* at Summary of Invention, Column 2 (TSDR 13) and Detailed Description of Embodiments of the Invention, Column 9 (TSDR 17).

2. Patent Application Publication No. 2016/0318423 for a “Snow Groomer or Other Tracked Vehicle and Systems Therefor.”⁶⁰

“The invention relates to tracked vehicles such as snow groomers and other off-road vehicles.”⁶¹ The invention refers to the components of the snow groomer or other tracked vehicle, including a mat for smoothing snow processed by a tiller.⁶² Each mat may generate a portion of the ridges and grooves forming the snow track while other portions of the ridges and grooves may be formed by the interconnection of the mats.⁶³ The mat assembly that is towed over the snow may be assembled in such a way as to leave a pattern “comprising a plurality of ridges and a plurality of grooves between the ridges.”⁶⁴ “This creates a distinctive and pleasing appearance to the snow being groomed.”⁶⁵ This implies that the snow track pattern of ridges and grooves is aesthetically pleasing as opposed to having utilitarian advantages. We note that the patent application does not refer to the utilitarian advantages of the snow track design sought to be registered.

⁶⁰ January 17, 2018 Office Action (TSDR 257-314).

⁶¹ *Id.* at Field [0002] (TSDR 294).

⁶² *Id.* at Summary of Invention [0008-0046] (TSDR 294-298) and at Detailed Description of Embodiments [0209-0221] (TSDR 311-313).

⁶³ *Id.* at Detailed Description of Embodiments [0220] (TSDR 312).

⁶⁴ *Id.* at Detailed Description of Embodiments [0218] (TSDR 312).

⁶⁵ *Id.* The utilitarian advantage of the invention is that it may produce an aesthetically pleasing snow track pattern, not that the snow track pattern itself has a utilitarian advantage.

3. Patent Application Publication No. 2011/0083347 for a “Towed Piste Processing Implement.”⁶⁶

This invention relates, in part, to a snow grooming vehicle with a “finisher arrangement” that forms a “profile pattern” in the snow during towing operations.⁶⁷ The invention creates a pattern very similar, if not identical, to the claimed design. See Figs. 4, 5, and 6 in the patent application.⁶⁸ The patent states that an “object of the invention” is to make “it easy to see where the piste surface has already been processed” and “permits good utilization of the processed piste surface,”⁶⁹ including a “processed piste surface which is provided with the profile pattern that can be easily traversed.”⁷⁰ The profile pattern described in the patent application is “channel-shaped.”⁷¹ The patent application teaches that the utilitarian advantage of the invention is that it can groom snow and that the groomed surface is easily identifiable and traversable. There is nothing in particular about this patent that refers to a specific utilitarian advantage to the snow pattern sought to be registered. *See Goodyear Tire and Rubber Co. v. Interco Tire Co.*, 49 USPQ2d 1705, 1716 (TTAB 1998) (subject matter sought to be registered has not been shown to be a superior design because, in part, the design is not any more functional than any other tire

⁶⁶ January 17, 2018 Office Action (TSDR 315-320). Patent 8443529 B2 issued May 21, 2013.

⁶⁷ *Id.* at Towed Piste Processing Element [0001] (TSDR 319).

⁶⁸ *Id.* at TSDR 316-317.

⁶⁹ *Id.* at Towed Piste Processing Element [0004] (TSDR 319) (makes it easy to see the processed surface and permits good utilization of the processed surface).

⁷⁰ *Id.* at Towed Piste Processing Element [0010] (TSDR 319) (“the processed piste surface which is provided with the profile pattern can be easily traversed over by skiers and snowboarders.”).

⁷¹ *Id.* at Towed Piste Processing Element [0003] (TSDR 319).

tread design). In sum, there are no utility patents that disclose the utilitarian advantages of the specific pattern sought to be registered.

B. Whether Applicant's advertising touts the utilitarian advantages of the design?

Applicant's advertising does not tout the utilitarian advantages of the subject matter sought to be registered. For example, while Applicant's website promotes the ability of its vehicles to provide "perfectly prepared snow cover and guarantees the perfect slope" and "the best corduroy in the world," Applicant does not refer to the subject matter sought to be registered, let alone the advantages that the Applicant's snow pattern offers.⁷² Terms such as "perfectly prepared snow," "the perfect slope," and "the best corduroy in the world" are advertising puffery, not specific statements of utilitarian advantages of the applied-for mark, itself. *Compare* TMEP § 1202.02(a)(v)(B) ("where the advertising statements clearly emphasize specific utilitarian features of the design claimed as a mark, the Board will reject such assertions of 'puffing.'") (citing *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) ("the clear import of the advertisement is that the shape of the guitar is what produces a better musical sound."); *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d at 1716-17 (specific statements of functional superiority may not be dismissed as mere puffery); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260 (TTAB 1993) (applicant touts the utilitarian advantages of its product configuration

⁷² January 17, 2018 Office Action (TSDR 750-754). Although the website attached to the Office Action does not display the URL, the Examining Attorney provided it in the Office Action (pinroth.com/en/snow-groomers/products/additional-devices/detail/476/posiflex-tiller-33/) (TSDR 24).

which demonstrates its superior design); *In re Witco Corp.*, 14 USPQ2d 1557, 1559-60 (TTAB 1989) (specific statements touting functional advantages of the configuration sought to be registered may not be dismissed as puffery). Further, as noted above, with the exception of one advertisement, the advertising attached to the Jean-Claude Perrault declaration does not display the subject matter sought to be registered in a discernable way and none of the advertisements refer to the advantages that the Applicant's design offers.⁷³

Finally, the Examining Attorney contends that Applicant's videos promote the fact that Applicant's "signature" "create[s] relief and increase[s] the visibility of the skiers."⁷⁴ However, as noted in the discussion of utility patents, the advantage of grooming a slope and creating a corduroy design is to improve visibility and the ability to traverse the slope. Accordingly, Applicant is doing nothing more than touting the advantage of a corduroy snow pattern. There is nothing in Applicant's advertising to explain why the specific subject matter sought to be registered is better than any other corduroy pattern.

C. Whether there are alternative designs?

Applicant concedes that there are few alternative designs.⁷⁵ Those that do exist include corduroy that does not incorporate ten equidistant grooves in a repeating pattern discussed above. In this regard, Applicant, asserts that a repeating pattern

⁷³ Jean-Claude Perrault declaration attached to the November 6, 2014 Office Action (TSDR 27-31).

⁷⁴ Examining Attorney's Brief (21 TTABVUE 12).

⁷⁵ Applicant's Supplemental Brief, p. 11 (13 TTABVUE 14); Applicant's Reply Brief, p. 6-7 (22 TTABVUE 8-9).

of, inter alia, five substantially equidistant grooves would be an alternative design for snow or sand.⁷⁶ Thus, according to Applicant's logic, any corduroy pattern comprising anything other than ten equidistant repeating grooves is a potential alternative design.

Alternative groomed snow patterns are reproduced below:

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⁷⁶ Applicant's July 17, 2017 Response to an Office Action (TSDR 8).

⁷⁷ January 17, 2018 Office Action (TSDR 624).

⁷⁸ *Id.* at TSDR 637.



⁷⁹ *Id.* at TSDR 696.

⁸⁰ November 6, 2014 Response to Office Action (TSDR 17).



. Because there are only a few alternative designs and because, based on the visual depictions in the record, the different corduroy designs are difficult to distinguish from one another, this factor weighs in favor of finding that the subject matter sought to be registered is functional.

D. Whether the design results from a comparatively simple or inexpensive method of manufacture?

Applicant asserts that it is unable to attribute a specific cost to the subject matter sought to be registered because the cost of its vehicles is dependent on the features that a customer orders, while the subject matter sought to be registered is a consistent result of the use of its vehicles.⁸² However, Applicant contends that its mat assembly which creates the subject matter sought to be registered is a plurality of

⁸¹ *Id.*

⁸² Applicant's Supplemental Brief, pp. 11-12 (13 TTABVUE 14-15); Applicant's Supplemental Brief, pp. 6-7 (19 TTABVUE 7-8). We note that this is attorney argument which is not supported by any evidence in the record.

mats which may be more expensive to make because multiple mats may cost more to assemble than one large mat.⁸³

Applicant states that a mat assembly comprising a plurality of mat section is neither a comparatively simple or inexpensive method of manufacture in relation to alternative mat assembly designs. In fact, it may actually be a more expensive method of manufacture in that, for example, multiple mats may cost more to assemble/join together than one large mat.⁸⁴

The Examining Attorney argues that “to the extent that it would be more expensive or complicated to manufacture the mat assembly without the gap [the space between the plurality of mats], the product design results from a simpler or less expensive method of manufacture.”⁸⁵ Despite Applicant’s assertion that it may be more expensive to manufacture grooming vehicles with multiple mats to produce the subject matter sought to be registered, the Examining Attorney points out that a simpler or less expensive method of manufacturing is not, in and of itself, dispositive of whether a mark is functional. *See In re Rolf Dietrich*, 91 USPQ2d 1622, 1637 (TTAB 2009) (“Nevertheless, even if applicant’s wheels with this design are more costly to produce, and while a lower manufacturing cost may be indicative of the functionality of a product feature, a higher cost does not detract from the functionality of that feature.”) (citing *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001)).

⁸³ Applicant’s Reply Brief, p. 7 (22 TTABVUE 9).

⁸⁴ Applicant’s July 12, 2017 Response to an Office Action (TSDR 6-7).

⁸⁵ Examining Attorney’s Brief (21 TTABVUE 15).

There is no evidence that the design sought to be registered results from a comparatively simple or inexpensive method of manufacture that gives Applicant a competitive advantage.

E. Summary of the *Morton-Norwich* factors.

The evidence shows that groomed snow is easier to see and easier to traverse. There is no evidence that snow that is groomed in the pattern of the subject matter sought to be registered offers any benefit other than what any other pattern of groomed snow offers. Accordingly, we find that the evidence of record is insufficient to prove that the subject matter sought to be registered is functional.

Decision: The refusal to register the subject matter sought to be registered on the ground that the specimens do not show use of the applied-for mark is affirmed.

The refusal to register the subject matter sought to be registered on the ground that it has not acquired distinctiveness is affirmed.

The refusal to register the subject matter sought to be registered on the ground that it is functional is reversed.