

This Opinion is not a
Precedent of the TTAB

Mailed: February 16, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Icelandic Provisions, Inc.
—

Serial No. 86768287
—

John L. Welch of Wolf Greenfield & Sacks PC,
for Icelandic Provisions, Inc.

Kristina Morris, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

—
Before Quinn, Kuczma and Lynch,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Icelandic Provisions, Inc. (“Applicant”) seeks registration on the Principal



Register of _____, a three-dimensional configuration of a container,¹ for:

¹ Application Serial No. 86768287 was filed on September 25, 2015, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b); Applicant subsequently filed its claim of first use anywhere and first use in commerce since at least as early as January 31, 2016. “The mark consists of the three-dimensional configuration of a container for the goods, the container

Dairy products, namely, skyr² in International Class 29.

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the applied-for mark consists of a nondistinctive configuration of packaging for the goods.

When the refusal was made final, Applicant appealed and requested reconsideration including an amendment of its application to the Supplemental Register in the alternative. After the Examining Attorney denied the request for reconsideration and found the amendment to the Supplemental Register to be acceptable, the appeal was resumed. Applicant and the Trademark Examining Attorney submitted briefs. For the reasons set forth below, we affirm the refusal to register on the Principal Register; however, the application is allowed to proceed to registration on the Supplemental Register.

I. Issue on Appeal

In refusing registration, the Examining Attorney asserts that the applied-for mark consists of a nondistinctive configuration of packaging for the goods. Because

having substantially the shape of a non-rectangular parallelogram in horizontal cross-section.”

² “Skyr” is a Scandinavian dairy product made from curdled milk. Collins English Dictionary-Complete and Unabridged, 12th Edition 2014 © HarperCollins Publishers 1991, 1994, ... 2014. <http://www.thefreedictionary.com/Skyr>. The Board may *sua sponte* take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including definitions in online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). See also Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1208.04 (2017).

the mark is not inherently distinctive, the Examining Attorney concludes it is not registrable on the Principal Register under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 1127, without sufficient proof of acquired distinctiveness.

Applicant asserts it is well established that product packaging may be inherently distinctive and thus registrable on the Principal Register without proof of acquired distinctiveness, citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). However, in the alternative, Applicant filed a request for reconsideration, amending its application to the Supplemental Register,³ which was found acceptable by the Examining Attorney.⁴

Thus, the issue presented for appeal is whether Applicant's applied-for mark,



, that is used for product packaging of skyr dairy products, is inherently distinctive under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 1127, and registrable on the Principal Register.

II. Registrability of Applicant's Mark

In refusing registration, the Examining Attorney asserts that Applicant's applied-for mark is not inherently distinctive and can only be registered on the Supplemental Register or on the Principal Register with sufficient proof of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Applicant maintains that the Examining Attorney failed to meet the USPTO's burden of proof to show that the

³ July 25, 2016 Request for Reconsideration After Final Action.

⁴ August 20, 2016 Denial of Request for Reconsideration.

subject mark is not inherently distinctive.⁵ In support of its position, Applicant cites to the Supreme Court's recognition in *Wal-Mart* that "retail customers of many different products are 'predisposed' through conditioning to regard packaging, containers, and other features of trade dress as signals of the source of a particular product." *Wal-Mart*, 54 USPQ2d at 1068.⁶ Applicant maintains that its product packaging constitutes inherently distinctive packaging registrable without proof of acquired distinctiveness.

Trade dress that is deemed to be product packaging may be inherently distinctive and therefore, registrable, without proof of acquired distinctiveness. *Wal-Mart*, 54 USPQ2d at 1069 (observing that "*Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive...."); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1085-86 (1992); *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010). The Supreme Court acknowledges that "[t]he attribution of inherent distinctiveness to certain categories of word marks and product packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product." *Wal-Mart*, 54 USPQ2d at 1068.

For purposes of evaluating the distinctiveness of marks under § 2 of the Trademark Act, inherently distinctive marks are marks whose intrinsic nature serves to identify their particular source. *Wal-Mart*, 54 USPQ2d at 1067-68, citing *Two*

⁵ Applicant's Brief p. 6 (4 TTABVUE 9).

⁶ Applicant's Brief p. 5 (4 TTABVUE 8).

Pesos, 23 USPQ2d at 1083.⁷ It “should be displayed with such prominence as will enable easy recognition” and “the average consumer will regard it as an unmistakable, certain, and primary means of identification pointing distinctly to the commercial origins of such product.” *In re Swift & Co.*, 223 F.2d 950, 106 USPQ 286, 289 (CCPA 1955).

Inasmuch as the Supreme Court in *Wal-Mart* did not accept or reject any of the tests used to determine whether packaging trade dress was inherently distinctive, our primary reviewing court and the Board look to *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977), to determine whether product packaging is inherently distinctive. See *In re Chippendales USA Inc.*, 96 USPQ2d at 1689; *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1122 (TTAB 2012); *In re Right-On Co. Ltd.*, 87 USPQ2d 1152, 1155 (TTAB 2008).

Applicant and the Examining Attorney agree that the *Seabrook* factors for determining whether a design is inherently distinctive are applicable in this case: (1) whether the design is a common basic shape or design; (2) whether the design is [not] unique or unusual in the field in which it is used; (3) whether the design is a mere refinement of a commonly-adopted and well-known form of ornamentation for the particular class of goods viewed by the public as a dress or ornamentation for the

⁷ The Supreme Court remarked that inherent distinctiveness for product packaging will not be found when it is “not reasonable to assume consumer predisposition to take ... packaging as indication of source.” *Wal-Mart*, 54 USPQ2d at 1068. Professor McCarthy notes that “[b]y implication, this means that where it is reasonable to assume consumer predisposition to take packaging as an indication of source, then inherent distinctiveness will be found.” J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:13 (4th ed., December 2016 Update).

goods; or (4) whether the design is capable of creating a commercial impression distinct from any accompanying matter.⁸ *Seabrook*, 196 USPQ at 291. A finding that any one of these factors, by itself, is satisfied, may render the mark not inherently distinctive. *In re Chippendales*, 96 USPQ2d at 1684, 1687; *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026, 2028 (TTAB 2010).⁹

Professor McCarthy observes that the first three parts of this test “are merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin.... The issue is whether the trade dress is of such an unusual design that a buyer will immediately rely on it to differentiate the source of the product.”¹⁰

The Examining Attorney begins by noting the description of Applicant’s applied-for mark provided in the application, which contains the statement “... the container having substantially the shape of a non-rectangular *parallelogram* in horizontal

⁸ Applicant’s Brief p. 5 (4 TTABVUE 8).

⁹ The decision in *Wal-Mart* does not diminish the usefulness of the *Seabrook* test as to cases presenting the question of the inherent distinctiveness of product packaging. *See e.g., In re Chippendales USA Inc.*, 96 USPQ2d at 1689 (“Nothing in the *Wal-Mart* decision questioned or undermined the reasoning in *Seabrook*. Indeed, the Court [in *Wal-Mart*] cited *Seabrook* but did not express any disagreement with its use to determine the inherent distinctiveness of trade dress, although rejecting it as a test for inherent distinctiveness in the context of product design.”); *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1420-21 (TTAB 2010).

¹⁰ MCCARTHY § 8:13. *See also In re Chippendales USA, Inc.*, 96 USPQ2d at 1685 quoting *Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994) (citing *Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 996 F.2d 577, 27 USPQ2d 1189, 1192-93 (2d Cir. 1993)); *In re Frankish Enters. Ltd.*, 113 USPQ2d 1964, 1970-71 (TTAB 2015); *In re Procter & Gamble Co.*, 105 USPQ2d at 1122 (product packaging trade dress found inherently distinctive); *In re Hudson News Co.*, 39 USPQ2d 1915, 1922 n.15 (TTAB 1996).

cross-section.”¹¹ (emphasis added). Thus, Applicant itself recognizes that its container is essentially a parallelogram.

The evidence of record produced by the Examining Attorney shows that “parallelogram” is a term used to refer to a common two dimensional and three dimensional geometric shape.¹² This supports the Examining Attorney’s conclusion that the drawing of the applied-for mark and Applicant’s renderings of the mark (shown on pp. 2-5 of the March 8, 2016 Response to Office Action), show that Applicant’s mark is in the shape of a three-dimensional parallelogram.¹³

The Examining Attorney next presents evidence showing that overall square and rectangular-shaped containers are commonly used in the yogurt and dairy industry¹⁴ and that tapered sides and rounded corners are also common features of containers utilized in those industries.¹⁵ Citing *In re Mars, Inc.*, 105 USPQ2d 1859, 1869-71 (TTAB 2013), the Examining Attorney argues that Applicant’s parallelogram-shaped

¹¹ Examining Attorney’s Brief (6 TTABVUE 6).

¹² See evidence attached to the April 9, 2016 Office Action, including <http://quest.garden.com/119/12/3/110213152608/> at p. 2, <http://formulas.mathcaptain.com/math/geometry-formulas.html> at pp. 3-4, and www.buzzle.com/articles/list-of-different-types-of-geometric-shapes-with-pictures.html at pp. 5 and 8.

¹³ Examining Attorney’s Brief (6 TTABVUE 6).

¹⁴ See evidence attached to the April 9, 2016 Office Action, including www.dairyfoods.com/articles/91687-dairy-packaging-gets-a-makeover at pp. 10-11; www.theeasymarket.com/dan-non-light-and-fit-nonfat-yogurt-cherry-vanilla-6-oz-cup.html#.VwtzFflViQl featuring Dan-non Light & Fit and Fruit on the Bottom yogurt at pp. 15-16; www.gianteagle.com/System-Pages/Product-Page/?ec=46675126263 featuring Breyers yogurt at p. 17, Chobani yogurt at p. 19, Dannon yogurt at p. 23, Müller yogurt at p. 25, Oikos yogurt at p. 27.

¹⁵ See evidence attached to the April 9, 2016 Office Action at www.gianteagle.com/System-Pages/Product-Page/?ec=46675126263 featuring Chobani yogurt at p. 19 and Müller yogurt at p. 25.

containers are merely a refinement of the square- and rectangular-shaped containers commonly used in the dairy industry.

Applicant contests the relevance of the Examining Attorney's evidence showing a parallelogram to be a common basic shape because, according to Applicant, none of the evidence shows a three-dimensional figure having a horizontal cross-section in the shape of a non-rectangular parallelogram, let alone one having tapered sides and rounded corners like Applicant's proposed mark. However, the evidence introduced by the Examining Attorney directly relates to three-dimensional representations of the two-dimensional figures shown. For example, the Intro to Geometric Shapes Internet page "...aim[ed] to teach fifth grade students...how to create and describe **common** shapes" shows several images in a diagram labeled "SHAPES" which includes three-dimensional diagrams of a cube and a cylinder, as well as two-dimensional images of a square, circle, **parallelogram**, rectangle and triangle.¹⁶ (emphases added).

Similarly, the Math Captain website on Geometry Formulas states "[g]eometry is all about shapes, size, lines, etc. We need geometry formulas to find the length, area, perimeter, **volume** of all the different shapes." The same page features images of a parallelogram, rectangle, square, etc. The following page contains a Geometry Formula Chart listing "some of the **basic** geometry formulas," providing the formulas

¹⁶ Final Office Action of April 9, 2016, p. 2 questgarden.com/119/12/3/110213152608/.

for determining not only the area and perimeter of the shapes, including parallelograms, but the **volume** and surface area as well.¹⁷ (emphases added).

The page from the Buzzle website shows images of two-dimensional shapes such as a parallelogram and a hexagon together with three-dimensional shapes including a cylinder and an octahedron, and explains that “[b]asically, there are two types of geometric shapes: two dimensional (2D) and three dimensional (3D). The former can be drawn with reference to the X and Y axes, whereas, the latter also includes the Z axis....”.¹⁸

Applicant’s argument that none of those pages specifically “shows a three-dimensional figure having a horizontal cross-section in the shape of a non-rectangular parallelogram”¹⁹ falls flat. The evidence demonstrates that parallelograms and three-dimensional parallelogram configurations are prevalent, even providing the mathematical formula for calculating the volume of three-dimensional parallelograms. Therefore, the general parallelogram configuration of Applicant’s packaging is akin to a common basic shape or design that is recognized as such in the sources cited by the Examining Attorney. *See Chippendales*, 96 USPQ2d at 1687 (first *Seabrook* factor asks, “does [the mark] employ a basic shape or design such as a ... geometric shape?”).

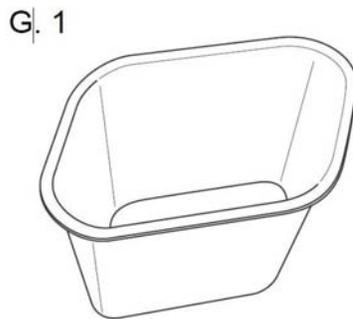
¹⁷ *Ibid.*, pp. 3-4 <http://formulas.mathcaptain.com/math/geometry-formulas.html>.

¹⁸ *Ibid.*, p. 5, www.buzzle.com/articles/list-of-different-types-of-geometric-shapes-with-pictures.html.

¹⁹ Applicant’s Brief p. 8 (4 TTABVUE 11).

Turning to the second factor, *i.e.*, whether the subject matter sought to be registered is unique or unusual in the field in which it is used, Applicant contends that nothing in the evidence demonstrates that the applied-for mark is not “unique or unusual” in its field.²⁰ Admittedly, there is no evidence showing use of the same exact configuration as that used by Applicant.

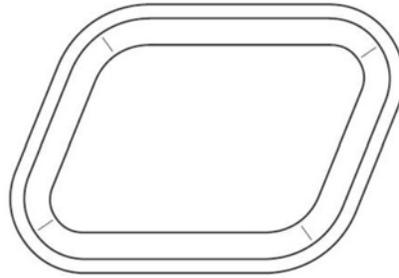
Turning to the third factor under the *Seabrook* test (*e.g.*, whether the design is a mere refinement of or variation on existing trade dress within the relevant field of use). In its application, Applicant describes its mark as consisting “... of the three-dimensional configuration of a container for the goods, the container having substantially the shape of a non-rectangular parallelogram in horizontal cross-section.” To show its applied-for container mark, Applicant’s submits evidence including a drawing of a perspective view of its container²¹:



²⁰ Applicant’s Brief p. 9 (4 TTABVUE 12).

²¹ March 8, 2016 Response to Office Action, p. 2.

and a drawing of the top plan view of the container²²:



Applicant also presents two photographs of “a model container shape, one taken looking down from above the open container” (presented on the left) and the other “showing the bottom surface of the container” (presented on the right)²³:



Applicant explains that “the adjacent sides of the container are in planes that do not meet at a right angle. The cross-section of the container taken in a plane parallel to the bottom (or top) is in the shape of a non-rectangular parallelogram with curved

²² March 8, 2016 Response to Office Action, p. 3.

²³ See attachments to March 8, 2016 Response to Office Action, pp. 4-5.

corners.”²⁴ Arguing that the non-rectangular shape of its container is unique for yogurt (or skyr) containers, and is not a basic or common shape in the field, Applicant concludes that the shape of its container is registrable as inherently distinctive.

As shown in the record, manufacturers of similar products use containers of various shapes, several of them having tapered side walls and rounded corners, to hold their goods, which also prominently display their word marks, logos and decorative images relating to their contents, some samples of which are shown²⁵:



p.15



p.27



p.17



p.21



p.23

²⁴ March 8, 2016 Response to Office Action.

²⁵ See April 9, 2016 Final Office Action.



p.19



p.25

The evidence submitted by the Examining Attorney shows that many yogurt and similar dairy products are sold in containers having square, rectangular and oblong shapes, *i.e.*, three-dimensional configurations, having tapered sides and rounded corners. Applicant's configuration, substantially consisting of the shape of a non-rectangular parallelogram in horizontal cross-section, is a recognized geometric shape and a mere common refinement of such configurations. As such, purchasers and prospective customers for Applicant's goods would be unlikely to regard its three-dimensional configuration as identifying and distinguishing Applicant's skyr and indicating its source. *See In re Mars, Inc.*, 105 USPQ2d at 1871 (applicant's container design is not unique in the sense it has an "original, distinctive, and peculiar appearance"); *In re Right-On Co. Ltd.*, 87 USPQ2d at 1155 ("While the [pocket stitching] design may in fact be unique, *i.e.*, it is the only such design being used, it also must possess an 'original, distinctive and peculiar appearance.'" *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960)."); *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253, 1255 (TTAB 1998) ("while the designs [of packaging for lights] applicant seeks to register may be unique in the sense that we have no evidence that

anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive”).

Thus, under the third factor of the *Seabrook* test, Applicant’s three-dimensional container is a mere refinement of common basic shapes, such as square- and rectangular-shaped food containers having tapered sides and rounded corners, commonly used in the yogurt and dairy industries rather than an inherently distinctive trademark for skyr dairy products. *See, e.g., In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d at 2029.

The fourth and last factor is whether Applicant’s design is capable of creating a commercial impression distinct from any accompanying matter. Applicant’s applied-for mark, shown in its specimen presented below, prominently features its ICELANDIC PROVISIONS word mark placed above a decorative image relating to the contents:



As such, it is similar to the packaged containers used by vendors of like products (shown above), who sell their products in round, square or other recognized geometric-shaped containers, which are labelled to prominently display the brand names of the goods with images relating to their contents.

The wording and design elements applied to Applicant's container contribute to the overall trade dress, and we see no basis for a finding that the shape of Applicant's container creates a separable commercial impression. Applicant provided no evidence to the contrary. *See In re Fantasia Distrib., Inc.*, 120 USPQ2d 1137, 1142 (TTAB 2016) (holding that applied-for mark "blends with the other elements of the trade dress [on the specimen] and does not make a distinct commercial impression as a source identifier"); *In re Wendy's Int'l, Inc.*, 227 USPQ 884, 886 (TTAB 1985) (finding as part of inherent distinctiveness analysis that "the design is not sufficiently unique or distinctive to create a commercial impression as a service mark separate and apart from the remainder of the matter as shown in the specimens of record").

Although the three-dimensional packaging configuration Applicant seeks to register may be unique in the sense that we have no evidence that anyone else is using an identical packaging configuration, it is nonetheless not inherently distinctive. *See In re Fantasia Distrib., Inc.*, 120 USPQ2d at 1141 ("Even if Applicant currently is the only user of a diamond pattern on e-hookahs, this fact alone does not imbue the design with source-indicating significance...."); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992), (although "applicant's applied for design may be unique in the sense that it is a 'one and only,' the record demonstrates that said design is not unique in the sense it has an 'original, distinctive, and peculiar appearance.'").

An inherently distinctive mark is one which is "by its very nature distinctive or unique enough to create a commercial impression as an indication of origin" *In re*

Right-On Co. Ltd., 87 USPQ2d at 1155 quoting *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979). While Applicant's design may in fact be unique, *i.e.*, it is apparently the only such configuration design being used, it also must possess an "original, distinctive and peculiar appearance." *Id.* quoting *In re McIlhenny Co.*, 126 USPQ at 140. Prospective customers viewing yogurt and related dairy product containers including those shown in the record and those used for Applicant's goods, are likely drawn to the products by viewing the prominent word marks, logos and the decorative colors used on the packaging *i.e.*, indicia other than the relatively common geometric shapes of the product containers.

Accordingly, prospective customers will likely perceive the three-dimensional configuration used by Applicant as simply a container for Applicant's product, with no source identification purpose. Ultimately "the focus of the [inherent distinctiveness] inquiry is whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive." *Tone Brothers, Inc. v. Sysco Corp.*, 31 USPQ2d at 1331 citing *Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 27 USPQ2d at 1192-93; *In re Chippendales USA Inc.*, 96 USPQ2d at 1685; *In re Procter & Gamble Co.*, 105 USPQ2d at 1122. Thus, if a mark is inherently distinctive, it is presumed that consumers will view it as a source identifier. Here however, Applicant's applied-for mark is not inherently distinctive.

We have considered each of the applicable *Seabrook* factors for inherent distinctiveness in light of the evidence of record. Nothing in the record leaves us to

conclude that customers would perceive and rely on Applicant's container design as an indication of source absent a showing of acquired distinctiveness.

III. Supplemental Register

Applicant amended its application to request registration on the Supplemental Register in the alternative.²⁶ Inasmuch as the Examining Attorney found the amendment acceptable, the application is allowed to proceed to registration on the Supplemental Register. *See* TBMP § 1215; TMEP § 816.04.

IV. Conclusion

In analyzing the evidence and arguments in light of the *Seabrook* factors for determining inherent distinctiveness, nothing in the record leads us to conclude that consumers would perceive and rely on Applicant's use of its three-dimensional shape as an indication of source absent a showing of acquired distinctiveness. Applicant has not submitted evidence of acquired distinctiveness, but has made a request, in the alternative, for registration of its mark on the Supplemental Register. The Examining Attorney has found Applicant's amendment to the Supplemental Register acceptable. Therefore, Applicant's mark is registrable on the Supplemental Register.

Decision: The refusal to register Applicant's mark on the Principal Register is affirmed. Because the Examining Attorney has accepted Applicant's amendment to the Supplemental Register in the alternative, the mark will proceed to registration on the Supplemental Register.

²⁶ July 25, 2016 Request for Reconsideration after Final Action.