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

| | |
|------------------------|---|
| Proceeding | 87285383 |
| Applicant | Reelex Packaging Solutions, Inc. |
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Opinion of Trademark Trial and Appeal Board In re Reelex Packaging Solutions, Inc.

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Reelex Packaging Solutions, Inc ,

Petitioner or Appellant,

v.

PETITION FOR REVIEW

U.S. Patent and Trademark Office ,

Respondent or Appellee.

Reelex Packaging Solutions, Inc.

(name all parties* bringing the petition or appeal)

hereby petition/appeal the court for review of the opinion refusing reg. nos. 87285383, 87285412 (describe
the order or decision and include decision number) of the Trademark Trial and Appeal Board

(name the agency, board, office or bureau) entered on Oct 23, 2019 (date).

The order or decision was received on Oct 23, 2019 (date).

Date: December 19, 2019

David P. Gordon

(Signature of petitioner, appellant
or attorney)

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(Address, phone number and e-mail of petitioner, appellant or attorney)

*See Fed. R. App. P. 15 (a) (2) for permissible ways of identifying petitioners.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CERTIFICATE OF SERVICE

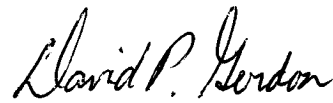
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**This Opinion is Not a
Precedent of the TTAB**

Hearing: August 14, 2019

Mailed: October 23, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
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In re Reelex Packaging Solutions, Inc.
—————

Serial Nos. 87285383 and 87285412
—————

David P. Gordon and Christian Mannino of Gordon & Jacobson, P.C.
for Reelex Packaging Solutions, Inc.

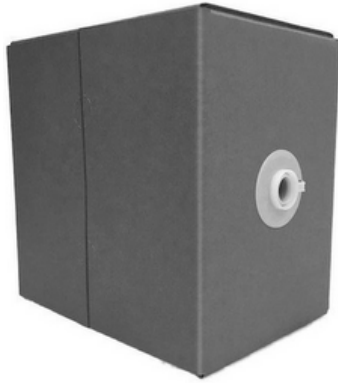
Suzanne Blane, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Iancu, Under Secretary of Commerce for Intellectual Property and Director of
the U.S. Patent and Trademark Office, Thurmon, Deputy Chief Administrative
Trademark Judge and Kuhlke, Administrative Trademark Judge.

Opinion by Thurmon, Deputy Chief Administrative Trademark Judge:

In these consolidated appeals,¹ Reelex Packaging Solutions, Inc. (“Applicant”) seeks registration on the Principal Register of the two box designs shown below for “electric cables and wire” in International Class 9.²



Application Serial No. 87285383
(the '383 trade dress)



Application Serial No. 87285412
(the '412 trade dress)

The Examining Attorney refused registration, finding Applicant’s trade dress functional, nondistinctive, and does not function as a mark to indicate the source of the goods identified in the applications. 15 U.S.C. §§ 1051, 1052, 1127. We affirm the refusal to register.

¹ We consolidate the appeals because they involve common issues of law and fact with similar records. *See In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1102 (TTAB 2018); *In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012). The briefs and evidence in the two appeals are nearly identical. Citations are to the record in Application Serial No. 87285383 unless otherwise noted. The specific trade dress is different in each application and where it is necessary to refer specifically to one design or the other, we do so below.

² Application Serial No. 87285383 was filed on December 30, 2016, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 1980. Application Serial No. 87285412 was filed on the same day, but is based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 2000.

I. The Trade Dress

Applicant is trying to register two box designs, as shown in the drawings above.

The first design, the '383 trade dress, includes the following description:

The mark consists of trade dress for a coil of cable or wire, the trade dress comprising a box having six sides, four sides being rectangular and two sides being substantially square, the substantially square sides both having a length of between 12 and 14 inches, the rectangular sides each having a length of between 12 and 14 inches and a width of between 7.5 and 9 inches and a ratio of width to length of between 60% and 70%, one, and only one rectangular side having a circular hole of between 0.75 and 1.00 inches in the exact middle of the side with a tube extending through the hole and through which the coil is dispensed from the package, the tube having an outer end extending beyond an outer surface of the rectangular side, and a collar extending around the outer end of the tube on the outer surface of the rectangular side of the package, and one square side having a line folding assembly bisecting the square side.³

This description defines a box with square sides and rectangular front, back, top, and bottom, just as the image shows. Boxes within the description may range in size from 12" x 12" x 7.5" (volume = 1080 in³) to 14" x 14" x 9" (volume = 1764 in³). The trade dress has a relatively small circular hole in the center of the front of the box with a payout tube and collar positioned with the hole. On its website, Applicant refers to

³ Serial No. 87285383.

this box as the REELEX I box.⁴ In addition, on its website it is listed for use with smaller wire and cable, typically with coil diameters of 9-16 inches.⁵

The second design, the '412 trade dress, is for the design shown on the right above.

This design includes the following description:

The mark consists of trade dress for a coil of cable or wire, the trade dress comprising a box having six sides, four sides being rectangular and two sides being substantially square, the substantially square sides both having a length of between 13 and 21 inches, the rectangular sides each having a length of the same length of the square sides and a width of between 57% and 72% of the size of the length, one, and only one rectangular side having a circular hole of 4.00 inches in the exact middle of the side with a tube extending in the hole and through which the coil is dispensed from the package, one square side having a tongue and a groove at an edge adjacent the rectangular side having the circular opening, and the rectangular side having the circular opening having a tongue and a groove with the tongue of each respective side extending into the groove of each respective side at a corner therebetween.⁶

This description defines a much wider range of box sizes, from 13" x 13" x 7.4" (volume = 1,251 in³) to 21" x 21" x 15" (volume = 6,668 in³). That is a range of over five times in volume. No range is given for the size of the circular hole.⁷ Applicant refers to this design as the REELEX II box.⁸ On its website, it is listed for use with structured

⁴ Office Action of April 5, 2017, at 46-47. All citations to documents in the application records contained in the USPTO's Trademark Status & Document Retrieval ("TSDR") system are to the downloadable .pdf versions of the documents. References to the briefs on appeal refer to the Board's TTABVUE docket system.

⁵ Office Action of June 29, 2018, at 19-20.

⁶ Serial No. 87285412.

⁷ '412 Response to Office Action of October 3, 2017, at 23-24 (Frank Kotzur, Applicant's longtime employee "Kotzur declaration").

⁸ *Id.* at 22.

networking cable (e.g., Cat. 5, 6, or 7 cable), coaxial cable, and other less-flexible wire or cable.⁹

II. Refusal on the Basis of Functionality

Under the statute, functional matter is unregistrable. 15 U.S.C. § 1052(e)(5) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) Consists of a mark which ... (5) comprises any matter that, as a whole, is functional”). Matter is functional if “it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citation omitted). “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.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65, 115 S. Ct. 1300, 1304 (1995); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:63 (5th ed. 2019).

These appeals go to the heart of the functionality doctrine, because Applicant seeks trademark protection for two boxes used with its patented system for coiling electric wire and cable. If these boxes provide important utilitarian advantages to parties that wish to use the technology disclosed in the patents after the patents’ expiration dates, providing trademark protection to Applicant could, under certain

⁹ ’412 Office Action of June 29, 2018, at 19.

circumstances, impair free and fair competition. *Cooper Indus. v. Leatherman Tool Grp., Inc.*, 532 U.S. 424, 441, 121 S. Ct. 1678, 1688 (2001) (“copying of the functional features of an unpatented product is lawful”). In addition, if the boxes provide utilitarian benefits for dispensing electric wire and cable generally, regardless of the coiling method, providing trademark protection could also impair free and fair competition.

“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 ‘competent evidence.’” *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) (quoting *In re Teledyne Indus.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982)). As we evaluate the two box designs at issue here, we must determine whether the designs sought to be registered, each taken as a whole, are functional. *Becton, Dickinson*, 102 USPQ2d at 1376 (consideration of “whether ‘an overall design is functional should be based on the superiority of the design as a whole, rather than on whether each design feature is ‘useful’ or ‘serves a utilitarian purpose.’”) (quoting *Textron, Inc. v. International Trade Commission*, 753 F.2d 1019, 1026 (Fed. Cir. 1985)).

The Board also uses the following factors to help determine whether a design or feature is functional:

- (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 Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982); *Becton, Dickinson*, 102 USPQ2d at 1377 (Fed. Cir. 2012) (using the *Morton-Norwich* factors). These factors are not exclusive, however, for functionality “depends upon the totality of the evidence.” *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002) (same).

Before we analyze the record under the four *Morton-Norwich* factors, we need to define the use and purpose of these boxes as gleaned from the identification of goods. If the designs are “dictated by” the functions they perform, the boxes are very likely functional. *Morton-Norwich*, 671 F.2d 1342; *see also In re Bose Corp.*, 772 F.2d 866, 227 USPQ2d 1, 6 (Fed. Cir. 1985) (“the shape of a speaker enclosure which conforms to the shape of the sound matrix is an efficient and superior design as an enclosure” and therefore functional); *Valu Eng’g, Inc. v. Rexnord Corp.*, 61 USPQ2d at 1425 (a design is functional if it “has a particular shape because it works better in [that] shape.”).

Certain features of these boxes are clearly dictated by utilitarian concerns. The rectangular shape of the boxes allows for stacking which is useful for shipping and storing. The boxes can be shipped without needing additional packaging. The ’412 design, the larger of the two, includes a built-in handle to make it easier to lift and

carry the box.¹⁰ These are all basic functions and thus utilitarian advantages provided by the boxes. Applicant touts these advantages, as the image below from its website illustrates:¹¹

| | | |
|---|--|---|
|  |  |  |
| Stackable | Lightweight & Easy to Handle | Easy to Ship |
| Reels and spools can roll, fall off shelves and are difficult to inventory, ship and stack. Because REELEX boxes are cubical, they inherently stack and display far better than rolls, spools and regular coils. | Spools are awkward to carry, a pain to set up and often require extra equipment just to make their use easier. With REELEX, the built-in handles make it easy to position and carry, and because there is no rotating mass, you can start dispensing whenever you want. No need for stands or brakes. | Reels and spools often require secondary packaging (including outer boxes) to ship. But, with REELEX, no additional packaging is necessary. Just put on a label and send it out the door. And because REELEX packages have no internal structure, they are far more lightweight than spools or reels. |

There is one general consideration worth noting before we turn to the more specific design elements of these boxes. Applicant touts that it is a leader in the figure 8 winding business and that its box designs have been the “standard” for many years.¹² These claims suggest that competitors need to use boxes of the same general size and shape in order to meet stacking needs and shelf spacing at warehouses, distribution centers, and retail outlets. Using nonstandard packaging would place Applicant’s

¹⁰ While not specifically recited in the description of the trade dress, because the drawing does not depict the handle in dotted lines, it is part of the claimed trade dress. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) §§ 807.08, 1202.02(c)(i) (2018).

¹¹ Office Action of June 29, 2018, at 23.

¹² Response to Office Action of October 3, 2017, at 33, 35 (exhibits to declaration of Timothy Copp, Applicant’s Vice President of Business Development “Copp declaration”).

competitors (or competitors of Applicant's licensees) at a substantial disadvantage, which suggests the standard box designs at issue here are functional.

The dimensions of the boxes and the size and placement of the payout tubes and payout holes are dictated by the amount and size of the electric wire and cable placed in the box.¹³ This is particularly demonstrated by Applicant's use of these boxes in conjunction with wire and cable wound into a figure 8 coil using Applicant's winding method. Applicant's winding "technology dates back to World War II when the REELEX figure-eight coil was first proposed to the military as a way to lay down field wire while still allowing an infantryman free use of both hands."¹⁴ Applicant obtained patents for this technology.¹⁵ The technology proved particularly useful for small gauge wire and cable and eventually led to what Applicant calls its REELEX

¹³ See Response to Office Action of October 3, 2017, at 24 ("If the box is too small for the coil, the box will bulge and either cause problems stacking, or threaten the structural integrity of the box itself. If the box is too big for the coil, the coil could slide or rotate within the package and cause unraveling and tangling issues. Many tangling problems in the field are caused by too large a box.) (packaging guide, exhibit to Kotzur declaration); Office Action of June 29, 2018, at 14 ("REELEX II features a much larger payout hole to increase bending radius and payout performance of products that are too large, stiff or sensitive to bending for REELEX I.") (Applicant's website www.reelex.com).

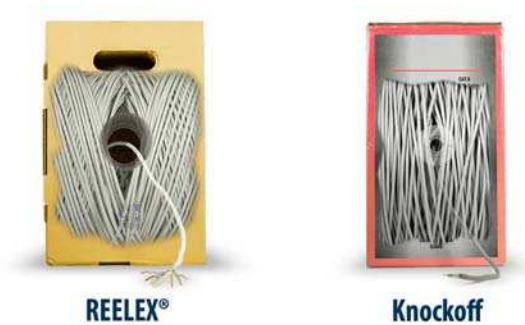
¹⁴ Response to Office Action of October 3, 2017, at 33 (Copp declaration, exhibit A).

¹⁵ *Id.* See also Kotzur declaration ¶ 3 ("I have been involved in the design of packages for figure-eight coiled cable products that are wound using [Applicant's] proprietary and patented coil winding technology.") Response to Office Action of October 3, 2017, at 21; Reelex website www.reelex.com ("REELEX is a patented method of winding cable or any cord-like product in such a way as to result in a reel-less, self supporting coil."); Office Action of November 8, 2018, at 21. We note that U.S. Patent Nos. 4,367,853, 4,406,419, 4,477,033, 4,741,495 are referenced in Applicant's advertising materials. Response to Office Action of October 3, 2017 at 28, 35 (Copp declaration exhibit A). We make no specific findings based on the content of these patents. The patents made of record are discussed below as part of the analysis under the first *Morton-Norwich* factor.

Much of this early development was done by Applicant's apparent predecessor, an entity known as Windings, Inc. Our references to Applicant include such predecessors.

system.¹⁶ Applicant licenses others to use its REELEX technology to wind and package coils of cable and wire.¹⁷

When Applicant's figure 8 winding system is used, the resulting coil has a roughly diamond-shaped opening in the sidewall of the coil, unlike a coil wound using other technology. The following illustration, using cut-away images, is taken from Applicant's website and helps show the difference:¹⁸



Applicant's competitors have a right to use box designs that will work well with figure 8 wound coils no longer covered by patents. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 25 USPQ2d 1913, 1923 (Fed. Cir. 1993) (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 9 USPQ2d 1847, 1855 (1989)) (“Defendant ... may copy plaintiff's goods slavishly down to the minutest detail: but he may not represent himself as the plaintiff in their sale.”); *New England Butt Co. v. International Trade Commission*, 756 F.2d 874, 225 USPQ 260 (Fed. Cir. 1985) (the policy behind the functionality doctrine is “not the right to slavishly copy articles

¹⁶ *Id.*

¹⁷ Applicant also licenses its know-how, which may be substantial and offer real benefits to its licensees. 4 TTABVUE 20. Its competitors, however, are free to use any expired patented technology and in so doing are likely to develop their own know-how over time.

¹⁸ Office Action of April 5, 2017, 44.

which are not protected by patent or copyright, but the need to copy those articles, which is more properly termed the right to compete effectively”). Applicant cannot use trademark law to inhibit potential competitors from gaining the experience and know-how needed to make high-quality figure 8 wound coils of cable and wire.

The figure 8 wound cable and wire sold by Applicant’s licensees, as shown below, has a diamond-shaped opening that extends from the outer edge of the coil to its open center.¹⁹



The cable or wire is wound in a figure 8 pattern in a manner that produces little or no twisting. The coil is unwound from its center, with the leading edge of the cable or wire threaded through the diamond-shaped opening as in the example above.

From this basic overview of Applicant’s figure 8 winding system, it is clear that several features are useful in a box made for a figure 8 wound coil. First, a payout hole is useful to allow users to take advantage of the easy and twist-free dispensing possible from a properly-wound figure 8 coil. Second, a payout tube extending from the payout hole to the center of the coil is useful to maintain the radial opening in the coil and to maintain the coil in alignment with the payout hole.

¹⁹ *Id.* at 48.

Third, the payout hole should be located on one of the rectangular panels in order to align it with the diamond-shaped radial opening in the coil. Fourth, it is useful to position the payout hole in the front panel, to provide easy access and a more direct path for dispensing the cable or wire. Fifth, it is useful to position the payout hole near the horizontal center of the front panel, because the diamond-shaped opening in the coil is near the horizontal center of the side of the coil, as shown in the comparison of the REELEX coil and a so-called knockoff above.

Sixth, it is useful to position the payout hole near the vertical center of the front panel for at least two utilitarian reasons. To begin with, this position leaves space for a handle in the upper part of the front panel. The '412 trade dress shows exactly this configuration and the '412 box is typically larger than the '383, meaning a handle is likely to be more useful with the '412 box. Positioning a handle in the upper area of the front panel is useful because it reduces how far a person must bend to reach the opening and lift the box.

Another advantage to positioning the payout hole near the vertical center of the front panel is that the circular outer surface of the coil will contact the rectangular front panel near its vertical center. This result follows from simple geometry. A circle that fills a square will touch the square at the center of each side. If the payout hole is not near the vertical center of the front panel, there will be open space between the payout hole and the outer surface of the coil. A longer payout tube may be needed, and the fit between the outer surface of the coil and the payout hole/tube will not be

as close. These may be relatively minor disadvantages, but they are easily avoided by positioning the payout hole in the vertical center of the front panel.

A seventh useful feature is a box with larger and generally square side panels and rectangular front, back, top and bottom panels. The figure 8 wound coils shown in the evidence have diameters that exceed their widths.²⁰ Applicant's packaging guidelines state, "The box should always fit the finished REELEX coil **snugly**."²¹ This requirement means the rectangular panels will be narrower (i.e., distance between side panels) than long.

The seven useful features described above combine to define a box with at least the following characteristics:

- square side panels and rectangular front, back, top and bottom panels, where the rectangular panels are narrower than long;
- a payout hole positioned near the center of the front panel;
- a payout tube extending from the payout hole to the center of the coil; and
- sizing that fits the coil snugly and a hole sizing that accommodates different sized cable and wire.

These features are all present in the '383 and '412 boxes and show that the designs were dictated by the utilitarian purpose they serve. *In re Morton-Norwich Prods., Inc.*, 213 USPQ at 17 (trade dress is functional if the design is dictated by the functions it must perform). For packaging a figure 8 wound coil of cable or wire, these boxes are "the best, or at least one, of a few superior designs." *In re Bose Corp.*, 227

²⁰ Response to Office Action of October 3, 2017, at 29, 31-33.

²¹ *Id.* at 25 (Exhibit to Kotzur declaration) (emphasis in original).

USPQ2d at 4. These combined features are “essential to the use or purpose of the article or affect[] the cost or quality of the article.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 US 844, 214 USPQ 1, 4 n.10 (1982). Though we find this analysis sufficient to show that the boxes are functional, we will review the four *Morton-Norwich* factors as well. It is not required that all four factors be proven in every case, nor do all four factors have to weigh in favor of functionality to support a refusal. Nevertheless, in reaching our decision, we will review all four factors. *See AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833 (TTAB 2013).

A. Do Applicant’s Patents Disclose Utilitarian Advantages of the Claimed Trade Dress?

The existence of a utility patent “is strong evidence that the features claimed therein are functional” and “[w]here 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.” *TrafFix*, 58 USPQ2d at 1005. The utility patent need not “claim the exact configuration for which trademark protection is sought in order to undermine an applicant’s assertion that an applied-for mark is not” functional. *Becton, Dickinson*, 102 USPQ2d at 1377. Rather, “a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Id.* As noted by Professor McCarthy in his discussion of *TrafFix*, “... while the Court continually talked about the evidentiary weight of what appeared in the patent claims, in fact the Court did not restrict the evidentiary use of a utility patent to its claims. The Supreme Court

used both disclosures in the specification and argument made in the prosecution history as persuasive evidence of functionality.” MCCARTHY, at §7:89. Likewise, McCarthy notes that “[i]t is proper to look to the disclosure (as distinguished from the claims) in a utility patent as evidence of the functionality of a shape. The Trademark Board has held that each **embodiment** of the invention described in a utility patent is equally functional for purposes of trademark law.” MCCARTHY, at 7:89.1 (citing *In re Bose, supra*, and *In re Edwards Ski Products Inc.*, 49 USPQ2d 2001 (TTAB 1999)).

In response to the Examining Attorney’s request for information and documentation for any patent that has as its subject the applied-for mark or any feature thereof, Applicant submitted five patents:²²

U.S. Patent No. 5,810,272 for a Snap-On Tube and Locking Collar for Guiding Filamentary Material Through a Wall Panel of a Container Containing Wound Filamentary Material;

U.S. Patent No. 6,086,012 for Combined Fiber Containers and Payout Tube and Plastic Payout Tubes;

U.S. Patent No. 6,341,741 for Molded Fiber and Plastic Tubes;

U.S. Patent No. 4,160,533 for a Container with Octagonal Insert and Corner Payout; and

U.S. Patent No. 7,156,334 for a Pay-Out Tube.

Many of the patents bear directly on the “tube extending through the hole” and “the tube having an outer end extending beyond an outer surface of the rectangular

²² Response to Office Action of September 26, 2017, at 13-62.

[front] side, and a collar extending around the outer end of the tube on the outer surface of the [front] rectangular side of the package,” which are part of the ’383 trade dress and “with a tube extending in the hole,” which is part of the ’412 trade dress.

Some relevant excerpts from the patents are set forth below:

Material from the core of the coil is drawn through a feed tube extending radially through the windings of the coil. The coil is packaged within a container provided with a window positioned for withdrawal of the material from the coil. ... Claim 1 ... and including a feedout tube inserted in said radial hole for feeding the inner end of the material and having opposing sides engaging the inner surfaces of the container, said feedout tube being aligned with said perforated hole; ²³

A payout tube assembly for unwinding filamentary material from a wound coil of filamentary material contained in a container having a wall panel with a hole for mounting a push-on tube and locking collar on the container wall panel, wherein a hollow payout tube having an end portion extends through the hole, the end portion including a flange extending around the periphery of the tube and having a surface engaging the inner surface of the wall panel surrounding the hole, and further including at least three segmented locking protrusions extending around the periphery of the end portion ... a locking collar for engaging the outer wall of the wall panel ... This invention relates to payout devices attached to containers for dispensing strand-like or filamentary material from a wound coil in the container, and more particularly to such payout devices comprising a hollow feed tube guide (payout tube) inserted through a hole in the wall panel of the container and pushed into locking engagement with locking collar so that the wall panel is retained between the locking collar and payout tube, whereby the strand-like or filamentary material can be withdrawn from the container through a central hole in the payout tube and the locking collar. ... Thus, a primary object of the invention is to provide a two-piece, push-on payout tube comprising the

²³ U.S. Patent 4,160,533, Response to Office Action of September 26, 2017 at 16-17.

payout tube and locking collar which can be snap-fastened together on opposite sides of the wall of a container, remain in a permanent locked position and provide a smooth radius between the edge of the payout tube and the locking collar to prevent a sharp bend in the filamentary material being withdrawn from the container and through the payout tube. ... Claim 1 A payout tube assembly for unwinding filamentary material from a wound coil of filamentary material contained in a container having a wall panel with a hole for mounting in said push-on tube and locking collar on the container wall panel. Comprising: a hollow payout tube having an end portion extending through the hole, said end portion including a flange extending around the periphery of the tube ...;²⁴

This invention relates to payout tubes for guiding filamentary material through a payout hole extending from the outer wind to the inner wind of a coil of filamentary material wound in a Fig. 8 wind, and in particular to such payout tubes made from corrugated fiber or plastic material and which have an oval, diamond, elliptical or round shape with an oversized opening to accommodate CAT 5, CAT 6, and CAT 7 cables for kinkless unwinding from the inner coil to the outer coil of the wound material. ... It is another object of the present invention to provide an enlarged payout tube that engages with an enlarged payout hole to provide payout of wound flexible material having unusually stiff, flexible, hard, soft, prone to tangling, large or small characteristics. It is another feature of the payout tube of the present invention that an enlarged payout tube provides kinkless and tangle-free unwinding of filamentary material from a wound package. It is a further advantage of the payout tube of the present invention that wound flexible material having unusually stiff, flexible, hard, soft, prone to tangling, large or small characteristics may be unwound without tangling or kinking. ... Claim 1 A payout tube ... comprising: an entrance opening and an exit opening in coaxial and spaced relationship with one another; the size of said entrance and exit openings are sufficiently large to allow the filamentary material to be withdrawn from the inside of the coil and

²⁴ U.S. Patent 5,810,272, Response to Office Action September 26, 2018, at 18, 23, 26.

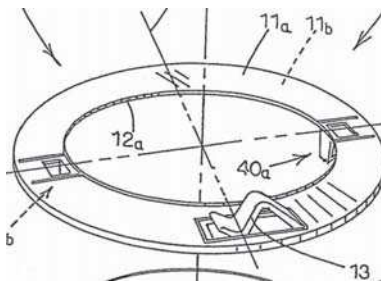
through the payout tube without birdnesting or kinking;²⁵ and

A pay-out tube adapted to be used in conjunction with a capable container for directing cable from a winding disposed within the container. The pay-out tube includes a molded tube for receiving and guiding cable from the interior of the cable container ... Pay-out tubes are commonly used in the cable industry. ... Fig. 1 ... Pay-out tube 10 is basically of a two-piece construction and includes a tube indicated generally by the number 20 and a collar indicated generally by the numeral 12. ... Turning now to collar 12, ... Disposed on surface 11a, aligned with the minor axis 25b is a clip 13. ... Turning now specifically to clip 13, in a preferred embodiment a wire or cable clip 13 is integrally molded into the collar 12.²⁶

The utility of a handle (present in the '412 trade dress) is claimed in one patent:

Claim 2 ... A package as in claim 1 wherein said container further includes a cutout portion forming a handle for transporting the package.²⁷

The utility of a cable catch on the outer flange of the payout tube (present in the '383 trade dress) is disclosed in another patent.²⁸



²⁵ U.S. Patent 6,341,741, Response to Office Action September 26, 2018, at 49, 53.

²⁶ U.S. Patent 7,156,334, Response to Office Action September 26, 2018, at 54, 60, 61.

²⁷ U.S. Patent 4,160,533, Response to Office Action of September 26, 2018, at 17.

²⁸ U.S. Patent 7,156,334 Figs 1, 6 (and accompanying description of those figures). The description of the '383 trade dress does not mention this feature, but it is shown on the drawing and Applicant did not exclude any parts of the drawing from the trade dress. See Trademark Rule 2.52(b)(4) ("The applicant must also use broken lines to show any other matter not claimed as part of the mark."). It is more clearly visible in the specimen of use.

The 6,086,012 patent ('012) discloses and claims a version of the REELEX II box (the '412 trade dress).²⁹ The claims in this patent are directed to a six-sided box made from twelve panels.³⁰ The patent also discloses information about the purpose and advantage of a box of the '412 box design.³¹

The '012 patent also explains that the box “is dimensioned in accordance with the diameter of the wound coil that is to be contained therein and may be manufactured in standard sizes to accommodate standard diameters of wound coils.”³² The patent provides as an example, “the container 60 shown in Fig. 10A may be 9.5 inches x 13.5 inches to accommodate a 12 inch diameter coil.”³³ We take the cited dimensions as referring to the rectangular panels of the box, so that the side panels are 13.5” squares for use with a coil having a 12” diameter. In a second patent, Applicant explains that 14 inch coils are “the nominal size for CAT5-CAT7 unshielded cables.”³⁴ These two patents are evidence that 12 and 14 inch diameter coils are standard sizes.

²⁹ U.S. Patent 6,086,012 at Fig. 10B and claims 1-26. Response to Office Action of September 26, 2018, at 29-39.

³⁰ While the number of panels required to make the six-sided box is not relevant to what is visible to consumers as a possible indication of source, and is not included in the description of the trade dress in the '412 application, the resulting six sides of the box are relevant.

³¹ '012 patent col. 2, ll. 8-15 (asserting that box with larger payout hole works better with CAT 5, CAT 6 and CAT 7 cable), 19-29 (asserting that REELEX II package provides better performance with various types of cable and wire).

³² *Id.* at col. 5, ll. 7-10.

³³ *Id.*

³⁴ U.S. Patent 6,341,741 at col. 9, ll. 13-14.

This evidence is significant for two reasons. First, it shows that the sides of the square panels should be about 1.5” larger than the coil diameter in order to fit well. As we noted above, Applicant’s packaging guidelines provide, “The box should always fit the finished REELEX coil **snugly**,”³⁵ and we find that sizing the square sides of the box about 1.5” larger than coil diameter meets this need. The coil diameter range listed for the REELEX II system is 12-22 inches.³⁶ The 13 – 21 inch range in the description of the ’412 trade dress covers almost the entire product size range for this type of box, leaving only coil diameters of 19.5” and larger outside the definition of the trade dress.

Second, this evidence identifies two typical or common coil sizes (i.e., 12” and 14”) and shows that both are covered by the ’412 trade dress. Given that this basic box design is sized to fit the most common coil diameters and that the ’012 patent identifies benefits of this basic design, we find this substantial evidence that the ’412 trade dress provides important utilitarian advantages. *TrafFix*, 58 USPQ2d at 1006. This evidence shows the ’412 trade dress is a simple, basic and adequate box design for figure 8 wound coils of cable and wire.

The coil size examples noted above are also relevant to the ’383 trade dress because that trade dress includes boxes with square sides ranging from 12” to 14”. Allowing 1.5” difference between the box dimensions and coil diameter, the ’383 trade dress is suitable for coils from 10.5” to 12.5” and we note the ’012 patent identified a

³⁵ Response to Office Action of October 3, 2017, TSDR 25 (Exhibit to Kotzur declaration) (emphasis in original).

³⁶ Office Action of June 29, 2018, TSDR.

12” coil as a typical or standard size. So while the ’383 trade dress does not cover as large a range of coil diameters as the ’412 trade dress, it does appear to include at least one common coil size.

Overall, the disclosures and preferred embodiments in the patents reveal the functionality of significant aspects of the designs. Much of the applied-for aspects in the applications are referenced in the utility patents and these aspects are not “merely an ornamental, incidental, or arbitrary aspect of the packaging.” *TrafFix*, 52 USPQ2d at 1005. The critical question is “the degree of utility present in the overall design of the mark.” *Becton, Dickinson*, 102 USPQ2d at 1376. Here, the specific size of the boxes and size and location of the payout holes is dictated by their function to house and dispense electric wire and cable of specific sizes. The size and nature of the cable dictates the size of the hole, the size of the coil dictates the dimensions of the box, including the fact that it is square on two sides and rectangular on other panels. Applicant’s argument that these features are ornamental and arbitrarily selected³⁷ is not supported by the record. All aspects are functional, and the sum of individually functional parts does not result in a protectable mark.

B. Does Applicant’s Advertising Tout Utilitarian Advantages of the Trade Dress?

Under this factor, we consider evidence regarding “advertising materials in which the originator of the design touts the design’s utilitarian advantages.” *Valu Engineering v. Rexnord*, 61 USPQ2d at 1426 (citing *Morton-Norwich*, 213 USPQ at

³⁷ See Kotzur declaration ¶¶ 7-8, Response to Office Action of October 3, 2017, at 22.

15-16). Applicant submitted evidence of advertising and the Examining Attorney identified pages from Applicant's website that tout the utilitarian advantages of the REELEX system. Applicant alleges that its figure 8 winding and packaging system provides better dispensing of the cable or wire.³⁸ More specifically, Applicant touts the following additional advantages for the boxes at issue here: "less waste and easy recyclability," "easier shipping and palletization," "easy to stack," "can be shipped without external packaging," and "simplifies storage."³⁹ This advertising, in short, promotes the substantial utilitarian advantages of the boxes.

An ad submitted by Applicant shows both boxes side-by-side and states, "For over 25 years, we've been the number one provider of low cost, reelless packaging to the wire and cable industry."⁴⁰ Another ad touts the flexibility and low cost of the two box designs at issue here.⁴¹ An article Applicant submitted identifies the claimed trade dress as "the standard package" for a wide range of wire and cable.⁴² Applicant also touts the utilitarian aspect of the payout tubes "to ensure each half-twist of the figure-eight resolves inside the coil, rather than outside. If no payout tube is used, the half-twists can create kinks and twists in the product which can cause payout issues. ... Innovative tube designs ensure smooth payout, even in cold temperatures or when

³⁸ Office Action of June 29, 2018, at 13-20.

³⁹ *Id.* at 17.

⁴⁰ Response to Office Action of October 3, 2017, at 33 (exhibit to Copp declaration) (also referring to the "low cost of the REELEX and REELEX II packaging").

⁴¹ *Id.* at 34.

⁴² *Id.* at TSDR 35.

packaging less-flexible products.”⁴³ This advertising is further evidence the box designs are functional.

Applicant’s website materials include numerous references to so-called knockoffs.⁴⁴ Applicant appears to define as knockoffs all coils of cable and wire sold by unlicensed parties in boxes similar to the ’383 or ’412 trade dress.⁴⁵ While Applicant identifies a number of allegedly inferior aspects of the winding and dispensing of these so-called knockoffs, there is no explanation for why these products are considered knockoffs. The samples of so-called knockoffs presented on Applicant’s website bear third party branding, which refutes the claim that these products are knocking off Applicant or trying to trade on Applicant’s good will.⁴⁶ *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1575 (TTAB 2009) (no intent to trade on goodwill where third parties “clearly display the manufacturer’s trademark or trade name on the” goods).

We find this advertising to be strong evidence of functionality, both for what it directly shows (utilitarian advantages of the two box designs) and for what it reveals about the likely consequences of issuing registrations for Applicant’s standard box designs.

⁴³ Office Action of June 28, 2018, at 14-15.

⁴⁴ Office Action of April 5, 2017, TSDR 44-50.

⁴⁵ *Id.* at 46-48.

⁴⁶ *Id.* at 47.

C. Are Equivalent Alternatives Available?

“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.” *TrafFix Devices*, 58 USPQ2d at 1006. The *TrafFix* decision does not mean competitive need is irrelevant, but rather that a design “cannot be given trade dress protection merely because there are alternative designs available.” *Valu Eng’g*, 278 F.3d at 1276; *see also Becton, Dickinson*, 102 USPQ2d at 1378.

The evidence discussed above shows the boxes are functional, and therefore this factor is less critical. For sake of completeness, however, we review the evidence Applicant submitted regarding alleged alternative designs. That evidence was provided in a single declaration by Frank Kotzur, a long-time employee of Applicant.⁴⁷ Mr. Kotzur asserts that both box designs would work with different shape or size payout holes. He identifies oval, elliptical, diamond and rectangular shapes as options. For the ’412 design, Mr. Kotzur says a payout hole of 1.5” or larger will work. But for the ’412 design, he notes that payout holes 2.5” and smaller or 6.0” and larger are alternatives. For both boxes, Mr. Kotzur asserts that different box shapes and aspect ratios are possible and that the payout hole could be on a different panel or off-center.

We cannot give much weight to Mr. Kotzur’s declarations because (1) he provides no evidence to support his speculation as to possible alternatives; (2) several of his

⁴⁷ Response to Office Action of October 3, 2017, TSDR 22-24. Mr. Kotzur is a named inventor on the patents Applicant identified and he had been an employee for 42 years when his declarations were submitted. He submitted a very similar declaration in support of each application.

assertions are contradicted by other evidence; and, (3) as an employee of Applicant, his declaration appears to be self-serving. On the first point, Mr. Kotzur does not provide any performance testing showing that these alternatives would work as well as the claimed trade dress. Nor does he provide any cost estimates for designing and producing such non-standard designs. Without such evidence, we cannot determine whether any of the alleged alternatives are equivalent in performance, quality or cost to the claimed trade dress.

We also question Mr. Kotzur's assertions because of the contradictions in his declarations. He states, for example, that any box "large enough to house the coil" will work, but Applicant's own packaging guidelines say the box should fit the coil "snugly." He states that "many design elements—shape and aspect ratio of the package, as well as the the [sic] shape, size, and location of the hole—which were selected for their ornamentality and distinctiveness." This statement is inconsistent with the documentary evidence discussed above, which refers to utilitarian advantages of the two boxes.

Applicant did not present any evidence of third parties using any of the alternative designs Mr. Kotzur claims are possible. There is evidence of third parties using boxes closer in size to the '412 trade dress, but using a payout hole closer in size to that identified with the '383 trade dress.⁴⁸

Applicant submitted some evidence of alternative designs used by third parties, but these appear to be used with spools of wire rather than with figure 8 wound coils

⁴⁸ Office Action of April 5, 2017, TSDR 47.

or other reel less coils.⁴⁹ Applicant submitted evidence showing different packaging options it provides including shrink-wrap and hard plastic packaging.⁵⁰ These are alternatives, but they are different options with a different set of advantages and disadvantages. For example, such designs require additional packaging for shipping and storage. These designs may require additional equipment and may cost more than the standard boxes at issue here. We find only similar boxes designed for use with figure 8 wound or otherwise reel less coils are relevant alternatives to the claimed trade dress. There is simply no evidence in the record of any such alternatives in use.

Finally, Applicant argues that because its trade dress definitions do not cover all sizes and shapes of boxes, its competitors have plenty of alternatives available. This argument misses the point. The boxes at issue here are simple, basic boxes that provide numerous utilitarian advantages for figure 8 or otherwise wound coils of cable and wire designed for dispensing from the center of the coil. That means the boxes are functional, and Applicant's competitors need not look for other possible alternative designs. Just forcing competitors to engage in the process of finding alternatives might hinder competition. The functionality doctrine protects Applicant's competitors and ensures they can use the same useful box designs Applicant has used for many years.

⁴⁹ Response to Office Action of October 3, 2017, TSDR 49, 54 (both appear to show a product with a spool in a box); 31 (ad showing spools that can be converted into figure 8 wound coils).

⁵⁰ *Id.* at TSDR 31.

D. Does the Trade Dress Result from Comparatively Simple or Inexpensive Methods of Manufacture

There is no evidence in the record concerning the cost or complexity of manufacturing the claimed trade dress.

E. Overall Design Is Functional

Having considered the evidence in the record, we find that the overall design of Applicant's trade dress is "essential to the use or purpose of the device" as used for "electric cable and wires." Thus, we find the packaging trade dress designs to be functional and not registrable on that basis. We, therefore, affirm the refusal to register under Section 2(e)(5).

III. Distinctiveness

Trade dress that is not inherently distinctive and that has not acquired distinctiveness under Section 2(f) of the Trademark Act must be refused registration. This is an independent ground for denying registration.

Product packaging trade dress may be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). Here, Applicant has effectively conceded that its packaging trade dress is not inherently distinctive by arguing during prosecution solely that its trade dress has acquired distinctiveness. It is Applicant's burden to prove its trade dress has acquired distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1331, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015).

To show these box designs have acquired distinctiveness, Applicant "must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Labs.*,

214 USPQ at 4 n.11; *see also In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005). The kind and amount of evidence necessary to establish acquired distinctiveness depends on the nature of the proposed mark and the circumstances surrounding its use. *In re Steelbuilding.com*, 75 USPQ2d at 1424; *In re General Mills IP Holdings II, LLC*, 124 USPQ2D 1016, 1018 (TTAB 2017). We require “more evidence ... where a mark is such that purchasers seeing the matter in relation to the offered goods would be less likely to believe that it indicates source in any one party.” *General Mills*, 1245 USPQ2d at 1018. For example, it has been held that color alone requires substantial evidence of acquired distinctiveness because “color is usually perceived as ornamentation.” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985); *General Mills* (finding no acquired distinctiveness for the yellow color of the regular CHEERIOS cereal box).

Courts and the Board have held that common product designs and basic packaging require more evidence of acquired distinctiveness. For example, the Federal Circuit found that eight years of continuous and substantially exclusive use of a pistol-grip water nozzle was insufficient to show acquired distinctiveness. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ2d 1, 3 (Fed. Cir. 1984). “One who chooses a commonplace design for his package, or one different from competitors only in essentially functional features, even if he is the first to do so, must expect to have to identify himself as the source of goods by his labelling or some other device.” *In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (CCPA 1980); *see also In re Ennco Display Sys., Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000).

Applicant's two box designs are common packaging devoid of any unusual or ornamental features. Indeed, most of the features of these boxes were dictated by the functions the boxes perform, as noted above in our discussion of functionality. Given the common nature of the trade dress before us, we find that only a strong showing of acquired distinctiveness will suffice. Applicant's evidence falls far short of satisfying this standard.

Acquired distinctiveness may be proven through "both direct and circumstantial evidence." *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018). "Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association may be inferred, such as years of use, extensive amounts of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers." *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1506 (TTAB 2017). Applicant submitted circumstantial evidence—advertising and sales volume—and direct evidence—declarations. Both Applicant and the Examining Attorney submitted circumstantial evidence of third-party use of similar boxes for similar goods.

A. The Circumstantial Evidence

Applicant submitted evidence of its advertising through declarations by Timothy Copp.⁵¹ Mr. Copp is Applicant's Vice President of Business Development, and he

⁵¹ See, e.g. Response to Office Action of October 3, 2017 ('412 application), at 27-41; Response to Office Action of October 3, 2017 ('383 application), at 26-40.

stated that Applicant has had advertising expenses of about \$2 million over 39 years for the '383 design and \$1.1 million over 16 years for the '412 design. Samples of this advertising were provided with Mr. Copp's declaration.

Trade dress is not likely to become distinctive without advertising drawing attention to the trade dress as a source identifier. None of Applicant's advertising did this. Rather, the advertising evidence simply shows Applicant's product and highlights REELEX as the brand. *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723-24 (TTAB 2010) (perhaps most damaging to showing of acquired distinctiveness is lack of any "look for" advertising); *see also Duraco Prods. Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 32 USPQ2d 1724, 1741 (3d Cir. 1994) (advertising expenditures "measured primarily with regard to those advertisements which highlight the supposedly distinctive, identifying feature" of the product configuration); *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 USPQ2d 1065, 1071-72 (7th Cir. 1995) ("look for" advertising encourages consumers to connect the claimed trade dress with the particular producer); *First Brands Corp. v. Fred Meyer Inc.*, 809 F.2d 1378, 1 USPQ2d 1779, 1782 (9th Cir. 1987) ("advertising campaign has not stressed the color and shape of the antifreeze jug so as to support an inference of secondary meaning").

Applicant's advertising tells consumers, "Always make sure you look for the REELEX trademark when purchasing cable."⁵² This advertising promotes the

⁵² Office Action of April 5, 2017, at 50.

REELEX trademark, not the box designs.⁵³ Applicant's packaging guidelines also emphasize promotion of the REELEX trademark through the following requirement for those packaging their goods in REELEX boxes:

As described at the beginning of this guide, all packages containing REELEX coils must have the REELEX trademark logo visible. The logo serves to identify to the end user that the package is a genuine REELEX package and will behave as such.⁵⁴

In guidance for end users, Applicant even tells consumers **not** to rely on the box designs to identify goods licensed by Applicant:

The REELEX trademark is required to be printed on all packages containing REELEX technology. Every package made on a REELEX machine should have a REELEX mark located somewhere on the package. No logo? Think twice about installing that cable!⁵⁵

These instructions to consumers are effectively an admission that the boxes are not distinctive and that only Applicant's trademarks are a reliable indicator of source. The following image is provided below the preceding passage on Applicant's website:⁵⁶

⁵³ Response to Office Action of October 3, 2017, at 28-36.

⁵⁴ Response to Office Action of October 3, 2017, at 25.

⁵⁵ Office Action of April 5, 2017, at 45.

⁵⁶ *Id.*



The REELEX word mark and Applicant’s design mark are both shown on every one of these boxes. Consumers are not likely to rely on the design of the box as a source identifier when Applicant’s licensees prominently feature these two trademarks on the boxes. Applicant submitted other advertising of its REELEX system, but all these items also display the REELEX mark.⁵⁷ We find the advertising of record does nothing to show these boxes have acquired distinctiveness.

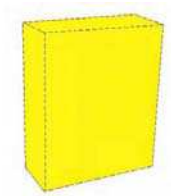
Mr. Copp’s declarations also state that Applicant’s boxes are used by over 100 licensees and that tens of millions of boxes of licensed REELEX coils have been sold.⁵⁸ Sales of a branded product develop recognition and goodwill in the brand. But it does not follow that consumers see these two boxes as brands merely because lots of boxes have been sold. *In re Serial Podcast, LLC*, 126 USPQ2D 1061, 1072 (TTAB 2018) (“Evidence of the commercial success of a product or service does not necessarily also mean that the consuming public perceives the mark used in connection with such products or services as primarily a source-indicator.”). As the advertising shows, the

⁵⁷ Response to Office Action of October 3, 2017, at 29-34.

⁵⁸ Response to Office Action of October 3, 2017, at 25.

boxes have the REELEX branding on them. Boxes used by Applicant's licensees will also bear the licensee's own branding. When faced with a commonly shaped box that has prominent branding of at least two different parties (i.e., Applicant and its licensee), we see no reason why consumers would take the extraordinary step and conclude that the boxes themselves are also a source identifier. Such an argument defies logic, common sense, and the precedents of the Board and its primary reviewing court.

The Board faced a somewhat similar situation in the *General Mills* case, which involved the mark shown below (used with boxes of regular CHEERIOS cereal).



General Mills submitted evidence to support its claim that the yellow color had acquired distinctiveness. *General Mills*, 124 USPQ2d at 1018-19. That evidence included unsolicited media references to the yellow color as “distinctive,” “instantly recognizable,” and “iconic.” *Id.* at 1019. Survey evidence was submitted showing over 50% of those sampled associated the yellow color with the CHEERIOS product. *Id.* at 1020-21, 1026-27.

After considering all the evidence, the Board found General Mills had failed to prove the yellow color had acquired distinctiveness. *Id.* at 1027. This conclusion was based in part on the fact that while boxes of regular CHEERIOS were yellow, the boxes also featured the CHEERIOS trademark. *Id.* at 1025 (all exposures to General

Mills' yellow trade dress "include repeated, prominent displays of the front of Applicant's box, with the mark CHEERIOS in bold, black letters in sharp contrast to the yellow background, as well as an audio track on which the term CHEERIOS is repeatedly sung or spoken"). Because the CHEERIOS trademark was prominent on the boxes, there was little reason for consumers to rely on the yellow color of the box as a source identifier.

This logic applies with even more force here, because Applicant has submitted so little evidence. There is no evidence of unsolicited media references to Applicant's boxes as distinctive or recognizable. There is no survey evidence. Applicant's sales volume and advertising expenditures are much smaller than those of General Mills.

The Board in *General Mills* also discussed third-party use of yellow packaging. *Id.* at 1022-23. There was evidence of several other cereals that used a yellow color in their packaging, including some of the same type of cereal in a yellow box or bags. *Id.* When the Board considered the evidence of third-party use together with the fact that the well-known CHEERIOS word mark was always used with the yellow box, it found that General Mills had not proven the yellow color had acquired distinctiveness.

In the case at hand, both Applicant and the Examining Attorney submitted evidence of third-party use of similar boxes for similar goods.⁵⁹ Applicant argues this evidence shows that third parties have copied the trade dress and that copying is evidence of acquired distinctiveness. We disagree. Copying is only evidence of

⁵⁹ Office Action of April 5, 2017, TSDR 47 (showing several so-called knockoffs with branding blurred out).

acquired distinctiveness if it is proven that the copying was done to trade on the goodwill of another party.

Take for example, the Board's decision in *In re Serial Podcast, LLC*, 126 USPQ2D 1061, 1075-77 (TTAB 2018), which found the following mark had acquired distinctiveness:



The Board's conclusion was based, in large part, on copies and parodies of this mark, many of which included the stylized elements of the mark and were clearly intended to identify the podcast with which the mark was used. *Id.* These examples of copying showed an intention by the copying parties to identify or parody the applicant's trademark. Such copying is evidence of acquired distinctiveness, because the copyst had to believe the mark was distinctive or the intentional effort to identify or parody the mark would fail.

Absent evidence of a similar intent, the alleged copying here does not prove acquired distinctiveness. In this case, the evidence shows that third parties using similar boxes tend to use their own trademarks on the boxes.⁶⁰ These are **not** the actions of parties trying to trade on Applicant's goodwill. This evidence shows other parties taking advantage of a useful box while applying their own branding to the box. *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d

⁶⁰ *Id.* at 7, 14-17, 20, 22-23, 25, 30-31, 37-38, 40.

1549, 1575 (TTAB 2009) (no intent to trade on goodwill where third parties “clearly display the manufacturer’s trademark or trade name on the” goods).

Courts and the Board have reached a similar conclusion in other cases where third parties copied a utilitarian product design or feature. “Where the proposed mark is a product design, the copier may be attempting to exploit a desirable product feature, rather than seeking to confuse customers as to the source of the product.” *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 (TTAB 2011)); *see also Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 USPQ2d 1065 (7th Cir. 1995) (copying product shape to take advantage of useful features is not evidence of acquired distinctiveness).

The circumstantial evidence of record does not support an inference that these boxes have acquired distinctiveness.

B. The Direct Evidence

Applicant’s distinctiveness arguments are based largely on five declarations, which are a form of direct evidence.⁶¹ The declarations are nearly identical and formulaic (although the use of reordered sentences may make the declarations appear different). The declarations also all feature the following line: “I can readily distinguish coiled cable having the applied-for trade dress from the boxes of coiled cable that are not licensed by Reelex, unless the non-licensed boxes are improper

⁶¹ Response to Office Action of October 3, 2017, TSDR 37-41. Nearly identical declarations were filed in support of the ’383 and ’412 applications, with the only significant difference being the different description of the trade dress.

knock-offs.”⁶² Reelex’s packaging guidelines **require** use of the REELEX trademark on all licensed packages, so there is an easy way to “readily distinguish” licensed from unlicensed products. The quoted statement undermines Applicant’s claim of acquired distinctiveness.

On one hand, the declarants are stating that they can readily differentiate a licensed product in a REELEX I or REELEX II box from products in completely different looking boxes. That is an entirely unremarkable assertion and it tells us nothing about whether Applicant’s boxes are distinctive. It simply means the declarants can tell apart products in packages that look different.

But when the declarants compare licensed and unlicensed products that use the same type of box, they cannot distinguish them. In other words, the design of the box is **not** a source identifier. The design of the box is not something these declarants can use to determine whether the goods are licensed by Applicant. These statements refute Applicant’s claim and show that the boxes are used by both licensed and unlicensed parties and thus, are not being used “to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. Applicant’s own declarants tend to show that the boxes are not distinctive.

Four of the five declarants are licensees of Applicant and, therefore, stand to benefit if Applicant is successful here. These are presented as sophisticated, knowledgeable declarants from different companies. Yet each declarant made exactly

⁶² *Id.*

the same statements about the trade dress. Clearly someone other than the declarants prepared these documents. All of these considerations undermine the reliability of the declarations. The fifth declarant represents a large trade group. We would be inclined to place more weight on this declaration if it had addressed industry-wide understanding, but it is essentially identical to all the others. We find this declaration also has little probative value.

Even if we accepted these declarations as evidence that the two boxes have acquired distinctiveness to “those in the field of packaged electrical cabling,”⁶³ that would not be sufficient. The applications identify the goods as “electric cables and wire.” There are no trade channel limits in the identification, so we must evaluate distinctiveness from the perspective of all consumers and users of “electric cables and wire,” and not solely from the perspective of experts in the field. *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ2d 373, 376 (CCPA 1959) (an applicant must “submit proof that its mark is distinctive, not only to ‘experts’ in the field, but to the purchasing public”); *In re UDOR U.S.A., Inc.*, 89 USPQ2d 1978, 1987 (TTAB 2009); *In re Edward Ski Prods., Inc.*, 49 USPQ2d 2001, 2005 (TTAB 1999). Here, four of the five declarations are from cable and wire manufacturers that use Applicant’s technology to distribute their wire and cable to end users. There are no declarations from retailers or end users of electrical wire and cable.

⁶³ 4 TTABVUE 19.

C. The Box Designs Are Not Distinctive

We find the evidence of record, including direct and circumstantial, does not prove the two box designs have acquired distinctiveness. And the Applicant has effectively conceded that its packaging trade dress is not inherently distinctive. Therefore, we affirm the refusal to register for lack of distinctiveness. 15 U.S.C. §§1051, 1052, 1127; *In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 594-96 (C.C.P.A. 1967); *In re J. Kinderman & Sons, Inc.*, 46 USPQ2d 1253, 1254-55 (TTAB 1998).

Decision: The refusals to register Applicant's '383 and '412 box designs are affirmed both because the designs are functional, and because they are not distinctive.⁶⁴

⁶⁴ Because we affirm on two independent grounds, we do not need to reach the refusal based on the third ground—that the designs do not function as marks to indicate the source of the goods identified in the applications.