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

Proceeding	87285383
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Appellant: REELEX PACKAGING  
SOLUTIONS, INC.

Serial No.: 87/285383

Examining Attorney: Suzanne Blane

Filed: December 30, 2016

Attorney Docket: REE-TM-012

APPELLANT'S BRIEF ON APPEAL

A Notice of Appeal to the Trademark Trial and Appeal Board was filed on April 2, 2019, in which Appellant appealed from the final refusal in the Office Action dated November 8, 2018.

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(1) INDEX OF CASES

*In re Charles N. Van Valkenburgh*, Serial No. 77025789 (TTAB, January 7, 2011).

*In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982).

*TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001).

*In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012). *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984).

(2) DESCRIPTION OF THE RECORD

All references to the TSDR will be with respect to the relevant document downloaded as a pdf file.

Appellant filed its application on December 30, 2016. On April 5, 2017 the Examining Attorney issued a non-final Office Action (“the first Office Action”) refusing registration on two grounds, functionality and non-distinctiveness. See Apr. 5, 2017 Office Action TSDR. The Appellant responded to the first Office Action on October 3, 2017. See Oct. 3, 2017 Response to Office Action TSDR.

In response to Appellant’s response, on November 1, 2017, the Examining Attorney approved the applied-for mark for publication on the principle register. Later, after approving the mark for publication, the Examining Attorney withdrew the mark from publication, and issued another non-final Office Action dated December 30, 2017 (“the second Office Action”). See Dec. 30, 2017 Office Action TSDR. As

noted in the second Office Action, the reason for withdrawing the application from publication was that “it was found the mark fails to function as an identification of source,” which was a new ground of refusal. Also, the Examining Attorney stated that the identification of goods required further clarification and that the specimen does not show the mark in use with the identified goods. Appellant notes that in the second Office Action, the Examining Attorney did not base refusal on grounds of functionality and Appellant considered the issue of functionality settled based on the evidence of record. Nonetheless, the Examining Attorney maintained the refusal on the ground of non-distinctiveness and added the new ground of refusal, i.e., failure to function as a trademark.

Appellant responded to the second Office Action on May 24, 2018. See May 24, 2018 Response to Office Action TSDR. In Appellant’s response, Appellant amended the mark description to clarify that the goods are identified as electric cables and wire in class 9, as suggested by the Examining Attorney in the second Office Action. On June 29, 2018 the Examining Attorney issued another non-final Office Action (“the third Office Action”). See June 29, 2018 Office Action TSDR. In the third Office Action, the Examining Attorney maintained all of the refusals in the second Office Action, and, additionally, reintroduced the functionality refusal that was raised in the first Office Action.

Appellant responded to the third Office Action on September 26, 2018. See Sep. 26, 2018 Response to Office Action TSDR. On November 11, 2018, the Examining Attorney issued a fourth, final Office Action, which maintains all of the rejections raised in the third Office Action. See Nov. 11, 2018 Office Action TSDR.

### (3) STATEMENT OF THE ISSUES

- A. Whether the applied-for mark for trade dress is functional.
- B. Whether the applied-for mark has acquired distinctiveness.
- C. Whether the applied-for mark functions as an indication of source of the identified goods.

#### (4) RECITATION OF THE FACTS

A. The Appellant is the developer and licensor of Reelex Licensed Packaging System, hereinafter referred to as the “Reelex System”. The Reelex System is used by cable and wire manufacturers around the world to package their cable and wire into what are known as “Reelex Packages”. Those manufacturers use proprietary winding machines that are designed, manufactured, and patented by Reelex, and Reelex knowhow to wind the cable and wire into finished coils of cable and wire. See Oct. 3, 2017 Response to Office Action, TSDR p. 33.

B. A Reelex Package, otherwise known as a Reelex Box, includes a wound coil of cable or wire inside a box. See Oct. 3, 2017 Response to Office Action, TSDR p. 33, and 37-41.

C. Appellant’s proprietary winding process winds cable in a figure-eight pattern that allows the cable and wire to be “paid out” from a box without kinking and tangling. See Nov. 8, 2018 Office Action, TSDR p. 34.

D. The applied-for trade dress is trade dress for electric cable and wire in class 9. See May 24, 2018 Response to Office Action, TSDR pp. 5 and 8.

E. The Appellant owns U.S. Patents 5,810,272; 6,086,012; 6,341,741; 4,160,533; and 7,156,334, which relate to various aspects of manufacturing coils of cable and wire that can be packaged. See Oct. 3, 2017 Response to Office Action, TSDR pp. 4-5. See Sep. 26, 2018 Response to Office Action, TSDR p. 11.

F. None of Appellant’s patents require the features of the box described in Appellant’s applied-for trade dress. Indeed, at least U.S. Patent 6,086,012 actually teaches at least three shapes (oval, elliptical, and diamond) of the payout hole that differ from the circular hole of the applied-for trade dress. See Oct. 3, 2017 Response to Office Action, TSDR pp. 4-5.

G. The applied-for trade dress incorporates many design elements – shape and aspect ratio of the box, as well as the shape, size, and location of the hole – which were selected for their ornamentality and distinctiveness. See Oct. 3, 2017 Response to Office Action, TSDR pp. 21-23.

H. The specific combination of sizes, shapes, and locations embodied in the applied-for trade dress are not dictated by the function of the box, but are instead arbitrarily selected. See Oct. 3, 2017 Response to Office Action, TSDR pp. 21-23.

I. REELEX publishes a “Packaging Guide” that includes a section “Box Design Guidelines” that does not require that a box have the applied-for design in order to perform its function and does not suggest that the applied-for configuration is preferred. See Oct. 3, 2017 Response to Office Action, TSDR pp. 21-24.

J. There are many alternative designs of the package that would appear different from the applied-for trade dress and would result in the same or lower component cost. See Oct. 3, 2017 Response to Office Action, TSDR pp. 21-23.

K. Some alternative embodiments of the design, include:

- Different hole/tube shape
  - Oval (U.S. Patent 6,086,012, Figs. 4 to 6 )
  - Elliptical (U.S. Patent 6,086,012, Fig. 7)
  - Diamond Shaped (U.S. Patent 6,086,012, Fig. 4)
- Different hole size
  - 1.5, 2.0, 2.5, 6.0, 8.0 inches
- Different hole location
  - Top and bottom of rectangular panel
  - Corner between rectangular panels (U.S. Patent 4,160,533)
- Different Box Shape and Aspect Ratio
  - Trapezoidal box
  - Cube box
  - Octagonal box (U.S. Patent 6,491,163)
  - Slingpack box (U.S. Patent 8,960,431)

- Different box closures
  - Square side having a line folding assembly divided 1/3 and 2/3.

See Oct. 3, 2017 Response to Office Action, TSDR pp. 21-23.

L. Any combination of these design variations would provide all of the function of the applied-for trade dress and with a different overall appearance, and some embodiments would provide that function at the same or lower cost. Indeed, there are a myriad of package designs that can be chosen that will have the functionality of the applied-for trade dress with a different overall appearance and would cost approximately the same. See Oct. 3, 2017 Response to Office Action, TSDR pp. 22-24.

M. Products having the applied-for trade dress have been marketed by the Appellant for over 39 years as of December 30, 2016. See Oct. 3, 2017 Response to Office Action, TSDR p. 26-36.

N. Over the years, as of December 30, 2016, in excess of \$2 million was spent to promote awareness of the product having the applied-for trade dress. The manner of such promotion particularly promoted the product's trade dress. See Oct. 3, 2017 Response to Office Action, TSDR pp. 26-36.

O. As a result of the various marketing and advertising efforts, as of December 30, 2016, more than 93.3 million Reelex Packages have been sold, each of which including a box having the applied-for trade dress. See Oct. 3, 2017 Response to Office Action, TSDR pp. 26.

P. The Executive Director of the Communications Cable & Connectivity Association (CCCA) and CEO/Director of the International Wire & Cable Symposium, David B. Kidoo, has declared that he recognizes coils of cable and wire having the applied-for trade dress as "Reelex Boxes" that are licensed by Reelex Packaging Solutions, Inc. See Oct. 3, 2017 Response to Office Action, TSDR p. 41. CCCA is a non-profit corporation that was started in June 2007 to explore ways to address communication network performance issues caused by non-compliant and counterfeit structured cabling components as well as identify potential threats to public safety these components may represent. CCCA is a major resource for well researched, fact-based information and education on the important issues, technologies and structured cabling products impacting the current and future needs of the building network and cabling infrastructure. CCCA is proactive in supporting and participating in codes and standards bodies and other

trade, industry and safety organizations, which affect the quality, performance and societal needs of the structured cabling infrastructure. See CCCA at <http://cccassoc.org/about/>, last reviewed on Jan. 10, 2019.

Q. Other declarants representing companies that are large consumers and users of cable and packaging who are very knowledgeable about such cable and packaging have similarly declared their ability to recognize whether or not a box of cable or wire is a Reelex Box by simply looking at the box. See Oct. 3, 2017 Response to Office Action, TSDR pp. 37-40. Those other declarants and their organizations include:

1. Wayne B. Roussel, Senior Packaging Engineer at Belden Inc.

Established in 1902, Belden Inc. is a global leader in signal transmission and security solutions for mission-critical applications in enterprise and industrial markets. See Belden Inc. at <https://www.belden.com/about>, last viewed on Jan. 10, 2019. Belden Inc. designs, manufactures, and sells a comprehensive portfolio of cable, connectivity, and networking products for the transmission of signals for data, sound and video applications. See Oct. 3, 2017 Response to Office Action, TSDR p. 37. In 2017, Belden Inc. had revenue of \$2.3 billion. See 2017 Annual Report, Belden Inc., available at <http://investor.belden.com/investor-relations/financial-information/latest-financials/default.aspx>, last viewed on Jan. 10, 2019.

2. Dominic Desmond, Vice President at Benfield Electric.

In operation for over 65 years, Benfield Electric is a supplier of products covering fields of electrical distribution, data communications, control, power systems, HVAC, and elevator equipment. See Oct. 3, 2017 Response to Office Action, TSDR p. 38. In 2018, Benfield Electric had revenue of over \$196 million. See D&B Hoovers, H.H. Benfield Electric Supply Company, Inc. profile at [http://www.hoovers.com/company-information/cs/company-profile.hh\\_benfield\\_electric\\_supply\\_company\\_inc.3ff8faf8901f8945.html](http://www.hoovers.com/company-information/cs/company-profile.hh_benfield_electric_supply_company_inc.3ff8faf8901f8945.html), last viewed on Jan. 10, 2019.

3. Darrell Edgett, Vice President and General Manager of Deca Cables Inc.

Deca Cables Inc. is a leading manufacturer of wire and cable for the industrial, petro-chemical, utility, mining, transportation, OEM, and electronic markets. See Oct. 3, 2017 Response to Office Action, TSDR p. 39. Deca Cables Inc. has over 40 years of manufacturing experience and is committed to design, development, and manufacturing process for wire and cable. See Deca Cables Inc. at <http://www.decacables.com/about>, last viewed on Jan. 10, 2019. In 2018, Deca Cables Inc. had revenue of over \$100 million. See Deca company profile at <https://www.zoominfo.com/c/decacables-inc/33165698>, last viewed on Jan. 10, 2019.

4. Brian Rizzo, CEO of ICE Cable Systems.

ICE Cable Systems is a leading manufacturer of premium low-voltage wire and cable products which are distributed in over twenty countries. See Oct. 3, 2017 Response to Office Action, TSDR p. 40. Founded in 2004, ICE Cable Systems had revenue of over \$10 million in 2018. See D&B Hoovers, Installers Choice Electronics, LLC, [http://www.hoovers.com/company-information/cs/company-profile.installers\\_choice\\_electronics\\_llc.cd79136745c454ca.html](http://www.hoovers.com/company-information/cs/company-profile.installers_choice_electronics_llc.cd79136745c454ca.html), last viewed on Jan. 10, 2019.

(5) ARGUMENTS

A. The Mark Should Not Be Refused as Functional under Section 2(E)(5)

The mark has been refused as being a functional design for packaging of goods. The Examining Attorney takes the position that a feature is functional if it is “essential to the use or purpose of the [product]” or “it affects the cost or quality of the [product].” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001). However, the Examining Attorney also notes that “where the evidence shows that the specific product or container configuration at issue provides no real utilitarian advantages to the user, but is one of many equally feasible, efficient and competitive designs, then it may be registrable.” See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982). Appellant submits that the above-noted facts are evidence that supports the conclusion that that the applied-for trade dress is

one of many equally feasible, efficient and competitive designs, and, thus, is registrable on the Principal Register.

As the *Morton-Norwich* court noted, “it is the ‘utilitarian’ design of a ‘utilitarian’ object with which we are concerned.” See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982), at 1338. In the present application, the utilitarian object recited in the applied-for trade dress is a box that has a *de facto* utility of storing and facilitating dispensing (or paying out) of wound cable or wire. Many such boxes (as cited by the Examining Attorney in the record) have a circular opening and a tube to guide wire out of the box. Such features, are thus, *de facto* functional in the same way a bottle holds liquid and a lamp provides light. Indeed, without opening the flaps of the box, the only way to dispense wire or cable from the box is to dispense through a hole in the box.

However, the other features of the applied-for trade dress, including the size and location of the hole, and the relative dimensions of the box (e.g., aspect ratio), taken together, render the overall trade dress non-functional, because the features of the applied-for trade dress do not necessarily allow the box to work better than any other box in the same category of goods applied-for. Instead, the applied-for trade dress, as a whole, provides an overall impression that is distinctive and source identifying, as testified to by Mr. Kidoo and others. See Facts P and Q, above. Indeed, none of the boxes cited by the Examining Attorney in the record has a 4.00-inch hole centered on one side of the box in combination with the relative dimensions of the length to width to height recited in the applied-for the same aspect ratio of length to width recited in the applied-for trade dress. Therefore, when viewed as a whole, all of the elements of the applied-for trade dress render it visually distinctive and non-functional.

The specific product or container configuration at issue provides no utilitarian advantages to the user, but is one of many equally feasible, efficient and competitive designs. The applied-for trade dress incorporates many design elements – shape and aspect ratio of the package, as well as the shape, size, and location of the hole – which were selected for their overall ornamentality and distinctiveness. The specific combination of sizes, shapes, and locations embodied in the applied-for trade dress are not

dictated by the function of the package, but are instead arbitrarily selected. See Oct. 3, 2017 Response to Office Action, TSDR p. 22.

The Appellant publishes a “Packaging Guide” that includes a section “Box Design Guidelines” that *does not* require that a box have the applied-for trade dress in order to perform its function and does not suggest that the applied-for configuration is preferred. See Oct. 3, 2017 Response to Office Action, TSDR pp. 22, 24, and 25. Indeed, there are many alternative designs of the packages that would appear different from the applied-for trade dress and would result in the same or lower component cost. See Oct. 3, 2017 Response to Office Action, TSDR p. 22. As noted above, alternative embodiments of the box design are feasible and any combination of the design variations would provide all of the function of the applied-for trade dress and with a different overall appearance, and some embodiments would provide that function at the same or lower cost. Indeed, there are a myriad of package designs that can be chosen that will have the functionality of the applied-for trade dress with a different overall appearance and would cost approximately the same. See Oct. 3, 2017 Response to Office Action, TSDR pp. 22-24.

The Examining Attorney states that “applicant also argues its trade-dress is unique in its design and function, in that no other competitive *trade dress* for coiled cable and wire dispenses the contents without tangling and compressing the cable and wire.” Nov. 8, 2018 Office Action, TSDR p. 4. (Emphasis added.) Respectfully, as noted above, Appellant has taken the exact *opposite* position. Specifically, Appellant has made clear that the shape of the box around the identified goods (the coil of cable and wire) does not provide any advantages for tangling or compressing cable and wire. Instead, the features that provide advantageous dispensing of the cable and wire without tangling are features of the coil of cable and wire (i.e., the goods themselves). Specifically, Appellant has repeatedly pointed out that the proprietary Reelex winding technology for manufacturing the coil of cable and wire in a figure eight pattern allows for the cable and wire to be dispensed without kinking. The specific configuration of the box around the coil does not contribute to the prevention of kinking. See Oct. 3, 2017 Response to Office Action, TSDR pp. 12, and 63-65.

Thus, it is clear that the designer of the knockoff box is not attempting to exploit a desirable utilitarian product feature of the *box*, but is instead seeking only to confuse customers as to the source of the goods (i.e., the coiled cable or wire) inside the box. See, e.g., *In re Charles N. Van Valkenburgh*, Serial No. 77025789 (TTAB, January 7, 2011). This confusion is causing harm in the marketplace and to Appellant and is precisely why Appellant is seeking trade dress protection for its distinctive and non-functional trade dress.

The Examining Attorney cites to Appellant's U.S. Patents 5,810,272; 6,086,012; 6,341,741; 4,160,533; and 7,156,334 to support the Examining Attorney's position on the functionality of the applied-for trade dress. The Examining Attorney states that "applicant is essentially asking for a trademark to protect packaging features for which applicant already holds patent protection." See Nov. 8, 2018 Office Action, TSDR p. 5. Also, the Examining Attorney states:

"The examining attorney does not challenge the superiority of applicant's packaging over that of its competitors. ... Applicant's industrial design of the components of its packaging provides what was at the time package protection and dispensing unique in its field. As such, applicant was awarded patents for its unique packaging that provides improved functioning of the packaging in that it produces and/or licenses. But the patents are utility patents for components that affect the functionality of applicant's packaging. *Applicant clearly states its packaging has been imitated and at times successfully copied. Such imitation and piracy constitutes patent infringement. Thus, applicant's mechanical design affects the functioning of the packaging but the superficial appearance is not sufficiently distinctive from other packaging for consumers to recognize the appearance as an indication of the source of the packaging.*" See Nov. 8, 2018 Office Action, TSDR p. 5. (Emphasis added.)

The Examining Attorney's statements are incorrect. Appellant is not seeking trade dress protection to protect features covered by Appellant's patents. The Examining Attorney's position completely mischaracterizes the scope of Appellant's patent rights and the scope of the applied-for trade

dress protection. Moreover, the Examining Attorney has not set forth any citations from any of Appellant's patents to support the proposition that the applied-for trade dress, as a whole (much less in part), is functional. Indeed, at least one of Appellant's patents, U.S. 6,086,012, teaches alternative payout hole shapes (i.e., other than circular), including oval, elliptical, and diamond shape, further supporting Appellant's position that the specific applied-for trade dress is arbitrary and not dictated by functional concerns. The record should clearly reflect what, if any, teaching in Appellant's patents is being relied upon that discloses the alleged utilitarian advantages of the applied-for trade dress.

Appellant is aware of the distinctions between patent and trademark rights, but is not aware of any law or regulation that would *per se* prohibit an applicant from obtaining trade dress protection for non-functional trade dress in a case where the applicant holds tangentially related utility patents. The Appellant does not seek to use the applied-for trade dress to monopolize ideas for how to use a box or for how to dispense wire or cable from a box. Rather, Appellant seeks to obtain a registration for a distinctive, non-functional trade dress.

Furthermore, the Examining Attorney conflates Appellant's argument regarding copying trade dress with patent infringement. The Examining Attorney starts from the premise that Appellant's trade dress is *per se* functional, and, thus, not registrable or capable of functioning as a trademark. Accordingly, the Examining Attorney sees Appellant's only remedy for copying and piracy as a remedy for patent infringement. Since the Examining Attorney begins with an incorrect premise concerning the functionality of Appellant's trade dress, the Examining Attorney has also incorrectly concluded that Appellant would not be entitled to a trademark remedy.

The Examining Attorney also states:

"In its May 24, 2018 response, applicant discussed particular ways in which its *box design* provides features and a consistency of performance unmatched by other boxes for the same goods.

'Applicant developed the market for packages for figure-eight coiled cable starting in 1976. More specifically, products having the applied-for trade

dress have been marketed by the Applicant for over 39 years. . . . [T]here are multiple suppliers of coiled cable and packaging for such coiled cable, which share the retail space with Applicant's product. Some of the competitive [sic] products have features that with [sic] some *visual similarities with an aspect of the Applicant's trade dress*, whether it be the circular shape of the payout type opening or the flange around the opening. However, such competitor products do not duplicate the well-known and widely-marketed overall configuration of the applied-for Reelex *trade dress*, which includes a generally circular outer flange and an inner raised circular lip around the payout tube hole.” See Nov. 8, 2018 Office Action, TSDR pp. 4-5. (Emphasis added.)

Respectfully, the quoted portion of Appellant's remarks are taken out of context and do not support the Examining Attorney's stated position at all. Indeed, nothing in the quoted portion of Appellant's remarks mentions anything about “particular ways in which its box design provides features and a consistency of performance unmatched by other boxes for the same goods”. Appellant has never stated on the record that the applied-for trade dress is in any way functionally “superior” to any other design on the market. Instead, Appellant has consistently explained that the box described in the applied-for trade dress provides no utilitarian advantages over other competitive box designs in the market. Indeed, the correct context of the above-quoted statement was to highlight the fact that there are many equally feasible, efficient, and competitive designs in the marketplace other than Appellant's applied-for trade dress, and, therefore, since Appellant's trade dress is but one of many of such equally feasible designs it may be registrable pursuant to *In re Morton-Norwich Products*. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

Accordingly, for at least the foregoing reasons, Appellant has provided the requisite competent evidence of the applied-for mark's nonfunctionality and has satisfied Appellant's burden of proof in rebutting the Examining Attorney's prima facie case. See *In re Becton, Dickinson & Co.*, 675 F.3d 1368,

1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984); TMEP §1202.02(a)(iv).

B. The Mark Should Not Be Refused Under Sections 1, 2, and 45 as being a Non-Distinctive

Configuration of Packaging for the Goods

It should be noted at the outset, that the goods of concern for the applied-for trade dress are not goods that the average person buys or consumes regularly. The goods are specialized and are known and used in the field of packaged electrical cabling. The facts noted above support Appellant's position that those in the field of packaged electrical cabling industry have come to recognize Appellant as the source of the applied-for trade dress for coils of cable and wire.

The Examining Attorney concedes that Appellant's evidence successfully shows marketing, sales success, length of use, and unsolicited media coverage. However, the Examining attorney takes the positions that Appellant has not provided evidence supporting exclusivity of use of the applied-for mark and no evidence linking the applied-for mark to a source. See Nov. 8, 2018 Office Action, TSDR p. 7. Appellant respectfully disagrees with these positions.

With regard to exclusivity, the Examining Attorney states "There is no evidence that establishes the applied-for mark as a recognizable source indicator absent the REELEX mark. That is, *applicant presents no evidence* that, absent the REELEX mark, the configuration mark has inherent or acquired distinctiveness in the field of product packaging." See Nov. 8, 2018 Office Action, TSDR p. 7. (Emphasis added.) Respectfully, the Examining Attorney is incorrect on the state of the record.

Appellant has thrice cited a product listing (lanshack.com) for CAT5e cable that shows a picture of a box that contains cable extending from a payout hole and which is described as "Cat5E 350 Shielded (STP), Direct Bury, CMX, Solid Cond. Cable – 1000 Ft by ABA Elite". The product description states "Four twisted pairs of 24 gauge solid copper conductors. Reelex Box – 1000 feet.". See Dec. 30, 2016 Specimen, TSDR p. 1; Oct. 3, 2017 Response to Office Action, TSDR pp. 17, and 58-59; and May 24, 2018 Response to Office Action, TSDR p. 13. The box shown in the picture clearly shows Appellant's

trade dress without the REELEX trademark. Moreover, in the lanshack.com webpage, item for sale is described as being a “Reelex Box”. Also, Applicant has submitted additional evidence showing websites of Electro Cables Inc. and Pacific Cabling Solutions Ltd., which both show images of boxes having the applied for trade dress and that are referred to as REELEX boxes. See Mar. 6, 2019 TEAS Request Reconsideration after FOA, TSDR pp. 1 to 4. In those images, the boxes themselves do not bear any logo or word mark of the Appellant. Thus, it is clear that those in the field of packaged electrical cabling associate the Appellant as the source of the trade dress (as well as the coiled configuration of the goods inside the box) shown in the Lanshack, Electro Cables Inc, and Pacific Cabling Solutions Ltd listings.

Moreover, the above evidence also should dispense with the Examining Attorney’s statement that because “the outward appearance of the packaging is so basic, it cannot be determined that the configuration on its own is anything but a commonly used packaging configuration for coiled cable and wire.” See Nov. 8, 2018 Office Action, TSDR p. 7. Clearly, the foregoing evidence shows that this position is untenable. The trade dress is well known to those in the relevant field and those in that field associate the Appellant as the the source of the trade dress. See Facts P and Q, above.

The Examining Attorney also states:

“Applicant argues that the Copp Declaration ‘shows that over the years, in excess of \$2 million was spent to promote awareness of the product. The manner of such promotion particularly promoted the product’s trade dress.’ The trade dress was promoted under the REELEX name, *therefore this evidence shows only that REELEX produces packaging that functions better than the packaging of its competitors.* As explained above, applicant cannot get trademark protection for functional features of its packaging.” See Nov. 8, Office Action, TSDR p. 7. (Emphasis added.)

The Examining Attorney’s conclusion regarding the promotion of Appellant’s trade dress, frankly, is not understood by Appellant. The Examining Attorney conflates the issue of distinctiveness with functionality. Appellant has promoted the applied-for trade dress over the years as being associated with the Appellant as its source and in association with the Appellant being the source of the winding

technology used to wind coils of wire and cable inside the box. The visual appearance of the box in the various product promotions is thus clearly tied to its source, i.e., the Appellant. Nothing in the advertisements points to the applied-for *trade dress* as functioning better than a competitor.

Further, it is well known that copying of trade dress is probative of its acquired distinctiveness. It is appreciated that such evidence may have minimal value where "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 Charles N. Van Valkenburgh*, Serial No. 77025789 (TTAB, January 7, 2011). Appellant has provided evidence of competitor products having packaging similar or identical to Appellant's trade dress. See Oct. 3, 2017 Response to Office Action, TSDR pp. 17, 42-57, 64-65. As noted above, the trade dress does not provide any desirable functional product features, since competitor coils of wire packaged even in knockoff boxes have far worse payout performance than licensed Reelex coils of wire packaged in boxes described in the applied for trade dress. Thus, the copying of Appellant's trade dress by competitors of Reelex is being done merely to confuse customers as to the source of the product, i.e., the coil of cable and wire inside the box. That is, the copying of the trade dress is being done to conceal from the relevant buying public that the wire and cable has not been wound using Reelex technology, and, thus, that the goods are not sourced by Reelex. Indeed, this is often being done to conceal and camouflage coils of cable and wire that are of inferior quality. See Oct. 3, 2017 Response to Office Action, TSDR pp. 63-65.

Further, the Examining Attorney states:

"The Office does not challenge applicant's long-standing position in the market for packaging for figure-eight coiled cable. That the applied-for trade dress has been marketed by the applicant for over 39 years is not in dispute. But applicant's evidence establishes consumer recognition of the Reelex brand. The appeal of the brand is the way its packaging functions as a dispenser for coiled cable. *The applied-for configuration mark has no characteristics to distinguish it from the appearance of its competitors' products.* Although applicant's packaging may enable superior performance in accessing coiled cable, *the distinctive elements of applicant's product are not apparent on its face.*

*The applied-for mark is simply not sufficiently distinctive to establish source in the absence of the REELEX name.” See Nov. 8, 2018 Office Action, TSDR p. 7. (Emphasis added).*

Again, as noted above, Appellant’s supplied evidence refutes the Examining Attorney’s conclusion. Product webpages clearly associate the trade-dress with the Appellant and distinguish that from the appearance of competitor products. Furthermore, Appellant has provided numerous declarations of distinguished individuals in the specialized field of packaged electrical cable who can readily distinguish coiled cable having the applied-for trade dress from boxes of coiled cable that are not licensed by Reelex (and which are not knockoffs) based on the elements of the applied-for trade dress, including the relative dimensions between the width and height of the box, and the size and location of the hole. See Facts P and Q, above, and Oct. 3, 2017 Response to Office Action, TSDR pp. 37-41. Thus, contrary to the Examining Attorney’s position, the applied-for mark *is* sufficiently distinctive to establish source in the absence of the REELEX word mark.

Continuing, the Examining Attorney states:

“Applicant argues, “The specific configuration embodied in the applied-for mark has been promoted by applicant as being a part of the Reelex brand of the product so that the product, as a whole, has acquired distinctiveness.” But, again, there is no evidence to support that applicant’s ‘advertising, promotion and marketing efforts have been at a level to induce consumers to associate the configuration embodied in the appliedfor trade dress as a trademark, which represents a source of goods.’ *Because the trade dress visible in the applied-for mark fails to show that which distinguishes it from the trade dress of applicant’s competitors, the only certainty is that applicant’s promotion and marketing efforts established source identification for REELEX as the source of the packaging.* The overall shape of the trade dress, a square box, and the place on the box from which cable is accessed is not significantly different from the trade dress of applicant’s competitors. *It is the function of the interior spooling that applicant markets as the distinctive qualities*

*of its goods*. That spooling mechanism is not visible on the applied-for mark.” See Nov.

8, 2018 Office Action, TSDR p. 7. (Emphasis added).

From the above quotation, it is clear that the Examining Attorney is confusing inherent distinctiveness, with acquired distinctiveness. The evidence of record shows that those in the field of packaged electrical cabling can readily distinguish between Appellant’s applied-for trade dress (which has been incorrectly stated as being a “square box” by the Examining Attorney) and the trade dress of competitors. Moreover, Appellant has consistently shown in its advertising coiled wire and cable along with the applied-for trade dress. It is impossible to separate the two and to conclude that all product awareness that results from Appellant’s advertising has only resulted in awareness of the coil, and not the trade dress which is shown.

C. The Mark Should Not Be Refused as Failing to Function as an Indication of Source for the Identified Goods

The Examining Attorney takes the position that Appellant is the source of the product packaging, but not the source of the coil and wire. The Examining Attorney also asserts that Appellant’s representative, Mr. Christian Mannino, concurred with that position. Both of the Examining Attorneys positions are incorrect, and Appellant has addressed this on the record. See September 26, 2018 Response to Office Action, TSDR pp. 7-10. Appellant is indeed the “source” of the identified goods and Appellant’s representative, Mr. Christian Mannino, did not state that Appellant is not the source of the coil. Here again, the Examiner confuses “source” in the trademark sense, with actual manufacturer. However, as noted by McCarthy on Trademarks and Unfair Competition, a source is not limited to being a manufacturer:

“Under modern trademark law, the ‘source’ identified by a trademark has been broadened to include not only manufacturing source, but also the source of standards as to the nature and quality of goods and services with which the mark is used. This provides the legal basis for the modern phenomena of trademark licensing and franchising. To have a valid

license, the licensor must control the nature and quality of the goods or services provided by the licensee users of the mark.”

(See McCarthy on Trademarks and Unfair Competition, Fifth Edition, June 2018 Update, Section 3:8.). See September 26, 2018 Response to Office Action, TSDR pp. 7-10. The Appellant has valid trademark licenses with its licensees, and controls the nature and quality of the goods (coils of cable and wire) produced by the licensees. The nature and quality of the goods (i.e., the coils) is controlled inherently by the winding machines that Reelex designs and manufactures, which are used, along with licensed patented technology and knowhow, by the licensees to manufacture all of the coils of cable and wire. The machines wind the coil in a figure eight pattern, which affects the quality of the wire payout from the coil. Thus, the nature and quality of each coil is associated with the Appellant licensor and its winding technology, and consumers have come to associate the applied-for trade dress as containing a coil of cable or wire that meets Appellant’s quality standards. Thus, regardless of whether Appellant physically manufactures the coils of cable and wire, Appellant is indeed the “source” of the goods (i.e., coils of cable and wire) identified by the applied-for trade dress by virtue of its licensing.

The Examining Attorney takes the position, which is unsupported by any fact, that a Reelex license only covers particular technology for product packaging materials and, thus, if the coiled cable or wire is not up to industry standards, it reflects poorly upon Appellant’s consumers and licensees, not upon the Appellant. See Nov. 8, 2018 Office Action, TSDR p. 10. Respectfully, this is incorrect. As noted in Appellant’s advertising evidence,

“The REELEX system is comprised of several components: the REELEX coil, *machinery for making the coil*, packaging supplies, the license agreement, and the patents that describe the REELEX system.”

See Oct. 3, 2017 Response to Office Action, TSDR p. 33. (Emphasis added.)

Therefore, since every coil of cable or wire is made using Appellant's licensed equipment, patented technology, and knowhow, if the coiled cable and wire is not up to industry standards, it most certainly reflects poorly upon Appellant.

The Examining Attorney also states:

*“End consumers of coiled cable and wire assume the name under which the cable and wire is marketed is responsible for the quality and ease of use of those goods. That is, consumers perceive the source of particular coiled cable and wire to be the name (mark) under which the coiled cable is marketed. Ads for coiled cable and wire do not feature the Reelex name. Ads for packaging for coiled cable and wire feature the Reelex name. Reelex is marketed in trade journals and featured at trade shows featuring product packaging for coiled cable. Reelex is not marketed directly to consumers of coiled cable.”* See Nov. 8, Office Action, TSDR p. 10. (Emphasis added.)

The Examining Attorney's position appears to be that a product package cannot bear more than one trademark, which is an untenable position. In the instant application, an end user may associate the type or brand of cable inside the box with the trademark of a cable manufacturer, e.g., Hitachi, while also associating the source of the trade dress and the configuration of the Hitachi cable (i.e., a figure-eight wound coil) with Appellant. Indeed, the evidence of record clearly shows that end users do associate the Appellant as the source of the configuration of the goods (i.e., the coil) as well as the trade dress, even while consumers separately associate the brand of the wire or cable (which is sold as a coil) with its manufacturer, e.g., Hitachi. For example, the lanshack.com product listing is for ABA Elite branded CAT5e cable that is wound in a figure-eight Reelex coil configuration dressed in the applied-for trade dress. See Oct. 3, 2017 Response to Office Action, TSDR p. 58. A consumer in the relevant field of packaged electrical cabling looking at the lanshack.com product listing would make those attributions. This is analogous to an end user who purchases a personal computer that bears the trademarks of Dell (computer manufacturer), Intel (chip manufacturer), and Microsoft (maker of computer operating system software). Such end user can differentiate and attribute the source of each part of the overall computer

system. Indeed, when a user is experiencing problems using their computer they often attribute the problem to the source of one or more of such marks based on the specific problem. Thus, since Appellant's trade dress does function as a trademark, there is no perception problem with users also independently perceiving the brand of the cable or wire used to make the coil.

Also, the Examining Attorney also states:

“Applicant's October 3, 2018 response filing provides examples of its licensing agreements with its consumers. Both consumer declarations and applicant's advertisements refer to licensing agreements. For example, ‘Reelex has, over a period of 39 years, licensed coiled cable or wire having the applied-for trade dress’ (Declaration of Timothy Copp, Response to Office Action filed 10/03/2017), ‘As a Windings licensee, you can buy our cutting-edge *winding and packaging equipment* at cost’ (App. A, Response to Office Action filed 10/03/2017), ... Notably, applicant's licenses are for packaging *materials* for the goods of others, not the goods being packaged.” See Nov. 8, 2018 Office Action, TSDR pp. 8-9.

Again, the Examining Attorney's position is not supported by the evidence. The above-noted citation clearly states that the license covers, among other things, winding and packaging *equipment*, i.e., machinery and technology for winding wire and cable into coils and machinery and technology for packaging the coils into packaging materials, i.e., boxes, which the end user is completely free to design on their own in view of the “Reelex Box Design Guidelines”. See Oct. 3, 2017 Response to Office Action, TSDR pp. 24-25. As noted above, the license ensures that Reelex's winding equipment, technology, and knowhow are used in the manufacture and packaging of every coil that is dressed in the applied-for trade dress. In this manner, Reelex winding technology is a part of every coil and is, therefore, “inside” every box of cable and wire that is sold.

The Examining Attorney also takes the position, which is unsupported by any fact, that “Although the identified goods are coiled cable and wire, *applicant's consumers are not purchasing cable and wire*, the consumers are purchasing *packaging* for cable and wire.” See Nov. 8, 2018 Office Action,

TSDR p. 8. (Emphasis added.) The evidence clearly shows that consumers are not buying empty boxes. As noted above, consumers are certainly buying coils of cable and wire wound using Reellex licensed equipment, technology, and knowhow, as evidenced by the product listing for a box of CAT5e cable from lanshack.com. See Oct. 3, 2017 Response to Office Action, TSDR pp. 58-60.

The Examining Attorney also cites to Appellant's website as alleged evidence that Appellant is the source of product packaging and not of cable and wire. However, the Examining Attorney's citations actually run contrary to the Examining Attorney's argument:

“Sometimes known as a ‘pull box’ package, 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. This *unique coil* dispenses from the inside-out without twists, tangles, snags or overruns.” See Nov. 8, 2018 Office Action, TSDR p. 9. (Emphasis added.)

As noted above, the configuration of the goods inside the box, i.e., the coil, are unique to Appellant. Reellex's packaging technology includes *methods* of winding and packaging wire and cable into packages of coiled wire and cable. The systematic manner of both winding and packaging is part of a “packaging system” (i.e., the aforementioned REELEX system) that is clearly associated with the Appellant. See Oct. 3, 2017 Response to Office Action, TSDR p. 33. Thus, Appellant is not only the source of packaging, but is also the source of the coils of wire and cable.

The Examining Attorney also states “Applicant's patents are not for cable and wire or coils of cable and wire but for technology licensed by others to produce coils of cable and wire.” Nov. 8, 2018 Office Action, TSDR p. 9. The Examining Attorney's statement supports Appellant's position. Appellant holds patents which, along with equipment and knowhow, it licenses to others to use to produce the coils of cable and wire that are dressed by the applied-for trade dress. The patents that are licensed and the methods used to wind the wire and cable into coils affects the quality of the wire payout from the coil (e.g., extent of tangling and kinking of wire). The nature and quality of each coil is associated with the Appellant and its winding technology. Therefore, regardless of whether or not Appellant actually manufactures the coils of cable and wire dressed by the applied-for trade dress, the

Appellant is indeed the “source” (for purposes of trademark registration) of the goods (i.e., coils of cable and wire).

Also, the Examining Attorney highlights the phrase “REELEX Packaging Solutions makes the package, not the wire” from Appellant’s website apparently to show that the Appellant is not the source of the goods, coils of cable and wire. See Nov. 8, 2018 Office Action, TSDR p. 9. However, as noted above, Appellant is the source of coils of cable and wire in view of the licensed use of proprietary winding technology to manufacture coils from wire and cable.

Finally, the Examining Attorney attempts to analogize Appellant’s licensing and quality control to that of Starbucks. See Nov. 8, 2018 Office Action, TSDR p. 10. The Appellant respectfully submits that the comparison is non-analogous and does little to clarify the issues on appeal. The Examining Attorney states:

“Applying the analogy directly to McCarthy’s broadened identification of source to include not only manufacturing source, but also the source of standards as to the nature and quality of goods and services with which the mark is used. If Reelex licenses its packaging technology to producers of packaging, Reelex must control the nature and quality of *the goods (packaging)* provided by the licensee users of the mark. Reelex is adversely affected by licensees producing poor quality packaging using the Reelex technology they licensed. Thus, the applied-for mark is a source identifier for producers of packaging, not of coiled cable.” See Nov. 8, 2018 Office Action, TSDR p. 10.

(Emphasis added.)

Again, the Examining Attorney approaches the analogy from the incorrect perspective that Reelex licenses *only* product packaging materials, which, as noted by Appellant above, is clearly erroneous. The Appellant’s licenses cover much more than product packaging materials. Reelex manufactures and licenses its winding and packaging equipment, patented technology, and knowhow to its licensees who transform third-party wire and cable into *coils* of cable and wire that are packaged into *boxes* using the licensed equipment, technology, and knowhow. Reelex sets the standards for winding the coils inside

every box by virtue of its proprietary technology inherent in every Reelex winding machine used to wind cable and wire into coils. Every time a consumer sees a box having the applied-for trade dress, the user expects that the coil inside the box has been wound using Reelex equipment, technology, and knowhow, and, therefore, that the coil meets the quality standards set by Reelex. That means that end users expect any Reelex coil (i.e., the goods) to be tangle- and twist-free upon payout from the box. Accordingly, if an end user receives a licensed Reelex Box of cable that kinks or twists during payout of the cable, Reelex (the understood source of the coil) will ultimately be blamed for the defect. Moreover, Reelex would be blamed for defects in payout from users of knockoff Reelex Boxes as well, since users would be unable to tell the difference of the coils from outside the box. Therefore, in view of all of the above, it is submitted that the applied-for trade dress is an indication of source for the identified goods.

#### (6) CONCLUSION

In light of all of the above, it is submitted that the application is in order for publication, and the Appellant respectfully requests that the Board direct the Examining Attorney to allow the case.

Respectfully submitted,

/Christian Mannino/

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