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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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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 REPLY BRIEF ON APPEAL

This Reply Brief is being timely submitted in response to the Examining Attorney's Appeal Brief dated May 31, 2019. Appellant's Arguments follow below.

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

Appellant has submitted unrebutted evidence sufficient to prove that the applied-for trade dress is one of many equally feasible, efficient and competitive designs, and, thus, is registrable on the Principal Register. See April 2, 2019 Appellant's Brief on Appeal, TSDR pp. 5-7, 10-15.¹ Contrary to the Examining Attorney's unsupported assertion, the claimed trade dress for a coil of cable or wire (that comprises a box) does not result in smoother dispensing of undamaged cable. See April 2, 2019 Appellant's Brief on Appeal, TSDR pp. 5 (Fact C) and 11. Rather, it is the proprietary, licensed Reelex winding technology and know-how for manufacturing the identified goods (coil of cable or wire) in a figure-eight pattern that allows for the cable and wire to be dispensed without kinking. See Oct. 3, 2017 Response to Office Action, TSDR pp. 12, and 63-65: "REELEX machines precision-wind clear, large payout holes in the coil, ensuring that each loop of the figure eight is on the correct side. **The loops cancel each other out inside the coil, allowing for 100% twist and tangle-free payout.**" See Oct. 3, 2017 Response to Office Action, TSDR p. 65 (emphasis added)

¹ See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982) "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."

The Examining Attorney also argues that the applied-for trade dress was chosen because the specific configuration has advantages related to certain characteristics, such as stackability, recyclability, and lighter weight. See May 31, 2019 Examining Attorney’s Appeal Brief, TSDR p. 8. However, none of those characteristics necessarily flows from the specific configuration of the applied-for trade dress, and all of those characteristics are *de facto* utilitarian features of all cardboard boxes of wire or cable.

The Examining Attorney cites to five of Appellant’s utility patents as *per se* evidence of functionality of the trade dress. See May 31, 2019 Examining Attorney’s Appeal Brief, TSDR, p. 8. However, the Examining Attorney has failed to *and cannot* cite specifically to any portions of those patents that allegedly supports Examining Attorney’s position on the functionality of the trade dress. Indeed, contrary to the Examiner’s position, none of the cited patents claim the design features at issue.

Thus, for at least the foregoing additional 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 ostensible *prima facie* case.

B. The Mark is a Distinctive Configuration of Packaging for the Identified Goods

In the Examining Attorney’s Appeal Brief, there appears to be substantial misunderstanding about what Appellant’s goods actually are, what the trade dress actually is, who the relevant buyer class is for Appellant’s goods, and how the specifics of Appellant’s business model interrelates to the foregoing. It is therefore helpful to review the facts using a common vocabulary from which both the Appellant and the Examining Attorney can frame the discussion.

The Appellant is the developer and licensor of the Reelex Licensed Packaging System, (the “Reelex System”). See Oct. 3, 2017 Response to Office Action, TSDR p. 33. The Reelex System is comprised of several components: machinery for making (i.e., winding) a figure-8 Reelex coil, the Reelex coil, packaging supplies, and a license agreement which licenses patents that claim aspects of the Reelex System. See Oct. 3, 2017 Response to Office Action, TSDR p. 33. “Packaging supplies” include boxes and payout tubes, which, when assembled and dressed around the coil, have the features of the applied-for

trade dress. The machinery for making the coil is designed for winding wire and cable into what is known as a “Reelex coil”, also referred to simply as a “coil.” “REELEX machines precision-wind clear, large payout holes in the coil, ensuring that each loop of the figure eight is on the correct side. The loops cancel each other out inside the coil, allowing for 100% twist and tangle-free payout.” See Oct. 3, 2017 Response to Office Action, TSDR p. 65. The coil and payout tube are “packaged” in a box, forming what is referred to interchangeably as a “Reelex Package” or “Reelex Box”. See April 2, 2019 Appellant’s Brief on Appeal TSDR p. 5. A licensee of the Reelex Packaging System uses the proprietary Reelex winding machines, which are designed, manufactured, and patented by the Appellant, with Appellant’s know-how to wind the cable or wire into finished coils of cable or wire, which can then be “packaged” with payout tubes and boxes, thereby forming a Reelex Package or Reelex Box. See Oct. 3, 2017 Response to Office Action, TSDR p. 33. Thus the term “package” in the coil industry is understood as including a set of items – a coil, a box, and a payout tube – and not a single item such as a box. See Oct. 3, 2017 Response to Office Action TSDR p. 33, where Fig. 1 is labeled “REELEX I Package.” Moreover, all operations by which cable or wire, a payout tube, and a box having the applied-for trade dress are manufactured into a Reelex Package are “packaging” operations, since they are all directed towards manufacturing a Reelex Package.

An understanding of Appellant’s business model is highly relevant for understanding the market for the applied-for trade dress. The Appellant’s customers include licensees of the “Reelex System”. Those licensees use the Reelex System to manufacture Reelex Packages or Reelex Boxes, each of which has the applied for trade dress and includes a coil of cable or wire wound in accordance with the Reelex System. Thus, the licensees of the Reelex System manufacture and use Reelex Packages (Reelex Boxes) bearing the applied-for trade dress, or sell Reelex Packages (Reelex Boxes) to wholesalers or retailers, the latter of which are overwhelmingly specialized trade retailers, such as Benfield Electric. See April 2, 2019 Appellant’s Brief on Appeal, TSDR p. 8. It is these users, wholesalers, and specialized retailers who have provided Declarations that are in the record. See April 2, 2019 Appellant’s Brief on Appeal TSDR pp. 8-9; and see Oct. 3, 2017 Response to Office Action TSDR pp. 37-40.

The market for Appellant's Reelex System, and therefore Packages having the applied-for trade dress, is understood by the advertising activities of the Appellant. Appellant has advertised and promoted the Reelex System and the applied-for trade dress in trade publications that target its licensee (and potential licensee) customers and those specialty retailers and wholesalers who deal in the specialized goods of reel-less coiled cable and wire. See Oct. 3, 2017 Response to Office Action, TSDR pp. 26-36. ***The goods of concern for the applied-for trade dress are not goods that the average person buys or consumes***; i.e., it is highly unlikely that anyone reading this brief has ever or will ever buy Appellant's goods. The goods are specialized and are known and used in the field of packaged electrical cabling. The facts noted previously and herein support Appellant's position that those customers in the relevant marketplace (e.g., licensees of the Reelex System, as well as wholesalers and retailers of Reelex Packages and Reelex Boxes) have come to look upon the applied-for trade dress as a trademark identifying the products solely of Appellant. See April 2, 2019 Appellant's Brief on Appeal pp. 7 to 9 Facts M to Q.

The Examining Attorney concedes that Appellant's evidence successfully shows marketing, sales success, length of use, and unsolicited media coverage. See May 31, 2019 Examining Attorney's Appeal Brief TSDR p. 15. However, the Examining Attorney takes the position that Appellant has not provided evidence from "the general consuming public, e.g., do-it-yourselfers and small contractors" of recognition of Appellant's trade dress. See May 31, 2019 Examining Attorney's Appeal Brief TSDR p. 15. In addition, the Examining Attorney states:

"In discussing the reasons for pursuing trademark protection for the applied-for mark, applicant notes the counterfeit packaging standing next to its own in the aisle of home supply shops such as Home Depot. Applicant attests that consumers standing before the display of boxed electrical cable cannot discern between the Reelex trade dress and that of its competitors. **Should the cable not dispense smoothly and undamaged, consumers will complain about the packaging, thus diminishing the Reelex Brand.** April 20th, 2018 conference call." See May 31, 2019 Examining Attorney's Appeal Brief TSDR p. 15. (Emphasis in the original).

Respectfully, Appellant has never attested that the relevant market for Appellant's goods was the general consuming public at general home supply shops, such as Home Depot because that is simply not the case.² As noted previously and again above, the relevant consuming public does not include the "general consuming public, e.g., do-it-yourselfers and small contractors." Moreover, the above statement of the Examining Attorney is directly contradicted by the Examining Attorney's previous admission of record that:

"Reelex is marketed in trade journals and featured at trade shows for product packaging for electric cable. See attachments to April 5, 2017 and June 29, 2018 Office actions.

Thus, Reelex is not marketed directly to consumers of coiled cable, but to consumers of product packaging for the cable." See May 31, 2019 Examining Attorney's Appeal Brief TSDR pp. 22-23. (Emphasis added.)

Thus, the Examining Attorney previously conceded that the relevant market for Appellant's goods is NOT the general consuming public at general home supply shops, such as Home Depot., but rather to people who read the relevant trade journals. Moreover, to correct the Examining Attorney's comment noted directly above, those in the relevant consuming public who read the trade journals that advertise Appellants goods and trade dress are consumers of more than merely "packaging supplies". Specifically, those in the relevant consuming public (e.g., wholesalers and specialty retailers of Reelex Packages (Reelex Boxes)) are certainly consumers of the identified goods (i.e., the coil of cable or wire) which are produced using Reelex licensed and patented technology, and which goods those consumers have come to associate Appellant as the source.

Furthermore, while the "focus" of secondary meaning is "the consuming public," it need not be proven among the *general* public if a product is targeted at only a specific segment of the general public. See McCarthy on Trademarks, Section 15.14(2), citing to *Centaur Communications, Ltd. v. A/S/M*

² This is the first time that the Examining Attorney has asserted that the market for Appellant's goods was the general consuming public at general home supply shops, such as Home Depot. No record of this has been found in any Interview Summary.

Communications, Inc., 830 F. 2d 1217, 4 USPQ2d 1541, 1544-45 (2d Cir. 1987). The Examining Attorney's statement above is understood to be an admission that Appellant's products are targeted at only a specific segment of the general public.³

In the present application, the relevant consuming public for the specialized goods (coils of cable or wire) include those to whom the Reelex System has been marketed: licensees and potential licensees of the Reelex System; and wholesalers and retailers of Reelex Packages and Reelex Boxes. This is a highly specialized and targeted segment of the general public. Clearly, based on the undisputed record evidence submitted, the targeted segment of the general public does recognize the applied-for trade dress as a trademark identifying the goods (i.e., Reelex coils) of the Appellant. See April 2, 2019 Appellant's Brief on Appeal TSDR pp. 7-9, Facts M to Q.

With regard to exclusivity, the Examining Attorney states "[t]here is no evidence supporting exclusive use of the applied-for mark and acquired distinctiveness of that mark *without the REELEX name.*" See May 31, 2019 Examining Attorney's Appeal Brief, TSDR p. 15. (Emphasis added.) Respectfully, the Examining Attorney is incorrect on the state of the record. The facts of the present application are analagous to those in *In re Schenectady Varnish Company, Inc.*, 126 USPQ 395, 1960. In that case, an applicant sought to register a design for sythetic resins on the principal register. The design consisted of a cloud and a lighting flash superimposed on the cloud. The applicant provided specimens of use that included the design with the word "SCHENECTADY" appearing in large letters across the central horizontal section of the lighting flash. The applicant also submitted as evidence letters from eleven of applicant's industrial customers, which included manufacturers of wire and cable, not end-users of the finished wire and cable. All of the letters submitted were similar except as to the number of years

³ A mark acquires secondary meaning when "it [is] shown that the primary significance of the term in the minds of the consuming public is not the product but the producer." *Id.* at 1221 citing *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 815 F.2d 8, 10 (2d Cir.1987) (20th Century II) (quoting *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F.Supp. 129, 133 (S.D.N.Y.1972) (emphasis in original)). The crux of the doctrine of secondary meaning "is that the mark comes to identify not only the goods but the source of those goods," even though the relevant consuming public might not know the name of the producer. *Id.* To establish secondary meaning, an applicant must show that the purchasing public associates goods designated by a particular mark with but a single — although anonymous — source. *Id.*

of association between the applicant and the customer companies.⁴ Despite the evidence, the Examining Attorney and the Board found that the design had always been used on applicant's labels and its advertising with the word mark "SCHENECTADY," and that therefore the letter and questionnaire evidence was insufficient to show that the design itself, apart from the word "SCHENECTADY", had trademark significance. *Id.* The Court reversed stating:

"Although those twenty-one companies all have a business relationship with appellant and the form which the responses took were conceived by appellant, there is no reason for us to believe that the officers of those companies failed to tell the truth in order to help appellant prove its case... we can only conclude that appellant has satisfactorily shown that its mark has acquired secondary meaning within the purview of section 2(f) of the Lanham Act.

Even though the number of questionnaires and letters is not great, since there is no evidence to the contrary and the results of the survey do not seem unlikely when the design itself and the length of time it has been used by appellant are considered, we are satisfied that appellant has shown secondary meaning and as such is entitled to have its design registered upon the principal register." *Id.* at. 397.

In the present application, as in *In re Schenectady*, the Examining Attorney takes the position that because Appellant's trade dress has appeared in promotional advertising along with the REELEX name, there is no evidence that supports the conclusion that the trade dress itself has acquired distinctiveness among the relevant consuming public for the identified goods, coils of cable and wire. This conclusion is contrary to the uncontested provided evidence and to the conclusion in *In re Schenectady*. Specifically, Appellant has provided evidence that the trade dress alone, apart from the REELEX name, has acquired secondary meaning in the minds of the relevant consuming public (i.e., licensees and potential licensees of the Reellex System, wholesalers, and retailers). For example, Appellant has thrice cited a product listing

⁴ The applicant also submitted as evidence questionnaires completed by ten other commercial customers (again, not end users) of the applicant.

(lanshack.com) for CAT5e cable that shows a picture of what is described in the listing as a “Reelex Box”. 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. Moreover, Appellant has submitted additional evidence showing websites of Electro Cables Inc. and Pacific Cabling Solutions Ltd. See Mar. 6, 2019 TEAS Request for Reconsideration After FOA, TSDR pp. 5 to 7. The Reelex Boxes shown in the lanshack.com listing, and the Electro Cables Inc. and Pacific Cabling Solutions Ltd. websites all bear the applied-for trade dress, but do not bear the REELEX logo or word mark. Thus, it is clear that those in the relevant consuming public (e.g., wholesalers, specialty retailers) can and do view the trade dress separate and apart from other REELEX trademarks and do associate the Appellant as the source of the trade dress (as well as the coiled configuration of the goods inside the Reelex Box).

Moreover, as in *In re Schenectady*, Appellant’s use of the applied-for trade dress with the relevant consuming public has been long and exclusive (over 39 years). See April 2, 2019 Applicant’s Brief on Appeal TSDR p. 7. Given the amount of advertising expenditures over this time targeting its intended market, the large amounts of sales in the relevant market, and the length of exclusive use, there is no reason for the Board to believe that those who submitted Declarations on behalf of Appellant (many of whom are officers of companies who are customers of Appellant) failed to tell the truth in order to help Appellant prove its case. That is, there is no reason to believe that Appellant’s trade dress, separate and apart from other REELEX trademarks, has not acquired a secondary meaning among the relevant consuming public (i.e., licensees and potential licensees of the Reelex System, wholesalers, and retailers) for the identified goods. Thus, the Board can only conclude, as the Court did in *In re Schenectady*, that Appellant has satisfactorily shown that its mark has acquired secondary meaning within the purview of section 2(f) of the Lanham Act.

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

The Examining Attorney takes the position that Appellant is only a source of product packaging, but not the source of the identified goods, i.e., a coil of wire or cable. Appellant has rebutted this position

on the ground that while Appellant does not manufacture wire or cable, the Appellant controls the nature and quality of the goods (i.e., the coils of wire and cable) by the winding machines that Reelex designs and manufactures, and which are used, along with licensed patented technology and know-how, by the licensees to manufacture all of the coils of cable and wire.⁵

The Examining Attorney argues that Appellants position is unpersuasive for several reasons.

“Applicant has applied for *a configuration of a box*, not the configuration of the coil inside the box. Further, applicant states 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.’ See applicant’s brief at 20. In addition to the volume of evidence in the record demonstrating that consumers view the applied-for mark as the source of the packaging rather than for cables, this statement underscores the fact that consumers do indeed distinguish between the packaging and the cable itself.” See May 31, 2019 Examining Attorney’s Appeal Brief TSDR p. 22. (Emphasis added.)

The Examining Attorney’s position is wrong on several accounts. First, Appellant has not “applied for *a configuration of a box*.” Appellant has applied for *trade dress* for *a coil* of cable or wire. The Reelex Package bears the trade dress, and contains a very specific coil, the Reelex coil, wound using only Reelex winding machines, technology and know-how. Those machines, technology, and know-how, are used to set the standards as to the nature and quality of every coil, regardless of the brand of wire or cable used. If the coil is not wound on a Reelex winding machine (a “counterfeit coil”), the coil does not have a precision-wound payout hole, leading to tangles, twists, and knotting of the wire or cable. These often render the entire package unusable, which must then be scrapped. See April 5, 2017 Office Action

⁵ “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.

TSDR p. 46. Moreover, counterfeit coils tend to be “flatter” than REELEX coils. This incorrect geometry can cause payout issues as well as damage to LAN cables. See April 5, 2017 Office Action TSDR p. 49. Consumers of the identified goods have come to rely on Appellant to ensure consistent quality of those goods. Therefore, regardless of the brand of wire or cable, every Reelex Package includes a *coil* of that brand of wire or cable and that coil *and its quality* is the direct result of the use of Reelex winding machines and technology by ALL licensees and manufacturers to wind the wire and cable into Reelex *coils*. Second, the evidence clearly shows that those relevant consumers in the market have come to associate the trade dress of the Reelex Package as an indication that the *coil* therein (and its quality) has been wound on a Reelex machine, and, thus that the coil (i.e., the goods) is sourced by the Appellant. Third, the ability of those in the specialized market to distinguish multiple trademarks on a single article of commerce does not make any one of the individual trademarks any less source-indicating. Clearly just as buyers of a Dell computer bearing the trademarks of Dell, Microsoft, and Intel can distinguish the marks and the associated goods from one another, so can the relevant consuming public of Appellant’s goods distinguish between the manufacturer of the wire or cable and the source associated with the form of that cable as a coil in the Reelex Box. Thus, the applied-for trade dress is an indication of source for the identified goods (coils of cable and wire), pursuant to Trademark Act Sections 1, 2, and 45.

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,

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