

This Opinion is Not a
Precedent of the TTAB

Mailed: June 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Interpage International, Inc.
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Serial No. 87346100
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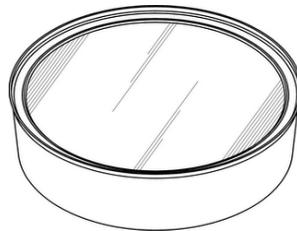
Charles H. Knull of Knull PC,
for Interpage International, Inc.

Christopher M. Nunley, Trademark Examining Attorney, Law Office 117,
Hellen Bryan-Johnson, Managing Attorney.

—
Before Cataldo, Wellington, and Shaw,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Interpage International, Inc. (“Applicant”) seeks registration on the Principal Register under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), of the following package configuration mark:



for “canned fish; tinned fish” in International Class 29.¹ The mark is described in the application as follows:

The mark consists of a three dimensional trade dress design of a package of the Applicant’s goods. The three dimensional product packaging is in the shape of a cylinder. The top of the product packaging is a transparent circle, represented by vertical lines, through which the product is seen. The solid portions represent opaque areas.

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that Applicant’s mark consists of “matter that, as a whole, is functional.” Specifically, the Examining Attorney asserts that “the transparent portion of the packaging serves a functional and utilitarian purpose, namely, allowing consumers to view or inspect the goods.”² The Examining Attorney also refused registration, in the alternative, on the ground that if the applied-for mark is ultimately determined to capable of functioning as a trademark, Applicant has not provided sufficient support for its claim that the proposed mark has acquired distinctiveness, under Section 2(f) of the Act.

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. We reverse the refusal to register on the basis that the proposed mark is functional, but affirm the alternative refusal on the ground that Applicant has not made a sufficient showing to support its acquired distinctiveness claim.

¹ Application Serial No. 87346100 filed February 22, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use of the mark anywhere and in commerce on December 1, 2012. Applicant amended the application to seek registration pursuant to Section 2(f) in its March 17, 2018 response to an Office Action.

² (Final) Office Action issued on April 9, 2018, TSDR p. 1.

I. Functionality

Section 2(e)(5) of the Trademark Act provides that registration of a mark may be denied if it “comprises any matter that, as a whole, is functional.” Generally, a product or package design is considered to be 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. Mktg. Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citations omitted); *see also*, *In re Mars, Inc.*, 105 USPQ2d 1859 (TTAB 2013). Prohibiting registration of functional designs allows for legitimate competition by effectively preventing a monopoly to a non-reputational, or non-source-identifying, feature of a product. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995) (describing a functional feature as on which the “exclusive use of would put competitors at a significant non-reputation-related disadvantage.”); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985) (“If the feature asserted to give a product distinctiveness is the best, or at least one, of a few superior designs for its *de facto* purpose, it follows that competition is hindered”).

Our determination of functionality is generally guided by the analysis first applied in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). *See Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1489 (TTAB 2017); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1513 (TTAB 2017); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017). *Morton-Norwich* identifies the following inquiries or categories of evidence as helpful in

determining whether a particular design is functional: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *Morton-Norwich*, 213 USPQ at 15-16.

Ultimately, the determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *E.g.*, *Valu Eng'g, Inc.*, 61 USPQ2d 1424; *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009). Moreover, we keep in mind that the Examining Attorney has the burden of making a *prima facie* showing that Applicant's mark is functional. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012).

With regard to the aforementioned *Morton-Norwich* considerations, Applicant asserts:³

In the present case, there is no utility patent at issue. Further, no advertising is in the record promoting the utilitarian advantages of the design. Additionally, no facts in the record support the notion that there is an absence of alternative designs for products and product packaging similar to Applicant's; indeed, there are a multitude of ways to package fish in see-through containers. Finally, neither Applicant nor the Examiner submitted any evidence as to the cost of Applicant's product; while Applicant's products are relatively low-priced preserved fish, and thus any packaging must also be relatively low-priced, no evidence exists in the record to support the notion that Applicant's design is solely the result of monetary concerns.

³ 6 TTABVUE 7.

The Examining Attorney does not dispute Applicant's assertions regarding the lack of relevant utility patents or the absence of advertisements of record that highlight a utilitarian feature in Applicant's mark.⁴ Nevertheless, the Examining Attorney contends that "the Morton-Norwich factors weigh in favor of finding the mark functional" and that "the totality of the evidence shows that the applicant's mark provides identifiable utilitarian advantages to the user (i.e. the ability to inspect the goods in low cost packaging)."⁵

The evidence in support of the functionality refusal is scant. Specifically, the Examining Attorney relies heavily on a single-page printout from the Wall Street Journal website that appears, in substantive part, as follows:⁶

⁴ 8 TTABVUE 6.

⁵ *Id.* at 6-7.

⁶ Attached to Office Action issued on March 20, 2017.

FOOD & DRINK

See-Through Food Packaging Boosts Sales

Clear Packages Draw Shoppers But Are Very Tricky; What's Best Left Unseen



Consumers love food sold in clear packaging, but it's a struggle for food companies because light degrades food. WSJ's Sarah Nassauer reports on Lunch Break with Sara Murray. Photo: Joshua Scott for The Wall Street Journal

The title in this screenshot indicates that clear packaging is desirable to consumers (“consumers love food sold in clear packaging”), but also that there are some practical drawbacks due to light causing food degradation (“it’s a struggle for food companies because light degrades food”). The Examining Attorney also submitted printouts from two third-party websites showing nuts and other snacks in clear packaging and what appears to be in transparent packaging, as well as a single screenshot that appears to be an article titled, “10 Best Transparent & See-Through Packaging Design Ideas for 2016” with photographs of various packaging.⁷

⁷ *Id.* As to article, aside from the title, the majority of the wording is illegible. We further note that none of the packaging depicted in the article is for fish products (TSDR p. 5).

The only other evidence submitted by the Examining Attorney consists of printouts from four different websites showing fish products offered in see-through packaging; a representative sample of this evidence appears as follows:⁸



The Examining Attorney asserts the aforementioned evidence shows that others “utilize clear packaging to allow consumers to inspect or view the goods.”⁹

On this record, we cannot conclude that Applicant’s proposed package configuration mark has a design feature that is “essential to the use or purpose” of goods or the package design “affects the cost or quality” of the goods. Only one website contains an explicit statement that consumers appreciate seeing food in transparent packaging, albeit with possible food degradation consequences. The other evidence includes only a handful of third-parties offering fish products in see-through

⁸ Attached to Office Action issued on December 4, 2017.

⁹ 8 TTABVUE 4.

packaging; however, we further note that the packaging depicted in those websites is not at all like Applicant's proposed mark. Indeed, to the extent that the third-party evidence showing fish products in transparent packaging is relevant, this evidence may be viewed as indicative of the availability to competitors of functionally equivalent designs other than Applicant's proposed cylindrical-shaped package design mark.

In his brief, the Examining Attorney raises the prospect of additional functional features within Applicant's proposed package configuration mark:

In this instance, the applicant's Package consists of a round container with a flat base, vertical sides, and a clear top. As shown in the evidence of record, it is common for packaging for food products to share similar utilitarian features. A flat base provides a sturdy platform which allows the Package to sit securely as placed and to be stacked for efficient shipping and storage. Vertical sides provide rigid support for the Package and enable the storage of goods. The round shape provides the largest possible storage volume per surface area while using the least amount of material. Additionally, the round shape provides additional stability and efficiency for stacking and storage. Finally, a clear top provides consumers the ability to view and inspect the goods while they are still inside the packaging. The applicant only ever contested the functional refusal issued by the examining attorney as it relates to the see-through portion of the packaging, and has not addressed the common utilitarian advantages of the flat base, straight sides, or circular shape of the Package.

This argument is troubling because this is the first mention by the Examining Attorney, who had not previously identified any of these purported functional or utilitarian features of Applicant's proposed mark. That is, within the four Office Actions issued, the Examining Attorney focused solely on "the transparent portion of packaging [that] serves a functional purpose, namely, allowing consumers to view or inspect the goods." In any event, there is no evidence of record to support the

assertions regarding additional putative utilitarian components in the mark. While the additional features of Applicant's package design mark may very well be utilitarian and functional, this must be demonstrated by evidence of record. *See In re Mars, Inc.*, 105 USPQ2d 1859 (holding "three-dimensional configuration of packaging for pet food that consists of a cylindrical, inverted pet food container" is functional based on record that included utility patents and technical disclosures.)

In sum, a prima facie showing that Applicant's proposed package design mark is functional has not been made. Accordingly, the refusal under Section 2(e)(5) is reversed.

II. Acquired Distinctiveness

We turn now to the Examining Attorney's refusal to register Applicant's proposed mark on the Principal Register under Section 2(f) due to insufficient proof of acquired distinctiveness of the proposed mark. "Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of [inherent] distinctiveness as an established fact." *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

Applicant bears the burden of establishing acquired distinctiveness. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018); *Yamaha Int'l Corp.*, 6 USPQ2d 1006-07. "The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the

use of the mark in each case.” *In re Chevron Intellectual Property Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010).

Applicant's burden is particularly high in view of the fact that the proposed product package configuration mark, on its face, does not appear to be particularly unique inasmuch as it is a cylindrically-shaped container, making it less likely to be perceived as a source indicator. *See In re American Academy*, 64 USPQ2d at 1753 (“However, ordinary geometric shapes such as circles, ovals, squares, stars, etc., are generally regarded as nondistinctive and protectable only upon proof of acquired distinctiveness.”); J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 7:33 (5th ed. Nov. 2018 update) (“Ordinary geometric shapes such as circles, ovals, squares, etc., even when not used as a background for other marks, are regarded as nondistinctive and protectable only upon proof of secondary meaning.”) As to the transparent circle top portion of Applicant’s package design mark, although we found the Examining Attorney’s evidence less probative for purposes of showing functionality, the evidence of transparency in food product containers has more relevance with respect to the distinctiveness of this feature in that that it shows consumers are accustomed to encountering food product packaging that is, at least in part, transparent. Furthermore, in cases of trade dress, like product packaging design, a mere statement of five years’ use is generally not sufficient. *See, e.g., In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1284, 1286 (TTAB 2000) (noting the statutory language regarding acquired distinctiveness “is permissive, and the weight to be accorded [evidence of five years of substantially exclusive use] depends

on the facts and circumstances of the particular case,” and finding evidence of seven to seventeen years of use insufficient to support a claim of acquired distinctiveness). Given the nature of Applicant’s mark—a cylindrical container for fish that, but for the transparent top, is much akin to the ubiquitous tuna fish cans found in grocery stores—this is a case where certainly more evidence than Applicant’s principal attesting to at least five years of substantially exclusive use of the package design and conclusion that it has become distinctive.

In support of its claim that the proposed mark has acquired distinctiveness, Applicant relies on the following evidence:

- The declaration of its president, Gregory Vernikov, who avers, *inter alia*:¹⁰
 - The mark has “become distinctive of the services [sic] through the applicant’s substantially exclusive and continuous use in commerce for at least five years immediately before the date of this statement.”
 - Applicant imports “160,000 products per year using the packaging that is the mark.”
 - The mark “has been prominently displayed on its promotional materials” since 2012.
 - Sales and advertising for the products using the mark have increased in the last five years, with \$200,000 in sales and \$25,000 spent in advertising in 2017.
 - Applicant has advertised using the mark in various publications.
- “Notes taken by the promotional staff” regarding promotional events at stores.¹¹
- Photographs of individuals holding what appears to be Applicant’s goods and the products on shelves.¹²

¹⁰ Attached to Applicant’s response filed on March 17, 2018.

¹¹ *Id.*

¹² *Id.*

We agree with the Examining Attorney that the evidence, when viewed in its entirety, does not support a finding that the applied-for mark has acquired distinctiveness. With respect to Applicant's sales and advertising figures, these are fairly general and there are no examples of promotional material showing how or why consumers would come to associate the packaging of Applicant's fish products as a source-identifier. *Cf., Grote Indus, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1213 (TTAB 2018) (where advertising prominently used word mark, consumers are more likely to associate the word mark rather than the design with the source of the goods); *see also, In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) (advertising displaying the design at issue along with word marks lacked the "nexus" that would tie together use of the design and the public's perception of the design as an indicator of source); *In re Mogen David Wine Corp.*, 372 F.2d 539, 152 USPQ 593, 595 (CCPA 1967) (where a container design appeared with a word mark, any alleged association of the design with the company "was predicated upon the impression imparted by the [word] mark ... rather than by any distinctive characteristic of the container per se.").

We also find little, if any, probative value in the promotional staff notes or the photographs of Applicant's goods for purposes of showing how or why Applicant's proposed package design mark would become distinctive as a source-identifier for Applicant's goods. In other words, although this evidence may show a degree of success at certain events or the manner in which Applicant's goods are presented and sold, there is no real indication that consumers be inclined to view the packaging of

Applicant's fish products as anything more than just packaging. Moreover, as the Examining Attorney's observed, the photographs of Applicant's actual goods show that they do not have a top that is entirely transparent but have a label covering approximately half of the top of the container. We agree with the Examining Attorney that this is inconsistent with the description of the mark in the application ("The top of the product packaging is a transparent circle"). Applicant asserts that this is irrelevant because "[t]he labeling obviously is there because the configuration is just a configuration--just a mark--and does not give all the information a consumer needs to make an intelligent purchase."¹³ This ignores the fact, however, that a "transparent circle" is claimed as a feature of the mark. Thus, if obscured by labelling, this certainly makes it more difficult for consumers to see this proposed feature, as described in the application and depicted on the drawing page, and likewise for this feature or the entire mark to acquire distinctiveness.

Ultimately, Applicant has not made a sufficient showing that its proposed package configuration mark has acquired distinctiveness.

Decision: The refusal to register Applicant's mark on the functionality ground is reversed. However, the refusal on the ground of an insufficient showing of acquired distinctiveness claim is affirmed.

¹³ 6 TTABVUE 13.