

This Opinion is Not a
Precedent of the TTAB

Mailed: September 12, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Buff and Shine Manufacturing, Inc.

—
Serial No. 88737597

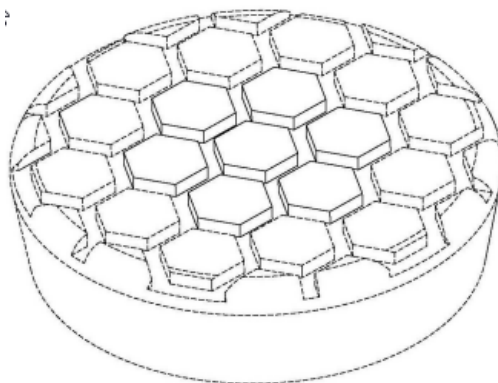
Todd Fitzsimmons of Fitzsimmons IP Law,
for Buff and Shine Manufacturing, Inc.

Shavell McPherson-Rayburn, Trademark Examining Attorney, Law Office 106,
Mary Sparrow, Managing Attorney.

—
Before Wellington, Hudis and Elgin,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Buff and Shine Manufacturing, Inc. (“Applicant”) seeks registration on the
Principal Register of the following product design configuration:



claiming that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(f), for “machine parts, namely, polishing discs for rotary machines, random-orbit machines, and other surface preparation machines for vehicles” in International Class 7.¹

The mark is described in the application as follows:

The mark consist[s] of a three-dimensional configuration of a polishing disc that includes a repeating pattern of hexagonal (or honeycomb) shapes on a front surface of the disc. The broken lines on the outer image and within the honeycomb pattern indicate placement of the mark on the goods and is not a part of the mark.

The Trademark Examining Attorney refused registration on three bases: (1) under Section 2(e)(5) of the Act, 15 U.S.C. § 1052(e)(5), on the ground that Applicant’s mark, which consists of a three-dimensional configuration of the goods, is a functional design for such goods; (2) on the ground that Applicant’s mark consists of a non-distinctive product design that is not registrable on the Principal Register under Sections 1, 2, and 45 of the Act, 15 U.S.C. §§ 1051-1052, 1127, and Applicant has not made a sufficient showing of acquired distinctiveness under Trademark Act Section 2(f); and (3) on the ground that Applicant’s mark fails to function as a trademark “because pursuant to the drawing the applicant is claiming only the center hexagon pattern” and “the honeycomb pattern [on the goods depicted in the specimen] appears the same throughout and there is nothing unique about the center area that shows what applicant is claiming as a mark,” pursuant to Sections 1, 2, and 45 of the Act.

¹ Application Serial No. 88737597 was filed on December 23, 2019 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 at least as early as July 1, 2009.

When the refusal was made final, Applicant appealed. The appeal has been briefed. For reasons explained below, we reverse the refusal on the ground that the proposed mark is functional, and on the ground that it fails to function as a trademark; however, we affirm the refusal on the ground that it is not inherently distinctive and has not acquired distinctiveness.

I. The Record

During the prosecution of the application, Applicant submitted the following materials:

- A declaration of Applicant's President and founder, Rich Umbrell ("Umbrell Dec."), with accompanying exhibits;²
- A (second) Declaration of Mr. Umbrell ("Umbrell Dec. II"), with accompanying exhibits;³
- A declaration of Todd Fitzsimmons ("Fitzsimmons Dec."), Applicant's counsel, with accompanying exhibits, including copies materials discussing polishing pads, a copy of a design patent (Patent No. D684,611, hereinafter "Patent '611") and copies of 'cease-and-desist' letters sent to putative infringers;⁴ and
- Printouts of photographs of its polishing disc pads (submitted as substitute specimens).⁵

The Examining Attorney submitted the following:

² Attached to Applicant's response filed May 23, 2020.

³ Attached to Applicant's response filed November 4, 2020.

⁴ Attached to Applicant's response (with petition to revive) filed August 24, 2021.

⁵ Attached to Applicant's response filed February 17, 2022.

- Internet printouts from third-party retail websites showing “honeycomb patterns are visually similar to elements on other polishing discs offered by other manufacturers” and that “the honeycomb/hexagon pattern appear[s] to be the preferred format used by those who manufacture polishing discs”;⁶ and
- Internet printouts from third-party websites (eBay and Detailing Supply Co.) advertising Applicant’s polishing discs for sale.⁷

II. Functionality Refusal Reversed

A. Applicable Law

Section 2(e)(5) of the Act prohibits registration of “a mark which . . . comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). “A product design or a product feature is considered functional in a utilitarian sense if: (1) it is ‘essential to the use or purpose of the article,’ or (2) it ‘affects the cost or quality of the article.’” *In re MK Diamond Prods.*, 2020 USPQ2d 10882, at *5 (TTAB 2020) (quoting *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982))).

Our determination of functionality is generally guided by the analysis first applied in *In re Morton-Norwich*, 213 USPQ 9, 15-16 (CCPA 1982). *See, e.g., 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*,

⁶ Attached to Office Action issued on November 30, 2020.

⁷ Attached to Office Action issued on October 27, 2021.

L.P. v. Ill. Tool Works Inc., 124 USPQ2d 1508, 1513 (TTAB 2017); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017).

The *Morton-Norwich* decision 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;⁸ 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.

The *Morton-Norwich* functionality considerations “are not exclusive, however, for functionality ‘depends upon the totality of the evidence.’” *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (quoting *Valu Eng'g*, 61 USPQ2d at 1424). Indeed, in any given case, some of the considerations may not be necessarily relevant to a finding of functionality, nor will they have to weigh in favor of functionality to support a finding of functionality. *Change Wind*, 123 USPQ2d at 1456; *Heatcon*, 116 USPQ2d at 1370. *Cf. Poly-America*, 124 USPQ2d at 1519 (“Petitioner need not present

⁸ We note that this consideration may be superfluous or irrelevant when functionality is found based on other considerations. *See, e.g., TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001, 1006 (2001); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1376, 102 USPQ2d 1372, 1378 (Fed. Cir. 2012). The reasoning is that there is “no need to consider the [third *Morton-Norwich* factor regarding] availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.” *Id.*, quoting *Valu Eng'g*, 61 USPQ2d at 1427; *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1202.02(a)(v)(C) (2022).

evidence fitting within all four categories in *Morton-Norwich*.”). Ultimately, the determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *See, e.g., Valu Eng’g*, 61 USPQ2d 1424; *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009).

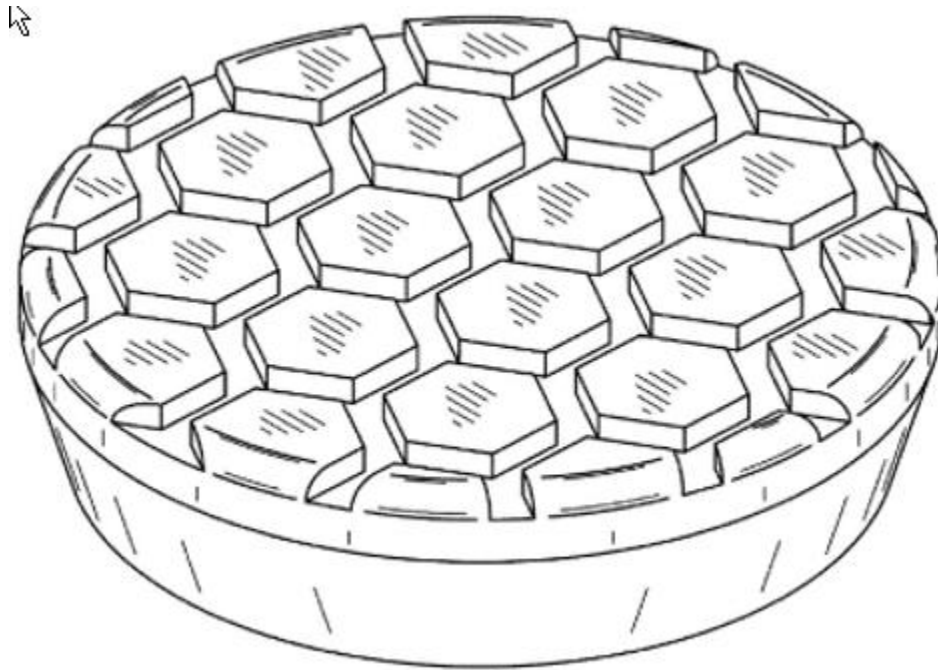
B. Analysis of Arguments and Evidence

As to the fourth *Morton-Norwich* functionality consideration, counsel for Applicant avers that, “in speaking with Mr. Umbrell [Applicant’s President], I learned that the claimed hex pattern is (A) not essential to the use or purpose of the buffing pad and (B) is generally more expensive than alternatives, given the complexity of the design.”⁹ In its brief, Applicant clarifies that “the honeycomb/hexagonal pattern used by [Applicant] is no cheaper to manufacture than the alternatives ... [and] if anything, [Applicant’s] design is more expensive as it requires six different cuts to create a honeycomb/hexagonal shape, whereas a rectangle only requires two different cuts (horizontal and vertical), and the ‘waffle’ texture does not require any cuts.”¹⁰ To the extent that Applicant’s counsel relies on communications from Mr. Umbrell to form the basis of his knowledge regarding the cost of manufacturing Applicant’s polishing discs, this is hearsay and thus its probative value is diminished. FED. R. EVID. 801, 802. Nevertheless, the Examining Attorney does not argue to the contrary or assert that Applicant’s product design helps minimize the cost or simplify the manufacture of its polishing discs.

⁹ Response filed August 24, 2021 (Fitzsimmons Dec. ¶ 5).

¹⁰ 4 TTABVUE 24.

In regard to the first *Morton-Norwich* functionality consideration, there are no utility patents of record. Applicant, however is the owner of a design patent, Patent '611, and argues that this is evidence that its proposed mark is not functional. The design patent's sole claim covers the "ornamental design for a buffing pad, as shown and described."¹¹ The following is the design patent's primary drawing:¹²



"Our law recognizes that the existence of a design patent for the very design for which trademark protection is sought 'presumptively . . . indicates that the design is not *de jure* functional.'" *In re Becton, Dickinson*, 102 USPQ2d at 1377 (quoting *Morton-Norwich*, 213 USPQ at 17 n.3); see also *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, *6 (TTAB 2019) (quoting the same language and finding a design patent for an umbrella "covers the applied for mark" and thus "is evidence of non-functionality").

¹¹ Attached to Response filed August 24, 2021 (Fitzsimmons Dec. Ex. G).

¹² *Id.*

Cf. Grote Indus., Inc. v. Truck-Lite Co., 126 USPQ2d 1197, 1206 n.25 (TTAB 2018) (design patent that is not identical to proposed mark is not probative of functionality); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1432-33 (TTAB 2016) (same).

As explained in TMEP Section 1202.02(a)(v)(A):

Design patents cover the invention of a new, original, and ornamental design for an article of manufacture. ... A design patent is a factor that weighs against a finding of functionality, because design patents by definition protect only ornamental and nonfunctional features. However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination.

[Citations omitted].

Accordingly, because the design patent is identical to Applicant's proposed mark depicted in the drawing, albeit without any dotted lines, it constitutes evidence weighing against a finding of functionality. We hasten to add that the existence of the design patent is not dispositive of the issue of whether Applicant's product design is functional, but is one piece of evidence relevant to our analysis.

The Examining Attorney maintains that, despite the absence of a utility patent, Applicant's design patent claimed priority as a continuation-in-part of a utility patent application (Serial No. 12/497,538), since abandoned, and that this is relevant to the question of functionality:¹³

It should also be noted that Applicant provides that its design patent claimed priority (as a continuation in part) to a utility patent application that was later abandoned. ... Whether abandoned or not, the fact that

¹³ 6 TTABVUE 6. See August 24, 2021 Response to Office Action, TSDR p. 73-80 (Exh. H).

Applicant even applied for a utility patent is strong evidence that Applicant itself believes the features at issue are functional.

However, the Examining Attorney does not reference any claimed utilitarian features in the application. Moreover, as Applicant explains, “the utility patent was abandoned . . . and (most importantly) claimed features that had nothing to do with the applied for mark (i.e., the claimed functionality was not the design).”¹⁴ We have reviewed the claims made in now-abandoned utility patent application, namely, for a “Buffing Pad Centering System,” and find they have no obvious bearing on any utilitarian features in Applicant’s applied-for mark, i.e., the repeating hexagonal design on the surface of the polishing disc. Moreover, the Examining Attorney does not point to any claims in the utility patent application or argue how the application is relevant, other than Applicant filed it.

As to the second *Morton-Norwich* functionality consideration, the record includes advertising for Applicant’s product stating that the “hex pattern” is deployed as a means of keeping the polishing pad cooler when polishing surfaces. For example, Applicant’s goods sold under the “Hex-Logic” brand are advertised for sale on a third-party automobile detail supply website as follows:¹⁵

¹⁴ 4 TTABVUE 5-6.

¹⁵ November 30, 2020 Office Action, TSDR p. 14.

Hex-Logic Quantum Medium-Heavy Cutting Pad, Orange (5.5")

HOME / ACCESSORIES / POLISHING PADS & ACCESSORIES / HEX-LOGIC QUANTUM MEDIUM-HEAVY CUTTING PAD, ORANGE (5.5")



\$10.99

1 + ADD TO CART

Information

Availability: In stock

Orange Quantum pad removes moderate to heavy swirl marks, scratches, oxidation, and water spots from painted finishes

Pair Orange pads with light swirl remover polishes like V36 or one-step polishes like VSS Scratch & Swirl Remover

Most efficient and advanced polishing pads on the market

Quantum Physics design maximizes surface contact, reduces and disperses heat, and reduces wear and tear on machine and pad

The highlighted language above reads “Quantum Physics design maximizes surface contact, reduces and disperses heat, and reduces wear and tear on machine and pad.”

A different example of advertising from Amazon describes the design of Applicant’s goods as, “the hex face will help dissipate polish or compounds evenly minimizing grabbing and reducing heat ...”¹⁶ The Examining Attorney argues that this type of advertising is “strong evidence that the matter sought to be registered is functional.”¹⁷

Applicant readily acknowledges this advertising and the highlighted feature of its product design’s ability to dissipate or minimize heat, but asserts that this is not due to the repeating hexagonal design necessarily but is attributed to the fact that the

¹⁶ November 4, 2020 Office Action, TSDR p. 23.

¹⁷ 6 TTABVUE 7.

pads are “textured.”¹⁸ Specifically, Applicant asserts that there are “flat” and “textured” pads, the latter having an uneven surface but not in any one specific design. This information is corroborated by an article submitted by Applicant discussing the efficacy of “flat versus textured” pads.¹⁹ The article specifically mentions Applicant’s “Hex Logic” brand, and questions the claim that textured pads are able to dissipate heat better:²⁰

Flat Pads Vs. Textured Pads (CCS, Hex Logic, Waffle)

Manufacturers generally claim textured pads run cooler and therefore last longer. I’ve personally seen no difference in performance of flat vs. textured pads. One important thing to note is that some polishers do not play nice with textured pads. Forced rotation buffers such as the Flex 3401 tend to walk around the paint on you when used with a textured pad.

In general, I opt for flat pads. They are typically cheaper, more abundant, more durable, and just plain work.

Thus, although Applicant’s goods may have the ability to dissipate heat, this is attributed to the fact the pads are textured, and not a result of the repeating hexagonal design. In other words, the design is not is “essential to the use or purpose” of the polishing pads. *MK Diamond Prods.*, 2020 USPQ2d 10882, at *5.

¹⁸ 4 TTABVUE 22.

¹⁹ August 24, 2021 Response to Office Action, TSDR pp. 46-47 (“Ultimate Beginner’s Guide to Buffing Pads” from www.thearteofcleanliness.com website).

²⁰ *Id.*

In terms of the third *Morton-Norwich* functionality consideration, Applicant submitted evidence of third-party textured pads with different repeating design patterns, e.g., described as “circular” (raised and recessed) or “triangular” or “waffle” or “rectangular.”²¹ These third-party pads may also tout the ability to dissipate heat. For example, the textured design of the following pad is advertised as “reduc[ing] surface friction and heat build[-]up between the pad and the paint”:²²



This evidence helps show that alternative functionally-equivalent designs are available to Applicant’s competitors. Although not essential to our decision, this weighs in favor finding the proposed mark is not functional.

C. Conclusion - Functionality

Upon review of the entire record before us, we conclude that the Examining Attorney did not make a prima facie showing that Applicant’s mark is *de jure* functional. *See In re Becton, Dickinson*, 102 USPQ2d at 1376. Accordingly, we reverse

²¹ *Id.* (Fitzsimmons Dec. ¶ 6, Exs. B-F).

²² *Id.* at p. 48.

the Examining Attorney's refusal to register Applicant's product design under Section 2(e)(5) of the Act.

III. Distinctiveness Refusal Affirmed

We turn now to the Examining Attorney's alternative refusal based on Applicant's product design mark being nondistinctive and Applicant's proof of acquired distinctiveness being insufficient.

A. Applicable Law

Pursuant to Sections 1, 2, and 45 of the Act, a mark may be only registered on the Principal Register for goods if it is distinctive and distinguishes an applicant's goods from those of others by indicating the source of the goods.²³ *See In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached.”)

Product configuration design marks, such as the one Applicant seeks to register, are never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068-69 (2000) (“In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist.”). *See also, e.g., OEP Enters.*, 2019 USPQ2d 309323, at *16 (“[P]roduct designs can never be inherently distinctive and will always require evidence of acquired distinctiveness or secondary meaning to be registrable as marks.”) (quoting

²³ Section 1 of the Act concerns the requirements for filing a trademark application; Section 2 lists the grounds on which the USPTO may refuse registration; and Section 45 provides the definition of a “trademark,” requiring that it “identify and distinguish [an applicant's] goods ... from those manufactured or sold by others and to indicate the source of the goods” 15 U.S.C. §§ 1051-1052, 1127.

Kohler, 125 USPQ2d at 1503-04). Accordingly, we must determine whether Applicant's evidence in support of its acquired distinctiveness claim under Section 2(f) of the Act is sufficient to show that "consumers perceive the design of Applicant's [goods] as an indicator of source." *In re Larian*, 2022 USPQ2d 290, at *51 (TTAB 2022).

Applicant bears the burden of proving, at least, a prima facie case of acquired distinctiveness in an ex parte proceeding. *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, *8 (TTAB 2021). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1335, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)). In making such a showing, Applicant must demonstrate that consumers perceive the primary significance of its product configuration as not the product, itself, but the source of that product. *Larian*, 2022 USPQ2d 290, at *37 (citing *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009)).

Our ultimate Section 2(f) analysis and determination in this case is based on weighing all of the evidence considered as a whole, under the following six factors:

- (1) association of the [mark] with a particular source by actual purchasers (typically measured by customer surveys);
- (2) length, degree, and exclusivity of use;
- (3) amount and manner of advertising;
- (4) amount of sales and number of customers;
- (5) intentional copying; and
- (6) unsolicited media coverage of the product embodying the mark.

In re SnowWizard, Inc., 129 USPQ2d 1001, 1105 (TTAB 2018) (quoting *Converse, Inc. v. Int'l Trade Comm'n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)).

These are known as the “*Converse* factors.”

Finally, “[i]t is axiomatic that ‘the lesser the degree of inherent distinctiveness, the heavier the burden to prove that [a mark] has acquired distinctiveness.’” *Larian*, 2022 USPQ2d 290, at *38 (quoting *Udor*, 89 USPQ2d at 1986). “While there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, the burden is heavier in this case because it involves product configuration[.]” *Id.* (quoting *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283-84 (TTAB 2000)); *see also* *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (evidence required to show acquired distinctiveness is directly proportional to the degree of nondistinctiveness of the mark at issue).

B. Analysis of Arguments and Evidence

In accordance with the last-mentioned axiom, *supra*, Applicant has a high burden for proving acquired distinctiveness because the mark sought for registration is a product configuration design, and because it is a repeating pattern of a fairly common geographic shape, i.e., a hexagon. The previously-discussed evidence of third-party polishing discs shows consumers are not unaccustomed to encountering textured polishing pads that have a repeating geographic shape design, such as a circle or triangle or rectangle. Although Applicant asserts that each geometric shape is associated with a particular source, there is no evidence that consumers perceive them in such a manner. Rather, without supporting evidence to the contrary,

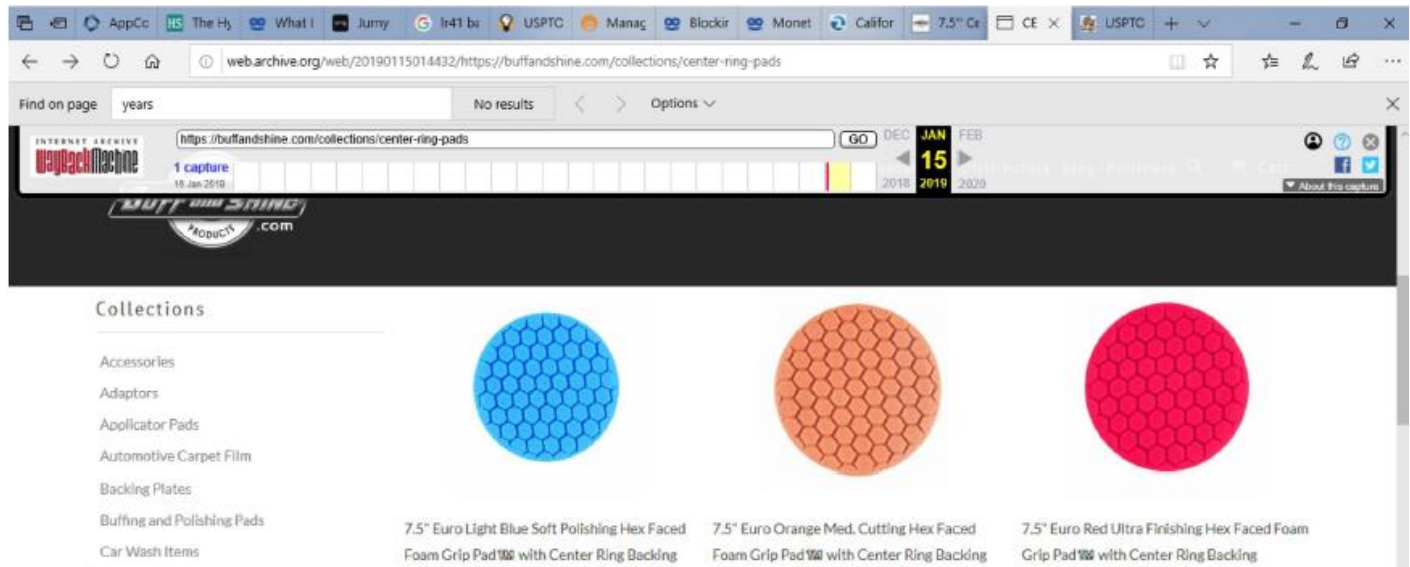
consumers encountering such products may simply believe that each is merely an ornamental design without any source-identifying quality.

Notably, the record is devoid of the types of evidence that can be probative in the context of certain *Converse* factors. Specifically, Applicant did not submit: (i) any customer surveys or declarations from actual purchasers attesting to their belief that they associate Applicant's proposed mark with Applicant as the source of its polishing discs, (ii) any evidence regarding the amount of sales, either in dollars or number of units sold, for Applicant's polishing discs having the repeating hexagonal pattern, or (iii) proof of Applicant's relevant market share for these goods. Although there is no requirement for any particular type of evidence or information to establish a prima facie showing of acquired distinctiveness, the absence of such evidence certainly makes our task of making a distinctiveness determination more difficult.

Instead, in arguing that its proposed mark has acquired distinctiveness, Applicant relies on the declaration of its President, Mr. Umbrell, who avers that Applicant has been manufacturing and selling polishing discs (pads) "bearing the applied-for-mark" since "at least July 2009."²⁴ Based on the "long term, continuous, and extensive use and promotion of the [proposed mark], consumer[s] now directly associate the hexagonal design with Applicant as the source of the pads."²⁵ Applicant also submitted archived printouts from its website, including the following:

²⁴ May 23, 2020 Response to Office Action, TSDR p. 10 (Umbrell Dec. ¶ 2).

²⁵ *Id.* at p. 11; Umbrell Dec. ¶ 3.



[from 2019].²⁶

Applicant further submitted evidence of its goods advertised for sale on third-party retail websites, including the following on Amazon.com:

²⁶ *Id.*; Umbrell Ex. B.

**Buff and Shine Center Ring 8\"
Hex Foam Pad (BFS-820RH)**
Brand: Buff and Shine

Price: \$25.85

Get a \$100 Amazon.com Gift Card upon approval for the Amazon Business American Express Card. Terms apply.

- Thickness - 1.375 in.
- Material Type - 50% Wool / 50% Acrylic blend 4 ply twisted yarn.
- Mounting - Grip Pad.
- Foam color - Black.
- Application - Finishing.

> See more product details

New (2) from \$25.85 + FREE Shipping

Click image to open expanded view

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The “product description” for the above pad includes: “we have shaped the front of the pad with a hex design ... the hex face will help dissipate polish or compounds evenly minimizing grabbing and reducing heat...”

Mr. Umbrell further testifies that in the past five years, Applicant advertised its proposed mark “in printed publications, such as Auto News Detailing, at tradeshow, via brochures [and catalogs] handed out and mailed to individual and companies.”²⁸ During this same time period, Mr. Umbrell states that Applicant “spent on average over \$100k per year advertising and promoting the applied-for-mark in various

²⁷ November 4, 2020 Response to Office Action; Umbrell Dec. II Ex. B.

²⁸ *Id.*; Umbrell Dec. II ¶ 8.

mediums, including trade shows ..., trade magazines, ... online forums ..., and print (brochures, catalogs, etc.), to name a few.”²⁹

Despite Mr. Umbrell’s averments regarding the extent of Applicant’s advertising, there is extremely little evidence demonstrating an effort by Applicant to associate its proposed mark with itself as a source-identifier. That is, even if we assume that Applicant’s polishing discs have been promoted extensively to the relevant consuming public, there is no showing of a continuous or concentrated effort to promote the repeating hexagonal design as a feature that distinguishes Applicant’s goods. The record is devoid of any “look for”³⁰ type of promotion whereby Applicant directs consumer attention to its proposed mark. *In re Becton, Dickinson*, 102 USPQ2d at 1376 (“Nothing in the text of the advertisements underscores this ‘look for’ concept.”). Rather, Applicant merely describes its goods as being “Hex-face” or, as discussed in the context of the functionality refusal, the “hex design” is described as helping dissipate or distribute heat more evenly. Again, these references to a hexagonal design feature are intended more to inform the consumer of a possible heat-dissipating feature of Applicant’s goods and not as a means of identifying the source of the goods.

²⁹ *Id.*; Umbrell Dec. II ¶ 9.

³⁰ “Look for” evidence can be described as:

... refer[ring] to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non-source-identifying manner.

Stuart Spector Designs, 94 USPQ2d at 1572.

Although “look for” advertising is not necessary to prove acquired distinctiveness, it often is probative to sway a fact finder in determining whether certain product design features have become distinctive in the minds of consumers over time and consumers may identify the source of the product by those features. *Kohler*, 125 USPQ2d at 1517 (lack of “look for” evidence is not fatal to a showing of acquired distinctiveness; however, “for consumers to have any realistic chance of recognizing the applied-for mark in Applicant’s advertising separate and apart from [other elements] that are also not part of the applied-for mark, Applicant’s advertising would have to ‘direct[] the potential consumer in no uncertain terms to look for’ the applied-for mark.”) (citing *Stuart Spector Designs*, 94 USPQ2d at 1574).

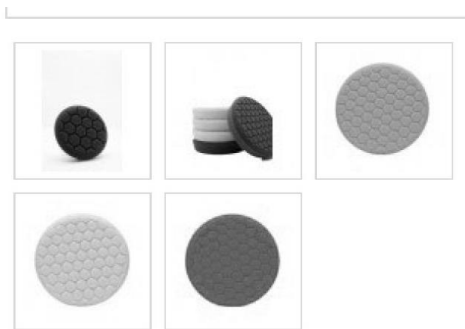
Applicant relies on Internet evidence that it submitted and argues that it “include[s] statements from companies and individuals acknowledging the exclusive association between [Applicant] and products bearing the applied-for-mark (i.e., the applied-for-mark functions as a source identifier for products designed and manufactured by [Applicant]).”³¹ Applicant argues that these statements are the “results of significant advertising over a ten-year period, educating the public that Buff and Shine is the source (and designer) of the hex-face pad”³² Applicant seems to equate this type of evidence with the type of evidence that is missing from the record, namely, direct evidence in the form of consumer surveys or consumer declarations

³¹ 4 TTABVUE 5.

³² 4 TTABVUE 17.

wherein consumers expressly state their association of the hexagonal design uniquely with Applicant.

We disagree with Applicant's characterization of the aforementioned Internet evidence, and do not find it shows "companies and individuals" making an "exclusive association" between Applicant and the hexagonal design pattern "as a source identifier. Rather, to the extent that others mention "hex" or "hexagonal" or any "design" of the pads, the references are for product-description purposes only and not as indicators of source. For example, Applicant highlights (in bold) and relies on the language "**Buff and Shine Hex Face Foam Pads were designed for the discerning enthusiast** or professional looking for a pad that **easily glides over any painted surface**" in the following web page screen capture:³³



Buff and Shine 7.5" Hex Pad

Condition: New product

Buff and Shine Hex Face Foam Pads were designed for the discerning enthusiast or professional looking for a pad that easily glides over any painted surface. The laser cut Hex Face conforms to curved, angled, sloped and flat surfaces while delivering even product distribution throughout the polishing process. Plus, these pads stay lubricated to reduce friction and marring.

³³ 4 TTABVUE 16; identifying Umbrell Dec. II Ex. E attached to November 4, 2020 Response to Office Action. The same language appears in another retail web page screen capture Applicant relies upon (*see* Umbrell Dec. II Ex. I).

An inference cannot be drawn from the above language that the repeated hexagonal design is (or should be) understood as an indicator of source. At best, the advertisement touts a particular design that works well in this configuration.

Applicant also relies on statements from consumers who refer to Applicant's use of the mark HEX-LOGIC³⁴ and argues that such statements show that "consumers that purchase the hexagonal-faced pads from [Applicant's] exclusive distributor, Chemical Guys, under the name 'Hex-Logic,' also understand that pads are manufactured by [Applicant]."³⁵ However, the statements, albeit made by consumers, demonstrate only that they are associating the mark "Hex-Logic," and not the repeating hexagonal (or honeycomb) pattern on its product, with Applicant.

In sum, the totality of the evidence falls woefully short of showing that the consuming public has come to understand the hexagonal design as an indicator of source. Noticeably absent is any statement, solicited or unsolicited, from a consumer of polishing discs attesting to the belief that the repeating hexagonal design is an indicator of source with respect to Applicant's goods.

Finally, we address Applicant's evidence regarding its efforts to "remove counterfeit products from the marketplace."³⁶ Applicant argues that it "has used [its design patent] to remove counterfeits from various websites, including www.eBay.com and www.amazon.com; said counterfeits being evidence of intentional

³⁴ Submitted by Applicant as Fitzsimmons Dec. Exs. AA-HH attached to August 24, 2021 Response to Office Action.

³⁵ 4 TTABVUE 20.

³⁶ Fitzsimmons Dec. ¶ 9, attached to August 24, 2021 Response to Office Action.

copying, which, as the Examiner states, is evidence of distinctiveness.”³⁷ In support, Applicant submitted copies of ‘cease-and-desist’ letters or other correspondence from its counsel to at least three different companies as well the retail websites Amazon and eBay.³⁸ Applicant received one response from counsel for one of the alleged infringers who stated that its client “does not admit to any infringement, [but] ... have agreed to remove the item for sale” and “any remaining inventory will be destroyed.”³⁹ In addition, Amazon stated that it was “in the process of removing” certain items for sale on its website that were “posted by third party merchants without prior review by Amazon.com.”⁴⁰

Applicant’s enforcement efforts have been successful in getting one company to agree to cease selling goods that Applicant objected to, albeit without admitting to any infringement. Similarly, Applicant was successful in its request for Amazon to remove certain goods listed for sale on its website. However, given the relatively few instances of alleged infringement and with limited success, it is difficult to draw a meaningful conclusion concerning whether the alleged infringers’ activity is a recognition of the acquired distinctiveness of Applicant’s repeating hexagonal design mark or to simply avoid future litigation. *Ennco Display Sys.*, 56 USPQ2d at 1286 (“We are unable to determine from the record whether the parties [settled] in recognition of the acquired distinctiveness of applicant’s product configurations, ... or

³⁷ 4 TTABVUE 18.

³⁸ Fitzsimmons Dec. Exs. I-Z, attached to August 24, 2021 Response to Office Action.

³⁹ *Id.* at TSDR p. 289, Ex. F.

⁴⁰ *Id.* at TSDR p. 451, Ex. G.

in order to settle [the dispute and avoid litigation].”); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7, 8 n.2 (CCPA 1977) (“Appellant argues that various letters (of record) from competitors indicating their discontinuance of use of its mark upon threat of legal action are evidence of its distinctiveness, but we agree with the TTAB that such evidence shows a desire of competitors to avoid litigation rather than distinctiveness of the mark”); *see also In re Dimarzo, Inc.*, 2021 USPQ2d 1191, at *12 n.24 (TTAB 2021) (Board unable to “conclude that settlement agreements obtained by Applicant, even if they did refer to the claimed color mark at issue, were probative of the distinctiveness of the mark as opposed to the referenced third parties’ desire to avoid litigation.”) (citing *Wella, supra*).

C. Conclusion – Distinctiveness

Based on the entirety of the record and upon weighing the *Converse* factors, we find Applicant has not carried the high burden of making a prima facie showing that its repeating hexagonal product design has acquired distinctiveness pursuant to Trademark Act Section 2(f) for polishing discs.

IV. Failure to Function Refusal Reversed

The Examining Attorney’s refusal to register Applicant’s proposed mark on the basis that it fails to function as a trademark is reversed. Specifically, the Examining Attorney’s basis for this refusal – articulated as “pursuant to the drawing the applicant is claiming only the center hexagon pattern” and “the honeycomb pattern [on the goods depicted in the specimen] appears the same throughout and there is

nothing unique about the center area that shows what applicant is claiming as a mark” – is not well taken.

Although the drawing for Applicant’s proposed mark depicts several hexagons without dotted lines (and the others dotted), the application’s description of the proposed mark clearly describes the proposed mark as “consist[ing] of a three-dimensional configuration of a polishing disc that includes a repeating pattern of hexagonal (or honeycomb) shapes on a front surface of the disc.” Applicant’s drawing, in conjunction with the description of what Applicant seeks rights in, is a “substantially exact representation” of the proposed mark, as contemplated by TMEP Section 1202.19(a). Accordingly, we do not agree that mark fails to function based on the Examining Attorney’s reasoning.

Decision: We reverse the refusal to register Applicant’s proposed mark under Trademark Act Section 2(e)(5), on the ground that it is functional, and on the ground that Applicant’s mark fails to function as a trademark.

However, we affirm the alternative refusal to register the proposed mark on the Principal Register under Trademark Act Sections 1, 2 and 45, on the ground that it is not inherently distinctive and has not acquired distinctiveness under Trademark Act Section 2(f).