

This Opinion is Not a
Precedent of the TTAB

Mailed: February 27, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re JM4 Tactical, LLC
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Serial No. 90518181
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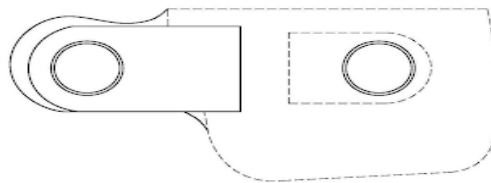
Brandon J. Leavitt of Leavitt Eldredge Law Firm for JM4 Tactical, LLC.

Karen K. Bush, Trademark Examining Attorney, Law Office 108,
Kathryn Coward, Managing Attorney.

—
Before Lynch, Acting Deputy Chief Administrative Trademark Judge, and Larkin
and Thurmon, Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

JM4 Tactical, LLC (“Applicant”) seeks registration on the Supplemental Register
of the proposed mark shown below for “Holsters” in International Class 13:



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¹ Application Serial No. 90518181 was filed on February 8, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claimed first use of the proposed mark and first use of the proposed mark in commerce at least as early as March 15, 2016.

Applicant describes its proposed mark as follows: “The mark consists of a product configuration of a holster, wherein the holster comprises a strap attached to a holster body, the strap having a securement device at an end of the strap, the body having a second securement device extending from the body, the dashed lines of the body represent positioning of the strap and securement devices and are not claimed as part of the mark.”

The Examining Attorney has refused registration of Applicant’s proposed mark on the Supplemental Register under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that the proposed mark, as a whole, is functional. Applicant appealed when the Examining Attorney made the refusal final, and the appeal is fully briefed.² We affirm the refusal to register.

I. Prosecution History and Record on Appeal³

We briefly summarize below the prosecution history of the involved application because it provides useful background to our analysis of the functionality refusal.

Applicant originally sought registration of its proposed mark on the Principal Register based on a multi-page specimen of use that we reproduce below:

² Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant’s appeal brief appears at 4 TTABVUE and its reply brief appears at 7 TTABVUE. The Examining Attorney’s brief appears at 6 TTABVUE.

³ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

MEDIUM 3 ORIGINAL MAGNETIC QUICK, CLICK, & CARRY HOLSTER
\$74.95 - \$89.95
***** (0 REVIEWS)
Color Choice *
Pick one...
Hand *
Pick one...
Accommodate Optic/RMR Sight (+\$5.00) Custom Order *
Pick one...
Please list Gun Model and Optic or RMR Model below.
I agree and understand that if I order without using the sizing recommendation of JMA Tactical I may be subject to an additional shipping charge in order to exchange - jm4tactical.com/sizing *
 I agree
Qty: 1
Share: f e t w p
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⁴ February 8, 2021 Application at TSDR 3.

⁵ *Id.* at TSDR 4.



After filing its application, Applicant attempted a pre-examination amendment to the drawing of its proposed mark.⁷

In the first Office Action, the Examining Attorney refused registration on two grounds: (1) Applicant's proposed mark was functional, and (2) Applicant's proposed mark was non-distinctive product design that was unregistrable on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). The Examining Attorney made of record U.S. Patent No. 11,000,113 captioned "Magnetic Firearm and Knife Holster,"⁸ and issued detailed information requests directed to the functionality refusal under Trademark Rule 2.61, 37 C.F.R. § 2.61, including whether the proposed mark was the subject of any utility or design patent or patent application.⁹ The Examining Attorney also

⁶ *Id.* at TSDR 5. This portion of Applicant's specimen is displayed horizontally in the application, but we have rotated it to appear in the vertical orientation in which the goods are used, as shown on the first page of Applicant's specimen.

⁷ May 17, 2021 Voluntary Amendment at TSDR 1-2.

⁸ September 13, 2021 Office Action at TSDR 2-6.


⁹ *Id.* at TSDR 1.

rejected Applicant's proposed amendment to its drawing because in her view the changes from the original drawing "would materially alter the mark in the drawing filed with the original application or as previously amended."¹⁰

In its response to the initial Office Action, Applicant disclosed U.S. Patent Nos. 9,784,530, D788,451, D811,731, D836,329, and D841,979,¹¹ and made of record copies of the patents.¹² Applicant also made of record what it described as "the signed statement of its principal, Chad Myer's [sic], wherein he references a plurality of advertising, promotional, and/or explanatory matter concerning the design and features of the [sic] embodied in the applied-for mark."¹³ Mr. Myers' one-paragraph statement is reproduced below:

When making a JM4 Tactical holster we went with this design because there is no one else that uses this design strap. It does cost more than the standard design because of the amount of leather and labor hours it take to make, but we wanted a unique look to our holsters. It has no functionality but the look is what we wanted. When people see the strap they automatically know that it is our holster. There are a lot of other ways to make holsters with belt clips and straps that belts feed through, but none like ours. Our holsters have had many articles written about them on Concealed carry.com, outdoor hub, recoil web, ammo land, Gunnerden.com, all outdoors.com, Usconcealedcarry.com, shooting illustrated.com, concealed nation.com, cheaper then dirt.com, guns.com. Everyone of these gun industry website love our unique design.

Signed James Chadwick Myers owner of JM4 Tactical.

X  Date: 03-14-2022

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¹⁰ *Id.* The Examining Attorney also stated that "[b]ased on the reinstatement of the original drawing, registration is also refused because this application and U.S. Application Serial No. 90520663 appear to be duplicate applications" and that "Applicant may respond to this refusal by abandoning one of them." *Id.*

¹¹ March 14, 2022 Response to Office Action at TSDR 112-13.

¹² *Id.* at TSDR 3-27.

¹³ *Id.* at TSDR 113.

¹⁴ *Id.* at TSDR 2.

Applicant also summarized and provided hyperlinks to 11 websites,¹⁵ and made of record numerous webpages regarding the design and functioning of various holsters, including Applicant's own.¹⁶ Applicant provided information regarding alternate designs of holsters, including what Applicant called "inside waste [sic] band" holsters,¹⁷ and stated that the holster design in its proposed mark costs more to produce than other standard holster designs.¹⁸

The Examining Attorney then issued a second non-final Office Action continuing the functionality and non-distinctive product design refusals, and rejecting as insufficient Applicant's evidence, including Mr. Myers' statement, regarding the claimed acquired distinctiveness of its proposed mark.¹⁹ The Examining Attorney required amendments to the drawing and description of the mark, invited Applicant to submit additional evidence of acquired distinctiveness or to consider amendment to the Supplemental Register, and made of record third-party websites that she claimed showed that the use of magnets on holsters serves a utilitarian advantage.²⁰

¹⁵ *Id.* at TSDR 113-14.

¹⁶ *Id.* at TSDR 28-111.

¹⁷ *Id.* at TSDR 115.

¹⁸ *Id.* at TSDR 116.

¹⁹ April 8, 2022 Office Action at TSDR 1.

²⁰ *Id.* at TSDR 3-6.

Applicant responded to this second non-final Office Action by amending its application to seek registration on the Supplemental Register,²¹ and arguing against the functionality refusal.²²

The Examining Attorney then issued an Office Action noting Applicant's amendment to seek registration on the Supplemental Register, and making final the functionality refusal, which the Examining Attorney stated precluded registration on the Supplemental Register.²³ The Examining Attorney made of record third-party webpages discussing the safety achieved by using a magnetic gun holster, including pages from Applicant's website discussing its holster.²⁴

II. Functionality Refusal

A. Background Regarding Concealed Carry Gun Holsters

Before we discuss the applicable law and the arguments and evidence bearing on the refusal, we briefly discuss the nature of the goods at issue to aid the reader in better understanding and following our functionality analysis. *See, e.g., McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559, at *17-36 (TTAB 2021) (discussing the nature of the gun barrels at issue on the opposer's functionality claim before addressing the merits of the claim).

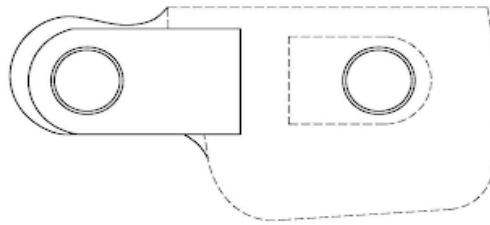
We reproduce again below the drawing of Applicant's proposed mark:

²¹ October 11, 2022 Response to Office Action at TSDR 2.

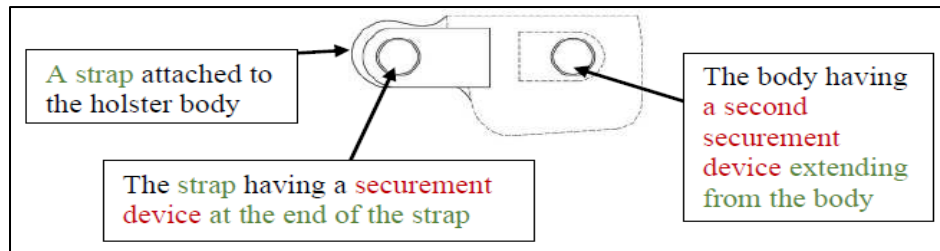
²² *Id.* at TSDR 2-4.

²³ November 7, 2022 Final Office Action at TSDR 1.

²⁴ *Id.* at TSDR 2-9.



As noted above, Applicant describes its proposed mark as “the product configuration of a holster, wherein the holster comprises a strap attached to a holster body, the strap having a securement device at an end of the strap, the body having a second securement device extending from the body, the dashed lines of the body represent positioning of the strap and securement devices and are not claimed as part of the mark.”²⁵ Applicant’s reply brief annotates its application drawing using the language of its description:



7 TTABVUE 4.²⁶

²⁵ The meaning of the legalese “securement device” in the mark description was clarified during prosecution. In response to an information request from the Examining Attorney regarding the nature of each “securement device” referenced in the description, Applicant “acknowledge[d] that the ‘securement device’ on the holster comprises 3 magnets integrated within the product’s strap assembly” and stated that “the use of magnets to secure the device is incidentally and internally embedded within the applied for mark” March 14, 2022 Response to Office Action at TSDR 117.

²⁶ Applicant’s use of the colors red and green in the annotation is discussed below.

Applicant's goods are broadly identified in the application as "holsters." The particular type of holster that contains Applicant's proposed mark is what Applicant describes on its website as a "concealed carry holster."²⁷ Such a holster is designed to allow a consumer to carry a firearm on the consumer's person without others noticing it.²⁸ Applicant describes these holsters as "IWB handgun holsters."²⁹ The first page of Applicant's specimen displayed above shows the body of Applicant's holster tucked inside the waistband of the user.³⁰

Applicant's website displays Applicant's "Original Magnetic Quick, Click & Carry Holster,"³¹ the goods identified in Applicant's specimen, as follows:



²⁷ November 7, 2022 Final Office Action at TSDR 9.

²⁸ Applicant states more colorfully on its website that it offers the consumer "a gun holster as reliable as the firearm you trust, that also helps your gun disappear in comfort when you conceal it from prying eyes." *Id.*

²⁹ *Id.* The initialism "IWB" stands for "inside waist band."

³⁰ February 8, 2021 Application at TSDR 3.

³¹ Applicant and third parties sometimes refer to this holster as the "QCC" holster.

³² November 7, 2022 Final Office Action at TSDR 9.

Applicant states on its website that its holster “is the first ever, and only, Magnetic retention concealed carry holster that provides you with a way to carry your firearm no matter what you wear from jeans and dress pants, to active wear like shorts and yoga pants,” and that the “Original Quick Click & Carry leather gun holster allow you to be armed without the hassle of belts or clips that can damage your clothing while maintaining a level of unprecedented comfort.”³³ A third-party review of Applicant’s holster provides a top-down view of the holster showing where the gun is inserted:



As shown in Applicant’s specimen of use and as described on Applicant’s website, the body of the holster containing the elements of Applicant’s proposed mark is worn inside the user’s waistband, and what Applicant describes in its application as “the strap having a securement device at the end of the strap” folds over the waistband and engages magnetically with what Applicant describes in its application as the “second securement device extending from the body” of the holster inside the waistband to keep the holster, and the gun within it, in place.

³³ *Id.*

³⁴ March 14, 2022 Response to Office Action at TSDR 31.

B. Applicable Law

“The Lanham Act does not exist to reward manufacturers for the innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.” *McGowen Precision Barrels*, 2021 USPQ2d 559, at *37 (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001)). “Nor does it protect trade dress in a functional design merely because a party has made an investment to encourage the public to associate a particular functional feature with a single manufacturer or seller.” *Id.* (quoting *TrafFix*, 58 USPQ2d at 1007). Section 2(e)(5) of the Trademark Act thus “prohibits registration of ‘a mark which . . . comprises any matter that, as a whole, is functional.’” *Id.* (quoting 15 U.S.C. § 1052(e)(5)). Because functional matter is barred from serving as a trademark, *id.*, it is ineligible for registration on either the Principal or Supplemental Register. *Id.*

“A product design or 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.’” *Id.* (quoting *TrafFix*, 58 USPQ2d at 1006) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 944, 214 USPQ 1, 4 n.10 (1982)). “In *TrafFix*, the Supreme Court confirmed the ‘*Inwood* formulation’ as the ‘traditional rule’ of functionality.” *Id.* (quoting *TrafFix*, 58 USPQ2d at 1006).

“In making our determination of functionality under the *Inwood* test, the Board may consider the categories of evidence set forth” in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982). *Id.*, at *38. *Morton-Norwich*

identifies the following inquiries or categories of evidence that may be 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.

Id. (citing *Morton-Norwich*, 213 USPQ at 15-16). These inquiries or categories of evidence “are not exclusive, however, for functionality ‘depends upon the totality of the evidence.’” *Id.* (quoting *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (internal quotation omitted)). “Therefore, in a given case, not all of the *Morton-Norwich* factors are necessarily relevant to a finding of functionality, nor do all four factors have to weigh in favor of functionality to support a finding of functionality.” *Id.* (citing *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017) and *Heatcon*, 116 USPQ2d at 1370). The Supreme Court has “made clear that if functionality is established under *Inwood*, further inquiry into facts that might be revealed by a full analysis of all types of *Morton-Norwich* evidence will not change the result—in particular, the availability of alternatives—and is unnecessary.” *Id.*, at *38-39 (citing *TrafFix*, 58 USPQ2d at 1006).

C. Summary of Arguments

Applicant's core argument is that the Examining Attorney “conflates the *de facto* functionality of a single feature within the Applicant's mark with the non-functional configuration of the design that incidentally comprises that feature—which

configuration is already protected by registered design patents, has never been advertised as functional, and is but one of several alternative, more cost-effective designs.” 4 TTABVUE 2-3. In its reply brief, Applicant argues that

the Examining Attorney devotes approximately 40% of her brief to showing the functionality of that same single feature without any substantive reference to the product configuration as a whole—or even arguing the standard *Inwood* formulation for imputing the functionality of a single feature against the whole. . . . In effect, the Examining Attorney has ignored the core substance of Applicant’s brief by failing to present any argument or evidence that would establish a *prima facie* case that the functionality of a single feature within the Applicant’s mark has rendered the entire mark functional pursuant to Section 2(e)(5) of the Trademark Act.

7 TTABVUE 2 (citations and quotations omitted).

Applicant and the Examining Attorney agree that the Board should consider the *Morton-Norwich* categories of evidence, 4 TTABVUE 3-4; 6 TTABVUE 3, and they both address each category. 4 TTABVUE 4-9; 6 TTABVUE 4-9; 7 TTABVUE 4-5. We will summarize their arguments together with respect to each category of evidence.

We begin with applicable patents, to which Applicant and the Examining Attorney devote substantial portions of their briefs. Applicant argues that “the record shows that the Applicant’s product incidentally comprises a magnetic retention functionality—with the *gravitas* of the Examining Attorney’s efforts apparently focused on conflating the *de facto* functionality of the Applicant’s product with a *de jure* functionality of the product configuration.” 4 TTABVUE 4. According to Applicant, “the Examining Attorney focuses entirely on defending the probative value of a cited utility patent disclosing the product functionality but entirely fails to

address the five cited design patents that protect the nonfunctional and ornamental configurations of the applied for mark.” *Id.* Applicant provides a table regarding its design patents for holster designs. *Id.* at 5.

Applicant further argues that

the USPTO in assessing functionality herein should not simply disregard: (1) that the cited utility patent discloses no utility as to the applied for strap assembly; (2) any overlap between the utility of this patent and the features of the applied-for mark is arbitrary or incidental only; or that (3) the applied-for mark has already been found nonfunctional in the five cited design patents.

Id. at 6. Applicant acknowledges that “its **product** incidentally comprises a magnetic retention functionality,” but argues that the **design and configuration of the product**, such as would define the location and quantity of magnets within the strap assembly, is already acknowledged as ornamental by a plurality of registered design patents that the Examining Attorney has chosen to ignore.” *Id.*³⁵

The Examining Attorney responds that Applicant’s proposed mark includes the positioning of magnets on the holster and that Applicant’s utility patent No. 9,784,530 “specifically identifies the magnets as part of the patent claim” and discloses the utilitarian purpose of the magnets. 6 TTABVUE 5. According to the Examining Attorney, the “claim and stated purpose of the utility patent clearly indicate the utilitarian advantages of the claimed magnets.” *Id.* The Examining Attorney rejects Applicant’s argument that what the Examining Attorney calls

³⁵ Unless otherwise indicated, all emphasis in bold in this opinion appeared in italics or underscoring in any quoted original text.

“magnetic retention functionality” is merely an incidental feature of the mark, *id.*, arguing as follows:

[A]pplicant submitted a drawing of the mark depicting the strap and the securement devices in solid lines, and describes the mark as “a product configuration of a holster, wherein the holster comprises a strap attached to a holster body, the strap having a securement device at an end of the strap, the body having a second securement device extending from the body, the dashed lines of the body represent positioning of the strap and securement devices and are not claimed as part of the mark.” In addition, the applicant “acknowledges that the ‘securement device’ on the holster comprises 3 magnets integrated within the products strap assembly’ . . . [B]y stating in the description that the mark consists of the strap having a securement device at an end of the strap and the body having a second securement device extending from the body, the applicant is claiming the magnetic securement devices as a feature of the mark. Because the drawing of the mark as well as the description of the mark references the magnet securement devices as being a specific and claimed feature of the goods, the magnets must be considered regarding the question of utilitarian advantage

Id. at 6 (record citation omitted).

With respect to Applicant’s design patents, the Examining Attorney argues that the “fact the applicant has design patents regarding the ornamental design of a gun holster has no bearing on whether the applied-for mark is functional. Because a design patent by its nature is limited to ornamentation, design patents ‘cannot include claims to the structural or functional aspects of the article.’” *Id.* at 7 (quotation omitted).

In its reply brief, Applicant argues that each of its design patents is virtually identical to its proposed mark, and that the existence of the design patents “**presumptively** . . . indicates that the design is not *de jure* functional.” 7 TTABVue

5 (all emphasis supplied by Applicant) (quoting *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012)).

Turning next to advertising, Applicant argues that “both Applicant and the Examining Attorney have placed into the record a plurality of advertising samples wherein the magnetic functionality of a holster is advertised **independently** from the applied for configuration comprising the locations and/or number of such magnets.” 4 TTABVUE 6. Applicant “acknowledges the existence of literature showing its **product** incidentally comprises a magnetic retention functionality,” but argues that “no such literature exists that touts the functionality of the applied for **design and configuration of the product.**” *Id.* at 7.

The Examining Attorney responds that “[t]he functionality of magnets is specifically touted in advertising materials regarding applicant’s holsters.” 6 TTABVUE 7. The Examining Attorney cites Applicant’s website at jm4tactical.com, third-party reviews of Applicant’s holsters, and competitors’ advertising and promotional materials touting the use of magnets on holsters. *Id.* at 7-8.

With respect to the third and fourth *Morton-Norwich* categories of evidence, Applicant states that it and “the Examining Attorney have collectively placed into the record the following alternative magnetic retention IWB holster designs that do not comprise or require the applied for configuration and are more efficient or cost effective to manufacture.” 4 TTABVUE 7. Applicant argues that “these alternative designs also evidence that the applied for product configuration is nonfunctional.” *Id.*

at 8. Applicant also notes that Mr. Myers stated that the holster design shown in the application costs more than standard designs to produce. *Id.*

The Examining Attorney responds that the availability of alternative holster designs and the fact that Applicant's holster design may be more expensive to produce are irrelevant because the patent and advertising evidence establish that Applicant's proposed mark is functional. 6 TTABVUE 9.

Applicant concludes its argument against functionality as follows:

the Examining Attorney conflates the *de facto* functionality of a single feature within the Applicant's mark with the non-functional configuration of the design that incidentally comprises that feature—which design is already protected by registered design patents, has never been advertised as functional, and is but one of several alternative, more cost-effective configurations. Accordingly, considering the Morton-Norwich factors, the Examining Attorney has not met its *prima facie* burden of functionality and the refusal under Section 2(e)(5) should be reversed.

4 TTABVUE 9.

The Examining Attorney concludes her argument for functionality as follows:

The configuration of the holster design depicts the magnetic securements as a feature of the product configuration, the applicant stated for the record that the securement devices consist of three magnets integrated within the products strap assembly, and the evidence clearly establishes a prima facie case that the magnetic securements are functional. The record shows the utilitarian advantages of the magnets used in holsters is twofold: first, they secure the holster to one's clothing, and second, the magnets also retain the gun in the holster. These functional features far outweigh any non-functional aspects of the holster configuration. The evidence establishes a prima facie case that the applied-for product configuration mark, which includes the magnets as a claimed feature of the mark, is functional. Because a determination that an applied-for configuration mark is

functional is an absolute bar to registration on the Principal or Supplemental Registers, the examining attorney respectfully requests the refusal be affirmed.

6 TTABVUE 9-10.

D. Defining the Proposed Mark

We begin our analysis by defining Applicant's proposed mark. *See In re Post Foods, LLC*, 2024 USPQ2d 25, at *2-3 (TTAB 2024). “[W]e consider ‘all elements, including those described in the application as well as those shown in the drawing page but we are not bound by what Applicant describes its mark to be in its application or in its brief.’” *Id.*, at *3 (quoting *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1487 (TTAB 2017) (internal quotation and quotation marks omitted)).

In its application, Applicant stated that its mark

consists of a product configuration of a holster, wherein the holster comprises a strap attached to a holster body, the strap having a securement device at an end of the strap, the body having a second securement device extending from the body, the dashed lines of the body represent positioning of the strap and securement devices and are not claimed as part of the mark.

The Examining Attorney argues that Applicant “submitted a drawing of the mark depicting the strap and the securement devices in solid lines, and describes the mark” in the manner set forth immediately above, and “acknowledges that the ‘securement device’ on the holster comprises 3 magnets integrated within the products [sic] strap assembly.” 6 TTABVUE 6.³⁶ The Examining Attorney further argues that

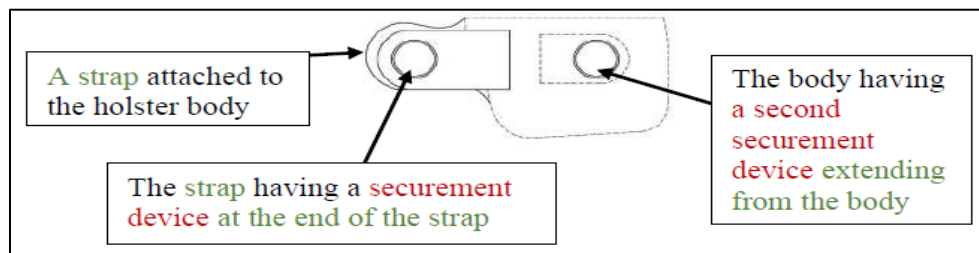
If applicant did not wish to claim the magnets as part of the mark, then the drawing should have depicted the

³⁶ March 14, 2022 Response to Office Action at TSDR 117.

circular securement portions in dotted lines, along with the other dotted line portions of the body portion of the design. Furthermore, applicant should then have clarified the description of the mark to delete reference to “the strap having a securement device at an end of the strap, the body having a second securement device extending from the body”. But by depicting the securement devices, which applicant confirms are magnets, in solid lines on the drawing, the applicant is thereby claiming them as a feature of the mark. Furthermore, by stating in the description that the mark consists of the strap having a securement device at an end of the strap and the body having a second securement device extending from the body, the applicant is claiming the magnetic securement devices as a feature of the mark. Because the drawing of the mark as well as the description of the mark references the magnet securement devices as being a specific and claimed feature of the goods, the magnets must be considered regarding the question of utilitarian advantage.

Id.

As discussed and shown above, Applicant’s reply brief annotates its drawing as follows:



7 TTABVUE 4. Applicant states that it “highlights in red the design feature established by the Examining Attorney to have a functional purpose whereas the green highlights feature design elements entirely free from allegations of functionality.” *Id.* (all emphasis supplied by Applicant). Applicant states that “[i]n effect, this figure shows a design comprising the locations of a strap and two

securement devices with respect to each other and the body of a gun holster ***independently*** from the imputed functionality of a single element of the overall design.” *Id.* at 4-5 (all emphasis supplied by Applicant).

We conclude that Applicant’s proposed mark consists of the shape, length, and positioning of the strap attached to the holster body, and the presence and positioning of the magnetic “securement devices” attached to the strap and to the holster body.

E. Relevant *Morton-Norwich* Categories of Evidence

We turn now to analysis of the record evidence regarding the relevant *Morton-Norwich* categories of evidence.

1. Patents

a. Utility Patents

Applicant owns U.S. Patent No. 9,784,530 (the “530 Patent”) captioned “Gun Holster System and Method of Use.”³⁷ “A prior [utility] patent . . . has vital significance in resolving the trade dress claim’ and ‘is strong evidence that the features claimed therein are functional.” *McGowen Precision Barrels*, 2021 USPQ2d 559, at *39 (quoting *TrafFix*, 58 USPQ2d at 1005). “Where a patent claims the feature in question, ‘one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.” *Id.* (quoting *TrafFix*, 58 USPQ2d at 1005). “[W]e are not limited to the claims in a patent in

³⁷ March 14, 2022 Response to Office Action at TSDR 3. Mr. Myers is the listed inventor.

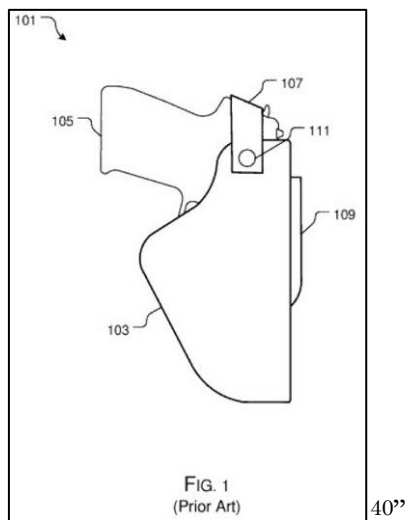
determining functionality; we may also consider the disclosures in the entire patent.”

Id., at *40 (citing *Becton, Dickinson*, 102 USPQ2d at 1377).

The Abstract of the '530 Patent states as follows:

A gun holster system includes a body having a front side and a back side forming an upper opening disposed therebetween and forming a lower opening at a lower surface of the body; a strap assembly integrally secured to the body; a first magnet disposed within a thickness of the fastener protrusion; and a second magnet disposed within a thickness of the housing. **The strap assembly includes an elongated strap extending from the body; a fastener protrusion extending from a surface of the elongated strap; and a faster [sic] housing extending from an outer surface of the back side of the body.**³⁸

The Background section of the '530 Patent explains that “[g]un holsters are well known in the art and are effective means to carry a firearm,”³⁹ and that in a conventional holster, such as the one shown in Figure 1 reproduced below:



³⁸ *Id.* at TSDR 3 (emphasis added).

³⁹ *Id.* at TSDR 8.

⁴⁰ *Id.* at TSDR 4.

“[o]ne of the common problems associated with holster **101** is the limited use and weight.”⁴¹ The Background states that “[f]or example, the bulkiness of holster **101** restricts the user’s ability to effectively conceal the firearm and the weight deters some parties from carrying the firearm.”⁴²

Figure 2 in the ’530 Patent, described as “a front oblique view of a gun holster system in accordance with a preferred embodiment of the present invention,”⁴³ shows the front of Applicant’s holster:

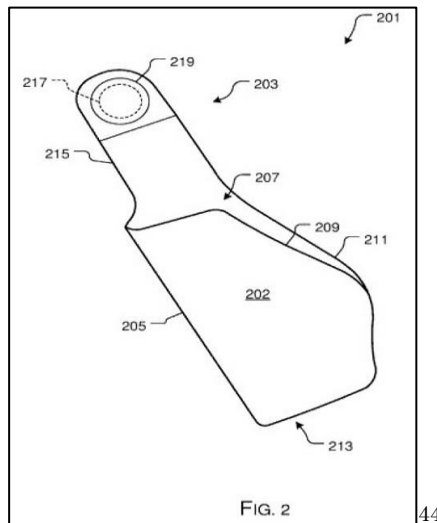


Figure 3 in the ’530 Patent, described as “a back oblique view of the gun holster of FIG. 2,”⁴⁵ shows the back of Applicant’s holster:

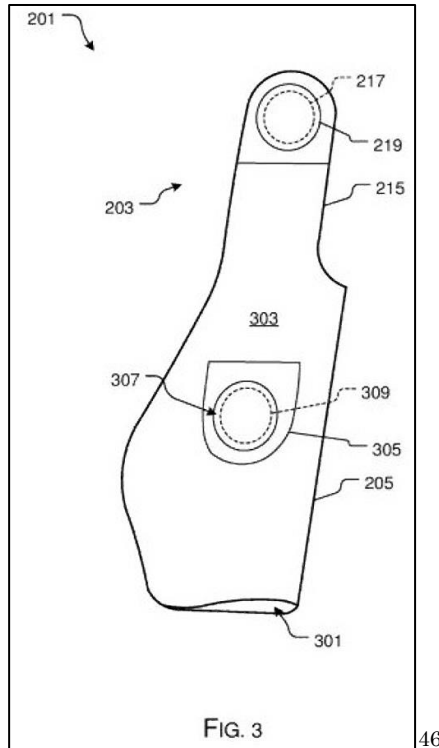
⁴¹ *Id.* at TSDR 8 (emphasis in bold in original).

⁴² *Id.* (emphasis in bold in original).

⁴³ *Id.*

⁴⁴ *Id.* at TSDR 5.

⁴⁵ *Id.*



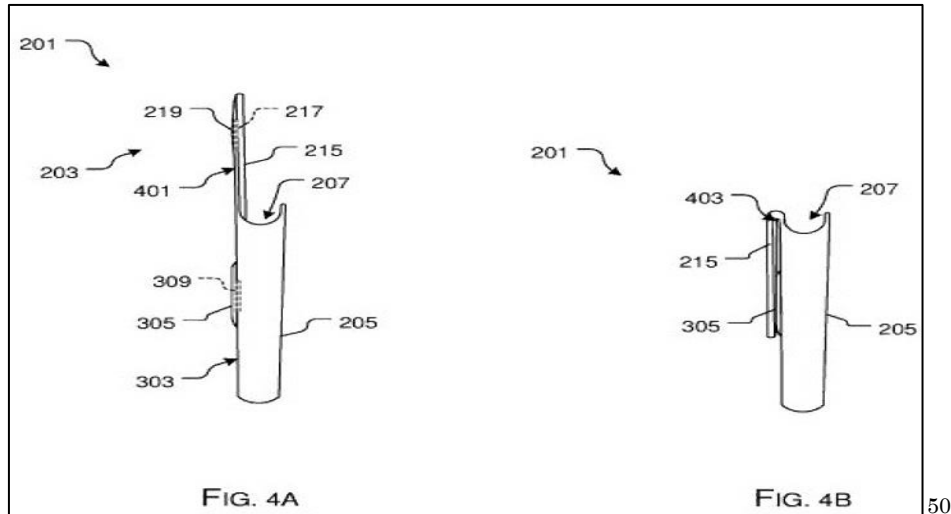
The '530 Patent's Detailed Description of the Preferred Embodiment ("Detailed Description") explains that "the gun holster system **201** overcomes one of [sic] more of the above-listed problems commonly associated with the conventional gun holsters."⁴⁷ The Detailed Description further explains that "[t]he system **201** is further provided with **2** magnets **217** disposed within the thickness of housing **305**. The two magnets provide additional means to secure the strap **215** to the body **205**. The magnet in **217** and **307** when connected cause retention on the gun so the gun will not fall out."⁴⁸

⁴⁶ *Id.* at TSDR 6.

⁴⁷ *Id.* at TSDR 8 (emphasis in bold in original).

⁴⁸ *Id.* (emphasis in bold in original).

The Detailed Description goes on to state that “[a]s shown in FIGS. 4A and 4B, the strap **215** is configured to fold about a joint **403** that enables connection between protrusion **219** and housing **305**.”⁴⁹ We reproduce Figures 4A and 4B below:



Independent Claim 1 of the '530 Patent is a “gun holster system for carrying a gun, comprising” the following:

- “a body having a front side and a back side forming an upper opening disposed therebetween and forming a lower opening at a lower surface of the body;”
- **“a strap assembly integrally secured to the back side of the body, the strap assembly having: a fastener protrusion extending from a back surface of the elongated strap; and a fastener housing extending from an outer surface of the back side of the body, the fastener housing being configured to engage with the fastener protrusion; wherein the elongated strap folds backwards and away from the upper opening to cause the fastener protrusion and the fastener housing to engage;”** and
- **“two magnets disposed within a thickness of the fastener protrusion, and a third magnet disposed within a thickness of the housing; wherein the two magnets are configured to engage with**

⁴⁹ *Id.* (emphasis in bold in original).

⁵⁰ *Id.*

the third magnet; wherein engaging the two magnets with the third magnet does not obstruct the upper opening and does not obstruct or hinder entire removal of the gun from the body; and wherein a combined magnetic retention strength generated by the two magnets is strong enough to retain the gun within the body.”⁵¹

Claim 1 of the '530 Patent refers to and describes the elements of Applicant's proposed mark consisting of the shape, length, and positioning of strap attached to the holster body and the presence and positioning of the magnetic "securement devices" attached to the strap and to the holster body. The '530 Patent as a whole makes clear that the strap attached to the holster body is configured as it is shown in Applicant's proposed mark to enable the user of the holster to conceal the gun held within the body of the holster inside the user's waistband without undue bulk or weight, and that the magnetic "securement devices" referenced in the description of the proposed mark are positioned where they appear in the proposed mark to secure the holster within the waistband and the gun within the holster. As the '530 Patent explains, the shape and positioning of the elements of the proposed mark "overcome[] one [or more] of the . . . problems commonly associated with the conventional gun holsters,"⁵² by enabling the user to secure the holster within the waistband, and the gun within the holster, with minimal bulkiness and weight and with maximum comfort.⁵³ To achieve these benefits, the strap attached to the holster body is positioned where it is at the top of the holster, has a magnetic securement device at

⁵¹ *Id.* at TSDR 9 (emphasis added).

⁵² *Id.* at TSDR 8.

⁵³ As discussed below, Applicant touts these benefits on its website, and third-party reviews in the record indicate that consumers recognize these benefits.

its end, and is of the length shown in the drawing of Applicant's proposed mark to enable the strap to engage with the second magnetic securement device positioned on the body of the holster.⁵⁴ The '530 Patent is strong evidence that Applicant's proposed mark "is in its particular [configuration] because it works better in that [configuration]," *Kohler*, 125 USPQ2d at 1493 (quoting *Becton, Dickinson*, 102 USPQ2d at 1376), by facilitating the engagement of the magnetic securement devices to achieve the two functional benefits discussed above.

"A third-party utility patent may be relevant evidence of functionality when it discloses the utilitarian advantages of the applied-for product configuration sought to be registered." *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1834-35 (TTAB 2013) (citing *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1921 n.7 (TTAB 2011); *In re Dietrich*, 91 USPQ2d 1622, 1627 (TTAB 2009)). The "Summary of Invention" in United States Patent No. 11,000,113 (the "113 Patent"), captioned "Magnetic Firearm and Knife Holster,"⁵⁵ discusses at least one additional possible utilitarian benefit of using magnetic securement devices in a holster, namely, to "attract the leading edge of a firearm or knife when the user brings either device in close proximity to the holster when re-holstering or re-sheathing the

⁵⁴ Claim 1 of the '530 Patent specifies that the two magnetic securement devices shown in the proposed mark "are configured to engage with the third magnet" that is "disposed within a thickness of the housing" (i.e., inside the holster body). The referenced "third magnet" is not shown in the proposed mark, but Claim 1 states that a "**combined magnetic retention strength generated by the two magnets** is strong enough to retain the gun within the body" (emphasis added), making it clear that the positioning of the magnet on the holster body in the proposed mark is essential to the product's second purpose of securing the gun within the holster.

⁵⁵ September 13, 2021 Office Action at TSDR 2-6.

respective weapon.”⁵⁶ The Detailed Description of the Invention in the ’113 Patent explains as follows:

The invention also lends itself to an improved method of securing a firearm, knife or other sheathed or holstered weapon. After drawing a firearm or knife from its holster or sheath in the conventional fashion, the weapon can be reinserted into its carrying device without bringing the eyes of the user toward the holster or sheath device. . . . Once the firearm or knife is in the immediate vicinity of [the magnets], the user will feel the attraction and contact of firearm or knife with the magnet located in the threshold area of a holster or sheath. The advantage of this method of securing a weapon into its carrying device is that the user need not look at the holster or sheath to find the entry point of the carrying device. Rather, the user’s eyes can remain elsewhere as the magnet will capture the weapon as it travels to the vicinity of the holster or sheath by the action of the user, soon to be captured by the pull of the magnet and leading the weapon to the point on the holster or sheath which allows the weapon to be slid further and seated into the carrying device without the user needing to be distracted by the user focusing on the proper entry of the weapon.⁵⁷

b. Design Patents

As discussed above, Applicant relies heavily on its ownership of various design patents for the ornamental designs of holsters. “[W]hile evidence of a design patent may be some evidence of non-functionality under *Morton-Norwich*, ‘the fact that a device is or was the subject of a design patent does not, without more, bestow on said device the aura of distinctiveness or recognition as a trademark.’” *Kohler*, 125

⁵⁶ *Id.* at TSDR 4.


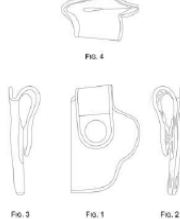
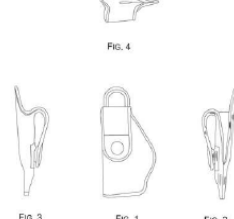

⁵⁷ *Id.* at TSDR 6.

USPQ2d at 1501 (quoting *Becton, Dickinson*, 102 USPQ2d at 1377 (quoting *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984)).

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. Absent identity between the design patent and proposed mark, the presumption loses force, and the “similar” design patents lack sufficient evidentiary value to overcome the strong conclusion in this case that [applicant’s] utility patent[] underscore[s] the functionality of significant elements of the proposed mark.

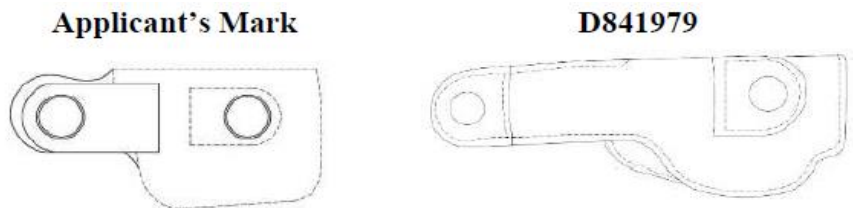
Id. (quoting *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1432 (TTAB 2016) (quoting *Becton, Dickinson*, 102 USPQ2d at 1377 (internal quotation omitted)). Even the presumptive non-functionality of a proposed mark arising from “identity between the design patent and proposed mark,” *id.*, may be overcome by other evidence of functionality. *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *10 (TTAB 2019).

As noted above, Applicant made its design patents of record and displayed figures from them in a table in Applicant’s appeal brief, which we reproduce below for ease of reference in following our discussion:

<p>D788,451 The ornamental design of a gun holster as shown and described.</p>	
<p>D811,731 The ornamental design of a gun holster as shown and described.</p>	
<p>D836,329 The ornamental design of a gun holster as shown and described.</p>	
<p>D841,979 The ornamental design of a gun holster as shown and described.</p>	

4 TTABVUE 5.⁵⁸

Applicant focuses in its reply brief on Patent No. D841979 (the “979 Patent”) in arguing that “the applied for mark is virtually identical to each design patent on record as represented by USPTO No. D841979.” 7 TTABVUE 5. Applicant displays the claimed “virtual identity” in Applicant’s reply brief as follows:

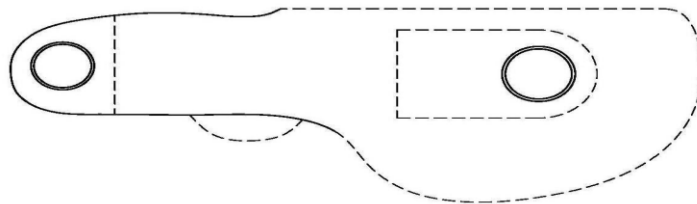


⁵⁸ Mr. Myers is the listed inventor on each patent. Applicant’s table does not include all of the figures in Patent No. D788,451. March 14, 2022 Response to Office Action at TSDR 10-20.

Id. Applicant argues that its “mark primarily differs from D841979 in that the [mark] has a strap secured to the gun holster body and the [patent] has a strap integral to the gun holster body,” which Applicant claims “is immaterial to the analysis before the Board.” *Id.* at 6. Applicant concludes in its reply brief that “D841979 and its sister patents presumptively indicate that the Applicant’s mark is nonfunctional.” *Id.*

We disagree. As shown above, Applicant’s design patents, including the ’979 Patent, all contain multiple additional holster features not found in the drawing of the proposed mark in the application. “Given the presence of many other elements in the design patent[s], [they are] not persuasive evidence of non-functionality.” *Kohler*, 125 USPQ2d at 1502 (discounting the probative value of the applicant’s expired design patent, which covered “multiple features of the three-dimensional GX Engine that not appear in the drawing of the applied-for mark.”).

None of the individual figures in Applicant’s design patents is identical to the proposed mark. As discussed above, Applicant attempted a pre-examination amendment to its drawing to substitute for its original drawing the proposed amended drawing shown below:



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⁵⁹ May 17, 2021 Preliminary Amendment at TSDR 2.

The proposed amended trademark drawing closely resembles Fig. 5 in the '979 Patent, but the Examining Attorney rejected that amendment because the “original drawing shows the mark as a product configuration of a holster wherein the holster comprises a strap attached to a holster body consisting of a particular length and design,” while the “proposed amended drawing shows the mark as a product configuration of a holster wherein the holster comprises a strap attached to a holster body with a **different** length and design.”⁶⁰ Applicant did not dispute the claimed differences between the drawings,⁶¹ or otherwise challenge the rejection of its proposed amended drawing.

To the extent that Applicant’s design patents show designs that are similar to Applicant’s proposed mark, they “lack sufficient evidentiary value to overcome the strong conclusion in this case that [Applicant’s] utility patent[] underscore[s] the functionality of significant elements of the proposed mark.” *Kohler*, 125 USPQ2d at 1501 (internal quotation omitted). We find that the first *Morton-Norwich* category of evidence supports a finding that Applicant’s mark, as a whole, is functional because it is essential to the use or purpose of Applicant’s holster for at least the two reasons discussed above (retention of the holster within the waistband and retention of the gun within the holster), either of which alone would suffice to show that the proposed mark as a whole is functional.

⁶⁰ September 13, 2021 Office Action at TSDR 1.

⁶¹ March 14, 2022 Response to Office Action at TSDR 112-19.

2. Advertising and Related Materials

“If a seller advertises the utilitarian advantages of a particular feature of its product, this constitutes strong evidence of functionality.” *Kohler*, 125 USPQ2d at 1502 (quoting *Kistner Concrete Prods.*, 97 USPQ2d at 1924). Although Applicant claimed during prosecution that it had made of record “a plurality of advertising, promotional, and/or explanatory materials concerning the design and features of the embodied [sic] in the applied-for mark,”⁶² the record does not contain any traditional print advertisements of the sort discussed and shown in *Kohler*. *Kohler*, 125 USPQ2d at 1522-24. It does contain Applicant’s website and pages from another website that are tantamount to advertising for Applicant’s holster, as well as multiple third-party webpages that discuss and review Applicant’s holster.

As shown and discussed above, Applicant’s website describes the holster design that includes the proposed mark as the “Original Magnetic Quick, Click & Carry Holster,” and as a “Magnetic Retention concealed carry holster” that “provides you with a way to carry your firearm no matter what you wear from jeans to dress pants, to active wear like shorts and yoga pants,” and that “allows you to be armed without the hassle of belts or clips that can damage your clothing while maintaining a level of unprecedented comfort.”⁶³ According to Applicant, the holster benefits both men and women “who wish to arm themselves in comfort, convenience, and the deep concealment that can only be found with this magnetic holster.”⁶⁴

⁶² *Id.* at TSDR 113.

⁶³ November 17, 2022 Final Office Action at TSDR 9.

⁶⁴ *Id.*

Applicant's website describes two "functions" of its magnetic retention concealed carry holster as follows:

Instead of clips, these IWB handgun holsters use strong, rare earth magnets that are strategically attached to serve two functions: 1. The first function of these magnets is to click into place on your waistband. This allows these concealed carry holsters to stay right where you put them, anywhere on your waist. 2. The second function, is that of magnetic gun holster retention. What this means is that once your gun is in this leather gun holster, it won't come out unless you want it to.⁶⁵

Applicant's website does not speak in the formalistic language of the '530 Patent or Applicant's description of its proposed mark, but the website touts at least two functional benefits of the shape, length, and positioning of the holster strap, and the presence and positioning of the "securement devices" attached to the strap and to the holster body: (1) the ability of the strap to replace a belt or clip in comfortably securing the holster inside the user's waistband by "clicking" into place over the user's waistband through contact between the magnetic securement device in the strap and the magnetic securement device in the body of the holster, and (2) securing the gun within the holster through the positioning of the magnetic securement device that Applicant states is "strategically attached" where it appears on the body of the holster.

⁶⁵ *Id.* (emphasis added).

A section of the website at concealedcarry.com, captioned “JM4 Original Magnetic Quick Click Carry Holster,”⁶⁶ discusses Applicant’s holster at length.⁶⁷ In answering the question “What Makes The JM4 Tactical Magnetic Holster Different?,” the website states that the holster “uses an amazingly effective set of dual-purpose rare earth magnets [that] click and clip onto any waistband so you can use it with shorts, sweats, activewear, yoga pants, or anything at all. Assuming the weight of the gun doesn’t pull the pants down, the holster will securely connect itself to your pants via the magnet.”⁶⁸ The website shows Applicant’s holster in use by consumers:



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⁶⁶ March 14, 2022 Response to Office Action at TSDR 48. These webpages and a number of other submissions by Applicant are difficult to read even when enlarged, and one cannot be read at all. *Id.* at TSDR 96-100. The party submitting evidence, including Internet materials, “must insure that the evidence is legible.” *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at *9 (TTAB 2022) (citations omitted). “Illegible materials are of no help to the Board or anyone else in deciding registrability questions before the Board” because “[w]e can consider the evidence, or a portion of the evidence, only if it is clear and legible.” *Id.*

⁶⁷ March 14, 2022 Response to Office Action at TSDR 47-51. Applicant characterizes this evidence as “Advertising/Promotional/Explanatory Material,” *id.* at TSDR 119, and it is in the nature of an advertisement for Applicant’s holster.

⁶⁸ *Id.* at TSDR 48.

⁶⁹ *Id.* at TSDR 49.



The website goes on to state that Applicant's holster "doesn't take up space with a backer for clips or extra material for any purpose," is "[j]ust exactly what you need to comfortably carry concealed IWB with or without a belt,"⁷¹ "will quickly slide onto your pants and is ready to go," and "increase[s] the odds of you having a firearm as part of an EVERY DAY CARRY system."⁷² The website discusses the magnetic securement devices in Applicant's holster as follows:

The Magnet in the Magnetic Holder Has a Second Purpose – Retention: In addition to securing the holster to your pants, the magnets also retain the gun in the holster. Like safety features, good retention is a sign of a good holster: **They choose [sic] magnets and designed the construction of the holster to place those magnets in the ideal place to create just the right amount of passive retention.**⁷³

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *Id.* This review reflects the statements in Claim 1 of the '530 Patent that the magnetic securement device shown in the drawing of the proposed mark is placed where it is shown in the proposed mark in order to attract the third magnet inside the waistband to create, in the words of the review, "just the right amount of passive retention" of the gun within the holster.

⁷³ *Id.* (first emphasis in original text; second emphasis added).

The website also displays the ability of the magnetic securement device in the body of the holster to retain a gun in the holster even against the force of gravity:



In addition to these materials, third-party reviews of Applicant’s holster design discuss similar utilitarian benefits of the shape, length, and positioning of the strap attached to the holster body,⁷⁵ and the presence and positioning of the magnetic securement devices attached to the strap and to the holster body.

A review of Applicant’s holster design on the website at concealednation.org states that Applicant’s holster

uses some very strong magnets to keep your defensive tool of choice in place right where you want it. One magnet is attached to the main body of the holster, while another is attached to a flap that goes over your belt line. When you want to carry, simply insert the holster inside your waistline and flip! the two magnets pull together and keep your stuff where it belongs.⁷⁶

⁷⁴ *Id.*

⁷⁵ Consumers are obviously unaware of the language used by Applicant to describe the elements of its proposed mark in its application and, as discussed below, some consumers use the word “flap” to refer to the part of the proposed mark that Applicant describes as the “strap.”

⁷⁶ March 14, 2022 Response to Office Action at TSDR 29.

The review goes on to explain that “that’s not all those magnets do. The location of the magnets ensures that your firearm is not leaving the holster unless you want it to. Seriously, I have hung the thing upside down and shook it. Didn’t budge.”⁷⁷

A review of Applicant’s holster on the website at usconcealedcarry.com states that Applicant “employs a pair of strong magnets in a holster system to securely carry a gun concealed. . . . Using the holster with the Ruger LC9s you see [in a picture in the review] is merely a matter of insert-gun-in-holster-and-insert-holster-inside-waistband.”⁷⁸ The review attributes to Mr. Myers the explanation that he chose magnets as securement devices because he and his wife are very active people and “[t]hey found that constantly rigging and unrigging a standard concealed carry holster was too much of a hassle for them, and they wanted something different.”⁷⁹

A review of Applicant’s holster on the website at guns.com states that “[w]hat’s new here is the way this holster secures to pants—and other objects. Who’d have thought that magnets could take the place of a clip or other belt attachment? They do on the QCC, making this one of the easiest holsters to don and to manage throughout the day.”⁸⁰ The review goes on to explain that “[o]ne magnet, one inch in diameter, is sewn into the holster about where the trigger guard is, and is next to clothing when the gun is tucked inside a waistband (IWB).”⁸¹ A “flap of double-ply leather extends

⁷⁷ *Id.*

⁷⁸ *Id.* at TSDR 35.

⁷⁹ *Id.* at TSDR 30.

⁸⁰ *Id.* at TSDR 39.

⁸¹ *Id.*

from the rear of the holster” and “[n]ear the end of this flap is another one-inch magnet. Both magnets are encased in leather so they can’t snag or catch.”⁸² The “flap sticks to the holster as the two magnets are attracted to one another, no matter that a heavy layer of pants material is between them.”⁸³ This reviewer gives Applicant’s holster a somewhat mixed overall review, but comments favorably about the holster’s “[q]uick and no-fuss installation on clothes,” the “[g]ood retention without any noisy or interfering straps,” the fact that the holster was “[m]ostly comfortable to wear, with a high-enough waistband,” and the “[d]iscreet concealment with minimal effect on physical profile.”⁸⁴

A review on the website at gunnersden.com describes and displays Applicant’s holster as follows:

⁸² *Id.* at TSDR 39-40.


⁸³ *Id.* at TSDR 40.

⁸⁴ *Id.* at TSDR 41.

It is essentially a leather concealed carry holster that utilizes magnets for the retention of the firearm and to attach to the clothing you're wearing.

What's great about it is that you can use any type of pants to include those that utilize a belt, sweatpants, yoga pants, etc.

The magnets are so strong that you can actually walk in your house, turn around, and stick it on your steel door, like I did below:



I can walk in my front door, and literally stick my gun upside down (or right side up) on my steel door. It stays put.

Yes, that's a full size Springfield Armory XD9 with a full magazine hanging upside down on my door.

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The review states that this “dual-purpose holster” uses magnets “placed in a manner so that they’re attracted to each other, and that’s what keeps your holster in place” and that “[o]ne magnet placed on each side of your clothing keeps the gun in place so it doesn’t move.”⁸⁶ The review goes on to discuss the “Ease of Use” and “Comfort”

⁸⁵ *Id.* at TSDR 58.

⁸⁶ *Id.* at TSDR 59-60.

provided by the holster design,⁸⁷ and shows the holster in use in “Concealed Carry in the 1 o’clock position”:



Concealed Carry in the 1 o'clock position

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The reviewer opines that Applicant’s holster “is the best concealed carry holster of this type, and one of the best concealed carry holsters available on the market right now.”⁸⁹

⁸⁷ *Id.* at TSDR 66-67. During prosecution, Applicant quoted this reviewer as stating that “I first got my hands on the JM4 Tactical leather holster a few years ago because I saw the design and liked what I saw.” *Id.* at TSDR 114. The reviewer indeed makes that statement, *id.* at TSDR 59, but we do not interpret it as referring to the source-identifying attractiveness of the design but rather to the functional benefits of the design that the reviewer discusses in detail.

⁸⁸ *Id.* at TSDR 67. This display of the holster in use makes clear that the strap feature of the proposed mark has the length shown in the application drawing to avoid interference of a belt or other form of waistband with the magnetic attraction of the securement device on the strap to the securement device on the portion of the holster inside the waistband.

⁸⁹ *Id.* The reviewer raises “[t]he one issue” with Applicant’s holster, having to do with re-holstering after use of the gun, which the reviewer states requires removal of the holster from the user’s body because it “collapses under the weight of your pants.” *Id.* This seems to have been a completely isolated complaint. Indeed, another reviewer states that “[a]nother advantage of the Quick Click & Carry holster is the ability to re-holster the gun without removing the holster from the carry position” because the “holster retains its open position when the gun is removed.” *Id.* at TSDR 84 (outdoorhub.com).

A review on the website at outdoorhub.com states that while Applicant's holster is "not the only holster that uses magnets to keep the holster on, what makes this one different is its patented magnetic retention of the gun itself."⁹⁰ The reviewer explains that "[o]ne magnet both retains the gun and provides attraction to a flap that's also magnetized and goes over the waistband to secure the holster in place."⁹¹

A review in the official journal of the National Rifle Association states that through the use of Applicant's holster, the "carry gun is retained through a snug wraparound fit inside the leather pocket and a magnetic clip that encourages retention inside the holster," that the "magnet also allows the users to place the holster at any point inside the waistband without the use of hooks or clips" by "tuck[ing] the holster inside the pants and snap[ping] the magnetic retention strap over the top of the waistband," and that the "magnetic retention will keep the holster in place."⁹²

A review on the website at alloutdoor.com states that a "seriously strong magnetic flap system is key to this unique holster and provides both retention and quick access in my favored location of concealed carry, the appendix."⁹³

These reviews reflect the utilitarian benefits of the shape, length, and positioning of the strap attached to the holster body, and the presence and positioning of the magnetic securement devices attached to the strap and to the holster body, that are

⁹⁰ *Id.* at TSDR 81.

⁹¹ *Id.*

⁹² *Id.* at TSDR 86.

⁹³ *Id.* at TSDR 103.

touted on Applicant’s website. We find that the second *Morton-Norwich* category of evidence supports a finding that Applicant’s proposed mark, as a whole, is functional because it is essential to the use or purpose of Applicant’s holster.

3. Availability of Alternative Designs

The record, including the ’113 Patent, shows that there are other gun holsters that employ securement devices consisting of magnets,⁹⁴ but “[t]he Supreme Court has held that where, as here, a ‘design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive need for the feature,’” *OEP Enters.*, 2019 USPQ2d 309323, at *12 (quoting *TrafFix*, 58 USPQ2d at 1006), or to “consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are other designs available.” *Id.* (quoting *Becton, Dickinson*, 102 USPQ2d at 1378 (internal quotation omitted)). Because the evidence relevant to the first two *Morton-Norwich* categories establish functionality, we need not consider the third *Morton-Norwich* category of evidence.

4. Whether the Proposed Mark Results in a Comparatively Simple or Cheap Method of Manufacture

As noted above, during prosecution Applicant offered the unsworn statement of Mr. Myers that Applicant’s holster “does cost more than the standard design because of the amount of leather and labor hours it take [sic] to make”⁹⁵ Even if this is

⁹⁴ *Id.* at TSDR 91-94 (Urban Carry LockLeather OWB holster).

⁹⁵ *Id.* at TSDR 2. Mr. Myers’ statement is not made under oath or penalty of perjury, and in the inter partes context, an “unsworn statement does not constitute testimony,” *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 (TTAB 2018) (internal quotation and quotation marks omitted), but the Examining Attorney addressed Mr. Myers’ statement in her brief, 6 TTABVUE 9, so we will consider it for whatever probative value it may have.

true, “evidence that a design costs more, or has no impact on cost, is irrelevant if the design is found to work better.” *OEP Enters.*, 2019 USPQ2d 309323, at *14. We have found above that Applicant’s proposed mark provides several utilitarian benefits to the user, and “[w]here a design has **use**-related benefits, there is no need to determine whether the design also has **cost**-related benefits.” *Id.* (quoting *Kohler*, 125 USPQ2d at 1503) (internal quotation marks omitted)). Because the evidence relevant to the first two *Morton-Norwich* categories establish functionality, we need not consider the fourth *Morton-Norwich* category of evidence.

5. Summary and Conclusion Regarding Functionality

The ’530 Patent establishes the functional benefits of Applicant’s proposed mark, namely, that the overall design, including the shape, length, and positioning of the strap, and the placement of the magnetic securement devices, enables the user to secure the holster within the waistband, and the gun within the holster, with minimal bulkiness and weight and with maximum comfort. The ’113 Patent suggests an additional benefit, namely, the ability of the user to return the gun to the holster using the magnetic attraction of the securement devices without the need to divert attention from the user’s surroundings. The benefits discussed in the ’530 Patent are touted on Applicant’s website and reflected on third-party websites and in product reviews. The first two *Morton-Norwich* categories of evidence show that Applicant’s proposed mark “is in its particular [configuration] because it works better in that [configuration],” *Kohler*, 125 USPQ2d at 1493 (quoting *Becton, Dickinson*, 102 USPQ2d at 1376), and make it unnecessary to consider the other categories. We find that Applicant’s proposed mark, as a whole, is functional within the meaning of

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Section 2(e)(5) of the Trademark Act, and is thus ineligible for registration on the Supplemental Register.

Decision: The refusal to register is affirmed.