

**THIS OPINION IS NOT  
CITABLE  
AS PRECEDENT OF  
THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

RFC

Mailed: January 29, 2004

Opposition No. 91125525

Wagner Spray Tech Corp.

v.

Graco Inc.

Before Cissel, Chapman and Hairston, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 18, 2003, applicant filed a motion for "clarification/reconsideration and modification of the Board's ruling of July 17, 2003, which granted applicant's motion to amend the identification-of-goods clause in its application, denied opposer's request for additional discovery, and denied both the motion and the cross-motion for summary judgment.

The reason for denying the summary judgment motions was that summary judgment cannot be granted on an unpleaded ground. Opposer had pleaded as grounds for opposition that the color blue which applicant seeks to register is an ornamental feature of the goods (paint sprayers) and does not function as an indication of their source; that the color is an aesthetically functional feature of the goods;

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and that the color has not acquired secondary meaning in connection with the specified goods because applicant has not been the exclusive user of the color in connection with these products. In that the summary judgment motions each sought judgment on the unpleaded ground of de jure functionality, the motions were denied.

Applicant now seeks a statement from the Board that functionality is no longer an issue in this case. Applicant reasserts the contention made in its motion for summary judgment that if functionality does remain an issue, then applicant is entitled to judgment in its favor on this issue because no genuine issue of material fact remains for trial on the ground, and based on the undisputed facts established by the record at this juncture, the mark applicant seeks to register is not functional as a matter of law.

Applicant's motion for reconsideration and modification is premised on the contention that the pleaded basis for the opposition, aesthetic functionality, is no longer recognized as a ground for opposition, so that the Board should rule against opposer on that claim as a matter of law. Additionally, applicant contends that although opposer's motion for summary judgment was based on de jure functionality, applicant's cross-motion was not so limited, and thus should have been interpreted to include all types of functionality claims, including aesthetic functionality,

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a claim on which applicant asserts that it is entitled to summary judgment.

As a final matter, in its reconsideration request, applicant asks the Board to modify its prior ruling to delete our statement that whether customers require applicant or opposer to supply blue sprayers is a genuine issue of material fact remaining for trial. Applicant argues that because the only remaining ground for opposition is opposer's claim that the color blue has not acquired secondary meaning in connection with applicant's products, whether or not customers require applicant or opposer to supply blue sprayers is immaterial to any remaining pleaded ground.

After carefully reviewing our prior ruling in view of applicant's arguments, we are unable to discern any error. The cross-motions for summary judgment were properly denied. Opposer's motion was clearly based on the unpleaded ground of de jure functionality and applicant's motion, argued in terms of "functionality," appeared to be based on the same ground. Even if applicant's motion had been stated in terms that would allow it to be interpreted as a claim that applicant was entitled to judgment in its favor on the issue of aesthetic functionality, there obviously remain genuine issues of material fact on this pleaded ground, so applicant's motion would have been denied on this basis.

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As we pointed out in our ruling, the ground pleaded in the Notice of Opposition is aesthetic functionality, rather than de jure functionality. Contrary to applicant's contention, this may be a recognized ground for opposition. See Wal-Mart Stores Inc. v. Samara Brothers Inc., 529 US 205, 54 USPQ2d 1065 (2000), citing Qualitex Co. v. Jacobsen Products Co, 514 US 159, 34 USPQ2d 1161 (1995). Because neither party established that no genuine issues of material fact exist with regard to this ground, summary judgment in favor of either party is not appropriate. Accordingly, aesthetic functionality remains an issue for trial in this case.

As noted above, in its request for reconsideration, applicant also asks us to modify our ruling to delete the statement that whether customers require applicant or opposer to supply blue sprayers is a genuine issue of material fact which remains for trial. As our discussion above should make clear, applicant's request that we strike this statement must be denied. In view of the fact that aesthetic functionality remains an issue in this case, whether customers require applicant or opposer to supply these products in the color blue is a genuine issue of material fact for trial.

Proceedings are resumed, and trial dates are reset as set forth below.

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30-day testimony period for party  
in position of plaintiff to close: April 5, 2004

30-day testimony period for party  
in position of defendant to close: June 4, 2004

15-day rebuttal testimony period  
for plaintiff to close: August 4, 2004

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after the completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.