UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 13, 2005

Opposition No. **91157923**

Georgia-Pacific Corporation and Fort James Operating Company

v.

Solo Cup Company

Before Hohein, Bottorff and Rogers, Administrative Trademark Judges.

By the Board:

On August 24, 2004, the Board denied applicant's motion for leave to conduct discovery under Fed. R. Civ. P. 56(f) and set applicant's time to respond to opposers' motion (filed April 29, 2004) for summary judgment. Opposers' motion for summary judgment has now been fully briefed.[1]

Opposers contend that applicant's configuration trademark is *de jure* functional "as stated in the U.S. Supreme Court's decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001)." *Notice of Opposition, paragraph 9.* Applicant argues that summary

[1] We have considered opposers' reply brief as it clarifies the issues before us. *See* Trademark Rule 2.127(a).

judgment should be denied because genuine issues of material fact exist as to whether its mark is *de jure* functional.[2]

In support of its position, applicant claims ownership of an expired design patent,[3] which it alleges covers "the overall design appearance of Applicant's lid that is the subject of Applicant's Mark." *Applicant's Opposition to Motion of Summary Judgment,* p. 11. Applicant has also submitted copies of other lids made by alleged competitors of applicant, showing that alternative product designs may exist, and opposers' responses to applicant's interrogatories, wherein opposers have identified manufacturers other than applicant that may have sold similar hot cup lids in the marketplace in the United States. Applicant has further submitted the declarations of two of its officers, who attest to their belief that the costs associated with the

[2] A proposed mark is *de jure* functional if the configuration of the product or its packaging embodies a design feature which is essential to the use or purpose of the article or if it affects the cost or quality of the article. *See TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 34, 58 USPQ2d 1001, 1006 (2001). In determining whether a proposed mark is *de jure* functional, the Board considers the four factors set forth in *In re Morton-Norwich Products, Inc*., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), namely: (1) the existence of a utility patent that discloses 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 alternative designs; and 4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product. *See also Valu Engineering, Inc. v. Rexnord Corp.,* 278 F.3d 1268, 1274, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), *citing Morton-Norwich,* 617 F.2d at 1340-41, 213 USPQ at 15-16.

[3] U.S. Design Patent No. 287,919.

manufacturing process required to make applicant's lid are no less than those costs required to manufacture applicant's competitors' lids.

We find that applicant has shown, by the evidence presented, that genuine issues of material fact exist as to opposers' claim that applicant's mark is *de jure* functional.[4]

In view thereof, opposers' motion for summary judgment is denied. Proceedings herein are resumed and trial dates are reset as follows.

DISCOVERY PERIOD TO CLOSE:	**March 31, 2005**
30-day testimony period for party in the position of plaintiff to close:	**June 29, 2005**
30-day testimony period for party in the position of the defendant to close:	**August 28, 2005**
15-day rebuttal period for party in the position of the plaintiff to close:	**October 12, 2005**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after

[4] The parties should note that the evidence submitted in connection with opposers' motion for summary judgment is of record only for consideration of the motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

completion of the taking of testimony. 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.

New Developments at the Trademark Trial and Appeal Board

- Files of TTAB proceedings can now be examined using TTAB Vue, accessible at http://ttabvue.uspto.gov. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format. Papers filed prior to January 2003 may not have been scanned. Unscanned papers are available for public access at the TTAB. For further information on file access, call the TTAB at 571-272-8500.

- Parties should also be aware of recent changes in the rules affecting trademark matters, including the rules of practice before the TTAB. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) (www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003) (www.uspto.gov/web/offices/com/sol/notices/68fr48286.pdf).

- The second edition (2d ed. rev. 2004) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.