

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

mbm

Mailed: January 22, 2018

Opposition No. 91212425 (**Parent**)

Opposition No. 91220233

Tyco Fire Products LP

v.

Globe Technologies Corporation

Before Mermelstein, Shaw, and Masiello,
Administrative Trademark Judges.

By the Board:

These consolidated proceedings now come before the Board for consideration of the motion for summary judgment of Tyco Fire Products LP (“Opposer”) on its claims that the applied-for mark of Globe Technologies Corp. (“Applicant”) is functional pursuant to Section 2(e)(5) of the Trademark Act; and that it constitutes non-distinctive product configuration that has not acquired distinctiveness under Section 2(f). The motion is fully briefed.

I. Background

Applicant seeks to register the following marks (in application Serial Nos. 85712593 and 85941089, respectively) for “a heat fusible link for use in fire protection

equipment” in International Class 9:¹



Application Serial No. 85712593 includes the following description of the mark: “The mark consists of a configuration of a copper rectangular heat fusible link with rounded edges with a transparent circle at the top and bottom. The oval surrounded by broken lines is not part of the mark.”

Application Serial No. 85941089 includes the following description of the mark: “The mark consists of a configuration of a rectangular heat fusible link with rounded edges with a transparent circle at the top and bottom. The oval surrounded by broken lines is not part of the mark.”

In each case, Opposer opposes registration of Applicant’s mark on the grounds that the mark is functional pursuant to Section 2(e)(5) of the Trademark Act; the mark is not distinctive and has not acquired distinctiveness and therefore does not operate as a trademark; and fraud.

In its answers, Applicant denied the salient allegations of the notices of opposition.

¹ Application Serial No. 85712593 is the subject of Opposition No. 91212425 and Serial No. 85941089 is the subject of Opposition No. 91220233. Application Serial No. 85712593 was filed August 24, 2012 and Application Serial No. 85941089 was filed May 23, 2013, each alleging December 31, 1992 as both the date of first use and the date of first use in commerce. Each application includes a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

Opposer has moved for summary judgment on its claims that Applicant's involved mark is functional and that it is a non-distinctive product configuration that has not acquired distinctiveness.

II. Pleading Matters

As an initial matter, Applicant asserts various affirmative defenses. As its first and third affirmative defenses, Applicant contends that Opposer failed to state a claim upon which relief can be granted, including fraud. These are not true affirmative defenses, because they relate to an assertion of the insufficiency of the pleading of Opposer's claims rather than a statement of a defense to a properly pleaded claim. Moreover, the Board finds that Opposer has sufficiently pleaded its standing, as well as its claims of functionality, fraud, and lack of distinctiveness. As its second affirmative defense, Applicant submits that Opposer's claims are barred by the doctrine of unclean hands. The Board finds that inasmuch as Applicant has failed to set forth any allegations of conduct on the part of Opposer that would constitute unclean hands, the defense lacks the necessary specificity. *See Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987). Finally, Applicant attempted to reserve the right to assert additional affirmative defenses at some unspecified time in the future. A party cannot reserve unidentified defenses since it does not provide a plaintiff with fair notice of such defenses. Accordingly, each of Applicant's affirmative defenses is hereby **stricken**.

III. Summary Judgment Motion

In support of its motion for summary judgment, Opposer submitted the declaration of Patricia Iannotti (Manager, Employee and External Communications

for Factor Mutual Insurance Company), who attaches, *inter alia*, images of a display of historic sprinklers from the 1880s through the present, featuring examples of fusible links. Opposer also submitted the declaration of Matthew Miller (Engineering Technician Supervisor for Opposer), who attaches, *inter alia*, images of third-party fusible links obtained by Opposer.

Additionally, Opposer submitted the declaration of Sean McConnell (counsel for Opposer), who attaches, *inter alia*, the following: (1) excerpts from the deposition of Manuel R. Silva, Jr., Opposer's expert witness; (2) copies of portions of the file history of Applicant's Serial No. 85712593; (3) documents produced by Opposer in response to Applicant's discovery requests; (4) Applicant's responses to Opposer's discovery requests; (5) excerpts from the deposition of Dr. Carl J. Boehlert, Applicant's rebuttal expert witness; (6) documents produced by Applicant in response to Opposer's discovery requests; (7) copies of expired U.S. utility patents; (8) copies of portions of the file history of Applicant's Serial No. 85470397.

In opposition to Opposer's motion for summary judgment, Applicant submitted the declaration of James R. Duby (counsel for Applicant), who attaches, *inter alia*, the following: (1) documents produced by Applicant in response to Opposer's discovery requests; (2) copies of the file history of Applicant's Serial No. 85712593; (3) copies of the file history of Applicant's Serial No. 85941089; (4) the expert report of Richard H. Zaitlen; (5) the rebuttal expert report of Dr. Boehlert; and (6) excerpts from the deposition of Mr. Silva.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceedings and the arguments and evidence submitted with respect to Opposer's motion for summary judgment.

A. Summary Judgment Standard

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c).

A movant for summary judgment carries the burden of proof in regard to its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the function of the Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. *See* TBMP § 529.01 (June 2017) and cases cited therein. When the moving party has supported its motion with a sufficient showing that, if unopposed, indicates there is no genuine dispute of material fact and that the moving party is entitled to judgment as a matter of law, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary

judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

B. Decision

Applicant's proposed mark is the configuration of a fusible link, which is used in fire protection equipment. 58 TTABVUE 4. The proposed mark in Application Serial Nos. 85712593 is identical to the proposed mark in 85941089, save for the fact that Application Serial No. 85712593 claims to be made of copper and the color copper, while Application Serial No. 85941089 is neither described as "copper" nor makes any claim to color. As explained by Opposer's expert, Mr. Silva, the fusible link consists of two plates placed under tension or load. 62 TTABVUE 6. The plates are held together by a fixed heat-sensitive material, which in the event of a fire melts or breaks once the ambient temperature reaches a certain degree, causing the plates to separate. *Id.* When the plates separate the fire detection or suppression system is activated. *Id.*

1. Standing

We first consider whether Opposer has standing to bring these opposition proceedings. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). As interpreted in binding precedent, a plaintiff must have a "real interest" in the outcome of the proceeding and a

“reasonable basis” for its belief of damage. *See Empresa Cubana del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie*, 50 USPQ2d at 1025-26); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). Here, the parties do not dispute that Opposer is a competitor of Applicant’s (66 TTABVUE 14); thus, there is no dispute of material fact as to Opposer’s standing to bring these consolidated opposition proceedings. *See AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1832-33 (TTAB 2013); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

2. Functionality

A mark is unregistrable under Section 2(e)(5) of the Trademark Act where it “comprises any matter that, as a whole, is functional.” Functional matter cannot be registered, even with a showing that consumers recognize the proposed mark as a source identifier. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001).² There are two forms of functionality: utilitarian functionality and aesthetic functionality. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 13 n.1 (CCPA 1982); *In re Florists’ Transworld Delivery Inc.*, 106 USPQ2d 1784, 1786-87 (TTAB 2013). The functionality doctrine is intended to

² Opposer appears to conflate the issues of functionality and acquired distinctiveness. Opposer contends that Applicant conceded that its designs are functional, because it amended its applications to claim acquired distinctiveness under Section 2(f) of the Trademark Act. 58 TTABVUE 10. In fact, the issues are not related. A finding of functionality is an absolute bar to registration. But a product design that is not functional may be registered, provided that a showing of acquired distinctiveness is made. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000). Therefore, amending the applications to claim acquired distinctiveness does not constitute a concession that the mark is functional.

preserve competition. *See Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1428 (Fed. Cir. 2002).

Generally, a product design or product feature is considered to be functional in a utilitarian sense if it is (1) “essential to the use or purpose of the article,” or if it (2) “affects the cost or quality of the article.” *TrafFix*, 58 USPQ2d at 1006 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). A functional feature is one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995). In *TrafFix*, the Supreme Court confirmed the “*Inwood* formulation” as the “traditional rule” of functionality. 58 USPQ2d at 1006. In making a determination as to whether a proposed mark is functional in a utilitarian sense, the following factors are often relevant:

- (1) The existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) Advertising by the applicant that touts the utilitarian advantages of the design;
- (3) Facts pertaining to the availability of alternative designs; and
- (4) Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Prods., 213 USPQ at 15-16. *See also In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372 (Fed. Cir. 2012); *Val Eng'g*, 61 USPQ2d at 1426. These well-known “*Morton-Norwich* factors” are “legitimate source[s] of evidence to determine whether a feature is functional.” *Valu Eng'g*, 61 USPQ2d at

1427. However, the Supreme Court has made it clear that the standard for functionality is set forth in *Inwood*, *i.e.*, whether a feature is “essential to the use or purpose of the device or ... affects the cost or quality of the device,” and that if functionality is properly established under *Inwood*, further inquiry into facts that might be revealed by a *Morton-Norwich* analysis will not change the result. *TrafFix*, 58 USPQ2d at 1006 (“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.”). Functionality is a question of fact and depends on the totality of the evidence in each particular case. *Valu Eng’g*, 61 USPQ2d at 1424; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); TBMP § 1202.02(a)(v). In any given case, any of the four *Morton-Norwich* factors might not necessarily be relevant to a finding of functionality, nor do all four factors have to weigh in favor of functionality to support a refusal. *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017); *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015). Based upon a careful review of the parties’ submissions, the Board finds that there is no genuine dispute of material fact that the configuration of Applicant’s goods is essential to the use and purpose of the goods and affects the cost and quality of the article under the standard set forth in *Inwood/TrafFix*.

In support of its motion for summary judgment, Opposer relies in significant part upon expired Patent No. 5120152 for a fusible link, which was assigned to and owned by Applicant. 63 TTABVUE 138-142; 66 TTABVUE 18. Opposer also attaches numerous other expired utility patents for fusible links owned by third parties,

Opposition Nos. 91212425 and 91220233

namely, U.S. Pat. Nos. 5686878, 729306, 1092562, 1092562, 1209574, 1613453, 2730900, 3061016, 3195647, and 3547201. It is Opposer's contention that the expired patents establish that Applicant's product configurations are functional.

Applicant argues to the contrary and asserts that although the '152 Patent and other third-party patents disclose utilitarian advantages of some of the features of the fusible links in general, none of the patents require the links or their individual components to be any particular shape or design. Applicant contends that its specific design—rectangular-shaped plates with rounded edges, circular holes, and, in the case of Application Serial No. 85712593, the color copper—are non-functional design choices that may be registered.

A utility patent that discloses the utilitarian advantages of a design is strong evidence that the disclosed features are functional. *TrafFix*, 58 USPQ2d at 1005. A utility patent need not “claim the exact configuration for which trademark protection is sought in order to undermine an applicant's assertion that an applied-for mark is not de jure functional.” *Becton, Dickinson*, 102 USPQ2d at 1377; *Change Wind Corp.*, 123 USPQ2d at 1456; *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1432 (TTAB 2016) (“We find Applicant's description of the invention in the utility patent, taken together with the drawings therein, to be on point with the relevant portion of the description and drawing of the tool in the present application for this product configuration motion mark.”).

Moreover, in considering any patent, the Board is not limited to consideration of the claims. *See Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d

1912, 1920 (TTAB 2011), and cases cited therein; *M-5 Steel Mfg., Inc. v. O'Hagin's, Inc.*, 61 USPQ2d 1086, 1096 (TTAB 2001), and cases cited therein; *cf. In re Shenango Ceramics, Inc.*, 362 F.2d 287, 150 USPQ 115, 120 (CCPA 1966) (“Although the patent claimed the middle or vibration-throttling rib in combination with a pedestal or foot rib, the result is no different where the configuration is present on a plate having no pedestal rib. ... Thus the result here is not dependent on the precise scope of the patent claims.”). A patent therefore need not *require* use of a specific design to have demonstrated its utilitarian purpose. *See Kistner Concrete*, 97 USPQ2d at 1920; *In re Edward Ski Prods., Inc.*, 49 USPQ2d 2001, 2003 (TTAB 1999).

The inclusion of a nonfunctional feature does not make an otherwise functional configuration distinctive and therefore registrable. *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748 (Fed. Cir. 2007). “[A] mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.” *Becton, Dickinson*, 102 USPQ2d at 1376. As the Federal Circuit has stated:

[B]efore an overall product configuration can be recognized as a trademark, the *entire* design must be arbitrary or non de jure functional. The reason for this is self-evident — the right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were accorded trademark protection because they included a few arbitrary and nonfunctional features.

Textron, Inc. v. U.S. Int'l Trade Comm'n, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985) (internal citations omitted).

It is clear from an examination of the evidence submitted by Opposer that many of the patents disclose the utilitarian function of the various elements of Applicant's

involved mark. Although the Federal Circuit has found that a finding of functionality should be based on an analysis of the design in its entirety and should not be based solely on a dissection of the individual features of a design, the Federal Circuit has also recognized that it is often necessary to consider functional aspects of individual design elements as part of the determination of the functionality of the overall design configuration. *See Becton, Dickinson*, 102 USPQ2d at 1377 (“[C]laim 4 of the ‘446 patent shows the utilitarian nature of at least two prominent features of BD’s mark”); *In re Teledyne Indus., Inc.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982). In determining functionality in this case, the Board therefore considers the undisputed evidence proffered by the parties with respect to individual features of the designs to inform the Board’s finding of the functionality of the overall designs.

To the extent Applicant claims the configuration of two symmetrical, partially overlapping plates as an element of its proposed mark, there is no dispute that this configuration serves a utilitarian function, as many of the utility patents demonstrate. Applicant does not dispute the fact that its plates do, in fact, overlap each other, and such design is evident from the drawing of the mark. The utility patents submitted by Opposer clearly tout the functionality of this design. Specifically, the ‘152 Patent discloses a fusible link having “two generally oval members in overlying relationship, the two members having relatively flat surfaces confronting one another.” 63 TTABVUE 138. The ‘152 and ‘878 Patents further disclose the overlying plate design.

The utility patents also disclose the functionality of using two identical plates in the fusible link manufacture. The '878 Patent claims that manufacturing identical plates “reduces manufacturing costs and ensures that the fusible link is assembled in only one way.” 63 TTABVUE 148. The '574 Patent also recommends making identical plates for cheapness and reliability. 63 TTABVUE 162. Accordingly, the evidence of record establishes that the use of identical, overlying plates serves a utilitarian function.

The drawing of each mark includes two horizontal rectangular/oval shapes within the body of the fusible link, one of which is disclaimed. The '152 Patent and others explain that each plate has one projection and one slot, while the other plate has an opposite corresponding slot and projection, enabling the pieces to fit together. 63 TTABVUE 140-141. There is no genuine dispute of material fact that both the slot and projection are functional. The '152 Patent and the '878 Patent explain that the interaction of the projection and corresponding slot prevents creeping of the plates under load. 63 TTABVUE 140, 148.

Applicant also claims “transparent circles” at opposite ends of each mark. The record shows that these “circles” are actually holes in the plates. There is no genuine dispute of fact that these holes are functional as they are the insertion points for hooks, wires, or other fasteners that connect the fusible links to fire suppression devices or systems. *See, e.g.*, 58 TTABVUE 14. Applicant contends that the circular shape of the holes is not functional and that none of the utility patents require that the holes be circular, arguing that they could be square, rectangular, diamond, or any

other shape. Although none of the patents specify that the holes must be circular in shape, the utilitarian function of a circular hole is apparent from the '152 Patent and numerous other third-party patents. The preferred embodiment of the '152 Patent shows circular shaped holes. 63 TTABVUE 139-40. The Board is mindful that drawings in a patent may include arbitrary design features that are not functional. *See Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 162 USPQ 552, 555-56 (CCPA 1969). In this instance, however, the drawings demonstrate that a common hook having a circular cross-section may be inserted into the circular holes to connect the link to the fire suppression system. 63 TTABVUE 139. Moreover, the '152 Patent states that the apertures are required "for the accommodation of a first hook-like attachment member." 63 TTABVUE 140. The '152 patent therefore appears to describe holes capable of receiving a circular shaped object, such as a hook. It follows that the circular hole depicted in the drawing of the patent is the most logical and effective choice.

Other third-party patents similarly depict or describe circular holes. One of the claims of the '562 Patent describes circular openings in the fusible link and also states that openings should be of "uniform diameter." 63 TTABVUE 159. The '562 Patent describes the holes in each plate as "eyes" and includes a drawing of the invention featuring circular-shaped holes. 63 TTABVUE 157-58. The '900 Patent similarly describes the holes as "eyes" capable of receiving a "hook" or other element. 63 TTABVUE 170.

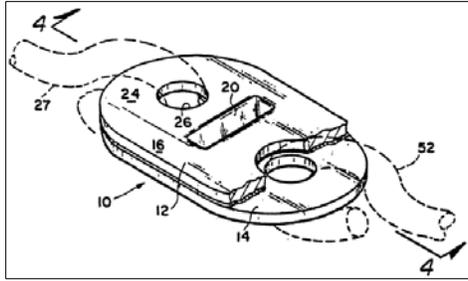
As explained in the '562 Patent, "the relative proportions of the links, openings and holding member, can be varied to suit the conditions demanded and the work to be performed." 63 TTABVUE 159. Thus, it is clear that the precise nature and shape of the hole is dictated by function, that is, the shape of the hole will be dictated by the nature of the fastener to be accommodated by the hole, and as depicted in several of the patents, it is expected that the fastener may have a circular cross-section and best fitted to a circular hole.

Opposer's expert further confirms that the shape of the holes serves a utilitarian function. Mr. Silva opines that circular holes are preferred because they are consistently wide holes that make installation easier from a variety of angles and because the circular hole "creates standard and stable tension points on the fusible link," which is consistent with the '562 Patent's claim that the holes should be of uniform diameter, which could logically only include circles. Mr. Silva further notes that circular holes are less likely to fray connectors, because they are uniform and free of sharp corners. 66 TTABVUE 87-88. Although Applicant contends any shape could be made free of sharp corners, a circle is the most logical and conventional choice.

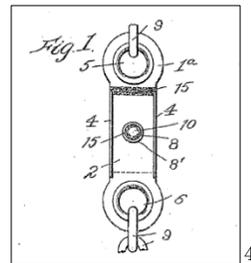
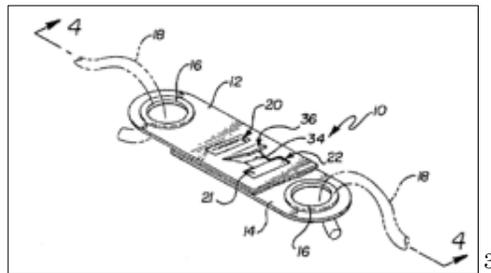
Applicant submits the rebuttal expert report of Dr. Boehlert, who provides that the holes could be squares, diamonds, or polygonal shapes, rather than circles. 66 TTABVUE 17. Although Applicant is correct that the holes *could* be another shape, Applicant does not raise a genuine dispute concerning the utilitarian superiority of a circular hole for use with a common hook, wire, or other fastener having a circular

cross-section, as shown in the '152 Patent and other third-party patents. The patent may not claim any specifically shaped hole, but its drawings disclose the obvious utility of the circular hole. *Cf. In re Rolf Dietrich*, 91 USPQ2d 1622, 1633 (TTAB 2009) (“The fact that the patents may encompass a wide variety of [bicycle wheel] spoking patterns means only that the patents are broad in scope, not that applicant’s particular applied-for design is not functional.”). Moreover, a circle represents one of a very limited number of common geometric shapes for a hole. Although it may be possible to manufacture fusible links with different shaped holes, Applicant has not rebutted Opposer’s evidence that the circular shape affects the use and function of the fusible link. *Cf. Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 96 USPQ2d 1404, 1408 (7th Cir. 2010) (finding circular shape of a towel to be functional in part because there are a limited number of simple geometric shapes).

Applicant also maintains that a non-functional feature of its fusible links is the rounded ends of the plates, which, according to Applicant, are a design choice not dictated by function and not covered by any of the patents. Although the rounded ends of the plates are not *claimed* in any of the utility patents, the rounded ends are described in the specification and the preferred embodiment, and are shown in the drawings of both the '152 Patent and other third-party patents. The '152 Patent describes its invention as having “oval plates” with “U-shape” ends. 63 TTABVUE 141:

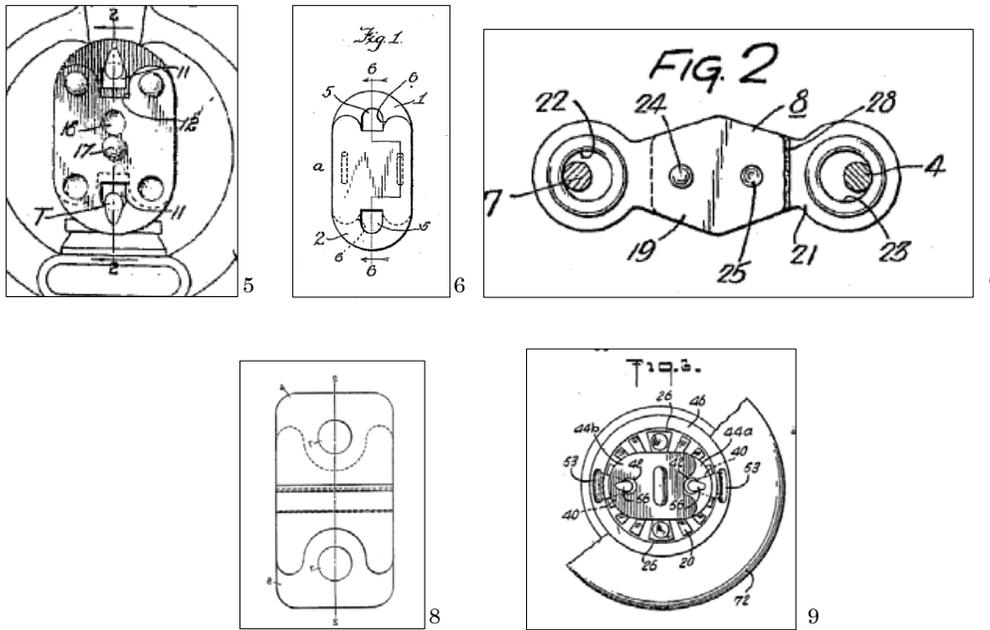


The '562 Patent discloses "round end links." 63 TTABVUE 158. The drawings of the inventions in numerous other third-party patents also clearly show links with rounded ends:



³ 63 TTABVUE 144, '878 Pat.

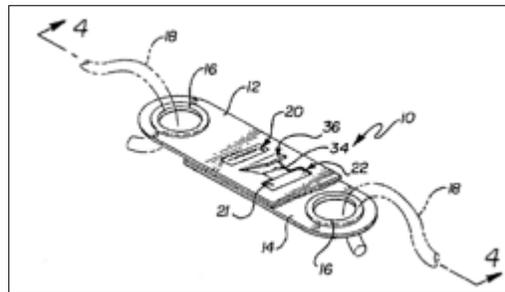
⁴ 63 TTABVUE 157, '562 Pat.



Although none of the utility patents explain the reasoning for the rounded edges, it is clear that at least some of them specifically disclose rounded edges as part of the nature of the invention. Opposer’s expert, Mr. Silva, submits that rounded edges serve a utilitarian function because they are less likely to damage packaging and are easier to handle. 66 TTABVUE 17. Although Applicant’s rebuttal expert, Dr. Boehlert, contends that rounded edges are not necessary and the same effect could be achieved with a plate that is simply “smooth and free of sharp edges,” 66 TTABVUE 17, Applicant does not rebut Opposer’s evidence that the rounded edges serve a functional purpose, irrespective of the availability of other designs. It is also not clear how the plates could be “free of sharp edges” without being rounded in some fashion.

⁵ 63 TTABVUE 161, ‘574 Pat.
⁶ 63 TTABVUE 165, ‘453 Pat.
⁷ 63 TTABVUE 169, ‘900 Pat.
⁸ 63 TTABVUE 172, ‘016 Pat.
⁹ 63 TTABVUE 176, ‘647 Pat.

Applicant further contends that its plates are in a “rectangular” shape, which is not claimed by any of the patents and which purportedly serves no utilitarian purpose. By referring to the shape of its product as “rectangular” Applicant appears to be referring to the fact that the fuse has two straight, parallel sides and is longer in one dimension than the other. The drawing of Applicant’s ‘878 Patent in fact shows plates having straight, parallel sides and rounded ends:



It is Applicant’s contention that other shapes, such as a square, could be used; however, the record demonstrates that many of the third-party patents demonstrate the fusible links must fit within the fire suppression or detection device or system in order to operate. As the many patents of record show, we live in a world of straight edges and right angles. The straight parallel sides of Applicant’s goods would be essential to fitting the goods into mechanisms that have limited space. Competitors who are required to eschew the use of straight, parallel sides in order to avoid infringing upon Applicant’s trademark rights would be put to “a significant non-reputation-related disadvantage.” *Qualitex*, 34 USPQ2d at 1164.

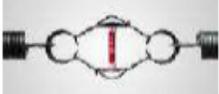
The utilitarian function of Applicant's design is further indicated by the common use of the rectangular/rounded shape by third parties. Some of the examples provided by Opposer include the following:¹⁰



Applicant, on the other hand, has pointed to other third-party fusible links as evidence of other available alternative designs. Applicant's examples include fusible links with plates that are not overlapping, plates that are not rectangular with rounded edges, and plates that have non-circular holes; however, many of Applicant's examples have at least one of these features. Some of Applicant's examples include:¹¹

¹⁰ 60 TTABVUE 6, 7, 12, 20, 29, 36, 44, 47, 50, 56, 66.

¹¹ 66 TTABVUE 20.

Tyco FL-1	Job Link	Elsie Model C	Elsie Model D	Elsie Model E
				
Elsie Model Y	NCA HVC	SR ETL	TL Fusible Links	EA link
				

It is clear from the record that, although other shapes are possible, the specific shape of the fusible link may be dictated by function. Applicant has not rebutted Opposer’s contention that in certain applications, fusible links with straight, parallel edges and circular holes are one of the few available alternatives. Although small variations may be made to accommodate the system or device, available options will be limited. *See* 61 TTABVUE 26 (the fusible links must meet certain requirements and undergo certain tests (e.g., temperature, response-time, corrosion, and strength tests) to be approved by a third-party certifying agency before they can be sold.); 58 TTABVUE 15 (noting that the length and width of the fusible links are limited because increasing the mass of the link will increase response time and because the links must be designed to fit into existing fire suppression systems); 61 TTABVUE 61 (glass bulb devices are an alternative to soldered plates, but glass bulbs are not desirable in restaurant systems).

Finally, Applicant contends that the design presented in Application Serial No. 85712593 is not functional for the additional reason that it contains a claim to the color copper. There is no genuine dispute of material fact that the copper color of the

Applicant's links is the naturally occurring result of the use of commercial bronze, which is composed of 90% copper. 58 TTABVUE 14; 63 TTABVUE 81 (commercial bronze is composed of roughly 90% copper); *id.* at 49 ("Globe states that the color copper results from a natural alloy.").

Although none of the utility patents provided by Opposer claim or disclose the use of copper or commercial bronze specifically, a review of the patents indicates that the choice of material is limited and made with an eye to functionality. The '152 Patent describes its preferred embodiment as being composed of "high temperature-resistant metal" and the '878 Patent provides that its links are constructed from sheet metal stock. 63 TTABVUE 140, 148. The '306 Patent, although it does not disclose the use of copper or bronze for the fusible links themselves, does explain the advantages of constructing the material in a sprinkler set of copper and bronze, which reduces corrosion and prevents the parts from sticking together. 63 TTABVUE 155. The '562 Patent states that the links are made of "some non-corrosive material, such as brass or the like." 63 TTABVUE 158. The '574 Patent states that the links should be made of a "fusible metal." 63 TTABVUE 162. The '453 Patent discloses that the plates are "preferably stamped from sheet phosphor bronze or some other suitable sheet metal." 63 TTABVUE 166.

The patents cited above therefore indicate, as further confirmed by Applicant's expert Mr. Silva, that copper-containing metals are useful materials for the manufacture of the links. As explained by Mr. Silva, commercial bronze is a strong, effective, and comparatively cheap option for manufacturing fusible links. 62

TTABVUE 9-10. Applicant does not dispute that the color is the result of the natural coloring of the commercial bronze, nor does Applicant appear to contest that commercial bronze has utilitarian function in a fusible link—rather, Applicant’s rebuttal expert contends that fusible links *can* be made of other metals, specifically, nickel and nickel alloys, pure copper and other copper alloys, stainless steel, carbon steel, and bismuth or cadmium based metals. 66 TTABVUE 451-52. Competitors who are required to eschew the use of copper, bronze, or other metals having a copper-like color in order to avoid infringing upon Applicant’s trademark rights would be put to “a significant non-reputation-related disadvantage.” *Qualitex*, 34 USPQ2d at 1164. Moreover, Applicant’s advertising touts the advantages of using unpainted links “[t]o assure maximum Performance & Safety” (63 TTABVUE 127), which demonstrates that requiring a competitor to paint its links to avoid infringing upon Applicant’s trademark rights would also put the competitor at “a significant non-reputation-related disadvantage.” *Id.*

The Board finds there is no genuine dispute of material fact that the copper color of Applicant’s mark is dictated by a functional feature of the goods. *See C5 Medical Werks, LLC v. CeramTec GmbH*, 249 F. Supp. 3d 1210, 1215-16 (D. Colo. 2017) (finding naturally occurring color pink of material used in artificial hip implants to be functional); *see also Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425 (TTAB 2007) (finding the color purple to be functional where the color was both naturally occurring and the result of artificial dying to color-code abrasives).

C. Conclusion

After careful consideration of the argument and evidence submitted by the parties, we find no genuine dispute of material fact on the issue of functionality. The configuration of Applicant's goods is, as a whole, essential to the use and function of Applicant's goods and affects the cost and quality of them. Opposer is accordingly entitled to judgment on its Trademark Act Section 2(e)(5) claim.¹² See *Greenhouse Sys. Ins. v. Carson*, 37 USPQ2d 1748 (TTAB 1995) (granting summary judgment in favor of opposer where there was no genuine dispute of material fact that only a limited number of alternatives were available and "allowing applicant to register one of those designs as a trademark would hinder competition."); *In re Lincoln Diagnostics Inc.*, 30 USPQ2d 1817, 1824 (TTAB 1994).

In view of the foregoing, Opposer's motion for summary judgment is **GRANTED**.

Insofar as the Board has granted Opposer's motion for summary judgment and found that Applicant's mark is functional pursuant to Section 2(e)(5) of the Trademark Act, the Board need not reach the question of acquired distinctiveness. See *TrafFix*, 58 USPQ2d at 1007 ("Functionality having been established, whether MDI's dual-spring design has acquired secondary meaning need not be considered."); *Becton, Dickinson*, 102 USPQ2d at 1372 ("We need not reach the issue of acquired distinctiveness. Even if the mark had acquired the requisite distinction, it fails

¹² Where functionality is properly established under *Inwood*, further inquiry into the other categories of evidence listed in *Morton-Norwich* is not necessary. *TrafFix*, 58 USPQ2d at 1006 ("Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.")

Opposition Nos. 91212425 and 91220233

registrability because we affirm the Board's conclusion that the mark as a whole is functional."). *See M-5 Steel Mfg. Co.*, 61 USPQ2d at 1097.

Accordingly, judgment is entered against Applicant, the oppositions are sustained, and the applications are refused registration.